

Decision for dispute CAC-UDRP-105050

Case number	CAC-UDRP-105050
Time of filing	2022-12-15 09:43:49
Domain names	shopdtswiss.com, bikedtswiss.com, dtswissdiscount.com, dtswissbike.com, storedtswiss.com, dtswissale.online

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	DT SWISS AG
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Complainant representative

Organization	Convey srl
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Respondents

Organization	Rhsjde Sgcge
Name	Kbfhh Ubdee
Name	Bbxdm Bbxdm
Name	Uncsj Ybcds
Name	Jbcged Ybder

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is one of the world's leading manufacturers of high-performance components for the segment of bicycles and is also the owner of the DT SWISS trademark including but not limited to the followings:

- European Union Trademark #001805332 – DT SWISS – class 9, 12, 25, 28;
- European Union Trademark #011178662 - DT SWISS - class 9;
- International Trademark #1144607B – DT SWISS - class 12 and 25;
- International Trademark #1144607 – DT SWISS - class 12 and 25;
- United States Trademark #4468251 - DT SWISS – class 12 and 25.

The trademark DT SWISS, registered since many years, is distinctive and well known all around the world in the sector of shoes and apparels.

The Complainant has been extensively using the "DT SWISS" denomination on all internet environments including and not limited to the company's official website <https://www.dtswiss.com> - among which are <dtswiss.fr>, <dtswiss.us>, <dtswiss.it> and <dtswiss.ch> and its official accounts on the major social networks such as Facebook, Instagram, YouTube, LinkedIn and Strava.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is one of the world's leading manufacturers of high-performance components for the segment of bicycles. In addition to the company's headquarters in Biel, it also has a network of production and sales sites in Germany, Poland, France, the USA and Taiwan.

The 'DT' in DT SWISS stands for Drahtwerke Tréfileries, the German and French words for 'wireworks'. So, overall, the name means 'wireworks made in Switzerland' and the headquarter is indeed in Biel, the biggest bilingual town in Switzerland, where many of Switzerland's finest watchmakers are based.

In 1994, Frank Böckmann, Maurizio D'Alberto and Marco Zingg founded the Complainant following a management buyout from the Biel-based "Vereinigte Drahtwerke".

DT Swiss's predecessor, the United Wireworks company, can be traced back to the 17th century. In 1994, a management buyout of its spoke business laid the foundations for the brand we know today. The subsequent year, the Complainant launched his patented hubs which was followed a hub lineup in 1999 and the start of nipple production.

The first mountain bike shocks were produced in 2001 and rims began in 2003, followed by complete wheels in 2004 and, finally, forks in 2006.

With a boom in the global market, modern materials and production methods, the Complainant, having around 900 employees now, has established production sites across the world – there's Grand Junction, Colorado, DT Asia in Taiwan, DT France, DT Swiss Deutschland GmbH and DT Poland as the wheel-building center. All design, development and product testing are still centered in Biel.

The Respondents, Rhsjde Sgcge, Kbfhh Ubdee, Bbxdm Bbxdm, Uncsj Ybcds, Jbcged Ybder, are all located in Hong Kong.

The Registration Date of the disputed domain names are as below:

shopdtswiss.com: 2022-06-01
bikedtswiss.com: 2022-06-01
dtswissdiscount.com: 2022-06-02
dtswissbike.com: 2022-09-26
storedtswiss.com: 2022-07-27
dtswissale.online: 2022-06-02

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

The Complainant claims rights in the DT SWISS marks through its global trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

The Complaint contends that addition of generic terms such as "bike", "discount" and "shop", in the disputed domain names are non-distinctive and the generic top-level domains ("gTLDs") do not affect the confusing similarity for the purposes of paragraph 4(a)(i) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of proof then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant claims that the Respondents are not licensees, authorized agents of the Complainant or in any other way authorized to use Complainant's trademark. Specifically, the Respondents are not authorized resellers of the Complainant and have not been authorized to register and use the disputed domain names. In addition, the Complainant further claims that the Respondents are not commonly known by the disputed domain names as individuals, business or other organization and his family name does not correspond to DT SWISS or the disputed domain names.

The Complainant further asserts that there is no disclaimer on the websites resolved by the disputed domain names as to the Respondent's lack of relationship with the Complainant. The use could be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names. Such wilful conduct clearly demonstrates, to the contrary, that Respondent is not intended to use the disputed domain names in connection with any legitimate purposes.

The Complainant also alleges that the Respondent is offering counterfeited goods of the Complainant via the websites resolved by the disputed domain names which cannot be deemed a legitimate non-commercial or fair use without intent for commercial gain. The sale of counterfeit products is a circumstantial evidence supporting the illegal Respondent activity and, consequently the absence of no rights or legitimate interests in respect of the domain names as indicated under paragraphs 2.13.2 and 3.1.4 of WIPO Overview 3.0.

The Panel finds that the Complainant has established a prima facie case that the Respondents have no rights or legitimate interests in the disputed domain names. The burden of proof has been shifted to the Respondents to prove that they have right or legitimate interests to the disputed domain names. However, the Respondents have not submitted an official response to rebut the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

The Complainant argues that Respondent had actual knowledge of the Complainant's rights in its asserted trademark that it has registered and intensive used of the trademark DT SWISS since many years. The Panel notes that the disputed domain names were registered in 2022 which is 20 years after the registration of the first DT SWISS trademark.

The Complainant asserts that the Respondents intentionally use the disputed domain names to sell counterfeit DT SWISS goods at a heavily discounted price. Using a confusingly similar domain name in a manner disruptive of a complainant's business by trading upon the goodwill of a complainant for commercial gain evinces bad faith under paragraph 4(b)(iii) & (iv) of the Policy. See *TOD'S S.p.A. vs. , 102869* (CAC 2020-03-06) ("The Panel finds that the Respondents have used the disputed domain names intentionally to attract Internet users to their websites offering counterfeit and other competing products for commercial gain by creating a likelihood of confusion with the Complainant's marks as to the source of the Respondents' website and the products promoted on it."); see also *Under Armour Inc. vs. Web Commerce Communications Limited/Whoisprotection.cc, 104892* (CAC 2022-11-11) ("Beyond this, the fact that prima facie counterfeit "UNDER ARMOUR" branded shoes and apparel were offered for sale on the website corresponding to (most of) the disputed domain names indicates that the Respondents were fully aware of the Complainant's trademarks reputation and association with the Complainant. This also indicates that Respondents' purpose in registering the disputed domain names was solely to capitalize on the reputation of these trademarks by diverting internet users seeking products of the Complainant to their own commercial website."). Complainant provides a screenshot of the resolving webpage, which displays the DT SWISS mark and various images of bike components for sale. Accordingly, the Panel agree that Respondent disrupts Complainant's business and attempted to commercially benefit off Complainant's mark in bad faith under paragraph 4(b)(iii) & (iv) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

PRELIMINARY FINDINGS - CONSOLIDATION:

Pursuant to Paragraph 10(c) of the Rules that a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules. The Rules further state that Respondent means the holder of a domain-name registration against which a complaint is initiated.

The Complainant submits that the followings are the same among the disputed domain names:

Phone number, city, state and zip code are identical;
Registrar, i.e. Name.com, Inc.;
Name server, i.e. cloudflare.com;
Opening hours, same pattern of the copyright disclaimer "Copyright 2022 © www. + domain name";
The ways of payment;
Lay-out of the websites, same components offered for sale.

The Respondent has not submitted a timely Response.

The Panel notes that Complainant's DT SWISS trademark appears in each of the 6 disputed domain names and the corresponding websites.

The Panel agrees that despite the registrants' emails may not be the same on the WHOIS for each of the disputed domain names, all of registrants all located in Hong Kong and are having the same registrant phone number which convincingly evidences that all of the disputed domain names are very likely under common control.

Having considered the key considerations listed out under Article 4.11.2 of the WIPO Overview 3.0, the Panel concludes that the consolidation request be accepted pursuant to paragraphs 3 and 10 (e) of the Rules.

PRINCIPAL REASONS FOR THE DECISION

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **shopdtswiss.com**: Transferred
2. **bikedtswiss.com**: Transferred
3. **dtwissdiscount.com**: Transferred
4. **dtwissbike.com**: Transferred
5. **storedtswiss.com**: Transferred
6. **dtwissale.online**: Transferred

PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION **2023-01-26**

Publish the Decision
