

Decision for dispute CAC-UDRP-105367

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| Case number | CAC-UDRP-105367 |
| Time of filing | 2023-04-24 08:24:07 |
| Domain names | cycledtswiss.com, dtswisscycle.com, outletdtswiss.com, soldesdtswiss.com, velodtswiss.com |

Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |
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Complainant

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| Organization | DT SWISS AG |
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Complainant representative

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| Organization | Convey srl |
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Respondents

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| Name | Bbxdm Bbxdm |
| Name | Dongyue Qiu |
| Name | Ridong Zhao |
| Name | Minmin Jiang |
| Name | Minmin Jiang |

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 the owner of various trademark registrations DT SWISS:

- European Union Trademark n. 001805332 – DT SWISS – Cl. 9, 12, 25, 28;
- European Union Trademark n. 011178662 - DT SWISS - Cl. 9;
- International Trademark n. 1144607B ext. in PRC – DT SWISS - Cl. 12 and 25;
- International Trademark n. 1144607 – DT SWISS - Cl. 12 and 25;
- United States Trademark n. 4468251 - DT SWISS – Cl. 12 and 25.

The disputed domain names were registered between September and November 2022

<cycledtswiss.com> on September 26, 2022;

<dtswisscycle.com> on October 31, 2022;

<outletdtswiss.com> on November 1, 2022;

<soldesdtswiss.com> on October 11, 2022;

<velodtswiss.com> on October 11, 2022.

PARTIES CONTENTIONS

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

The Complainant claims that it 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.

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 trademark DT SWISS, registered since many years, is distinctive and well known all around the world in the sector of manufacturing of cycling components.

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.

The disputed domain names were registered by the Respondent between September and November 2022, without authorization of Complainant, and have been pointed to websites where Complainant's counterfeit products are offered for sale.

The Complainant addressed a cease-and-desist letter to the owner of the disputed domain names in order to notify the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer, of the disputed domain names to the Complainant. The Respondent has not deemed appropriate to answer.

The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights

- The disputed domain names are confusingly similar to trademarks in which Complainant has rights. The disputed domain names incorporate the whole of the Complainant's trademark DT SWISS and the fact that they include non-distinctive elements, such as "cycle", "soldes" and "velo" and "outlet", and the generic top-level domain .com does not affect the confusing similarity.
- It is a well-established principle that domain names that wholly incorporate trademarks, in particular ones as famous as DT SWISS, are found to be confusingly similar for the purposes of the Policy, despite the fact that the disputed domain names may also contain descriptive, generic or geographical terms.

- The combination of the trademark DT SWISS with generic terms, connected to the sector where the Complainant is active, could suggest improperly to consumers that the disputed domain names and corresponding websites might be controlled by the Complainant or with the Complainant's authorization.
- The addition of generic words to a trademark in domain names is also insufficient in itself to negate confusing similarity between a trademark and a domain name. Furthermore, the top level ".com" is merely instrumental to the use in Internet and not able to affect the confusing similarity of the disputed domain names to the Complainant's trademark.

The Respondent has no rights or legitimate interests in respect of the disputed domain names

- The burden of proving the absence of the Respondent's rights or legitimate interests in respect of the disputed domain names lies with the Complainant. It is nevertheless sufficient for the Complainant to produce prima facie evidence in order to shift the burden of production to the Respondent.
- The mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name. The Respondent is not licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain names.
- The Respondent is not commonly known by the disputed domain names as individual, business or other organization and its name does not correspond to DT SWISS or the disputed domain names.
- The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute.
- The disputed domain names are redirected by the Respondent to websites where the Complainant's trademark DT SWISS is published, and counterfeit products are offered for sale.
- Moreover, there is no disclaimer as to the Respondent's lack of relationship with the Complainant.
- It is apparent that the Respondent's uses 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.
- In light of the low prices the items, offered for sale via the websites corresponding to the disputed domain names, are counterfeit and therefore such use 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 any rights or legitimate interests in respect of the domain names.

The disputed domain names were registered and are being used in bad faith

- In light of the registration and intensive use of the trademark DT SWISS since many years, the Respondent could not have possibly ignored the existence of the Complainant's trademark, confusingly similar to the disputed domain names.
- The disputed domain names were registered in 2022, which is 20 years after the Complainant obtained its first DT SWISS trademark registrations.
- Furthermore, the actual knowledge DT SWISS trademark by Respondent at the time of the registration of the disputed domain names is demonstrated by the facts that the Respondent has offered for sale counterfeited items of the Complainant in the websites corresponding to the disputed domain names.
- Therefore, it is clear that the Respondent was well aware of the trademark DT SWISS and he has registered the disputed domain names with the intention to refer to the Complainant and its trademarks.
- The registration of a domain name with the knowledge of the complainant's trademark is evidence of bad faith.
- Indeed, the fact that replicas of the Complainant's cycling components are offered for sale on the websites corresponding to the disputed domain names indicates that the Respondent has been fully aware of the Complainant's mark's reputation and association with the Complainant and that his purpose in registering the disputed domain names, which incorporates the Complainant's trademark DT SWISS, was solely to on the reputation of the Complainant's trademarks by diverting Internet users seeking DT SWISS products to his website for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites.
- Moreover, on the web sites corresponding to the disputed domain names, there are no disclaimers informing the users as to the Respondent's lack of relationship with the Complainant and the Respondent.
- The Respondent offers for sale the Complainant's components disproportionately below the market value: for the same wheels or fork there are huge differences between the Complainant's suggested retail prices and the prices indicated in the Respondent's website. Such conduct constitutes a further evidence that the components offered for sale are counterfeited and that the Domain Names have been registered and used in bad faith.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

NO RIGHTS OR LEGITIMATE INTERESTS

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).

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).

PROCEDURAL FACTORS

According to Registrar, the registrants of the disputed domain names have been identified as Bbxdm Bbxdm (<cycledtswiss.com>), Dongyue Qiu (<dtswisscycle.com>), Ridong Zhao (<outletdtswiss.com>), Minmin Jiang (<soldesdtswiss.com>) and Minmin Jiang (<velodtswiss.com>).

The Complainant claimed that all disputed domain names were under common control and registered by the same person. The Complainant therefore asked the Panel to allow the consolidation of the Respondent(s) based on the following factors:

1. two of the disputed domain names have the same registrant;
2. the disputed domain names were registered between September and November 2022;
3. the phone number is identical for the disputed domain names <dtswisscycle.com>, <soldesdtswiss.com> and <velodtswiss.com>;
4. the disputed domain names have the same registrar, i.e. Name.com, Inc.;
5. the disputed domain names use the same namerserver, i.e. cloudflare.com;
6. the disputed domain names are all registered within .COM top-level domain;
7. there are the same opening hours and same ways of payment announced on the corresponding websites;
8. the same components are offered for sale on the corresponding websites.

According to the paragraph 10(e) of the Rules of UDRP Policy "a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules". According to Paragraph 3(c) of the UDRP Rules states that: "The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder". In order to file a single complaint against multiple respondents, the complaint must meet the following criteria: (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, Section 4.11.2).

Given the above reasons, the Panel accepts the Complainant's request to have the Complaint filed against multiple Respondents.

Otherwise, 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.

PRINCIPAL REASONS FOR THE DECISION

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) The respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the "DT SWISS" trademarks:

- European Union Trademark n. 001805332 registered from February 4, 2002;
- European Union Trademark n. 011178662 registered since February 6, 2013;
- International Trademark n. 1144607B ext. in PRC registered since October 25, 2012;
- International Trademark n. 1144607 registered since October 25, 2012;
- United States Trademark n. 4468251 registered since January 21, 2014.

The disputed domain names have been registered between September and November 2022, i.e. more than 20 years after the first of the above mentioned DT SWISS trademark registration, and fully incorporates the Complainant's DT SWISS trademark. It is therefore confusingly similar to the trademark for purposes of UDRP (WIPO Jurisprudential Overview 3.0, Section 1.7).

The generic terms "CYCLE", "OUTLET", "SOLDES" or "VELO" in the disputed domain names either describe the nature of business of the Complainant or refer to the sale of the goods. The term DT SWISS, however, is the dominant element of the disputed domain names and will immediately trigger a corresponding link to the Complainant and its trademarks.

Therefore, the addition of the non-distinctive generic terms does not prevent the disputed domain names from being confusingly similar to the Complainant's trademarks. The addition of the generic top level domain ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain names to be confusingly similar to the Complainant's trademark DT SWISS which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

As stated in the WIPO Jurisprudential Overview 3.0 at Section 2.1, while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain names, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term "DT SWISS" or that the Respondent is using the disputed domain names in connection with a bona fide offering of goods or services.

There is also no evidence, that the Respondent is making a legitimate noncommercial or fair use of the domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Neither license nor authorization has been proven to be granted to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain names.

Moreover, the disputed domain names resolved to the websites where the Complainant's trademark DT SWISS is published and prima facie counterfeit DT SWISS branded products are offered for sale with the prices significantly lower than the prices of the same product offered on the official Complainant's websites. There is no evident disclaimer as to the Respondent's lack of relationship with the Complainant. Such use cannot be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names. Furthermore, such use of the disputed domain names cannot be considered a legitimate non-commercial or fair use without intent for commercial gain,

because the Respondent is undoubtedly attempting to gain from the sales of prima facie counterfeit products and it is clear that the Respondent's intention is to benefit from the Complainant's trademarks' reputation to disrupt the Complainant's business and to illegitimately trade on the Complainant's fame for commercial gain.

Finally, the Respondent had an opportunity to present its argument or evidence that it has rights or legitimate interests in the disputed domain names but failed to respond to the cease-and-desist letter sent by the Complainant.

The Panel therefore considers that 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).

III. Registered and Used in Bad Faith

The Respondent has registered the disputed domain names which consists of the full content of the Complainant's trademark "DT SWISS" and generic terms either describe the nature of business of the Complainant or refer to the sale of the goods. There are no doubts that the Complainant's trademark is distinctive, famous and is well-known worldwide. It could be therefore concluded that the Respondent had or should have the Complainant and its trademark in mind when registering the disputed domain names.

Furthermore, the disputed domain names redirect to the websites with the offer of the replicas of the Complainant's goods. This indicates that the Respondent was fully aware of the Complainant's trademark reputation and the purpose of the registration of the disputed domain names was solely to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking DT SWISS products to its websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites

The tarnishment of a Complainant's trademark by conduct such as offer of the replicas or counterfeit products constitutes evidence of bad faith registration and use of the disputed domain names.

Considering the (i) confusing similarity between the Complainant's well-known trademark and the disputed domain names, (ii) long time between the registration of the Complainant's trademark and the disputed domain names, (iii) use of the disputed domain names for the offer of the replicas of the Complainant's goods or counterfeit products, (iv) absence of any disclaimers informing the users as to the Respondent's lack of relationship with the Complainant, (v) distinctiveness of the Complainant's trademark and (vi) the failure of the Respondent to submit a response to the cease and desist letter and to the complaint or to provide any evidence of good faith use, the Panel finds that the disputed domain names have been registered and are being used in bad faith.

Thus, 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 Panel finally considers that the Complainant has shown that the disputed domain names <cycledtswiss.com>, <dtwisscycle.com>, <outletdtswiss.com>, <soldesdtswiss.com> and <velodtswiss.com> are confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain names and the disputed domain names have been registered and are being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **cycledtswiss.com**: Transferred
2. **dtwisscycle.com**: Transferred

3. **outletdtswiss.com**: Transferred
 4. **soldesdtswiss.com**: Transferred
 5. **velodtswiss.com**: Transferred
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PANELLISTS

| | |
|------|-------------|
| Name | Petr Hostaš |
|------|-------------|

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|------------------------|------------|
| DATE OF PANEL DECISION | 2023-05-29 |
|------------------------|------------|

Publish the Decision
