Decision for dispute CAC-UDRP-106070

Case number	CAC-UDRP-106070
Time of filing	2024-01-03 09:58:04
Domain names	siemensmx.com

Case administrator

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

Complainant

Organization	Siemens Trademark GmbH & Co. KG

Respondent

Organization	BUILDPOINT CONSTRUCTION GROUP

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 name.

IDENTIFICATION OF RIGHTS

International Registration Number 637074 for the trademark “SIEMENS” dated September 06, 2018 and designating Mexico;

- International Registration Number 1308447 for the trademark “SIEMENS Ingenio para la vida” dated March 3, 2016 designating Mexico; and

- National Registrations of Mexico Numbers 593144, 2598162, 498103, 498104, 1017952, 1013721, 511472, 498105, 498107, 498106, 498108, 498101, 511471, 511470, and 1025716 for the trademark “SIEMENS”.

FACTUAL BACKGROUND

The Complainant is a trademark holding company and is a subsidiary of Siemens Aktiengesellschaft, one of the world’s largest corporations, providing innovative technologies and comprehensive know-how to benefit customers in 190 countries. Founded more than 170 years ago, the company is active - to name but a few examples - in the fields of medicine, automation and control, power, transportation, logistics, information, and communications. It operates its business under the trademark SIEMENS and is the owner of numerous trademark registrations around the world and has conducted business in Mexico since 1894. The Complainant also owns the domain names <siemens.com> and <siemensus.com> that reflect its trademark.

The disputed domain name was registered on July 2, 2023 and resolves to a website that displays the SIEMENS logo and photos of Complainant’s products and claims to offer such goods for sale. However, the site contains no postal address or phone number, and an insufficient disclaimer buried at the very bottom of the page.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name 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 name is 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).

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 name (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 name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

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

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

(i) the disputed 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 disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Further, as UDRP proceedings are administrative in nature, the standard of proof is the balance of probabilities (i.e., more likely than not). Simyo GmbH v. Domain Privacy Service FBO Registrant / Ramazan Kayan, D2014-2227 (WIPO February 27, 2015); LoanDepot.com v. Liu Yuan, FA 1762239 (FORUM January 15, 2018).

Finally, in view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also GROUPE CANAL + v. Danny Sullivan, 102809 (CAC January 21, 2020) (“the Panel, based on the poorly supported and conclusory allegations of the Complainant, retains that the Complainant has not prevailed on all three elements of the paragraph 4(a) of the Policy and, therefore, rejects the Complaint.”).

1. Confusing Similarity

The Complainant has established its rights to the SIEMENS trademark through its submission into evidence of international trademark registration certificates, the earliest of which dates back to 1995, covering many countries such as Mexico. It also submits screenshots of its own www.siemens.com website showing actual use of the trademark. The disputed domain name combines the Complainant’s trademark with the letters "mx“ and the “.com“ gTLD. These additions are very minor and do not dispel the confusing similarity between the disputed domain name and the Complainant’s trademark. Avast Software s.r.o. v. Milen

Radumilo, 102384 (CAC April 19, 2019) (“it is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity.”).

Also, the extension “.com” typically adds no meaning or distinctiveness to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. Novartis AG v. Wei Zhang, 103365 (CAC December 9, 2020) (“it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ‘.com’) is to be disregarded under the confusing similarity test”).

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of a descriptive letters thereto in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant’s trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

2. Rights or Legitimate Interests

The Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii). Should it succeed in that effort, the burden then shifts to Respondent to show that it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, UDRP-102378, (CAC March 8, 2019) ("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 contends that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent is not commonly known by the disputed domain name, nor has the Complainant authorized the Respondent to use the SIEMENS trademark in any way. Where a response is lacking, relevant information includes the WHOIS record and any other assertions by a complainant regarding the nature of its relationship with a respondent. See LABORATOIRE NUXE v. Domains For Sale, UDRP-106079 (CAC January 25, 2024) (“Past panels have held that a respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name.”). The WHOIS record for the <siemensmx.com> domain name identifies the registrant as “Leonel Lopez Castillo / Buildpoint Construction Group”. The Complainant further asserts that “[t]he Respondent is not and has never been one of the Complainant’s representatives, employees or one of its licensees, nor is otherwise authorized to use the trademarks “SIEMENS”. The Complainant does not have any connection with the Respondent.” Panels may use these assertions as evidence of lacking rights or legitimate interests. Accordingly, the Panel agrees that the Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).

Next, the Complainant argues that the Respondent uses the disputed domain name “to intentionally and misleadingly attract Internet users to Respondent’s website for Respondent’s own profit”. The selling of a complainants’ products, whether as an authorized or unauthorized dealer, is subject to the now-familiar four-part test set out in the seminal UDRP decision of Oki Data Americas, Inc. v. ASD, Inc., D2001-0903 (WIPO Nov. 6, 2001).

Of most relevance to the current case is the third element of the Oki Data test, whether or not the website of the disputed domain name accurately discloses the registrant's relationship with the trademark owner. The Complainant claims that the Respondent is not an authorized distributor of its products. However, the Panel deems this factual question to be of limited impact in the present case because, even assuming arguendo that the Respondent is an authorized dealer, it fails to clearly disclose its lack of a relationship with the Complainant on the <siemensmx.com> website. Complainant provides a screenshot of the resolving website associated with the disputed domain name, which prominently displays the title “Siemens Mexico” followed by the text “Leaders in automation equipment”. It further displays a photo which incorporates most of the Complainant’s graphic SIEMENS logo and its tagline “Ingenuity for life”. The site also contains various photographs of the Complainant’s products allegedly for sale as well as a quote from a named individual who is listed simply as “CEO”. Finally, only at the very bottom of the page is there is a copyright notice listing the name Buildpoint Construction Group S De RL De CV.

Past UDRP decisions involving domain names that couple a two-letter country code with a complainant’s well-known trademark have considered the Oki Data test. See The Gillette Company LLC v. Nghi Huynh Quoc, D2023-3239 (WIPO October 2, 2023) (oralbvn.com ordered transferred where it uses the Complainant’s ORAL-B trademark in its entirety, merely adding the geographic identifier “vn” for Viet Nam, and the website fails the Oki Data test by not providing a prominent notice of the lack of a relationship with the Complainant). See also Olive & Orange Limited v. dsad adsad, UDRP-105762 (CAC November 8, 2023) (orlakielyuk.com and other domain names ordered transferred based on a failure to satisfy the Oki Data test) Here, the Panel finds that the disputed domain name features the Complainant’s SIEMENS trademark and adds only the letters “mx” referring to the country of Mexico. This clear attempt to create an association with the Complainant, combined with use of the trademark on the Respondent’s website and the lack of a disclaimer that is likely to be noticed by users fails to clearly and accurately disclose its lack of a relationship with the Complainant under the third element of the Oki Data test. The small-print and minor reference to the Respondent’s company name

does not alter this conclusion. Thus, Respondent fails to use the domain name in connection with a bona fide offering of goods or services under Policy paragraph 4(c)(i), or a legitimate noncommercial or fair use per Policy paragraph 4(c)(iii).

In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) and of the Policy and demonstrated that the Respondent has no rights or legitimate interests in the disputed domain name.

3. Bad Faith Registration and Use

The Complainant argues that Respondent had prior knowledge of the SIEMENS mark at the time of registering the <siemensmx.com> domain name. Actual knowledge of a complainant's trademark may form the foundation upon which to build a case for bad faith under Policy paragraph 4(a)(iii). See, Facebook, Inc. v. DNS Admin / OT NetWork, FA 1827546 (FORUM Feb. 28, 2019) ("The Panel finds on the balance of probabilities that, at the time of registration of the Domain Name, June 12, 2018, Respondent had actual knowledge of Complainant's FACEBOOK mark. The website to which the Domain Name resolved to makes direct references to Complainant."). Here, as the Respondent's website makes prominent and multiple uses of the Complainant's trademark, the Panel finds it quite certain that the Respondent knew of the trademark at the time that it registered the disputed domain name.

The Complainant further claims that Respondent attempts to create a likelihood of confusion regarding Complainant's affiliation with the Respondent's website in order to further a business where products are distributed for commercial gain and in competition with Complainant. Using a disputed domain name to trade upon the goodwill of a complainant for commercial gain can demonstrate bad faith under Policy paragraph 4(b)(iv). See Fanuc Ltd v. Mach. Control Servs., FA 93667 (FORUM Mar. 13, 2000) (finding that the respondent violated Policy paragraph 4(b)(iv) by creating a likelihood of confusion with the complainant's mark by using a domain name identical to the complainant's mark to sell the complainant's products). As noted above, Complainant provides a screenshot of the resolving website associated with the domain name, which makes prominent and repeated use of the Complainant's mark and logo and displays various of its products allegedly for sale. It asserts that "[t]he Respondent had a clear intention of taking predatory advantage of the goodwill of the Siemens Group, by diverting Internet traffic, intended for the legitimate global and local (Mexico) website of Siemens Group". The Panel agrees and finds that the Respondent registered and uses the disputed domain name to commercially benefit from confusion with the Complainant's trademark in bad faith under Policy paragraph 4(b)(iv).

Finally, the Complainant asserts that the Respondent failed to respond to cease-and-desist letters sent through its registrar and hosting provider. Failure to respond to a cease-and-desist letter can be indicative of bad faith per Policy paragraph 4(a)(iii). See Arla Foods Amba v. James Moore, UDRP-105866 (CAC November 25, 2023) (finding that failing to respond to a cease-and-desist demand letter constitutes bad faith). On this basis the Panel finds further support for its above conclusion that the Respondent has acted in bad faith pursuant to Policy paragraph 4(a)(iii).

In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) and that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **siemensmx.com**: Transferred

PANELLISTS

Name	**Steven Levy**

DATE OF PANEL DECISION 2024-01-31

Publish the Decision