Decision for dispute CAC-UDRP-106131

Case number	CAC-UDRP-106131
Time of filing	2024-01-17 10:08:06
Domain names	schindler-elevator.online

Case administrator

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

Complainant

Organization	INVENTIO AG

Complainant representative

Organization	Convey srl

Respondent

Name	Oleg Kruchko

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

In this proceeding the Complainant relies on various trademarks with the “SCHINDLER” word element, including the following trademark registrations:

- International trademark registration under the Madrid system “SCHINDLER” (word) No. 1265628, registration date is May 1, 2015, protected inter alia in Albania, Algeria, Australia, EU, China, India, Japan, Russia and Turkey;
- International trademark registration under the Madrid system “SCHINDLER” (word and device) No. 1633618, registration date is August 10, 2021, protected inter alia in Australia, Brazil, China, EU, Russia, Turkey and Ukraine; and
- International trademark registration under the Madrid system “SCHINDLER” (word and device) No. 883565, registration date is January 13, 2006, protected inter alia in Australia, China, Japan, Kazakhstan, Russia, Singapore, Ukraine and USA.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE

COMPLAINANT HAS RIGHTS

The Complainant states that it is one of the leading manufacturers of escalators, moving walkways and elevators worldwide, founded in Switzerland in 1874. The Complainant alleges that it is present in over 140 countries and employs more than 60.000 people worldwide. Its production facilities are located in Brazil, China, Slovakia, Spain, Switzerland, India and the United States.

The Complainant asserts that its trademark “SCHINDLER” is distinctive and well known all around the world in the sector of manufacturing of escalators, moving walkways and elevators.

The Complainant claims it has been extensively using the “SCHINDLER” denomination on the internet including the company’s official website https://www.schindler.com and its official accounts on major social networks such as “LinkedIn”, “Twitter”, “Instagram” and “YouTube”.

The disputed domain name was registered on September 14, 2023 and the Complainant claims that the disputed domain name “has been pointed to a website where products in competition with the Complainant’s products are promoted”.

The Complainant sent a cease-and-desist letter to the Respondent prior to initiating this proceeding but received no response.

The Complainant contends the disputed domain name is confusingly similar to its trademarks. The Complainant claims that it is a well-established principle that domain names that wholly incorporate trademarks, in particular ones as famous as “SCHINDLER”, are found to be confusingly similar for the purposes of the Policy, despite the fact that they may also contain descriptive, generic or geographical terms.

The addition of “elevator” is insufficient to negate confusing similarity.

The addition of the gTLD <.online> does not affect confusing similarity.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not a licensee or authorized dealer of the Complainant nor has been authorized by the Complainant to use its trademark in the disputed domain name.

The Complainant is not aware of the existence of any evidence demonstrating that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name as an individual, business, or other organization.

There is no evidence of bona fide offering of goods or services.

The Complainant concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant’s submissions on the bad faith element of the Policy can be summarized as follows:

1. Its mark enjoys worldwide reputation in the sector of escalators, moving walkways and elevators and the disputed domain name was registered on September 14, 2023, many years after the registration of the Complainant’s mark.
2. By choosing the generic word “elevator”, it is clear that the Respondent was well aware of the trademark “SCHINDLER” and he has registered the disputed domain name with the intention to refer to the Complainant and its trademarks.
3. The registration of a domain name with the knowledge of the complainant’s trademark is evidence of bad faith.
4. The disputed domain name resolves to Registrar’s parking page. The Complainant relies on the passive holding doctrine and the “Telstra” decision (**WIPO Case No. D2000-0003, “Telstra Corporation Limited v. Nuclear Marshmallows**”).

The Complainant alleges that its trademark has a high degree of distinctiveness, the Respondent has not replied to its cease-and-desist letter and, following the receipt of this letter, the Respondent has not changed the redirection from the parking page, the Respondent has concealed his identity and there is not any chance of good faith use by the Respondent.

Therefore, the Complainant claims the disputed domain name was registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section above.

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.

Language of the administrative proceeding

The Registrar in its communication to the Czech Arbitration Court (CAC) stated that the language of the registration agreement is Russian.

The Complainant requests that English shall be the language of this proceeding based on the following:

- the disputed domain name contains Latin characters;
- the disputed domain name includes the generic English word “elevator”;
- the Respondent’s e-mail contains the generic English word “lift”, as a synonym of “elevator”;
- the translation of the Complaint into Chinese (sic) would also cause additional expense and delay, making unfair to proceed in Russian.

Based on the above the Complainant alleges that the Respondent understands English and the corresponding website is dedicated to English speaking internet users.

Under par. 11 (a) of the UDRP Rules unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

As noted in “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition” (“WIPO Overview 3.0”) panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement and such scenarios include inter alia:

- the language/script of the domain name particularly where the same as that of the complainant’s mark;

- any content on the webpage under the disputed domain name, potential unfairness or unwarranted delay in ordering the complainant to translate the complaint; and

- other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement (see sec. 4.5.1).

The Panel needs to consider the interests of both parties to the proceeding and provide them with a fair opportunity to present their case and at the same time to ensure that the administrative proceeding takes place with due expedition.

The Panel is not entirely persuaded by Complainant’s reasoning for a language change provided above. In particular, the Panel notes that the disputed domain name does not resolve to any active website and therefore one cannot conclude that the “corresponding website is dedicated to English speaking internet users”.

However, the Panel decides to proceed in English based on the following:

- The Complainant provided proof of sending a cease-and-desist letter to the e-mail address of the Respondent on November 27, 2023. This e-mail address was later confirmed by the registrar in its verification. The letter was in English, however the disputed domain name was mentioned a few times along with Complainant’s trademarks, including in the subject line and it was clear that the content of the letter relates to the disputed domain name.

- The disputed domain name contains Complainant's trademark along with the English word "elevator" descriptive of Complainant's activities.

- The CAC sent a notification to the Respondent of commencement of the administrative proceeding in Russian. The Respondent did not respond.

Based on the above, the Panel finds that the Respondent was notified, including by the CAC notice in the Russian language, and should have been aware of the situation and this proceeding.

The Panel knows both Russian and English and had the Respondent submitted any response in Russian, the Panel would have taken it into consideration.

However, the Respondent chose not to respond. In particular, the Respondent did not challenge choice of the English language as the language of this proceeding and never questioned the language issue in this dispute in any way.

Taking into account that the Complainant sent a letter to the Respondent prior to filing this complaint, that the CAC sent a notification to the Respondent in Russian, that the disputed domain name is in the Latin script fully incorporating the Complainant's mark plus the English word descriptive of Complainant's goods and services, and the Respondent's failure to respond, the Panel finds that it would be unfair to the Complainant to order it to translate the complaint into Russian.

The Panel is also mindful of the obligation to ensure that the administrative proceeding takes place with due expedition.

Based on the above the Panel agrees with the Complainant and decides to proceed in English.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar

The Complainant provides evidence of the international trademark registrations with the word element "SCHINDLER".

As confirmed by WIPO Overview 3.0: "where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case" (see sec. 1.2.1).

The disputed domain name fully incorporates the Complainant's mark with the addition of the descriptive word "elevator".

As stated in WIPO Overview 3.0: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element" (see sec. 1.8).

The Complainant's word trademark "SCHINDLER" (word element "SCHINDLER") is recognizable within the disputed domain name and the "elevator" element is descriptive and refers to Complainant's activities.

The gTLD ".online" is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see **"Julian Barnes v. Old Barn Studios", WIPO Case No. D2001-0121; "Belupo d.d. v. WACHEM d.o.o.", WIPO Case No. D2004-0110**.

The disputed domain name was registered on September 14, 2023. It does not resolve to any active page.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests. It allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and **CAC Case No. 101284**: "A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant".

The Complainant has made a prima facie case of Respondent's lack of rights or legitimate interests.

The Respondent is not known by the disputed domain name and is identified as an individual with no connection to the Complainant's business, the disputed domain name or any name corresponding to the disputed domain name. The Complainant has not granted any license or authorization to use its trademark to the Respondent and the Complainant is not doing any business with the Respondent. There is no any evidence of rights or legitimate interest of the Respondent.

Passive holding of the disputed domain name in the circumstances of this case does not create any rights or legitimate interests of the Respondent.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see sec. 3.1 of WIPO Overview 3.0). Targeting with an intent to take unfair advantage is important in establishing bad faith under the UDRP.

The Panel finds that the Complainant provided sufficient evidence that the disputed domain name was registered and is being used in bad faith despite certain shortcomings in its submissions[i].

The Panel's findings are based on the following:

1. The nature of the disputed domain name and the timing of the registration of the disputed domain name – September 14, 2023, many years after the Complainant obtained protection for its trademarks and many years after the Complainant started its business. The nature of the disputed domain name indicates that the Respondent was most likely aware of the Complainant and its trademark when he registered the disputed domain name. The addition of a descriptive term "elevator" related to the Complainant's business indicates targeting.
2. The strength of the Complainant's "SCHINDLER" trademark. The Complainant provided evidence of its global presence, history and strong reputation of its "SCHINDLER" trademarks (including various publications, press releases and receipt of an award).
3. Passive holding of the disputed domain name in the circumstances of this case indicates both registration and use in bad faith. WIPO Overview 3.0 states that "from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding" and the panelists "will look at the totality of the circumstances in each case" (sec. 3.3). The Panel notes that passive holding per se does not indicate bad faith. However, the totality of the circumstances of this dispute proves bad faith of the Respondent, in particular: i) strength of the Complainant's mark and timing of registration of the disputed domain name, ii) the nature of the disputed domain name, iii) failure of the Respondent to respond and take part in this proceeding, failure to respond to a cease-and-desist letter sent prior to initiating this proceeding and iv) the implausibility of any good faith use to which the domain name may be put given the nature of the domain name. Any possible explanation of a potential legitimate use is solely within the Respondent's knowledge and the Respondent failed to respond and provide any explanations.

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent takes unfair advantage of the Complainant's mark.

The Panel holds that the third requirement of the Policy has been satisfied.

[i] Some of the arguments and assertations made by the Complainant are not related to this dispute. They may be related to one of the previous UDRP disputes where the same Complainant was involved, e.g. a statement that: "the disputed domain name has been pointed to a website where products in competition with the Complainant's products are promoted" and a statement about "Chinese language" that is not relevant to the present proceeding. The Complainant also provided some proof of its activities in China that is not specifically relevant to the present proceeding where the Respondent is in Russia, not China. These shortcomings are not fatal to the Complainant's case. However, it is advisable to pay more attention next time to both arguments and evidence.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **schindler-elevator.online**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2024-02-23

Publish the Decision