Decision for dispute CAC-UDRP-106209

Case number	CAC-UDRP-106209
Time of filing	2024-02-01 11:54:39
Domain names	oerllkon.com

Case administrator

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

Complainant

Organization	OC Oerlikon Corporation AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Ghost Bank, chocofoodsllc.com

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

The Complainant has demonstrated ownership of rights in the trademark OERLIKON for the purposes of standing to file a UDRP complaint.

The Complainant is the owner of numerous trademark registrations for OERLIKON, including the following:

- International trademark registration No. 927142 for OERLIKON (word mark), registered on May 26, 2006, in classes 4, 7, 9, 12, 19, 40 and 42;

- International trademark registration No. 965695 for OERLIKON (semi-figurative mark), registered on July 5, 2007, in classes 6, 07, 09, 12, 19, 35, 37 and 42;

- International trademark registration No. 940898 for OERLIKON (word mark), registered on August 2, 2007, in classes 6, 12 and 19;

- United States trademark registration No. 4293850 for OERLIKON (semi-figurative mark), filed on May 26, 2006, and registered on February 26, 2013, in international classes 7, 9, and 42;

- United States trademark registration No. 3987820 for OERLIKON (word mark), filed on May 23, 2007, and registered on July 5, 2011, in international classes 7, 9, 11, 12, 35, 37 and 42.

FACTUAL BACKGROUND

The Complainant is part of the Oerlikon group, a market leader in advanced materials, surface engineering and polymer processing solutions, designed for applications in growth markets, such as the automotive industry, aerospace, energy, the tooling industry and additive manufacturing.

The Oerlikon group is structured in two divisions: one (Surface solutions) dedicated to materials and surface solutions and the other (Polymer Processing Solutions) related to production technologies for synthetic fibers and polycondensation systems.

The origins of the Complainant date back to September 1907 when a machine tool factory called Schweizerische Werkzeugmaschinenfabrik Oerlikon was founded in Oerlikon, a district of the city of Zurich.

In 1936, the company became known as Werkzeugmaschinenfabrik Oerlikon&Co. and expanded in different sectors, laying down the foundations of the highly diversified Oerlikon-Bührle group.

It entered in the vacuum business in 1957 as well as in the European space industry in 1968 whilst in 1973, the group, consolidated under the Oerlikon-Bührle Holding (OBH) umbrella and was listed on the stock exchange.

The Oerlikon-Bührle group continued to expand and integrated Balzer AG. In 1994, it also acquired the Leybold group – specialized in vacuum technology and merged with Balzers to form Balzers & Leybold thin film technology.

In 1998, the group split up and the core business was renamed Unaxis, changing its name once again in May 2006 to OC Oerlikon Corporation AG, Pfäffikon.

With an active business presence also in the Unites States of America, the Complainant currently employs 13.000 people at 205 locations in 37 countries. In 2022, the Complainant generated CHF 2.9 billion in sales and invested CHF 105 million in R&D.

The Complainant is also the owner of several domain names comprising the mark OERLIKON, including <oerlikon.com>, which was registered on November 25, 1998, and is used by the Complainant to promote its products and services under the trademark OERLIKON.

The disputed domain name <oerllkon.com> was registered on August 10, 2023, and does not resolve to an active website.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name <oerllkon.com> is confusingly similar to the trademark OERLIKON in which the Complainant has rights as it reproduces the trademark in its entirety with the mere misspelling of the letter “i”, which has been substituted by the letter “l”, and the generic Top-Level Domain (gTLD) “.com”.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name because: i) the Complainant has never granted the Respondent any right to use the OERLIKON trademark in the disputed domain name, nor is the Respondent affiliated to the Complainant in any way; ii) the Respondent is not commonly known by the disputed domain name and does own any corresponding registered trademarks; iii) the structure of the disputed domain name, incorporating a misspelled version of the Complainant’s widely known trademark OERLIKON, reflects the Respondent’s intention to create an association, and subsequent confusion, with the Complainant, its OERLIKON trademark and the Oerlikon group in internet users’ mind; iv) the Respondent’s use of the disputed domain name capitalizes on the Complainant’s trademark and cannot be considered as a bona fide offering of goods or services or as a legitimate noncommercial or fair use.

With reference to bad faith registration, the Complainant claims that the Respondent had knowledge of the Complainant and its OERLIKON trademark at the time of registration of the disputed domain name because: i) the Complainant’s trademark registrations predate the registration of the disputed domain name of several years; ii) the Respondent has never been authorized by the Complainant to register the disputed domain name; iii) the Complainant enjoys a strong online presence, being very active on social media to promote its trademark, products and services; iv) the Oerlikon group has an active business presence in the United States, where the Respondent is based; and v) by conducting a simple online search regarding the name “oerlikon” on popular search engines, the Respondent would have learnt about the Complainant, its trademark and business.

The Complainant also claims that, in view of i) the distinctiveness, reputation and extensive online presence of the OERLIKON trademarks worldwide; ii) the fact that the disputed domain name consists of a misspelled version of the Complainant’s OERLIKON mark, thus amounting to a typosquatting; iii) the Respondent’s failure to respond to a cease and desist letter sent by the Complainant; and iv) the fact that the Respondent registered an additional domain name incorporating a misspelled name of a third-party company, the Respondent’s passive holding of the disputed domain name does not prevent a finding of bad faith use.

RESPONDENT

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

1. The Complainant has provided evidence of ownership of valid trademark registrations for OERLIKON.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark OERLIKON as it reproduces the trademark in its entirety with the mere with the mere substitution of the letter "i" with the letter "l". The Panel notes that the letter "i" written in uppercase is identical to the letter "l" in lowercase. As stated in prior UDRP decisions, a domain name which consists of a common, obvious, or intentional misspelling of a trademark, such as substitution of similar-appearing characters (like upper versus lower-case letters) is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.

As to the gTLD" .com", as established in a number of prior UDRP cases, it is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the trademark OERLIKON in which the Complainant has established rights for the purpose of paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a prima facie case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

The Panel notes that, based on the records, the Complainant has not authorized the Respondent to register and use its trademark OERLIKON. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name.

As highlighted above, the disputed domain name, confusingly similar to the Complainant's trademark, is not resolving to an inactive website. The Panel finds that the Respondent's use does not amount to a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name without intention to misleadingly divert the consumers or to tarnish the Complainant's trademark.

Moreover, the disputed domain name, being almost identical to the Complainant's trademark, carries a high risk of implied affiliation with the Complainant.

Therefore, the Panel finds that the Complainant has demonstrated that the Respondent has no rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy.

3. As to bad faith at the time of registration, the Panel finds that, in light of the prior registration of the trademark OERLIKON in many countries - including the United States, where the Respondent is based -, the extensive use of the trademark in connection with the

Complainant's products and services, promoted online via the Complainant's website www.oerllkon.com and on social media, the Respondent was or could have been aware of the Complainant's trademark when it registered the disputed domain name in August 2023.

Moreover, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

As indicated above, the disputed domain name is currently not pointed to an active website. As established in a number of prior UDRP cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding. In the present case, considering i) the well-known character of the Complainant's trademark OERLIKON, ii) the circumstance that the disputed domain name is a clear typosquatting of the Complainant's trademark OERLIKON and its domain name <oerlikon.com>; iii) the Respondent's failure to reply to the Complainant's cease and desist letter and to file a Response, iv) the implausibility of any good faith use to which the disputed domain name may be put, the Panel finds that the current passive holding of the disputed domain name does not prevent a filing of bad faith use.

Therefore, the Panel finds that the Complainant has also demonstrated that Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **oerllkon.com**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2024-03-18

Publish the Decision