Decision for dispute CAC-UDRP-106233

Case number	CAC-UDRP-106233
Time of filing	2024-02-19 10:55:02
Domain names	tkrupp-ssteel.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	thyssenkrupp AG- thyssenkrupp Intellectual Property GmbH

Respondent

Name	zhuo yang gang tie shang hai you xian gong si

OTHER LEGAL PROCEEDINGS

The Complainant informs the Panel that legal actions had previously been initiated against the Respondent "zhuo yang gang tie shang hai you xian gong si" where it was found that the Respondent had misused domains similar to the Complainant's trademarks for phishing, attempting to defraud consumers.

A summary of the cases and outcome is set out in the table below:

Case ID	Domain(s)	Outcome for Complainant
(2023) CAC 105574	<krupp-alloy.com>	Won
(2023) CAC 105410	<krupp-materials.com>	Won
WIPO Case D2023-0881	<kruppss.com>, <krupp-steel.com>	Won
(2023) CAC 105669	<k-alloy.com>	Lost

IDENTIFICATION OF RIGHTS

The Complainant is the owner of an extensive list of trademarks comprising the word "krupp" and "KRUPP" by means of several international and national trademark registrations in many countries, such as: EU (European Union). BR (Brazil), GB (United Kingdom), WO (World Intellectual Property Organization), US (United States), CN (China), IL (Israel), DE (Germany), BO (Bolivia), CA (Canada), CL (Chile), CO (Colombia), DK (Denmark), FI (Finland), ID (Indonesia), IR (Iran), MX (Mexico), PE (Peru), PL (Poland), PY (Paraguay), SE (Sweden), TH (Thailand), UY (Uruguay), VE (Venezuela), and ZA (South Africa).

The Complainant is also the owner of the trademark "tk" as set out in the table below.

Country	Trademark Classes	Application Date	Application No.	Registration Date	Registration No.

DE	01, 06, 07, 09, 11, 12, 17, 35, 37, 40, 42	19.03.2020	302020103777.1/06	24.04.2020	302020103777
WO	01, 06, 07, 09, 11, 12, 17, 35, 37, 40, 42	20.03.2020	1541703	20.03.2020	1541703
AU	06, 07, 09, 12, 37, 42	20.03.2020	2128521	07.06.2022	2128521
BR	06, 07, 09, 12, 35, 37, 42	20.03.2020	1541703		
CA	06, 07, 09, 12, 35, 37, 42	20.03.2020	1541703		
CH	06, 07, 09, 12, 35, 37, 42	20.03.2020	1541703	20.03.2020	1541703
EU	06, 07, 09, 12, 35, 37, 42	20.03.2020	1541703	20.03.2020	1541703
GB	01, 06, 07, 09, 11, 12, 17, 35, 37, 40	20.03.2020	1541703	20.03.2020	1541703
NO	06, 07, 09, 12, 35, 37, 42	20.03.2020	1541703	20.03.2020	1541703
SG	06, 07, 09, 12, 35, 37, 42	20.03.2020	1541703	20.03.2020	1541703
US	01, 06, 07, 09, 11, 12, 17, 35, 37, 40	20.03.2020	79289928	28.09.2021	6495509

FACTUAL BACKGROUND

The Complainant is a German conglomerate with more than 100.000 employees and a revenue of more than 38 billion EUR in fiscal 2022/2023. It is one of the world's largest steel producers and was ranked tenth largest worldwide by revenue in 2015.

The Complainant’s company name is the result of a merger of two German well-known steel companies, Thyssen AG founded in 1891 and Krupp AG founded in 1811.

As early as the 1980s, the companies began negotiations on a merger and began closely cooperating in some business areas. In 1997, the companies combined their flat steel activities, with a full merger completed in March 1999.

The Complainant’s business activities are organized into five segments : Automotive Technology, Decarbon Technologies, Materials Services, Steel Europe and Marine Systems round 4,000 employees work in research and development at 75 locations all over the world, mainly in the fields of climate protection, the energy transition, digital transformation in the industry and mobility of the future.

The Complainant’s product portfolio includes “steel”, “metals”, “alloys”, “rolled steel”, “stainless steel”, “nonferrous metals”, “hot strip”, “heavy plate”, “sheet and coated products”, “organic coated strip and sheet”, “composite material”, “electrical steel”, “packaging steel”, “precision steel strip”, “submarines”, “naval surface vessels”, “naval services”, “steering”, “dampers”, “springs and stabilizers”, “axle assembly”, “camshafts”, “crankshafts and conrods”, “bearings”, “undercarriages”, “chemical plants”, “coke plant technologies”, “industrial plant services”, “cement plants”, “mining and mineral solutions”, “automotive plants”, “materials handling”, “planning and technical assessments”, “system integration”, “automation solutions”, “handling and transport”, “jigs and tools”, “assembly lines”, “plastics”, “materials services (processing)”, “logistics services”, infrastructure projects and services”.

The Complainant also maintains a strong online presence and operates its main webpage at <www.thyssenkrupp.com>, which it registered on December 5, 1996.

The Complainant is also the registrant of numerous additional domain names containing its trademark and company name “krupp” and “thyssenkrupp”, including <krupp.com>; <krupp.de> and <krupp.cn>. The Panel observes from the evidence adduced by the Complainant that it owns approximately 268 registered domain names.

The disputed domain name <tkrupp-ssteel.com> was registered on May 5, 2023.

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.

The Respondent failed to file any administratively compliant response.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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).

The Panel accepts that the Complainant has rights by reason of its ownership of the registered trademarks “krupp”, “KRUPP” and “tk”. The question is whether the disputed domain name is identical or confusingly similar to the Complainant’s trademark(s).

The Complainant contends that the disputed domain name <tkrupp-ssteel.com> is confusingly similar with its trademarks and domains.

Whether a disputed domain name is identical or confusingly similar to a trademark can be determined by making a side-by-side comparison with the disputed domain name. See F. Hoffmann-La Roche AG v. P Martin, WIPO Case No. D2009-0323.

A disputed domain name is identical to the trademark when it is a character for character match. It is confusingly similar when it varies the trademark by, for example, adding generic terms to the dominant part of the trademark.

Here, the disputed domain name is formed with two terms “tkrupp” and “ssteel”, separated by a hyphen "-".

The Complainant contends that the sole dominant and distinctive element of the disputed domain name is the term “tkrupp”.

On a side by side comparison, this term incorporates the trademark “tk”. It also incorporates the trademark “krupp”. The Panel considers that, on the one hand, the trademark “krupp” has a consonant “t” added to it; and on the other hand, the trademark “tk” has the word “rupp” added to it, which does not have a recognized meaning in English.

The Panel considers, however, that the dominant feature of this term is “krupp”. Given the well-known association between "thyssen" and "krupp" as a corporate entity, it is likely that a consumer would view the reference to the consonant “t” as an abbreviation for “thyssen”. This is further accentuated when the term “tk” is also a registered trademark of the Complainant.

The second term “ssteel” comprises of the consonant “s” added to the noun “steel”. While the term “ssteel” has no meaning, it is, nevertheless, seeking to phonetically convey or describe an alloy of iron used as a structural and fabricating material. It is likely paired with “tkrupp” to convey to consumers a descriptive association with “t[hyssen]krupp”.

The Panel accepts the Complainant's contention that the “krupp” trademark appears to be the dominant element in the disputed domain name that seeks to create the impression that they are controlled by the Complainant. It is likely that the relevant public's attention will be captured more by the initial parts of a sign. See Dr. Ing. h.c. F. Porsche AG v. Rojeen Rayaneh, WIPO Case No. D2004-0488, where the Panel stated that it is a long-established precedent that confusing similarity is generally recognized when well-known trademarks are paired up with different kinds of generic prefixes and suffixes.

It is also trite to state that the addition of the gTLD “.COM” does not add any distinctiveness to the disputed domain name and will be disregarded for the purposes of considering this ground.

Accordingly, the Panel considers that the disputed domain name is confusingly similar to the Complainant’s trademark and this ground is made out.

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).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. See Document Technologies, Inc. v. International Electronic Communications Inc, WIPO Case No. D20000270.

If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See Croatia Airlines

d.d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455.

The Complainant contends the Respondent has no rights to the disputed domain name for the following reasons:

1. There are no indications that the Respondent has been commonly known by the domain name.
2. The Respondent does not use the disputed domain name for non-commercial purposes.
3. The Respondent has never been authorized by the Complainant to register or use any of its trademarks, nor has it been authorized to register or use any domain name incorporating the Complainant's trademark and company name. Rather, the Respondent has no connection at all with the Complainant or any of its affiliates.

The Panel accepts the evidence adduced that the Complainant's trademark "KRUPP" is well-known world-wide. The Complainant's numerous trademarks registered world-wide and its ownership of a vast array of domain names by reference to its trademark are irrefragable evidence showing its long history of use of its trademark "KRUPP" in connection with its business.

The evidence here also shows that the Respondent is not commonly known by the disputed domain name, nor the Respondent has legitimate interest over the disputed domain name.

The Panel accepts the contention that the Respondent does not use the disputed domain name for non-commercial purposes. The Panel is also prepared to infer from the evidence adduced that the Respondent is not making a legitimate commercial or fair use of the disputed domain name but rather it is riding on the reputation of the Complainant to best serve its own unauthorised activity for commercial gain or otherwise using the disputed domain name.

The Panel considers that a strong inference can be drawn that the only reason why the Respondent registered the disputed domain name is to take advantage of the Complainant's goodwill and valuable reputation in the "KRUPP" trademark.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Given the evidence adduced by the Complainant of its portfolio of trademarks and wide reputation which the Panel accepts as evidencing the strength of its reputation, the Panel accepts and finds that the Respondent has no rights or legitimate interests to the disputed domain name.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that 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).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The Complainant asserts that it enjoys worldwide reputation and market presence in the steel sector. The evidence adduced support this assertion.

The Complainant further asserts that the Respondent must have had knowledge of the Complainant's well-known trademarks and company name, when choosing the disputed domain name and when using the "KRUPP" trademark on its website.

The Panel accepts that the Complainant's company name as well as its trademark "KRUPP" and others including "THYSSENKRUPP" have a strong reputation and are widely known not only in Germany but also in many other countries in the world.

Registration of a domain name which appears to be connected to a well-known trademark has been found by other Panels to constitute opportunistic bad faith. See F. Hoffmann-La Roche AG v. Contactprivacy.com / Mike Kazaros, WIPO Case No. D2010-2212.

Here, the Respondent's registration of the disputed domain name, given the widespread use of the Complainant's "KRUPP" trademark over a long period of time, its market presence in the steel industry, the history of UDRP proceedings between the parties, and the Respondent's lack of association with the Complainant suggests that the Respondent had actual or constructive knowledge of the Complainant's rights at the time the Respondent registered the disputed domain name.

The Panel is prepared to infer that the Respondent has been fully aware of the Complainant, its "KRUPP" trademark when purchasing the disputed domain name, i.e. registering it in its own name.

Accordingly, the Panel is prepared to draw the adverse inference that the Respondent registered the disputed domain name incorporating the "KRUPP" trademark directly relating to the Complainant's business intentionally, to take advantage of reputation of the "KRUPP" trademark and the Complainant's business goodwill.

Use in bad faith

The Panel has already accepted the Complainant's widely held reputation in its "KRUPP" trademark and its market presence in the steel industry.

The Complainant contends that the Respondent is using the disputed domain name in bad faith for fraud purposes. It asserts that the Respondent is using the email of the disputed domain name to contact the Complainant's customers, which has resulted in the Complainant's customers making enquiries of the Complainant to verify the same.

The Complainant has adduced evidence of purported use by the Respondent of the disputed domain name to mislead the relevant public including its customers, to the extent that customers have even paid for the goods but have received any products.

The Panel accepts the uncontradicted evidence adduced to support a finding of use in bad faith.

Further, the Complaint asserts that the term "KRUPP" does not exist in any language. There is no other reason to choose a domain name comprising the Complainant's well-known trademark as the distinctive and therefore dominant element, except of the fact, that the Respondent intends is to participate in the Complainant's reputation and economic success.

The Complainant contends that this is neither a bona fide use of the disputed domain name nor a legitimate non-commercial or fair use. See Ford Motor Company v. Domain Administrator, WIPO Case No. D2008-1856 and Intesa Sanpaolo S.p.A., v. Shawn Chiu Wai, WIPO Case No. D2010-0946.

The Panel accepts the contention that free-riding on the rights of another does not constitute a bona fide use of a domain name. See Robert Bosch GmbH v. Asia Ventures, Inc., WIPO Case No. D2005-0946 and Abbott Laboratories v. United Worldwide Express Co., Ltd., WIPO Case No. D2004-0088.

The Panel accepts the uncontradicted assertion of the Complainant that the Respondent cannot claim any rights or legitimate interests in the disputed domain name. Accordingly, the Panel considers that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent and used in bad faith.

PROCEDURAL FACTORS

Language of proceedings request

The Complainant requests that the English language should be the language of the proceeding rather than the Chinese language for the following reasons:

1. English is a neutral language.
2. The disputed domain name and all its content are in English. This fact is a clear indication that the Respondent has sufficient knowledge of the English language to conduct this proceeding in English. Since English is the world trade language and therefore the most important language for international communication it is obvious that the Respondent use this language with the intention of attracting consumers worldwide, beyond the Chinese market.
3. The phishing emails, the invoices, and the quotations sent by the Respondent are all in English. This fact provides support that the Respondent has sufficient knowledge of the English language to conduct this proceeding in English.
4. Determining Chinese as the language of the proceeding would lead to considerable disadvantages for the Complainant. It has to be pointed out that the Complainant has no knowledge at all of the Chinese language.
5. Determining Chinese as the language of the proceeding would give the Respondents a clear advantage although it is obvious that the disputed domain name was registered in bad faith.
6. It would be both procedurally and economically efficient to proceed in English.

Rule 11(a) of the UDRP rules states:

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.

Here, the language of the registration agreement is Chinese as verified by the Registrar.

In conducting the administrative proceeding, the Panel is required to ensure under Rule 10 of the UDRP rules that the Parties are treated with equality and be given a fair opportunity to present its case.

The Respondent has not filed any administratively compliant response to the Complainant's Amended Complaint despite attempts

made to contact the person listed in the Registrar's information.

On balance, the Panel considers the proceedings can proceed in the English language given the disputed domain name use an English language trademark that is combined with an English language non-distinctive or generic term “SSTEEL”.

In the circumstances, the Panel accepts the Complainant's request and considers that it is appropriate to proceed to determine the proceeding in the English language.

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC’s responsibility to achieve actual notice to the Respondent.

On March 13, 2024 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

That the written notice was not sent on the Respondent's address of seat because the address was insufficient and non-existent. The notice of the Commencement of the administrative proceeding was therefore only sent by email.

The written notice was sent both in Chinese and English.

The e-mail notice sent to <postmaster@tkrupp-ssteel.com> was returned back undelivered as the e-mail address had permanent fatal errors.

The e-mail notice was also sent to <sales1@shzy-steel.com>, but we never received any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed site.

The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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

The Complainant owns the international trademarks “tk”, “krupp” and “KRUPP” and multiple domain names with the “KRUPP” trademark which are used in connection with its goods or services.

The Respondent registered the disputed domain name <tkrupp-ssteel.com> on May 5, 2023.

The disputed domain name was registered after the Complainant’s trademark “tk”, “krupp”, and “KRUPP”.

The Complainant has also previously initiated UDRP proceedings against the Respondent in the CAC and WIPO challenging the Respondents’ registration of other disputed domain names.

The Complainant challenges the registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

For the reasons articulated in the Panel’s reasons above, the Complainant has satisfied the Panel of the following:

(a) The disputed domain name is confusingly similar to the Complainant’s widely known trademarks.

(b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.

(c) The disputed domain name has been registered and is being 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. **tkrupp-ssteel.com** : Transferred

PANELLISTS

Name	**William Lye OAM KC**

DATE OF PANEL DECISION 2024-03-25

Publish the Decision