# Decision for dispute CAC-UDRP-107234

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| Case number | CAC-UDRP-107234 |
| Time of filing | 2025-01-23 09:31:45 |
| Domain names | thyssenkruppuhde.com |

## Case administrator

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| Name | Olga Slanařová (Case admin) |

## Complainants

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| Organization | thyssenkrupp AG- thyssenkrupp Intellectual Property GmbH |
| Organization | thyssenkrupp Uhde GmbH |

## Respondent

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| Organization | NameInvest Inc. - Registered Office |

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

Complainant states that it is the owner of numerous trademarks that consist of or contain THYSSEN, THYSSENKRUPP and UHDE. The Complaint contains extensive schedules of registrations for these trademarks but does not provide any documentation in support thereof. However, exercising its authority pursuant to paragraph 10 of the Rules, the Panel has confirmed registrations for the following select trademarks:

- EU Reg. No. 001037555 for THYSSEN (registered March 22, 2000) for use in connection with, inter alia, “chemicals used in industry”;
- EU Reg. No. 000964353for THYSSENKRUPP (registered January 7, 2000) for use in connection with, inter alia, “chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry”;
- EU Reg. No. 1340849for UHDE (registered June 2, 2016) for use in connection with, inter alia, “chemicals used in industry and science, in particular hydrocarbons, alkanes, isobutyl, olefins, paraffins, aromatics”.

See WIPO, section 4.8: “[I]t has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision…. This may include… accessing trademark registration databases.”

FACTUAL BACKGROUND

Complainant states that it is “a globally recognized leader in the planning, construction, and servicing of chemical plants”; that it was “[f]ounded in Dortmund in 1921 by Friedrich Uhde”; that after a number of acquisitions and mergers, it “became part of ThyssenKrupp Technologies” in 1999; that it has “more than 100.000 employees and a revenue of more than 38 billion EUR in fiscal 2022/2023”; and that “[i]t is one of the world’s largest steel producers and was ranked tenth largest worldwide by revenue in 2015.”

The disputed domain name was created on April 8, 2022, and, as stated in the Complaint, “resolves to a website with no content” (although a screenshot included with the Complaint shows that the disputed domain name is used in connection with what appears

to be a monetized parking, or “pay-per-click” website, with links labelled (as translated from German) “Electronics Development Service,” “CNC Offer” and “Commercial Register Extract”). Complainant states, and provides evidence in support thereof, that “Respondent explicitly offered the disputed domain for sale to the Complainant.”

Complainant states that Respondent “has repeatedly engaged in registering domains containing trademarks of prominent companies, only to offer these domains for sale at inflated prices,” citing LEGO Juris A/S v. Nameinvest Inc. / E.B, WIPO Case No. D2014-0803 (transfer of <lego-wear.com>); Deutsche Lufthansa AG v. Emma Boiton / NameInvest Inc., Forum Claim No. 1811218 (transfer of <lufthansa.shop>); and Weight Watchers International, Inc. v. NameInvest Limited, WIPO Case No. DCH2009-0024 (transfer of <weightwatcher.ch>).

Complainant also states, and provides evidence in support thereof, that Respondent registered the domain name <thyssenkrupp-industrials.de> in 2019, which Complainant “out of necessity” purchased from Respondent; and that Respondent has registered additional domain names that it has offered for sale to Complainant.

## PARTIES CONTENTIONS

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that it has rights in the THYSSEN, THYSSENKRUPP and UHDE trademarks based on the registrations listed in the Complaint, including those cited above; and that the disputed domain name is confusingly similar to these trademarks because “the elements of the disputed domain are identical to the complainant's trademarks ‘thyssenkrupp’, ‘ThyssenKrupp’ and ‘Uhde’” and “[t]he combination of these marks into a single domain name does not diminish the distinctiveness of either mark [but] [i]nstead, it reinforces the association with the Complainant trademarks.”

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the disputed domain name because, inter alia, “Respondent’s registration of the disputed domain name, given the widespread use of the Complainant’s ‘thyssenkrupp’ and ‘uhde’ mark and the Respondent’s lack of association with the Complainant, constitutes an attempt to derive unjustified commercial benefit on the back of the Complainant’s rights”; “Respondent has no prior right in the contested domain name”; “Respondent thus purchased/registered the disputed domain name containing the Complainant’s well-known trademarks at least in order to benefit from the Complainant’s reputation”; and “[f]ree riding on the rights of another does not constitute a bona fide use of a domain name.”

Paragraph 4(a)(iii): Complainant states that the disputed domain name was registered and is being used in bad faith because, inter alia, “[t]he Respondent’s bad faith is evident and underscored by a pattern of behavior that involves the deliberate registration of domains incorporating well-known trademarks, including the Complainant’s trademarks, with the sole intent of profiting financially at the expense of trademark owners”; the passive-holding doctrine applies given “the well-known status of the mark and the absence of rights or legitimate interests of the 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

**Identical or Confusingly Similar: Paragraph 4(a)(i)**

The trademark citation and documentation provided by Complainant are sufficient to establish that Complainant has rights in the trademarks described above.

As to whether the disputed domain name is identical or confusingly similar to these trademarks, the relevant comparison to be made is with the second-level portion of the disputed domain name only (i.e., "thyssenkruppuhde") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11.1.

Here, the disputed domain name contains each of the trademarks described above in their entirety. As set forth in section 1.7 of WIPO Overview 3.0: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

**Rights or Legitimate Interests: Paragraph 4(a)(ii)**

Complainant states that Respondent has no rights or legitimate interests in respect of the disputed domain name because, inter alia, "Respondent's registration of the disputed domain name, given the widespread use of the Complainant's 'thyssenkrupp' and 'uhde' mark and the Respondent's lack of association with the Complainant, constitutes an attempt to derive unjustified commercial benefit on the back of the Complainant's rights"; "Respondent has no prior right in the contested domain name"; "Respondent thus purchased/registered the disputed domain name containing the Complainant's well-known trademarks at least in order to benefit from the Complainant's reputation"; and "[f]ree riding on the rights of another does not constitute a bona fide use of a domain name."

WIPO Overview 3.0, section 2.1, states: "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 Panel finds that Complainant has established its prima facie case and, without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

**Registered and Used in Bad Faith: Paragraph 4(a)(iii)**

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

As set forth in section 3.1.4 of WIPO Overview 3.0: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar… to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." That is applicable here.

Further, WIPO Overview 3.0, section 3.3, states:

> From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding.
>
> While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and

(iv) the implausibility of any good faith use to which the domain name may be put.

Here, the trademarks owned by Complainant appear to be distinctive and to have a high degree of reputation given that they have been used for many years, are protected by numerous registrations, and used by a company that has “more than 100.000 employees and a revenue of more than 38 billion EUR in fiscal 2022/2023.” Further, Respondent did not submit a response or provide any evidence of actual or contemplated good-faith use. And it is implausible to conceive of any good faith use to which the disputed domain name may be put.

Finally, the Panel takes note of the decisions against Respondent in previous cases under the Policy, as well as Respondent’s actions toward Complainant, which appears to indicate a “pattern of such conduct” under paragraph 4(b)(ii) of the Policy.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **thyssenkruppuhde.com**: Transferred

## PANELLISTS

| Name | **Douglas Isenberg** |
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DATE OF PANEL DECISION 2025-02-27

Publish the Decision