Decision for dispute CAC-UDRP-107275

Case number	CAC-UDRP-107275
Time of filing	2025-01-29 10:22:17
Domain names	wurthmodyf-de.com

Case administrator

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

Complainant

Organization	Würth International AG
Organization	Würth Modyf GmbH & Co. KG

Complainant representative

Organization	HK2 Rechtsanwälte

Respondent

Name	Mandy Mohr

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

All Würth Line companies derive their right to operate under the names “Würth” and “Wuerth,” and all affiliated companies derive their right to use the designation “Member of the Würth Group” from Complainant 1.

Complainant 1, Würth International AG, holds trademark rights in the mark “WÜRTH” including, but not limited to, the following registration: International Registration No. 567225, registered on June 22, 1990, covering multiple classes of goods and services and designating nearly 50 countries for the marks “Würth” and “Wurth.”

Complainant 2, Würth Modyf GmbH & Co. KG, holds trademark rights in the mark “MODYF,” including German National Registration No. 30425078 (DPMA), registered on May 11, 2004, covering multiple classes.

FACTUAL BACKGROUND

The Complainants are both part of the globally operating Würth Group. Many Würth-affiliated companies bear the name of their founder, Adolf Würth, who established the Group in 1945 with the initial purpose of selling screws. Over time, Würth Group has grown into a global wholesaler specializing in fasteners, screws and screw accessories, dowels, chemicals, electronic and

electromechanical components, furniture and construction fittings, tools, machines, installation materials, automotive hardware, inventory management, and storage and retrieval systems.

Würth Group is the world market leader in its core business, namely the trade of assembly and fastening materials. It comprises over 400 companies in more than 80 countries and employs more than 85,000 people worldwide. In the business year 2023, Würth Group recorded a total revenue of EUR 20.4 billion.

Beyond its commercial activities, Würth Group is extensively engaged in cultural and sports promotion. Among other initiatives, Würth is an official partner of the German Football Association (DFB) and collaborates with various Bundesliga football clubs. Additionally, Würth Group has been an active sponsor in the motorsports industry for over 40 years.

The disputed domain name was registered on October 21, 2024. At the time of filing this Complaint, the disputed domain name resolved to a website that targeted Complainants' trademarks and business by displaying an online shop, which appeared to be fraudulent. The disputed domain name is currently redirected to a page displaying an error message.

PARTIES CONTENTIONS

COMPLAINANT:

(i) Complainant 1 holds rights in the "WÜRTH" trademark, while Complainant 2 holds rights in the "MODYF" trademark, as set forth in the "Identification of Rights" section above. The disputed domain name is confusingly similar to both trademarks, as it fully incorporates the marks, with the only modification being the omission of the German umlaut "Ü" in "WÜRTH."

(ii) The Respondent has no legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name, nor has Complainants authorized or licensed the Respondent to use the "WÜRTH" and "MODYF" marks in any manner. Moreover, the Respondent is not using the disputed domain name for any bona fide offering of goods or services, nor for any legitimate noncommercial or fair use. Instead, until recently, the disputed domain name resolved to a website that targeted Complainants' trademarks and business by displaying an online shop, which—to the best of Complainants' knowledge—was entirely fraudulent. As of the date of filing this Complaint, the website associated with the disputed domain name is offline.

(iii) Respondent registered and used the disputed domain name to mislead Internet users into believing it was an official or authorized website of Complainant. Given the global recognition of Complainants' trademarks, Respondent knew or should have known of their prior rights. Respondent has a pattern of registering similar fake online shops using brand names, reinforcing that the domain name is part of a broader fraudulent scheme that harms Complainants' reputation.

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

Multiple Complainants

In the present proceeding, there are two Complainants, namely, Würth International AG ("Complainant 1") and Würth Modyf GmbH &

Co. KG (“Complainant 2”). Paragraph 3(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) provides that “[a]ny person or entity may initiate an administrative proceeding by submitting a complaint.” FORUM’s Supplemental Rule 1(e) defines “The Party Initiating a Complaint Concerning a Domain Name Registration” as either “a single person or entity claiming to have rights in the domain name, or multiple persons or entities who have a sufficient nexus who can each claim to have rights to all domain names listed in the Complaint.”

The Panel further observes that previous UDRP precedents have established that multiple complainants may submit a single complaint if they can demonstrate a sufficient connection, such as a licensing arrangement, a partnership, or an affiliation that justifies them acting as a single entity for the purposes of the proceeding. See Vancouver Org. Comm. for the 2010 Olympic and Paralympic Games & Int’l Olympic Comm. v. Malik, FA 666119 (Forum May 12, 2006), where the panel accepted this approach.

Complainants assert that they are both part of the globally operating Würth Group. Many Würth-affiliated companies bear the name of their founder, Adolf Würth, who established the Group in 1945 with the initial purpose of selling screws. All Würth Line companies derive their right to operate under the name “Würth” and “Wuerth,” while all affiliated companies derive their right to use the designation “Member of the Würth Group” from Complainant 1.

The Panel also notes that Complainant 1 holds rights in the “WÜRTH” trademark, while Complainant 2 holds rights in the “MODYF” trademark, as set forth in the "Identification of Rights" section above.

In view of the foregoing, the Panel finds that there exists a sufficient nexus or connection between the Complainants and therefore treats them as a single entity in this proceeding. Accordingly, unless individual reference is necessary, Complainants shall be collectively referred to as “Complainant” in this decision.

Language of the Proceedings

The Panel notes that the Registration Agreement is in Chinese, making Chinese the default language of the proceedings. However, Complainant has requested that the proceedings be conducted in English. Under UDRP Rule 11(a), the Panel has the discretion to determine the appropriate language of the proceedings, considering the specific circumstances of the case. See Section 4.5, WIPO Overview 3.0; see also Lovehoney Group Limited v. Yan Zhang, CAC 103917 (Aug. 17, 2021) (proceedings conducted in English despite the Registration Agreement designating Japanese as the language).

Complainant supports its request with the following arguments:

- Complainant is a German company with no familiarity with Chinese, and requiring it to proceed in Chinese would impose a disproportionate financial burden due to the need for specialized translation services.
- Respondent registered the domain name under the ".com" top-level domain, which suggests familiarity with English.
- The disputed domain name itself is not in Chinese characters, indicating that the choice of a Chinese Registrar was not due to language preference.
- The fake online shop previously operated under the domain name was not in Chinese but in various European languages, further demonstrating Respondent’s ability to understand languages other than Chinese.

Pursuant to UDRP Rule 11(a), the Panel finds these arguments persuasive. Given the specific circumstances of this case and the absence of any Response or objection from Respondent, the Panel determines that the language of the proceedings shall be English.

The Panel is further satisfied that all other procedural requirements under the UDRP have been met and that there is no reason to delay the issuance of a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(2) Respondent has no rights or legitimate interests in respect of the domain name; and

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

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the 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 and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnetmarketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Rights

Complainant 1 holds rights in the “WÜRTH” trademark, while Complainant 2 holds rights in the “MODYF” trademark, as set forth in the "Identification of Rights" section above. The disputed domain name is confusingly similar to both trademarks, as it fully incorporates the marks, with the only modification being the omission of the German umlaut “Ü” in “WÜRTH.”

The Panel recognizes that an international or national trademark registration is sufficient to establish rights in a trademark. Complainant has submitted evidence of their trademark registrations with international authorities and the German national trademark office - German Patent and Trade Mark Office (DPMA). Accordingly, the Panel finds that Complainant has established trademark rights in “WÜRTH” and “MODYF.”

Complainant further argues that the disputed domain name is confusingly similar to their "WÜRTH" and "MODYF" trademarks, as it fully incorporates both marks, differing only by the omission of the German umlaut “Ü” in “WÜRTH.” The Panel observes that the omission of an umlaut is generally not considered a distinguishing factor in domain name comparison (Glashütter Uhrenbetrieb GmbH v. Wang Liqun, WIPO Case No. DNL2016-0054).

In this regard, the disputed domain name bears a high degree of similarity to Complainant 1’s name and “WÜRTH” trademark, Complainant 2’s “MODYF” trademark, or is identical to the combination of “WÜRTH” and “MODYF,” each of which enjoys broad trademark protection. The Panel concurs with Complainants' position and concludes that the disputed domain name is confusingly similar to the “WÜRTH” and “MODYF” trademarks.

No rights or legitimate interests

A complainant must first make a prima facie case that a respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), after which the burden shifts to the respondent to demonstrate it does have rights or legitimate interests. See Section 2.1, WIPO Jurisprudential Overview 3.0 ("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 Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name because the Respondent is not commonly known by the disputed domain name, nor has the Respondent been authorized by the Complainant to use the Complainant's mark, and the Respondent is not affiliated with the Complainant. Relevant information, such as WHOIS data, can serve as evidence to demonstrate whether a respondent is or is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii). The Panel notes that the WHOIS data lists "Mandy Mohr" as the registrant, and there is no evidence in the record indicating that the Respondent was authorized to use the mark. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).

Complainant asserts that Respondent does not use the disputed domain name in connection with a bona fide offering of goods or services, nor for any legitimate noncommercial or fair use, as Respondent is attempting to pass itself off as Complainant. When a respondent impersonates a complainant through a disputed domain name, such conduct does not constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use under Policy paragraph 4(c)(i) or (iii). See Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund, FA 1790949 (Forum July 9, 2018) (finding that a respondent’s use of a domain name to feature a complainant’s mark and related content did not qualify as a bona fide offering of goods or services under Policy paragraph 4(c)(i) or a legitimate noncommercial or fair use under Policy paragraph 4(c)(iii)).

Complainant provides evidence in the form of a screenshot of the website associated with the disputed domain name, demonstrating that Respondent’s website prominently displays Complainant’s marks “WÜRTH” (omitting the umlaut) and “MODYF” in black and red and offers various types of apparel and footwear. Complainant emphasizes that the online shop operating under the disputed domain name lacks a legally required imprint (as mandated under German and EU law), does not provide valid contact details, and includes only generic terms and conditions. To the best of Complainant’s knowledge, the website is entirely fraudulent and part of a broader data theft and fraud scheme.

Even if the disputed domain name were used for an actual online shop, panels have recognized that any resellers, distributors, or service providers using a complainant’s trademark in a domain name to offer related goods or services may only establish a bona fide offering of goods and services if they satisfy the cumulative requirements of the “Oki Data test” (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903). A key requirement of this test is that the website must accurately and prominently disclose the registrant’s relationship with the trademark holder. See WIPO Jurisprudential Overview 3.0, Section 2.8.1. In this case, the website under the disputed domain name makes no such disclosure, further confirming that Respondent is not a legitimate reseller or distributor.

The Panel finds that Respondent’s activities associated with the disputed domain name are fraudulent, create a likelihood of confusion with Complainant’s trademarks, and are intended to mislead or disrupt Internet users. Accordingly, the Panel concludes that Respondent’s fraudulent activities and unauthorized passing off do not constitute use of the disputed 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 under Policy paragraph 4(c)(iii).

Based on the foregoing considerations, the Panel finds that Complainant has established a prima facie case against Respondent. As Respondent has failed to submit a Response or provide any rebuttal, the Panel determines that Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on the respondent's website or location.

Complainant asserts that Respondent registered and is using the disputed domain name in bad faith by disrupting Complainant's business and misleading Internet users for commercial gain. When a respondent impersonates a complainant through a disputed domain name, such conduct may constitute bad faith disruption under Policy paragraph 4(b)(iii) and an attempt to attract users for commercial gain under Policy paragraph 4(b)(iv). See Bittrex, Inc. v. Wuxi Yilian LLC, FA 1760517 (Forum Dec. 27, 2017) (finding bad faith under Policy paragraph 4(b)(iv) where "Respondent registered and uses the domain name in bad faith by directing Internet users to a website that mimics Complainant's own website to confuse users into believing that Respondent is Complainant, or is otherwise affiliated or associated with Complainant").

As previously noted, Respondent's website prominently displays Complainant's marks "WÜRTH" (without the umlaut) and "MODYF" in black and red and offers various apparel and footwear, despite strong indications that the site is fraudulent. The Panel finds that Respondent's use of the disputed domain name disrupts Complainant's business by misleading consumers and falsely suggesting an affiliation with Complainant. This conduct serves to redirect Internet users to Respondent's website, thereby exploiting Complainant's goodwill. Accordingly, the Panel concludes that Respondent registered and used the disputed domain name in bad faith under Policy paragraph 4(b)(iv).

Complainant further argues that Respondent registered the disputed domain name with actual knowledge of Complainant's trademark rights, given the global recognition of Complainant's "WÜRTH" and "MODYF" trademarks. While constructive knowledge alone is insufficient to establish bad faith under Policy paragraph 4(a)(iii), actual knowledge of a complainant's trademark rights is sufficient and may be inferred where a respondent uses the disputed domain name to impersonate the complainant. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum Feb. 6, 2014) (finding actual knowledge where the domain name incorporated the complainant's mark and the respondent's use implied an affiliation with the complainant); see also Spectrum Brands, Inc. v. Guo Li Bo, FA 1760233 (Forum Jan. 5, 2018) ("[T]he fact that Respondent registered a domain name that looked identical to the SPECTRUM BRANDS mark and used it as an email address to pass itself off as Complainant shows that Respondent knew of Complainant and its trademark rights at the time of registration.").

The Panel infers that Respondent had actual knowledge of Complainant's rights in the "WÜRTH" and "MODYF" trademarks at the time of registration, as evidenced by:

- Respondent's unauthorized use of Complainant's trademarks;
- Respondent's offering of products under Complainant's marks; and
- The widespread recognition of Complainant's trademarks, as noted in the Factual Background section.

Accordingly, the Panel concludes that Respondent registered the disputed domain name in bad faith under Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **wurthmodyf-de.com**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2025-03-17

Publish the Decision