Decision for dispute CAC-UDRP-107699

Case number	**CAC-UDRP-107699**
Time of filing	**2025-08-14 14:00:54**
Domain names	**bilstein.shop**

Case administrator

Name	**Olga Slanařová (Case admin)**

Complainant

Organization	**thyssenkrupp Bilstein GmbH**

Respondent

Name	**Ingo Knarr**

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 is the owner of many trademark registrations including the following examples:

- International trademark Registration No. 1025467, dated November 4, 2009, for the trademark BILSTEIN;
- International trademark Registration No. 1688993, dated May 2, 2022, for the trademark BILSTEIN; and
- International trademark Registration No. 383704, dated September 30, 1971, for the trademark BILSTEIN and Design.

FACTUAL BACKGROUND

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

In 1873, the Complainant’s predecessor company was founded by August Bilstein in Altenvoerde, Westphalia. In 1927, the company then had its first experience as an automotive supplier: The son of the founder Hans Bilstein started on the road to the automotive accessories industry in 1927 by cooperating with the Berlin-based Levator-Hebezeug-Fabrik, which was taken over in 1930. This also brought their crane production to Bilstein, which was only discontinued in 1992 after the takeover by Krupp. 1954 saw the start of development of the monotube gas pressure shock absorber based on the de carbon principle: Bilstein builds the first gas pressure shock absorber based on an idea by the French vibration researcher Bourcier de Carbon. In it, a gas pressure cushion compensates for the difference in volume when the piston moves in and out. From 1957, gas pressure shock absorbers were produced for Mercedes-Benz original equipment. In 1991, the company was taken over by Krupp Stahl AG; the company initially traded as Krupp Bilstein GmbH; after the merger of the Thyssen and Krupp groups, the company was renamed ThyssenKrupp Bilstein. The Complainant also maintains a strong online presence and operates its main webpage at “www.bilstein.com”, which it registered on August 8, 1996. The Complainant is also the registrant of other domain names containing its trademark and company name “Bilstein”.

The disputed domain name was registered on March 5, 2025 and resolves to a page displaying the message „Domain parked. This

domain is managed with <easyname.com>. Prior to this, the disputed domain name automatically redirected users to the website at www.tunership.de. On April 1, 2025, the Complainant had entered into a Permit Agreement with a company by the name of TUNERSHOP GmbH in which it granted a limited license to use the BILSTEIN trademark for the purpose of promoting the sale of the Complainant's products.

On July 10, 2025, the Complainant sent a demand letter to the Respondent, at an email address that includes the domain name tunershop.com. In subsequent correspondence, the Respondent did not accede to the Complainant's request for a voluntary transfer of the disputed domain name but claimed not to be the registrar or domain holder and suggested that the Complainant contact the domain holder to ask if they would be willing to sell the domain.

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

Media & Sports e.K. is a service agency for internet services, hosting, and the creation of online presences. Media & Sports e.K. is registered in the commercial register of the Hof District Court under HRA 4521. Media & Sports e.K. serves, among others, TUNERSHOP GmbH, one of the largest online retailers of tuning parts, which sells car accessories worldwide.

TUNERSHOP GmbH sells original BILSTEIN products and has been authorized by thyssenkrupp Bilstein GmbH to use the "Bilstein" trademark. TUNERSHOP GmbH has commissioned Media & Sports e.K. to create an online shop for original Bilstein products under the domain www.BILSTEIN.shop and to provide technical support.

After TUNERSHOP GmbH was informed that thyssenkrupp Bilstein GmbH would not approve the planned online shop, the project was terminated. The domain is currently not used commercially. The domain is currently not used commercially.

PARTIES CONTENTIONS

THE COMPLAINANT:

The disputed domain name is identical or confusingly similar to the Complainant's trademark as it contains the entirety of the trademark and adds only the „.shop" top-level domain.

The Respondent has no rights or legitimate interests in the disputed domain name where it is not commonly known thereby, it registered the disputed domain name without authorization and in violation of an agreement between the Complainant and TUNERSHOP GmbH, it formerly redirected the disputed domain name to its the www.tunershop.de website which sells a variety of automobile parts and related products, and, after the Complainant sent its demand letter to the Respondent, the disputed domain name resolves to a registrar parking page with no substantive content.

The disputed domain name was registered and is used in bad faith where the Respondent had prior knowledge of the Complainant's trademark and based on the above-mentioned activities.

THE RESPONDENT:

After TUNERSHOP GmbH was informed that thyssenkrupp Bilstein GmbH would not approve the planned online shop, the disputed domain name will be a non-commercial price comparison portal for original Bilstein products. In any case, no registered trademarks will be used, and a disclaimer will be clearly positioned stating: "The website operator is not a group company of thyssenkrupp Bilstein GmbH."

At no time was there any malicious use or intent to deceive website visitors or using the domain names in bad faith.

THE COMPLAINANT'S SUPPLEMENTAL SUBMISSION:

After the Response was filed, the Complainant submitted a further pleading titled “Response to Respondent's reply” and this has been accepted by the Panel.

This further pleading restates that “The Respondent was never authorized by the Complainant to register or hold a domain name consisting of the BILSTEIN mark.”. It goes on to highlight the fact that “[t]he disputed domain was registered on 5 March 2025. The Respondent claims that he can rely on alleged permission under the Authorization of Use Agreement. However, this Agreement was only concluded on April 1, 2025. Furthermore, the Agreement does not contain any permission to register the BILSTEIN trademark as a domain name.”.

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 disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy is a standing requirement which is satisfied if the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. Furthermore, it is not as extensive as the “likelihood of confusion” test for trademark infringement applied by many courts. Rather, under the Policy confusing similarity is commonly tested by comparing the Complainant’s trademark and the disputed domain name in appearance, sound, meaning, and overall impression. See Administradora de Marcas RD, S. de R.L. de C.V. v. DNS Manager / Profile Group, 101341 (CAC November 28, 2016).

It has been consistently held that “[w]here 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.”. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”), at paragraph 1.2. In this case, the Complainant has submitted screenshots from the World Intellectual Property Organization website demonstrating that it owns a registration of the BILSTEIN trademark. The Panel accepts this evidence as proof of the Complainant’s asserted trademark rights.

Next, the second level of the disputed domain name consists entirely of the Complainant’s trademark and the disputed domain

name only adds the ".shop" TLD. This does not dispel the confusing similarity between the disputed domain name and the Complainant's trademark in a side-by-side comparison appropriate to Paragraph 4(a)(i). Entain Operations, Ltd. v. Chai Rui Chen, UDRP-106451 (CAC May 26, 2024) (bwin.tokyo found to be identical or confusingly similar to the BWIN trademark). Further, the addition of a gTLD typically adds no meaning to a domain name. Lesaffre et Compagnie v. Tims Dozman, 102430 (CAC May 2, 2019) ("the top-level suffix in the domain name (i.e. the '.com') must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration."). Thus, the Complainant asserts that the disputed domain name is confusingly similar to the asserted trademark and will lead internet users to wrongly believe that the disputed domain name originates from or is endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. Guangdong Qisitech CO., LTD. v. Xiao Chun Liu, UDRP-107372 (CAC April 22, 2025) (confusing similarity found where "[t]he disputed domain names [geekbari.com, geekbarcm.com, geekbarz.com] contain the Complainant's trade mark "GEEK BAR" in its entirety with the addition of the letters "i", "cm" and "z".").

Accordingly, the Panel finds that the Complainant has rights to the BILSTEIN trademark and that the disputed domain name is confusingly similar to such trademark. Thus, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

2. Rights or Legitimate Interests:

Paragraph 4(c) of the Policy sets out certain circumstances which, if proven by the evidence presented, may demonstrate a respondent's rights or legitimate interests in respect of a disputed domain name.

First, the Panel concludes, on the basis of the Complainant's undisputed contentions, that the Respondent has not made use, or made demonstrable preparations for use of the disputed domain name in connection with a bona fide offering of goods or services as noted in paragraph 4(c)(i) of the Policy. Although a company named TUNERSHOP GmbH, is party to an April 1, 2025 „Permit Agreement" which includes limited authorization to use the BILSTEIN trademark in promoting the sale of the Complainant's products, according to the Complainant, the Respondent, in his individual capacity, „has never been authorized by the Complainant to register or use the BILSTEIN trademark, nor to incorporate it into any domain name.". Rather, correspondence between the Complainant and the Respondent, prior to the filing of the present action and copies of which have been submitted into evidence, indicates that the disputed domain name formerly automatically redirected users to the www.tunershop.de website and that the Respondent claims an intention of setting up a website to offer the Complainant's products. After this correspondence, the disputed domain name began resolving to a parked page that contains only the message „Domain parked. This domain is managed with <easyname.com>. It is particularly noteworthy that the Respondent's email address in this exchange uses a "@tunershop.de" address, despite the Whois record listing the Registrant Organization as "Media & Sports", thus leaving open the question of on whose behalf the Respondent was corresponding. Nevertheless, the Panel concludes that the Respondent had no authorization to register the disputed domain name personally or on behalf of Media & Sports e.K. and that, even were it acting under the auspices of TUNERSHOP GmbH who is party to the Permit Agreement, it registered the disputed domain name prior to the Permit Agreement coming into effect and it would nevertheless be in violation of a document titled Bilstein Partner Guide which contains the following language: „Domains: Never use the BILSTEIN brand name in any form in your domain name to avoid giving the impression it is an official BILSTEIN website.". Past decisions under the Policy have held that use of a disputed domain name in violation of a contract is not a bona fide offering of goods or services. See, e.g., Shopify Inc. v. Hulmiho Ukolen, 24034-UDRP (CIIDRC August 17, 2023) (no bona fide use found where „the provisions of the Partner Agreement explicitly prohibit Respondent from incorporating SHOPIFY into a domain name...").

Further, as the Whois record for the disputed domain name identifies the Registrant Name as „Ingo Knarr" and the Registrant Organization as "Media & Sports", there is no evidence before this Panel to suggest that the Respondent is itself commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

Finally, it cannot be said that the Respondent has made a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain as noted in paragraph 4(c)(iii) of the Policy. The Respondent stated, in its correspondence with the Complainant, that its intention was to create a website offering the Complainant's products for sale. Further, the Response states that "TUNERSHOP GmbH has commissioned Media & Sports e.K. to create an online shop for original Bilstein products" and goes on to say that "After TUNERSHOP GmbH was informed that thyssenkrupp Bilstein GmbH would not approve the planned online

shop, the project was terminated. The domain is currently not used commercially. The idea is that this will not be an online shop for Bilstein products, but rather a non-commercial price comparison portal for original Bilstein products.”. While the UDRP does provide room for nominative fair use by a distributor, the Respondent submits no evidence to support its above-mentioned claims and, in any event, the prohibition on ownership of domain names in the Bilstein Partner Guide places any such activity outside the ambit of the test for nominative fair use by distributors as set out in the seminal case of Oki Data Americas, Inc. v. ASD, Inc., D2001-0903 (WIPO Nov. 6, 2000). See, e.g., The Goodyear Tire & Rubber Company v. Artemio Garza, Sunil Shahzad, Promotora Internacional de Neumáticos SA, D2020-0019 (WIPO July 21, 2020) („The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark.”).

Therefore, based on the evidence before it, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) and of the Policy and demonstrated that the Respondent has no rights or legitimate interests in the disputed domain name.

3. Bad Faith Registration and Use:

In order to prevail in a dispute, paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name has both been registered and is being used in bad faith.

The Complainant states that it is „a globally recognized German company“ and that the BILSTEIN trademark is famous. In support, it provides screenshots of its own www.bilstein.com website. While this does show some effort at promoting its products, it alone does not demonstrate the reputation and scope of the trademark. However, as noted in the previous section, the Complainant provides screenshots of correspondence it has had with the Respondent in which it appears that the Respondent is an employee of one of the Complainant’s customers and it expressly stated that it was intending to set up a shop that will sell the Complainant’s products. From this, the Panel finds sufficient evidence to conclude that the Respondent had actual knowledge of the Complainant’s rights in the BILSTEIN trademark at the time that it registered the disputed domain name.

As for use, the Complainant has submitted evidence that the disputed domain name resolves to a page with no substantive content. Such lack of activity can demonstrate bad faith use of a domain name that is confusingly similar to an asserted trademark. BOURSORAMA v. Sahad Mohammed Riviera (Sahari Muti Inc), UDRP-105427 (CAC June 15, 2023) ("a passive holding of a disputed domain name may, in appropriate circumstances, be consistent with the finding of bad faith, in particular in circumstances in which, for example, (1) the Complainant's trademark is reputed and (2) there is no conceivable use that could be made of the disputed domain name and would not amount to an infringement of the complainant’s trademark’s rights.") As noted above, the Complainant’s evidence of its trademark’s reputation is slim but the fact that the second level of the disputed domain name is identical to the Complainant’s trademark and is followed by the highly relevant gTLD „.shop“ tilts this issue slightly in favor of the Complainant.

Of further importance is the Respondent’s behavior when approached by the Complainant in its pre-Complaint correspondence. In its initial reply to the Complainant’s demand letter, the Respondent states: „We have reserved the domain <bilstein.shop> because we are currently setting up a shop that will exclusively offer Bilstein products.“. However, after the Complainant persists in demanding a transfer of the disputed domain name, the Respondent replies: „Unfortunately, we are unable to transfer the domain as we are not the registrar.“. When pressed on the issue of ownership, the Respondent states: „we are neither the registrar nor the domain owner“ and then goes on to say: „Before requesting an Auth Code, I believe you should first ask the registrar/domain owner whether they would be willing to sell the domain to you“. The Complainant asserts that these inconsistent statements raise suspicion of the Respondent’s credibility and further „demonstrate the Respondent’s intent to derive monetary benefit from the domain name, which contains the Complainant’s exact trademark“ by offering to sell it to the Complainant in violation of paragraph 4(b)(i) of the Policy. As noted above, it is unclear to the Panel who is the Respondent’s employer and thus who is the “we” referred to in its correspondence. Regardless, the suggestion that the disputed domain name may be for sale to the Complainant, whose trademark was specifically copied, lends credence to the Complainant’s assertions and makes it more likely than not that the Respondent’s actions run afoul of paragraph 4(b)(i) of the Policy.

In considering all of the above circumstances of this case, the Panel finds that the Complainant has demonstrated the Respondent’s

bad faith registration and use by a preponderance of the evidence.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **bilstein.shop**: Transferred

PANELLISTS

Name	**Steven Levy**

DATE OF PANEL DECISION 2025-09-12

Publish the Decision