Decision for dispute CAC-UDRP-107901

Case number	CAC-UDRP-107901
Time of filing	2025-09-21 19:16:44
Domain names	bilstein.org

Case administrator

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

Complainant

Organization	thyssenkrupp Bilstein GmbH

Respondent

Organization	SuperAspect LTD

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

International Trade Mark Registration No. 1025467 BILSTEIN registered from 4 November 2009 for various motor vehicle parts in class 12 and designating protection in numerous jurisdictions.

FACTUAL BACKGROUND

The Complainant operates an automotive parts business that was first founded by August Bilstein in 1873 and now focuses on the manufacture of shock absorbers. It trades under the name "Bilstein" and operates a website at <bilstein.com>, being a domain name that was first registered in 1996.

The Complainant employs approximately 4,100 people who work across production sites in Germany, Great Britain, Romania, USA, China and Mexico.

In addition to use on its website, the Complainant uses the "Bilstein" trade mark in catalogues and print advertising. Further, it owns numerous domain names containing "bilstein" and it has numerous registrations around the world for trade marks consisting of, or containing, "Bilstein", including the above-mentioned international registration. The Complainant has asserted, and the Respondent has not disputed, that "bilstein" has no known generic meaning in any language. It is simply the surname of the Complainant's founder.

The Respondent is a company incorporated in the United Kingdom that operates a domain name trading business. It registered the disputed domain name on 27 October 2023 at a cost of USD$18.49. At the time of the complaint the disputed domain name did not resolve to an active website. Rather it resolved to a parking page that listed it for sale at a price of USD$3,495.

PARTIES CONTENTIONS

The Complainant's rights in the BILSTEIN trademark do not appear to be in dispute. The Complainant contends it has rights in this

trademark and that it is identical or confusingly similar to the disputed domain name. That particular contention is not expressly disputed by the Respondent.

The Complainant contends that its BILSTEIN trademark is well-known, enjoys a high reputation and is promoted through a strong online presence. In such circumstances the Complainant further contends that: "There can be no doubt that the Respondent had knowledge of the Complainant's well-known trademarks and company name when registering the disputed domain name bilstein.org. In the present case, particular account must be taken of the fact that the Complainant's trademark is an unusual term consisting of the surname of his funder (sic.) August Bilstein". Therefore, the Complainant argues that the Respondent registered the disputed domain name in bad faith and was opportunistically seeking to profit from the reputation in BILSTEIN.

Finally, the Complainant further asserts that the Respondent has no rights or legitimate interests in the disputed domain name. It points to the fact the Respondent has not used the disputed domain name for an offering of goods and services. However, its primary contention appears to be that given BILSTEIN is well-known and a distinctive name there is no plausible reason for the Respondent to register the disputed domain name other than to misled consumers or benefit from the reputation in the trademark.

The Respondent contends that at the time of registering the disputed domain name it had no knowledge of the Complainant's BILSTEIN trademark. It further asserts that it operates a legitimate business of trading in domain names and its offer to sell the disputed domain name for AUD$3,495 was not an inflated price but rather the value of the disputed domain name. The Respondent therefore denies that it has registered and used the disputed domain name in bad faith. Further, the Respondent contends it does have a legitimate interest in the disputed domain name by reason of its trading activities in buying and selling domain names. Finally, the Respondent does not appear to dispute the Complainant's contention that BILSTEIN is well-known and an unusual term with no generic meaning.

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

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

A. RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has an international trademark registration consisting of the word BILSTEIN. Further this registration designates a number of jurisdictions and it predates the registration date of the disputed domain name by over a

decade.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark BILSTEIN.

The next question is whether the disputed domain name is confusingly similar to the BILSTEIN trademark.

The Panel disregards the gTLD suffix ".org" for the purpose of this comparison. It is of no branding significance.

The remaining element of the disputed domain name is merely the word <bilstein>, which is identical to the Complainant's trademark. There is therefore no difference between the BILSTEIN trademark and the disputed domain name that would be of any branding significance to an internet user.

The disputed domain name is confusingly similar to the BILSTEIN trademark.

B. NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests (Croatia Airlines d. d. v. Modern Empire Internet Ltd. WIPO Case No. D2003-0455). Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Respondent is not identified in the Whois database as having a name related to the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name. Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy ¶ 4(c) (ii) that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c) (ii).”).

Further, the Respondent has not used the disputed domain name to offer any good or service and it appears uncontested that BILSTEIN is a name with no generic meaning.

In such circumstances the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests. Therefore, the Respondent now carries the onus to rebut this prima facie case.

The Respondent's argument is that its legitimate interest in the disputed domain name results from the fact it is a legitimate business that is entitled to practice in the trade of buying and selling of domain names for profit. The Panel accepts that such a trading business may be legitimate. However, that is not the question to be determined in the present proceeding. The legitimacy of the Respondent's business as a whole is not a key matter for determination. The question is does the Respondent have a right or legitimate interest in the particular disputed domain name.

It is acknowledged that a registrant may have a legitimate interest in a domain name by reason of domain investing. Namely, a registrant may register a domain name for the purpose of reselling it for a profit in the future. This practice is commonly undertaken for domain names incorporating descriptive or dictionary terms whereby the registrant has no intent to profit or exploit some trademark owners’ rights (see Javier Narvaez Segura, Grupo Loading Systems S.L. v. Domain Admin, Mrs Jello, LLC. WIPO Case No. D2016-1199).

However, in the present case BILSTEIN is a name with no generic meaning. The Respondent has not put forth any explanation why it wholly incorporated this name in the disputed domain name as opposed to any other word or words. It is silent on that point. Further, whilst the Respondent does dispute that it knew of BILSTEIN and the time of registration it does not expressly dispute the Complainant's contentions that BILSTEIN is its well-known trademark and a distinctive name.

In answer to the prima facie case against it, the Respondent has failed to demonstrate that it has any rights or legitimate interests in the disputed domain name.

C. BAD FAITH

Passive holding of a domain name, such as for the purposes of resale, may, in appropriate circumstances, be indicative of bad faith. However, it will only be so indicative when all the circumstances of the Respondent's behaviour indicate it is acting in bad faith (Telstra Corporation Ltd v. Nuclear Marshmallows D2000-0003 (WIPO 18 February 2000).

It is of great concern to the Panel that BILSTEIN is a well-known and distinctive trademark. Further, it is a trademark used in the Respondent's home jurisdiction of Great Britain where the Complainant has a production site.

The Respondent has offered no plausible explanation why it wholly incorporated BILSTEIN in the disputed domain name as opposed to any other word or words. The Panel does not accept the Respondent's assertion that it did not know of the BILSTEIN trademark at the time of registering the disputed domain name.

The Panel finds that the Respondent had such prior knowledge at the time of registering the disputed domain name and therefore its only purpose in registering the disputed domain name was to opportunistically profit from confusing similarity. The Respondent

clearly targeted the Complainant's well-known trademark for this purpose and this is a case in which such profit would likely result from resale of the disputed domain name for an amount well in excess of the Respondent's out-of-pocket costs for registration, which is further indicative of bad faith (see Arla Foods Amba and Mejeriforeningen Danish Dairy Board v. Mohammad Alkurdi D2017-0391). Whilst in many circumstances it is not necessarily bad faith to profit from the resale of a domain name (such as where there is a legitimate interest of the kind referred to in Section B above) here the only foreseeable reason for the high value in the disputed domain name would be because of the Complainant's reputation in BILSTEIN. The Respondent has no justification in seeking to profit from such a reputation that in no way belongs to it.

Therefore, in consideration of all the circumstances 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. **bilstein.org**: Transferred

PANELLISTS

Name	**Andrew Sykes**

DATE OF PANEL DECISION 2025-10-17

Publish the Decision