

ADMINISTRATIVE PANEL DECISION

Sandvik Intellectual Property AB, Seco Tools AB v. shen Jie, EVRAZ-ENGINEERING LTD

Case No. D2023-0312

1. The Parties

The Complainants are Sandvik Intellectual Property AB and Seco Tools AB, Sweden, represented by SILKA AB, Sweden.

The Respondent is shen Jie, EVRAZ-ENGINEERING LTD, China.

2. The Domain Names and Registrar

The disputed domain name <pramet.group> is registered with TLD Registrar Solutions Ltd (the “Registrar”).

The disputed domain name <sandvik-coromant.org> is registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 24, 2023. On January 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 26, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for Privacy, Whois Privacy Corp.) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 27, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on January 30, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 8, 2023. In accordance with the Rules,

paragraph 5, the due date for Response was February 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 1, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on March 8, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Sandvik IP is a wholly owned subsidiary of Sandvik AB. Seco Tools AB is a wholly owned part of the Sandvik Group. Seco Tools AB owns the PRAMET registered trademarks and Sandvik AB owns the SANDVIK COROMANT registered trademarks. Sandvik IP provides intellectual property consultancy services to Sandvik AB. Both Sandvik and Seco are concerned with the engineering, production and sale of machining solutions. According to its 2021 Annual Report, Sandvik had approximately 44,000 employees and revenues of SEK 99 billion, with a portfolio of 3,700 patents and investments in R&D of approximately SEK 3.7 billion. Seco operates in more than 75 countries and is one of Sandvik's international network of companies selling its products.

The registered trademarks owned by the Complainants include PRAMET, International registration No 367748A, covering China, Russian Federation, and the European Union, amongst others, registered on April 6, 1970, in relation to classes 3,6,7,8,9, and 17 (owned by Seco Tools AB) and SANDVIK COROMANT (device), and International registration No. 1160354 registered on January 14, 2013, in relation to classes 6, 7, 8, 9, 35, 37, 40, 41 and 42 (owned by Sandvik Intellectual Property AB).

Both disputed domain names were registered by the Respondent on October 5, 2022. Both disputed domain names at one time resolved to websites offering goods online, but currently <pramet.group> resolves to a website which offers goods online similar to those offered by the Complainants, whereas the <sandvik-coromant.org> resolves to a pay-per-click ("PPC") website.

The Complainants operate the domain names <dormerpramet.com> (registered on June 30, 2014) ,and <coromant.com> (registered on September 23, 1996) which has the subdomain <sandvik.coromant.com>).

5. Parties' Contentions

A. Complainants

The Complainants note that they are here jointly filing a single complaint concerning multiple domain names against a single respondent. They say that in assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation (referring to paragraphs 10(e) and 3(c) of the UDRP Rules).

The Complainants point out that Sandvik Intellectual Property AB and Seco Tools AB form part of the Sandvik Group. Sandvik IP AB being in fact a subsidiary of Sandvik AB, and Seco Tools AB being a wholly-owned part of the Sandvik Group, operating as part of its Sandvik Machining Solutions business. They also note that they have filed previous UDRP complaints together in which the consolidation, also requested here, was accepted by the UDRP panels concerned. The Complainants point to the fact that they are related entities, form part of the Sandvik Group and, hence, they have a common grievance against the Respondent, who has engaged in conduct that has affected the Complainants' individual rights in a similar fashion. They submit that for those reasons consolidation would be equitable and procedurally efficient.

As indicated above, the Complainants conduct significant business globally by reference to the SANDVIK COROMANT and PRAMET registered trademarks that they own as part of the Sandvik Group. The Complainants point out that their trademarks form a recognizable part of the disputed domain names, and that therefore the latter should be considered confusingly similar to their respective marks (pointing to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, third Edition ("[WIPO Overview 3.0](#)"), section 1.7). The addition of hyphens is said to be insufficient to avoid a conclusion of confusing similarity, and the generic Top-Level Domain ("gTLD") extensions are to be ignored in this context.

The Complainants say that the Respondent has never been licensed or authorized to use their registered trademarks in any way, that there is no evidence that the Respondent has trademark rights in relation to the relevant terms, and that there is no evidence the Respondent was known, prior to registration, by the terms "sandvik coromant" or "pramet". These terms have no descriptive meaning in the English language.

The disputed domain names at one time resolved to two almost identical websites offering goods online, but currently, the Complainants show, <pramet.group> resolves to a website which offers goods online allegedly similar to those offered by the Complainants, and <sandvik-coromant.org> resolves to a PPC website. The website to which the <pramet.group> disputed domain name resolves, displays both the relevant Complainant's mark and also the marks of other unrelated third parties, and offers goods for sale under those trademarks. The website does not include any disclaimer pointing out that the website has no relationship with the Complainants, and the copyright notice of the website including the Complainant's PRAMET trademark, seeks to create an association with the Complainants. There is thus, according to the Complainants, no *bona fide* use that complies with the *OKI Data*¹ tests. The Complainants point out that <sandvik-coromant.org> resolves to a PPC website, showing a variety of hyperlinks to third parties' sites, most of them related to the sale of goods similar to those offered by the Complainants. Again, this does not amount to a *bona fide* offering of goods, and there is a high risk of implied but false association with the Complainants. The Complainants in any case deem it almost impossible for the Respondent to make any legitimate use of the disputed domain names.

The Complainants point out that the disputed domain names were registered in 2022, long after the relevant trademarks of the Complainant were adopted for use and were registered, and that it is implausible that the Respondent was unaware of them. The results of Google searches conducted the day before the date of registration point almost exclusively to the Complainants, and in any case, the latter say, only somebody fully aware of the Complainants' activities would register two domain names on the same day incorporating two different marks of the Complainants. Registering domain names that include the trademarks of well-known companies, the Complainants say, is indicative *per se* of bad faith. The facts relating to the present use of the disputed domain names, related above, point to bad faith use, and the Complainants say that it is likely the <sandvik-coromant.com> website was previously used in a manner similar to the present use of the <pramet.group> website. In accordance with those facts, and the fact that the disputed domain names are very similar to those used by the Complainants to operate their online presence, the Complainants contend that the Respondent is using the Complainants' marks in order to intentionally attempt to attract for commercial gain Internet users to their websites by creating the likelihood of confusion with the Complainants' marks as to the source, sponsorship, affiliation or endorsement of the web site or goods or services offered on it, which amounts to registration and use in bad faith in accordance with paragraph 4 (b)(iv) of the Policy.

The Complainants also point to the fact that the Respondent used a privacy service, and has been involved in a number of previous trademark-abusive domain name registrations as further evidence of bad faith on the part of the Respondent. Finally, the Complainants say that MX servers are configured in relation to the domain name <sandvik-coromant.org>, which indicates a risk that the Respondent will use this domain name to create an email address, with the suffix "@sandvik-coromant.org" for the purpose of deception. The Complainants point out that previous UDRP panels have considered the activation of MX servers as additional evidence of bad faith.

¹ *Oki Data Americas, Inc. v. Berkshire Trust*, WIPO Case No. [D2002-0415](#).

When the Complainants were informed by the Center of the identity of the registrant, they pointed out that the so-named Respondent was involved in previous UDRP decisions, *Seco Tools AB v. Evraz-Engineering Ltd.*, WIPO Case No. [D2019-2594](#) and *Sandvik Intellectual Property AB (SIP AB), Seco Tools AB, Walter AG v. Domain Admin, Whois Privacy Corp. / shen Jie, EVRAZ-ENGINEERING LTD*, WIPO Case No. [D2022-1946](#), and therefore they say that it is evident that the Respondent has specifically targeted the Complainants and their business by registering multiple domain names directly affecting the Complainant's wholly owned companies, which is said to be a clear indicator of registration and use in bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Preliminary issue – Consolidation of Complainants

The Complainants have brought a single consolidated Complaint against the Respondent and have requested that consolidation be granted since it meets the criteria set forth in prior UDRP decisions and in paragraph 4.11 of [WIPO Overview 3.0](#).

This is a clear case where consolidation is justified. Both Complainants are part of the Sandvik Group and have closely interrelated businesses. The two disputed domain names were registered on the same date by the same party and both include identical copies of the respective Complainants' trademarks. It appears likely that at one point both disputed domain names resolved to very similar websites, even though at present one resolves to a PPC site and another to a site containing hyperlinks to unrelated third parties. These are typical tactics commonly deployed by those who register domain names incorporating trademarks in relation to which they have no rights. Both are motivated by a similar desire to derive financial advantage from misleading consumers as to the existence of a link with complainant trademark owners. Additionally, it seems the Respondent has previously targeted trademarks of the Complainants for abusive registrations. The fact that the two domain names were each registered with a different registrar is of little consequence. The two Complainants have a common grievance against the Respondent, whose conduct has affected their individual rights in a similar fashion. Consolidation is equitable and procedurally efficient.

Therefore consolidation of this matter in relation to the two Complainants and two disputed domain names is warranted.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The disputed domain names are not identical to the respective SANDVIK COROMANT and PRAMET registered trademarks of the Complainants. However, in each case those trademarks are immediately recognizable in the respective disputed domain names, satisfying the requirements for confusing similarity under Paragraph 4(a)(i) of the Policy.

Therefore the Panel holds that the domain name <sandvik-coromant.org> is confusingly similar to the trademark SANDVIK COROMANT of Sandvik Intellectual Property AB, and the domain name <pramet.group> is confusingly similar to the PRAMET trademark of Seco Tools AB.

B. Rights or Legitimate Interests

The Respondent has not replied to any contentions of the Complainants and has thus not put before the Panel any material that would support rights or legitimate interests being recognized in its favor. The Complainants have not authorized or licensed the Respondent to use any of their registered trademarks in any way, and there is nothing before the Panel to suggest that the Respondent was known by the disputed

domain names or the Complainants' trademarks, or conducted any legitimate business as such or had obtained any rights by registration anywhere. The disputed domain names resolve to either PPC sites or sites that offer hyperlinked competing goods, and in some cases the relevant sites have also contained further reproductions of the Complainants' marks. Other than by these means, the Respondent has made no use of the disputed domain names, and hence no use that could qualify as justifiable under the Policy. Registering domain names that include distinctive and well established trademarks registered and used by third parties, to generate revenue in any of the ways described is not an activity of a kind that results in the upholding of rights or recognition of legitimate interests.

Therefore the Panel holds that the Respondent does not have rights or legitimate interests in either of the disputed domain names.

C. Registered and Used in Bad Faith

Since the Respondent registered both disputed domain names on the same day, and has then used them in similar ways, and each contains an identical copy of a highly distinctive trademark relating to similar business sectors, it is unimaginable that the Respondent was unaware of the Complainant and its rights at the time. It is clear that the Respondent intended to use the disputed domain names to attract the attention of Internet users and mislead them into thinking the sites to which they were taken are legitimately connected with the Complainants. That is not in fact the case, and further supporting a finding of bad faith use is the fact that the Respondent also reproduced the PRAMET registered trademark in one of the relevant sites and likely reproduced the SANDVIK COROMANT mark in another site. It seems the Respondent has engaged in this type of abusive domain name registration activity before, and also reproduced other distinctive trademarks belonging to unrelated third parties in a manner that was unauthorized. The Respondent thus set out to profit from the deception of Internet users to the detriment of the Complainants, whose well-established goodwill he deliberately misused.

Therefore the Panel holds that both disputed domain names were registered and used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <pramet.group>, and <sandvik-coromant.org> be transferred to the Complainants.

/William A. Van Caenegem
William A. Van Caenegem
Sole Panelist
Date: March 22, 2023