

ADMINISTRATIVE PANEL DECISION

**Simon-Kucher & Partners Strategy & Marketing Consultants GmbH v.
Matthew Collins, Bridgepoint Consulting
Case No. D2023-2438**

1. The Parties

The Complainant is Simon-Kucher & Partners Strategy & Marketing Consultants GmbH, Germany, represented by SKW Schwarz Rechtsanwälte Steuerberater Wirtschaftsprüfer Partnerschaft mbB, Germany.

The Respondent is Matthew Collins, Bridgepoint Consulting, United States of America.

2. The Domain Name and Registrar

The disputed domain name <slmon-kucher.com> (the “Disputed Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2023. On June 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 8, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 June 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on July 19, 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

The Complainant is a German consultancy company present in more than 30 countries.

The Complainant is the owner of several registered trademarks (hereinafter the “SIMON-KUCHER Trademarks”) including:

- the international wordmark SIMON-KUCHER & PARTNERS, No. 992355, registered on November 27, 2008 for products and services in classes 35, 36 and 41; and
- the German figurative mark  , No. 3020221085364, registered on June 9, 2022 for products and services in classes 9, 35, and 42.

The Complainant is also the owner of a domain name incorporating part of the SIMON-KUCHER Trademarks: <simon-kucher.com>.

The Disputed Domain Name was registered on May 18, 2023, and resolves to an inactive website.

5. Parties' Contentions

A. Complainant

First of all, the Complainant asserts that the Disputed Domain name is almost identical to its earlier SIMON-KUCHER Trademarks, since the differences to the dominant and distinctive element of its SIMON-KUCHER Trademarks are limited to the second letter within the first word: “l” instead of “i” for “slmon” instead of “simon”. The Complainant adds that the replaced letter only slightly differs in its graphical appearance.

Secondly, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, since the Respondent is unknown to the Complainant. The Complainant has not licensed the Respondent to use the SIMON-KUCHER Trademarks and to register and use the Disputed Domain Name.

Lastly, the Complainant asserts that the Disputed Domain Name was registered and is being used in bad faith. The Complainant points out the passive holding of the Disputed Domain Name and the intent of confusion of the Respondent in the choice of the Disputed Domain Name is evidence of bad faith. The Complainant submits that the Respondent is involved in typosquatting and that the Disputed Domain Name is used to drive traffic to it. The Complainant adds that there is also a risk that the Disputed Domain Name will be used to pass off as individuals from the Complainant to commit fraud (e.g., by emailing another party to request the payment of a fraudulent invoice) or trick individuals into revealing sensitive information.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has right;

- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the SIMON-KUCHER Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Disputed Domain Name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In 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 the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Regarding the Disputed Domain Name, the Panel finds that it is composed of the dominant and distinctive element of the SIMON-KUCHER Trademarks, in which the letter "i" is replaced by the letter "l", which constitutes a classic case of "typosquatting", and the generic Top-Level Domain ("gTLD") ".com".

The applicable gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

The SIMON-KUCHER Trademark remains clearly recognizable within the Disputed Domain Name.

Therefore, the Panel holds that the Complainant has established the first element of paragraph 4(a) of the Policy and that the Disputed Domain Name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, 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 *prima facie* 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Indeed, the Complainant has not licensed or otherwise authorized the Respondent to use the SIMON-KUCHER Trademarks or to apply for any domain name incorporating the said trademarks.

Moreover, it appears from the non-use of the Disputed Domain Name that the Respondent is not using or has not prepared to use the Disputed Domain Name with a *bona fide* offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain.

Finally, the Respondent did not reply to the Complainant’s contentions, and consequently, did not rebut the Complainant’s *prima facie* case.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainant has established that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent’s 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 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 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.

According to prior UDRP decisions, particular circumstances that panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion), [...], (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name (see section 3.2.1 of the [WIPO Overview 3.0](#)).

First of all, the Panel finds that it is established that the SIMON-KUCHER Trademarks were registered and used before the registration of the Disputed Domain Name. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name given that it reproduces the Complainant's SIMON-KUCHER Trademarks almost in its entirety, with a misspelling of the term "simon".

The misspelling of the SIMON-KUCHER Trademarks by replacing the "i" in "Simon" by a "l", which is graphically very similar, demonstrates the Respondent's intention to impersonate the Complainant or an entity related to the Complainant. In addition, the Disputed Domain Name is highly similar to the Complainant's own domain name <simon-kucher.com> used by the Complainant for its commercial activities. There is no doubt that the Respondent was aware of the Complainant and its SIMON-KUCHER Trademarks and has precisely chosen and registered the Disputed Domain Name in bad faith.

Moreover, the Panel notices that the Disputed Domain Name does not reach to an active website. The consensus view amongst UDRP panels is 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, [...] and (iv) the implausibility of any good faith use to which the domain name may be put" (see section 3.3 of the [WIPO Overview 3.0](#)).

The Panel is convinced that the overall circumstances of this case suggest that the Respondent's non-use of the Disputed Domain Name is in bad faith. Such circumstances include:

- the fact that the Complainant is present in numerous countries,
- the distinctiveness and reputation of the SIMON-KUCHER Trademark,
- the nature of the Disputed Domain Name which consists of a misspelling of the SIMON-KUCHER Trademark,
- the Respondent's failure to provide any answer to the Complainant's contentions, and
- there appears to be no conceivable good faith use that could be made by the Respondent of the Disputed Domain Name.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraph 4(a)(iii).

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 name, <slmon-kucher.com>, be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: August 2, 2023