

ADMINISTRATIVE PANEL DECISION

Sick AG v. Evgeniy Bakilov “Ingeneering+”, LLC
Case No. D2023-4355

1. The Parties

The Complainant is Sick AG, Germany, represented by Christoph Ludewigt, Germany.

The Respondent is Evgeniy Bakilov “Ingeneering+”, LLC, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <sick-russia.com> is registered with Registrar of Domain Names REG.RU LLC (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on October 20, 2023. On October 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 24, 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.

On October 26, 2023, the Center informed the Parties in Russian and English that the language of the registration agreement for the disputed domain name was Russian. On October 26, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in both English and Russian, and the proceedings commenced on November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 23, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on December 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

The Complainant is a global manufacturer of sensors and sensor solutions for industrial applications. Its company has a global presence with almost 50 subsidiaries, participations, and sales agencies, and employs 11,909 employees worldwide. In 2022, the Complainant made sales worth EUR 2.2 billion. The Complainant's official website is located at the domain name <sick.com>.

The Complainant is the owner of the International trademark SICK with registration No. 545046, registered on December 5, 1989 for goods and services in International Classes 9, 36, 37, 41, and 42 (the "SICK trademark"). The SICK trademark registered in various jurisdictions, including the Russian Federation, where the Respondent and its business are located.

The disputed domain name was registered on August 14, 2023. It resolves to a Russian language website that displays the Complainant's SICK trademark and offers for sale products of the Complainant. The website claims to be an official dealer of the Complainant in the Russian Federation.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its SICK trademark, because its distinguishing element "Sick" is identical to this trademark, while the element "Russia" is only a geographical location.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has no connection to the Complainant and has not received any authorization to use the Complainant's SICK trademark in the disputed domain name or in any other manner. The Complainant adds that the Respondent has not been authorized to sell the Complainant's sensor products, but nevertheless offers them on the website at the disputed domain name. The Complainant further points out that the website at the disputed domain name falsely claims being an official dealer of the Complainant in the Russian Federation and that all text and images on it have been copied from the Complainant's website without authorization.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, it was registered with the purpose to sell the Complainant's products in the Russian Federation by pretending to be their authorized distributor. The Complainant states that it has not given its consent for such activities and that it instructs its distributors not to sell any of its products in the Russian Federation.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural issue – Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the Parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requests that the language of the proceeding be English for several reasons, including that the disputed domain name includes the English word “Russia” and the contact email address under the disputed domain name contains the English word “sales”. The Complainant adds that it will have to bear substantial additional expenses if the Complaint has to be submitted in Russian, which would also delay the proceeding.

The Respondent did not make any comments with respect to the language of the proceeding. It did not object to the Complainant’s request that the language of the proceeding be English and did not bring forward any reasons why that would not be efficient or fair.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel must exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the Parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily 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. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of the SICK trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the SICK trademark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the SICK trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “-russia”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the SICK trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The disputed domain name resolves to a website offering the Complainant’s SICK products for sale in the Russian Federation and in the Commonwealth of Independent States.

Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. The Panel will therefore consider whether the Respondent complies with the so-called “Oki Data test” (see section 2.8.1 of the [WIPO Overview 3.0](#)), which contains the following cumulative requirements:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

The Respondent’s website claims that it is an “Официальный дилер Sick в России” (in English: “Official dealer of Sick in Russia”), and includes the following statements:

“Одним из преимуществ работы с официальным дилером Sick является гарантия качества продукции” (in English: “One of the advantages of working with the official Sick dealer is the guarantee of the quality of the production”);

“На всю продукцию мы предоставляем индивидуальные цены напрямую от завода изготовителя” (in English: “For all products we provide customized prices directly from the manufacturer’s factory”);

“На всю продукцию мы предоставляем гарантию от 12 до 60 месяцев, а также постпродажный сервис” (in English: “We provide a 12 to 60 months warranty on all products, as well as after-sales service”).

These statements on the Respondent’s website create a false appearance that the Respondent is an official dealer of the Complainant for the Russian Federation, that it is legitimately offering the Complainant’s products for sale there directly from the Complainant’s factories, and that it legitimately provides warranty and after-sales services for such products.

At the same time, the Complainant maintains that it has not authorized the Respondent to sell its products in the Russian Federation and that it has forbidden its authorized distributors to sell any of its products in this country. The Respondent has not submitted any statement or evidence in this proceeding to deny or contradict these assertions of the Complainant.

It follows from the above that the Respondent's website does not "accurately and prominently disclose" the Respondent's lack of relationship with the holder of the SICK trademark, i.e., the Complainant. Rather, it attempts to confuse visitors that the Respondent is an official dealer of the Complainant. Considering this, the Panel finds that the Respondent does not comply with the requirements of the Oki Data test and that its conduct does not give rise to rights or legitimate interests in the disputed domain name.

The Panel therefore finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The circumstances of this case point to a conclusion that the Respondent had knowledge of the Complainant and its SICK trademark when it registered and started using the disputed domain name, and that it targeted the Complainant with these actions for commercial gain. The SICK trademark was registered for the territory of the Russian Federation, where the Respondent and its business are located, thirty years before the Respondent registered the disputed domain name in 2023. The disputed domain name has the appearance of an official website of the Complainant for the Russian Federation, and the Respondent started using it immediately for a website selling the Complainant's products and falsely claiming to be an official dealer of the Complainant.

The Respondent has not brought forward any justification for the registration and use of the disputed domain name. In these circumstances, the Panel finds that the Respondent has registered and is using the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the associated website, by creating a likelihood of confusion with the Complainant's SICK trademark as to the affiliation or endorsement of its website and of the products and services offered on it.

Based on the available record, the Panel therefore finds that the Complainant has established the third element of the Policy.

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, <sick-russia.com>, be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: December 22, 2023