

## **ADMINISTRATIVE PANEL DECISION**

Ralf Bohle GmbH v. Chen Shengqiu  
Case No. D2023-4534

### **1. The Parties**

The Complainant is Ralf Bohle GmbH, Germany, represented by MSA IP - Milojevic Sekulic & Associates, Serbia.

The Respondent is Chen Shengqiu, China.

### **2. The Domain Name and Registrar**

The disputed domain name <swbbikeparts.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on November 3, 2023. On November 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 10, 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 amended Complaint in English on November 13, 2023.

On November 10, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On November 11, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

The Center verified that the Complaint together with the amended 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 in English and Chinese of the Complaint, and the proceedings commenced on November 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 8, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on December 14, 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 manufacturer of tires and other equipment and parts for bicycles and wheelchairs. The Complainant started manufacturing bicycle tires in 1973 under its brand name SCHWALBE, and is now present in the market in more than 40 countries around the world.

The Complainant has a large international trademark portfolio for its SCHWALBE mark, including the following trademark registrations: International Trademark Registration No. 719983 for SCHWALBE, registered on May 19, 1999; International Trademark Registration No. 1171528 for SCHWALBE, registered on July 17, 2013; European Union Trademark Registration No. 011061322 for SCHWALBE, registered on December 18, 2012; and United States of America Trademark Registration No. 2482677 for SCHWALBE, registered on August 28, 2001. The Complainant also has a strong online presence and owns a domain name portfolio including various domain names incorporating its SCHWALBE mark.

The disputed domain name was registered on November 5, 2022, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name previously directed to an active webpage impersonating the Complainant by using the Complainant's trademarks and product images and by offering for sale SCHWALBE-branded products to Internet users. However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive webpage.

#### **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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its registered trademark for SCHWALBE and its commonly used abbreviated form SWB, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith to divert Internet users to the Respondent's webpage which impersonates the Complainant and offers for sale counterfeit products.

The Complainant essentially contends that the disputed domain name is confusingly similar to the Complainant's famous trademark SCHWALBE as it incorporates the common abbreviated version of such trademark, namely SWB, in its entirety, with the only differing elements being the addition of the words "bike" and "parts" to the disputed domain name. The Complainant also argues that the disputed domain name was diverting Internet traffic to a website that impersonated the Complainant's website and offered what are presumed to be counterfeit products to Internet users. The Complainant also argues that the Respondent had or can be expected to have had prior notice of the Complainant's trademarks at the time the disputed domain name was registered, since the Complainant's prior trademarks for SCHWALBE were registered many years before the registration of the disputed domain name and have become well-known.

The Complainant essentially contends that the registration of the disputed domain name was made primarily with intention to attract, for commercial gain, Internet users to website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of website or of a product or service on website in accordance with paragraph 4(b)(iv) of Policy. The Complainant concludes that the registration and use of the disputed domain name in such circumstances constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Chinese. 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 requested that the language of the proceeding be English for several reasons, including the fact that the Complainant is a company located in Germany, and has no knowledge of the Chinese language and the fact that the disputed domain name consists exclusively of Latin characters, using English words "bike" and "parts", and that the disputed domain name initially resolved to a webpage where the content was exclusively in the English language, which suggest that the Respondent has knowledge of the English language.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to 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.

### **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 a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

Particularly, the Panel finds that the Complainant has shown valid and relevant rights in its registered trademark for SCHWALBE and in the common abbreviated version of such trademark, namely SWB. The Panel notes that it is the settled view of panels applying the Policy that an abbreviation of a registered mark incorporated into a domain name may be sufficient to constitute confusing similarity (see e.g., *Banque Saudi Fransi v. ABCIB*, WIPO Case No. [D2003-0656](#); and *Dow Jones & Company, Inc. & Dow Jones LP v. T.S.E. Parts*, WIPO Case No. [D2001-0381](#)). Upon review of the Complaint's evidence as well as of the content of

the website associated with the disputed domain name (before it was deactivated), the Panel concludes that SWB is indeed a common abbreviation of the Complainant's registered trademark SCHWALBE and that the Respondent clearly targeted this trademark through its use of the disputed domain name (see [WIPO Overview 3.0](#), sections 1.7 and 1.15). Moreover, the Panel finds the entirety of the known abbreviation to the SCHWALBE mark, being SWB, is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

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.

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 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. 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.

Having reviewed the record, the Panel finds 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 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.

Moreover, the Panel notes that, based on the evidence submitted by the Complainant, the Respondent used the disputed domain name to connect it to a website impersonating the Complainant by using the Complainant's trademarks and product images and by offering for sale SCHWALBE-branded products to Internet users. In this case, the Panel also accepts the Complainant's argument that, given the unclear origin, the lack of any clear disclaimer and false suggestions of affiliation on the website linked to the disputed domain name and given the heavily discounted product prices, it is very likely that the products that were offered by the Respondent on such website were counterfeit products.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods and impersonation/passing off) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive webpage. In this regard, the Panel finds that holding a domain name passively, without making any use of it, also does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#); and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

The Panel finds 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.

In the present case, the Panel notes that the Respondent has registered a domain name which is confusingly similar to the Complainant's well known, intensely used and distinctive trademark SCHWALBE, as abbreviated to SWB. The Panel refers to a number of prior decisions under the Policy which have recognized the well known nature of the SCHWALBE trademark, see for instance *Ralf Bohle GmbH v. Liu Zhongsen*, WIPO Case No. [D2023-1211](#); and *Ralf Bohle GmbH v. BaiYumin*, WIPO Case No. [D2023-3497](#). The Panel deduces from this fact that by registering the disputed domain name, the Respondent deliberately and consciously targeted the Complainant's prior well known trademarks for SCHWALBE and its common abbreviation SWB. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states "[p]anelists have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Furthermore, the Panel also notes that the Complainant's trademarks for SCHWALBE were registered several years before the registration date of the disputed domain name. The Panel deduces from these elements that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks at the time of registering the disputed domain name. In the Panel's view, these elements indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Panel notes that, based on the evidence submitted by the Complainant, the Respondent used the disputed domain name to connect it to a website impersonating the Complainant by using the Complainant's trademarks and product images and by offering for sale apparently fake SCHWALBE-branded products to Internet users. In this case, the Panel accepts that, given the unclear origin, the lack of any clear disclaimer and false suggestions of affiliation on the website linked to the disputed domain name, and given the heavily discounted product prices and the lack of an explanation by the respondent, the products offered by the Respondent on such website were counterfeit products.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods and impersonation/passing off) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

However, on the date of this Decision, the disputed domain name links to an inactive website.

Panels have found 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. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. 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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, the misleading use made of the disputed domain name by the Respondent before it was deactivated, and the implausibility of any good faith use of the disputed domain name by the Respondent, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds the third element of the Policy has been established.

## **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 <swbbikeparts.com> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: December 28, 2023