

ADMINISTRATIVE PANEL DECISION

Inventio AG v. Domains By Proxy, LLC / Peter Schume
Case No. D2022-0267

1. The Parties

The Complainant is Inventio AG, Switzerland, internally represented.

The Respondent is Domains By Proxy, LLC, United States of America (“United States”) / Peter Schume, United States.

2. The Domain Name and Registrar

The disputed domain name, <schindlerliftsltd.com>, is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 26, 2022. On January 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 28, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 31, 2022 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 February 1, 2022.

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 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 22, 2022.

The Center appointed David Stone as the sole panelist in this matter on February 28, 2022. 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 Inventio AG, Switzerland, a wholly owned subsidiary of Schindler Holding AG, Switzerland, the parent company of the Schindler Group. The Schindler Group provides elevators, escalators, moving walkways and their maintenance and modernization services. The Complainant's business was founded in 1874 and operates around the world, with over 1000 branch offices in more than 100 countries.

The Complainant owns the following registered trade marks (the "Marks"), among others:

- (i) SCHINDLER: International registration No. 1265628 dated May 1, 2015, with Swiss priority of December 2, 2014, in Nice classes 06, 07, 09, 37, 38, 42 and 45, designating, *inter alia*, the United States; and
- (ii) SCHINDLER: United States Registration No. 5262871, registered on August 15, 2017, in Nice classes 06, 07, 09, 37, 38, 42 and 45.

The disputed domain name was registered on May 13, 2021, and resolves to an inactive website.

On May 17, 2021, the Complainant sent an authorization request to the Respondent, requesting them to show their rights to and legitimate interests in the Marks or to delete the disputed domain name. The Respondent did not reply to this request.

On September 3, 2021, the Complainant sent a takedown request to the Registrar which was rejected due to a lack of authorization.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is partially identical and confusingly similar to the Complainant's Marks. Disregarding the Top-Level Domain ("TLD"), ".com", the Marks are completely contained in the disputed domain name and the Complainant contends that the Marks are the distinctive component. Additionally, the Complainant contends that the other components of the disputed domain name are confusingly similar.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to make use of its Marks, nor has the Respondent provided the Complainant with any evidence of its use of the disputed domain name in connection with any *bona fide* offering of goods or services.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant's Marks are well-known internationally in the market for elevators and escalators. The disputed domain name contains (i) the Marks, (ii) "lifts", which is a core business product of the Complainant and (iii) "Ltd", the abbreviation of "Limited", the legal form of several Schindler companies. Therefore, the Complainant contends it is not possible to conceive of a use of the disputed domain name which is not related to the Complainant's activities and that there is no doubt that the Respondent knew of the Complainant and the Marks at the time of the registration of the disputed domain name. Additionally, the Complainant contends that the passive holding of a domain name by the Respondent constitutes bad faith use.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets out the three requirements that the Complainant must prove in order to succeed:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (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

On the evidence provided by the Complainant, the Panel is satisfied that the Complainant has rights in the Marks. In assessing similarity between the Marks and the disputed domain name, it is permissible to ignore the TLD ".com". As the Complainant contends, the Marks are completely contained in the disputed domain name. Although the Marks and the disputed domain name differ by the inclusion of "lifts" and "Ltd", as the Marks are clearly recognisable within the disputed domain name, the addition of these terms does not prevent a finding of confusing similarity. The disputed domain name is therefore confusingly similar to the Marks (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

The Panel concludes that the condition in paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the criteria that determine whether a domain name registrant has rights or legitimate interests in a domain name:

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

The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the burden shifts to the Respondent to prove that such rights and interests do exist. The Respondent has provided no evidence to prove this.

On the facts before the Panel, the Respondent has not demonstrated that it is commonly known by the disputed domain name, nor that it has been authorized to use the Complainant's Marks. The Respondent has not demonstrated use, or preparations for use, of the disputed domain name in connection with a *bona fide* offering of goods or services. Further, the Respondent has submitted no evidence to prove its legitimate noncommercial or fair use.

The Panel therefore finds that there is no legitimate reason for the Respondent to choose the disputed domain name.

The Panel concludes that the condition in paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out the non-exhaustive criteria for bad faith. Generally, for the purposes of the Policy, bad faith constitutes registration and use of a domain name in order to:

- (i) sell, rent or transfer the domain name to the trade mark owner (or a competitor thereof) for a profit; or
- (ii) prevent the trade mark owner from registering its trade mark in a domain name, provided that the respondent is engaged in a pattern of such conduct; or
- (iii) disrupt the business of a competitor; or
- (iv) divert Internet traffic for commercial gain.

On the evidence put forward by the Complainant, both the registration of the disputed domain name and the use to which it has been put indicate bad faith on the part of the Respondent.

In relation to bad faith registration, the Complainant's registration of the Marks significantly predates the registration of the disputed domain name. In addition to this, the inclusion of the words "lifts" and "Ltd" after the Marks in the disputed domain name creates a composition that effectively impersonates the Complainant. On this basis, the Panel finds that the Respondent was well aware of the Complainant's Marks at the time of registration.

In terms of bad faith use, the disputed domain name is currently not being used by the Respondent and does not resolve to an active website. It is an established principle that passive holding of a domain name by the respondent such as in the present case can still amount to the disputed domain name being used in bad faith (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and section 3.3 of the [WIPO Overview 3.0](#)). In such circumstances, the Panel must examine all the facts of the case to determine whether the static holding page still amounts to bad faith use by the Respondent.

The Panel concludes that the Respondent's passive holding of the disputed domain name does constitute bad faith use. The reasoning is as follows:

- (i) the Complainant's Marks have a strong reputation and are widely known;
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name; and
- (iii) there is no legitimate use of the disputed domain name by the Respondent.

The Panel concludes that the condition in paragraph 4(a)(iii) of the Policy is satisfied.

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, <schindlerliftsltd.com>, be transferred to the Complainant.

/David Stone/

David Stone

Sole Panelist

Date: March 9, 2022