

## **ADMINISTRATIVE PANEL DECISION**

Julius Blum GmbH v. Son Ha

Case No. D2022-0657

### **1. The Parties**

The Complainant is Julius Blum GmbH, Austria, represented by Torggler & Hofmann Patentanwälte GmbH & Co KG, Austria.

The Respondent is Son Ha, Viet Nam.

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

The disputed domain name <blum-vietnam.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 24, 2022. On February 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 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 March 1, 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 March 3, 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 March 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 25, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on March 29, 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 one of the large manufacturer of furniture fittings that was founded in 1952 and operates under the brand BLUM.

In order to safeguard its activities, the Complainant has registered numerous trademarks all over the world, including International Registrations No. 996 626 (registered on November 18, 2008, designating Viet Nam), No. 598 611 (registered on February 16, 1993, designating Viet Nam) and No. 1 171 363 (registered on April 29, 2013), providing protection for different types of furniture fittings of classes 6 and 20 of the Nice Classification.

The Respondent registered the disputed domain name <blum-vietnam.com> on December 12, 2017.

The Panel accessed the disputed domain name on April 8, 2022, which resolved to a webpage on which hardware, in particular furniture fittings, were been offered for sale.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name is nearly identical and confusingly similar to the Complainant's trademark. The Complainant's mark BLUM is fully incorporated and the addition of the geographical suffix "vietnam" has no trademark significance and does not eliminate a likelihood of confusion with the Complainant's trademark. Geographical additions do not alter the underline meaning of a domain name, so as to avoid confusing similarity. The Respondent is using the disputed domain name in connection with the sale and advertisement of hardware products, in particular furniture fittings and therefore for goods which are covered by the Complainant's trademark registrations.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has never licensed or in any way authorized the Respondent to register or use its trademark BLUM as a domain name. By creating a domain name that uses the mark BLUM together with a geographical wording, the Respondent is improperly confusing consumers into believing that they have reached the Complainant's website for Viet Nam or – in the alternative – creating a false impression that the Respondent is associated or affiliated with the Complainant. A reseller of trademark goods that is unaffiliated with or unauthorized by a trademark holder may well have certain use rights regarding the mark. However, this fair use right is carefully bounded by the requirement that a reseller may not make use of the mark in a way that is likely to confuse consumers as to an affiliation between the trademark holder and the reseller. In the present case, the geographical indicator clearly suggests an affiliation with the Complainant. Customers seeking spare parts or support for the Complainant's products would enter the disputed domain name expecting to contact the Complainant's Vietnamese subsidiary. In fact, a person entering the disputed domain name ends up at the webpage not affiliated or associated with the Complainant. The case at hand is even more serious as the name "blum" in the disputed domain name gives rise to the expectation of the customers to enter a webpage where only high-quality goods of the Complainant are offered. However, these expectations are not met as goods from other manufacturers and even furniture fittings of the Complainant's competitors are offered.

- The disputed domain name was registered and is being used in bad faith. Many factors demonstrate the Respondent's bad faith. The Respondent has registered and is using the disputed domain name in bad faith and with the fraudulent intent to lure internet users into the belief that the Respondent is, or is affiliated with, the Complainant. By using the disputed domain name, the Respondent intentionally attempts to attract Internet users for financial gain to the Respondent's website by creating a likelihood of confusion with the Complainant's mark. When registering the disputed domain name, the Respondent must have been aware of the Complainant which has been doing business in Viet Nam for over 20 years. The disputed domain name has been designed to imply that there is an affiliation between the Respondent and the Complainant or that the Complainant endorses the Respondent's activities even though no such affiliation or endorsement exists. UDRP panels have addressed such situations in several instances and have consistently held that it is bad faith to misrepresent an affiliation with a third party where none exists.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a 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 rights; and
- (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**

The Panel has no doubt that "Blum" is a term directly connected with the Complainant's trademarks.

Exhibits 4, 5, 6 and 7 to the Complaint show International Trademark registrations for BLUM that date as early as 1993.

The trademark BLUM is wholly encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark BLUM merely by the inclusion of the suffix "-vietnam" and of the generic Top-Level Domain ("gTLD") extension ".com".

Previous UDRP decisions have found that the mere addition of symbols such as hyphens and of geographical terms (such as "Viet Nam") to a trademark in a domain name does not avoid a finding of confusing similarity (see, e.g., *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#); and *Allianz SE v. IP Legal, Allianz Bank Limited*, WIPO Case No. [D2017-0287](#)).

It is also already well established that the addition of a gTLD such as ".com" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, and that the Complainant has satisfied the first element of the Policy.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

(i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name; or

(iii) 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 at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

Indeed, the Complainant showed that the disputed domain name is linked to an e-commerce website offering furniture fittings and other hardware articles for sale, in Vietnamese language, together with competing products from other brands.

The website does not adequately clarify why the Respondent has chosen the specific term "blum-vietnam" to compose the disputed domain name, which naturally induces the visitor to believe it is the Complainant's official e-commerce for Viet Nam.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in 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 registration 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 documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2017) the trademark BLUM was already directly connected to the Complainant's furniture fittings, including Viet Nam, where both parties are established.

Also, as already referred above, the disputed domain name points to an e-commerce website offering for sale BLUM fitting furnitures as well as products from other brands, in competition with the Complainant.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant’s trademark, as well as that the adoption of the expression “blum-vietnam” together with the gTLD extension “.com” could be a mere coincidence.

Furthermore, by associating the disputed domain name with an e-commerce website targeting the furniture market, the Respondent:

(i) amplifies the likelihood of confusion with the Complainant’s trademark;

(ii) potentially obtains revenue from this practice; and

(iii) deprives the Complainant from selling its products to prospective clients who are clearly looking for the Complainant.

Finally, the passive and non-collaborative posture of the Respondent, not at least providing justifications for the use of a third party trademark, certainly cannot be used in benefit of the Respondent in the present case.

Such circumstances, associated with the lack of any plausible interpretation for the adoption of the term “blum-vietnam” by the Respondent, are enough in this Panel’s view to characterize bad faith registration and use of the disputed domain name in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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, <blum-vietnam.com>, be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: April 12, 2022