

ADMINISTRATIVE PANEL DECISION

Ceratizit S.A. v. 杨娄 (yang lou), 森拉天时精密工具 (苏州) 有限公司 (sen la tian shi jing mi gong ju (su zhou) you xian gong si)
Case No. D2022-2220

1. The Parties

Complainant is Ceratizit S.A., Luxembourg, represented by Office Freylinger S.A., Luxembourg.

Respondent is 杨娄 (yang lou), 森拉天时精密工具 (苏州) 有限公司 (sen la tian shi jing mi gong ju (su zhou) you xian gong si), China.

2. The Domain Name and Registrar

The disputed domain name <ceratizittools.com> (the “Domain Name”) is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 17, 2022. On June 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 20, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on June 20, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint in English and Chinese on June 21, 2022.

On June 20, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On June 21, 2022, Complainant submitted a request that English be the language of the proceeding. Respondent did not comment on the language of the proceeding.

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 Respondent in English and Chinese of the Complaint, and the proceedings commenced on June 28, 2022. In accordance with the

Rules, paragraph 5, the due date for Response was July 18, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 19, 2022.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on August 1, 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

Complainant, a technology company headquartered in Luxembourg, develops and produces hard material cutting and wear protection in the carbide industry. Complainant has more than 30 production sites and 70 sales subsidiaries worldwide, and holds over 1,000 utility patents and utility model patents. It has over 200 employees at its research & development departments / innovation centres in Reutte, Austria and Tianjin, China. In addition, Complainant collaborates with leading universities and research centers around Europe. Complainant also has many affiliated companies around the world, including CB-CERATIZIT which is the second largest carbide manufacturer in China and Taiwan Province of China. CB-CERATIZIT employs more than 1,700 people at 7 production sites and 14 sales subsidiaries and specializes in the production of carbide rods, industrial wear parts, high-quality cutting tools and solutions for wood and stone working.

Complainant owns numerous registered trademarks with the mark CERATIZIT, including:

- International registered trademark number 1047079 for CERATIZIT word mark, registered on February 18, 2010, designating European Union, Japan, Singapore, United States of America, Türkiye, Switzerland, China;
- International registered trademark number 1068793 for CERATIZIT HARD MATERIAL MATTERS word and design mark registered on January 7, 2011 designating European Union, Japan, Singapore, Türkiye, Switzerland, China; and
- International registered trademark number 1367357 for CERATIZIT word and design mark registered on May 31, 2017, designating China.

Complainant also owns and operates the domain name <ceratizit.com>.

The Domain Name was registered on January 21, 2021, and previously resolved to a website prominently featuring the mark CERATIZIT and a logo representing a triangle, similar to the CERATIZIT design mark, and which are identical or similar to Complainant's trademarks and offered machine tools and cutting tools. At the time of the filing of the Complaint, the Domain Name resolved to an error or inactive website.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the Domain Name is identical and confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark registrations for CERATIZIT and own domain names incorporating the CERATIZIT trademarks. Complainant contends that Respondent registered and is using the Domain Name to confuse Internet users looking for *bona fide* and well-known CERATIZIT products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademarks, and that Respondent has no rights or legitimate

interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Name for directing the Domain Name to a website unrelated to Complainant, when Respondent clearly knew of Complainant's rights. The Domain Name is also very similar to one of Complainant's trade names, and there is a risk for possible illegal phishing attempts.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Procedural Issue – Language of the Proceeding

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain name, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Complainant submitted its Complaint in English. In its Complaint, email dated June 21, 2022, and amended Complaint, Complainant requested that the language of the proceeding be English. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Name is Chinese.

Complainant contends that: the Domain Name is registered in Latin characters and wholly incorporates the term "ceratizit" which is identical to Complainant's CERATIZIT trademark, while the term "tools" in the Domain name is also an English word; and that the Domain Name resolved to a website that contains both Chinese and English content. Complainant thus contends that for the above reasons, Respondent understands English. Complainant further noted that it had already suffered damage by the use and identical reproduction of its trademark CERATIZIT, and would be further disadvantaged if Complainant had to incur translation costs.

In exercising its discretion to use a language other than that of the Registration Agreement for the Domain Name, 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.

The Panel accepts Complainant's submissions regarding the language of the proceeding. The Panel notes that the Center notified the Parties in Chinese and English of the language of the proceeding as well as notified the Parties in Chinese and English of the Complaint. Respondent chose not to comment on the language of the proceeding nor did Respondent choose to file a Response.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Chinese and to conduct the proceeding in Chinese.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

6.2. Substantive Issues

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy to the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case Respondent has failed to formally respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the CERATIZIT trademarks, as noted above. In particular, Complainant's use and registration of the CERATIZIT trademarks long predate the registration of the Domain Name. Complainant has also submitted evidence which supports that the CERATIZIT trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the CERATIZIT trademarks.

With Complainant's rights in the CERATIZIT trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant's CERATIZIT trademark. This trademark, which is fanciful and inherently distinctive, is recognizable in the Domain Name. The addition of the term "tools" does not prevent a finding of confusing similarity between Complainant's trademark and the Domain Name.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and the CERATIZIT trademarks, and does not have any rights or legitimate interests in the Domain Name.

Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the CERATIZIT trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with the CERATIZIT trademarks. Moreover, there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, Complainant asserts and has provided evidence that the Domain Name previously redirected to a third party website featuring the mark CERATIZIT and a logo representing a triangle, similar to the CERATIZIT design mark, as well as products such as machine tools and cutting tools, which are in the same industry as Complainant, which has not been rebutted by Respondent. At the time of this Decision, the Domain Name resolves to an error or inactive page. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Further, the nature of the Domain Name comprising Complainant's trademark and the additional term "tools" indicates an awareness of Complainant.

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The Panel finds that Complainant provided ample evidence to show that registration and use of the CERATIZIT trademarks long predate the registration of the Domain Name. Complainant is also well established and known. Indeed, the record shows that Complainant's CERATIZIT trademarks and related services are widely known and recognized. Therefore, and also noting the composition of the Domain Name

itself, Respondent was likely aware of the CERATIZIT trademarks when he registered the Domain Name, or knew or should have known that the Domain Name was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's CERATIZIT trademark with the addition of the term "tools" which are products in Complainant's line of business, suggests Respondent's actual knowledge of Complainant's rights in the CERATIZIT trademark at the time of registration of the Domain Name and his effort to opportunistically capitalize on the registration and use of the Domain Name considering that Complainant is in the business of industrial and hard material cutting tools. Complainant also owns the domain name <ceratizit.com>.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, Complainant asserts that the Domain Name previously redirected to a third party website (which incorporates Complainant's trademark in its entirety), and features products such as machine and cutting tools, which are directly in Complainant's field of business and industry, and which has not been rebutted by Respondent. It is more likely than not that Respondent seeks to create likelihood of confusion with Complainant and/or its trademarks.

Although the Domain Name currently resolves to an inactive or error page, from the inception of the UDRP, panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the [WIPO Overview 3.0](#).

In the present circumstances, including the distinctiveness and reputation of the CERATIZIT trademarks, the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and the implausibility of any good faith use to which the inherently misleading Domain Name may be put, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Domain Name <ceratizittools.com> be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: August 15, 2022