

ADMINISTRATIVE PANEL DECISION

Hochtief Aktiengesellschaft v. Privacy Protect, LLC (PrivacyProtect.org) /
I.C.M.

Case No. D2022-2736

1. The Parties

The Complainant is Hochtief Aktiengesellschaft, Germany, represented by Kümmerlein, Simon & Partner Rechtsanwälte mbB, Germany.

The Respondent is Privacy Protect, LLC (PrivacyProtect.org), United States of America (“United States”) / I.C.M., United States.

2. The Domain Name and Registrar

The disputed domain name <hochtiefinvestment.com> (the “Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2022. On July 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 27, 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 the Complainant on August 9, 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 August 10, 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 August 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on September 20, 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 a German company involved in the provision of infrastructure around the world. It has traded continuously for more than 145 years and has since 1919 offered its services under the trade mark HOCHTIEF (the "HOCHTIEF Mark"). It also uses a corporate logo featuring the word "Hochtief" and a triangle device. It has been involved in numerous high-profile projects globally including the Swiss Gotthard Tunnel and the Burj Khalifa in Dubai.

The Complainant holds a registered trade mark in the United States for the HOCHTIEF Mark (registration number 6,428,594) for various services in classes 35, 36, 37, and 42, registered on July 20, 2021, and first used in the United States in 2008.

The Domain Name was registered on June 24, 2022. It is used for a website (the "Respondent's Website"). At various points the Respondent's Website has purported to offer investment (and construction) services under the HOCHTIEF Mark and the Complainant's corporate logo. It has contained references to being involved in the construction of the Swiss Gotthard Tunnel, a high-profile project in which the Complainant was involved in. Finally the Respondent's Website has displayed, as senior executives of the entity located at the Respondent's Website, the names and photos of a number of the Complainant's senior executives, further creating the impression that the Respondent's Website is the official website of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainant's HOCHTIEF Mark;
- (ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the HOCHTIEF Mark, having registered the HOCHTIEF Mark in the United States. The Domain Name is confusingly similar to the HOCHTIEF Mark, merely adding the descriptive word "investment" and the generic Top-Level Domain ("gTLD") ".com" to the wholly incorporated HOCHTIEF Mark.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known as the Domain Name nor has the Complainant provided a licence or authorization to register the Domain Name or any domain name incorporating the HOCHTIEF Mark. There is no evidence, since the Respondent registered the Domain Name, of the Respondent's use of, or demonstrable preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services or for a legitimate non-commercial purpose. The Domain Name resolves to a website that offers financial services under the HOCHTIEF mark with additional details clearly indicating that the Respondent is seeking to pass itself off as the Complainant. This does not provide the Respondent with rights or legitimate interests.

The Domain Name was registered and is being used in bad faith. Given the reputation of the Complainant and the use of the Respondent's Website (including the reproduction of photos of the Complainant's senior executive team on the Respondent's Website), the Respondent must have had knowledge of the HOCHTIEF Mark at the time of registration of the Domain Name. Such knowledge is an indication of bad faith

registration. The Respondent is using the Domain Name for a website that passes itself off as being an official website of the Complainant in order to offer investment services. This amounts to bad faith use under paragraph 4(b)(iv) of the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the HOCHTIEF Mark, having registrations for the HOCHTIEF Mark as a trade mark in the United States.

The Domain Name incorporates the HOCHTIEF Mark in its entirety and adds the word "investment" and the gTLD ".com". UDRP panels have repeatedly held that where the relevant trade mark is recognizable within the domain name, that is sufficient to reach a conclusion that the domain name is similar to the trade mark; see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Domain Name is confusingly similar to the Complainant's HOCHTIEF Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

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

The Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the HOCHTIEF Mark or a mark similar to the HOCHTIEF Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name.

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods or services. Rather, the use of the confusingly similar Domain Name for a website that at various points has impersonated the Complainant (through the use of the HOCHTIEF Mark, the Complainant's logo, and images and names of the Complainant's senior executive members) for the purpose of advertising investment services, does not, absent further explanation, amount to use for a *bona fide* offering of goods or services.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has failed to rebut that *prima facie* case and establish that it has rights or legitimate interests in the Domain Name under the Policy. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has 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 trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trade mark 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 the respondent's website or location or of a product or service on the respondent's website or location. (Policy, paragraph 4(b)).

The Panel finds that the Respondent was aware of the Complainant and its reputation in the HOCHTIEF Mark at the time the Respondent registered the Domain Name. The Respondent's Website has made direct reference to the Complainant, including reproducing its corporate logo and names and images of its senior executives. In these circumstances, the Respondent's conduct in registering the Domain Name when it was aware of the Complainant's rights and lacked rights or legitimate interests of its own amounts to registration in bad faith.

As set out in the paragraph above, the Respondent's Website passes itself off as an official website of the Complainant for commercial gain (by encouraging visitors to use the Respondent's purported investment services under the misapprehension that they are dealing with the Complainant, a well-regarded and long-standing company). In these circumstances, the Panel finds that the Respondent is using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the HOCHTIEF Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. As such the Panel finds that the Domain Name is being used in bad faith.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) 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, <hochtiefinvestment.com>, be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: October 4, 2022