

ADMINISTRATIVE PANEL DECISION

Villeroy & Boch AG v. Dmitry A Lisodet
Case No. D2022-3497

1. The Parties

The Complainant is Villeroy & Boch AG, Germany, represented by Taylor Wessing LLP, Germany.

The Respondent is Dmitry A Lisodet, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <villeroy-boch.shop> (“Disputed Domain Name”) is registered with RU-CENTER-MSK (Regional Network Information Center, JSC dba RU-CENTER) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2022. On September 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 22, 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 (Privacy protection service - whoisproxy.ru) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 30, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant sent an email requesting for an amendment of the Complaint on September 30, 2022 regarding the newly identified registrant.

On September 30, 2022, the Center sent an email in English and Russian to the Parties regarding the language of the proceeding. The Complainant requested that English be the language of the proceeding on the same date, referring to the respective arguments contained in the Complaint in support of its request. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment regarding the Respondent’s contact information of 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 October 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 27, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on November 2, 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, named after its founders, Francois Boch and Nicloas Villeroy, began as a manufacturer of ceramics in 1748. It is located in Germany, has around 7,000 employees, operates facilities in 13 countries in Europe and Asia, and sells its products in 125 countries worldwide. The Complainant's group of companies generated a turnover of EUR 945 million in 2021.

The Complainant is the owner of numerous registrations for trademark VILLEROY & BOCH in various jurisdictions around the world, including but not limited to, European Union Trade Mark Registration No. 001840362 (registered on January 4, 2002), and International Registration No. 586592 (registered on March 2, 1992) designating many countries including Russian Federation, where the Respondent resides.

The Complainant is the registrant of various domain names featuring the VILLEROY & BOCH trademark, notably <villeroy-boch.com> and <villeroy-boch.de>.

The Disputed Domain Name was registered on July 25, 2022. The Disputed Domain Name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First, the Complainant submits that the Complainant is the owner of numerous trademark registrations consisting of the designation "VILLEROY & BOCH" in various jurisdictions around the world. The Complainant also submits that the Complainant and its VILLEROY & BOCH trademarks have accrued tremendous goodwill and a well-established reputation, which has also been recognized in a number of earlier UDRP Panel decisions.

Second, the Complainant asserts that the Disputed Domain Name is confusingly similar to the Complainant's VILLEROY & BOCH trademarks as the Disputed Domain Name reproduces the Complainant's well-known VILLEROY & BOCH trademarks, with the only difference being that a hyphen is used to combine the names "Villeroy" and "Boch" instead of an ampersand ("&"). This difference is negligible compared to the distinctive elements "Villeroy" and "Boch". As the sign "&" cannot technically be included in a domain name, it is often replaced by the word "and" or a hyphen, as is the case with the domain names owned and used by the Complainant itself.

Finally, the Complainant argues that the generic Top-Level Domain (“gTLD”) “.shop” has to be disregarded when evaluating the confusing similarity of the Complainant’s trademarks to the Disputed Domain Name.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant submits that before the Complainant became aware of the dispute, the Respondent had not been using either the Disputed Domain Name, or a name corresponding to it, in connection with a *bona fide* offering of goods and services. There is no indication that the Respondent has made any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services or for legitimate non-commercial use.

Second, the Complainant contends that the Disputed Domain Name does not resolve to an active website. Thus, the mere holding of a domain name does not establish rights or legitimate interests in the domain name.

Third, there is no evidence that the Respondent has ever been commonly known by the Disputed Domain Name or the trademark VILLEROY & BOCH, or that the Respondent owns any prior rights in the name or trademark VILLEROY & BOCH. The Complainant has not licensed or otherwise permitted the Respondent to use its well-known and distinctive trade name or VILLEROY & BOCH trademarks, or to apply for the registration of the Disputed Domain Name.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant contends that at the time of registration of the Disputed Domain Name, neither the Respondent nor any other person not connected to, or authorized by, the Complainant had a legitimate interest in registering the Disputed Domain Name. Given the reputation and recognition of the VILLEROY & BOCH trademarks due to their longstanding, intensive and widespread use, the Respondent had to be fully aware of the existence of the Complainant and its trademarks when registering the Disputed Domain Name. The Respondent could not have been unaware that the Disputed Domain Name can attract Internet users in a manner that is likely to create confusion for such users, and the Respondent is evidently targeting the Complainant in order to take advantage of the Complainant’s VILLEROY & BOCH trademarks.

Second, the Complainant argues that the Disputed Domain Name is used in bad faith. While the Disputed Domain Name does not resolve to an active website, the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. In this case, the Complainant asserts that there is no conceivable good faith use to which the Respondent could put the Disputed Domain Name that would not infringe the Complainant’s trademarks.

Finally, the Complainant submits that the Respondent used a privacy service. In light of the overall circumstances, it can only be concluded that the underlying beneficiary is using a privacy service to conceal its identity. This adds to the evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Procedural issues

(i) The Respondent’s Identity

The Panel notes that at the time the Complaint was filed on September 21, 2022, the Respondent was identified as “Privacy protection service – whoisproxy.ru”. On September 22, 2022, the Registrar revealed

the underlying registrant. The Center sent a Notice of Registrant Information to the Complainant on September 30, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant sent an email requesting for an amendment of the Complaint on September 30, 2022 regarding the newly identified registrant.

(ii) Language of the Proceeding

The Complaint was filed in English on September 21, 2022. On September 22, 2022, the Registrar confirmed that the language of the Registration Agreement is Russian. As the Complaint was filed in English, the Center, in its notification dated September 30, 2022, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Russian, or (iii) a substantiated request for English to be the language of the proceeding by October 3, 2022.

On September 30, 2022, the Complainant responded to the Center, confirming its request that English be the language of the proceeding as indicated in section IV, Annexes 2 and 3 of the Complaint. The Respondent did not give any comment on this issue.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, *e.g.*, *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

- (i) the fact that the Complainant, a German business entity, does not appear to be able to communicate in Russian, and therefore, if the Complainant was required to have the documents translated into Russian, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;
- (ii) the Disputed Domain Name contains an English word, *i.e.*, "shop"; this suggests that the Respondent has knowledge of the English language and will be able to communicate in English;
- (iii) the Respondent did not object for English to be the language of the proceeding, and did not submit a Response in either English or Russian.

Therefore, for the purpose of easy comprehension of the Complainant (ultimately, the Party solely taking part in the proceeding) of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

(iii) The Respondent's Failure to Respond

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, *e.g.*, *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. [D2010-1413](#), and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

B. Identical or Confusingly Similar

The Complainant is required to establish the two following elements: (1) that it has trademark rights, and, if so, (2) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Panel finds that the Complainant has evidenced that it has rights in and to the VILLEROY & BOCH trademarks, which were registered in a number of countries well before the registration of the Disputed Domain Name.

Second, the Panel finds that the Disputed Domain Name reproduces the Complainant's VILLEROY & BOCH trademarks. The only difference between the Disputed Domain Name and the trademarks is that a hyphen is used to combine the names "Villeroy" and "Boch", instead of an ampersand ("&"). In this regard, the Panel finds that the said difference does not prevent a finding of confusing similarity between the Complainant's trademarks and Disputed Domain Name. See *Bang & Olufsen a/s v. Unasi Inc.*, WIPO Case No. [D2005-0728](#); *Villeroy & Boch AG v. Jian Qui*, WIPO Case No. [D2022-2317](#).

Third, the Panel finds, similarly to the other UDRP panels, that the addition of the gTLD ".shop" to the Disputed Domain Name can be disregarded for the purposes of the Policy (see, e.g., *Cintas Corporation v. Casey Davis*, WIPO Case No. [D2022-3148](#); *Boot Barn, Inc. v. Domain Protection Services, Inc. / Khne Behui*, WIPO Case No. [D2022-3018](#); *Cache-Cache v. xiuzhen zhang*, WIPO Case No. [D2022-2727](#); *Virgin Enterprises Limited v. Cesar Alvarez*, WIPO Case No. [D2016-2140](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's VILLEROY & BOCH trademarks, and the first element of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

"(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 trademark 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 trademark or service mark at issue."

Noting the facts and arguments set out above, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The consensus of previous UDRP panels is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the disputed domain name (see e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. [D2001-0121](#)). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no response was submitted with evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that no license, permission, or authorization of any kind to use the Complainant's trademarks has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction. Thus, the Panel finds that the Respondent has no rights in the VILLEROY & BOCH trademarks.

The Panel finds, according to what the Complainant established and similar to other UDRP panels, that the VILLEROY & BOCH trademarks are recognized as well-known (See *e.g. Villeroy & Boch AG v. Jian Qiu*, WIPO Case No. [D2022-2317](#); *Villeroy & Boch AG v. Whois Data Shield/Hong Kong Names LLC.*, WIPO Case No. [D2008-1300](#); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#)).

The Disputed Domain Name resolves to an inactive website as of the date of this decision. The Panel also notes that it has been more than 3 months from the registration of the Disputed Domain Name to the date of this decision, so the Respondent has had sufficient time to build its website under the Disputed Domain Name if it has such intention. However, no evidence is available on the Respondent's preparation to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Hence, in absence of this evidence, the Panel is of the view that paragraph 4(c)(i) is not met.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that there is no evidence that would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, by incorporating the Complainant's distinctive trademark in its entirety within the Disputed Domain Name, the composition of the Disputed Domain Name is such to carry a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

“(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 online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The above four circumstances are not exhaustive and bad faith may be found by the Panel alternatively in other circumstances.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not reply to the Complainant's contentions and therefore, did not refute the Complainant's contentions.

The Panel further finds that the Complainant's VILLEROY & BOCH trademarks have been registered in many countries. As mentioned in the section C above, the Panel finds that the trademarks VILLEROY & BOCH are well known.

Given the reputation and wide use of the VILLEROY & BOCH trademarks by the Complainant, which predated the registration date of the Disputed Domain Name, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, the Panel is of the view that the nature of the Disputed Domain Name, incorporating the Complainant's well-known trademarks with only the ampersand replaced by a hyphen, indicates itself that the Respondent deliberately selected the Disputed Domain Name. The Panel considers such registration is an attempt by the Respondent to take advantage of the Complainant's goodwill (see the section 3.2.1 of the [WIPO Overview 3.0](#)).

It is further noted that as of the date of this Decision, the Disputed Domain Name has not been used. From the inception of the UDRP, panelists 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 [WIPO Overview 3.0](#)).

In light of this doctrine, the Panel finds that at the time of registration of the Disputed Domain Name, the Complainant had a considerable reputation in the VILLEROY & BOCH trademarks. Hence, the Panel is of the view that the Respondent intentionally chose to register the Disputed Domain Name comprising of the Complainant's VILLEROY & BOCH trademarks with merely the substitution of a hyphen for the ampersand, in order to somehow confuse Internet users that the Disputed Domain Name may have a connection with the Complainant. Furthermore, the Respondent has failed to submit a response and/or to provide any evidence of actual or contemplated good faith use of the Disputed Domain Name. Therefore, the Panel considers that it is implausible for the Respondent to engage in any good faith use of the Disputed Domain Name.

Taking into account all of the above, the Panel finds that the Disputed Domain Name was registered and used by the Respondent in bad faith and the third element under paragraph 4(a)(iii) of the Policy is 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 <villeroy-boch.shop> be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: November 16, 2022