

## **ADMINISTRATIVE PANEL DECISION**

MBN GmbH v. Donica Ioel

Case No. DMD2022-0001

### **1. The Parties**

The Complainant is MBN GmbH, Germany, represented by Bettinger Scheffelt Kobiako von Gamm, Germany.

The Respondent is Donica Ioel, Republic of Moldova.

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

The disputed domain name <proled.md> is registered with Information Technology and Cyber Security Service (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 4, 2022. On February 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 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 15, 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 in English on March 16, 2022.

On March 15, 2022, the Center transmitted an email in Romanian and English to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on March 16, 2022. The Respondent did not comment on the language of the proceeding.

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 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 11, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on April 27, 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.

### **Language of proceedings**

According to the information provided by the Registrar, the language of the Registration Agreement for the disputed domain name is Romanian. Under paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative 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. The Complainant requests that the language of proceedings be English. It notes that the Respondent operates a website under the disputed domain name in the English language, which shows that the Respondent can communicate without difficulty in English.

The Center has sent all its communications to the Respondent in both English and Romanian and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted a Response or any objections to the Complainant's request that the proceedings be held in English, and the website at the disputed domain name was indeed in English, as per the unrebutted evidence submitted by the Complainant.

The above satisfies the Panel that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient. Therefore, in exercise of its powers under paragraph 11 of the Rules, the Panel decides that the language of this administrative proceeding will be English.

### **4. Factual Background**

According to information in the Complaint, the Complainant is a German company operating in the development and manufacture of LED lighting and one of the pioneers in the field. The Complainant distributes its products to a wide network of architects, electricians and wholesalers in the member states of the European Union, Switzerland, and many other countries worldwide. It has offices in both Germany and Austria and has an annual turnover for the 2021 fiscal year of roughly EUR 15,000,000.

The Complainant has registered several trademarks consisting of PROLED including the International trademark registration No. 921936, registered on March 21, 2007, and the European Union Trade Mark No. 011590569, registered on July 17, 2013.

The Complainant has also registered numerous domain names that include the PROLED trademark, including the domain name <proled.com> or <proled.org>.

The disputed domain name was registered on January 17, 2020, and according to the evidence submitted by the Complainant, it was used for a website that offered LED lighting luminaires and related products. At the date of the decision the disputed domain name does not resolve to an active website.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant argues that it has established rights in the term PROLED and that the disputed domain name is identical to the trademark PROLED in which it has rights.

As regards the second element, the Complainant shows that the Respondent is not a licensee of the Complainant, nor has he been otherwise allowed by the Complainant to make any use of its PROLED trademark, in a domain name or otherwise. The Respondent can also not conceivably claim that he is commonly known by the Complainant's trademarks, given that the term PROLED is exclusively associated with the Complainant. Moreover, the Respondent copied most of the website of a company that is a competitor of the Complainant, without rights, or permission. Under these circumstances, the Respondent has knowingly registered the disputed domain name with the intention of deceiving and misleading Internet users.

In what concerns the third element, the Complainant argues that its PROLED trademark is distinctive and exclusively connected with the Complainant and that it was registered long before the disputed domain name. Given also the fact that the Respondent claims to be engaged in the same industry as the Complainant, namely the sale of lighting products and related goods, it is inconceivable that the Respondent was not aware of the Complainant's trademark at the time of the registration of the disputed domain name, and, therefore, it has chosen the disputed domain name to cause confusion amongst Internet users in order to take unfair advantage of the Complainant's goodwill and reputation. As regards the use, the Complainant argues that by using a domain name identical to the Complainant's PROLED trademark for the promotion of LED lightning products while falsely pretending to be associated with a British designer and manufacturer of LED lighting luminaires and by copying most of its website without right, or permission, the Respondent is clearly making false representations that he and/or his website have a sponsorship, approval or association with the original PROLED trademark owners/licensees/customers, which is not the case.

### **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Matters**

No communication has been received from the Respondent in this case. However, given that the Complaint was sent to the relevant address disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent's failure to file any Response. While the Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent's default.

### **6.2 Substantive Matters**

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant has proved its rights over the PROLED trademark.

The disputed domain name consists of the PROLED trademark, in addition to the country-code Top-Level Domain (“ccTLD”) “.md”. The ccTLD is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark, as it is required for technical reasons. See section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

This Panel concludes that the disputed domain name is identical or confusingly similar to the Complainant’s trademark PROLED, and, therefore, finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

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

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie case* demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case the Complainant has established a *prima facie case* that it holds rights over the trademark PROLED and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name.

There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, according to the unrebutted evidence put forward by the Complainant, at the date of the Complaint the disputed domain name was used to sell LED lighting luminaires and related products, pretending to be an English company, competitor of the Complainant. The Respondent’s use of the disputed domain name cannot be considered a legitimate noncommercial or fair use without intent for commercial gain. Rather, it appears that the Respondent’s intention was to illegitimately trade on the Complainant’s prior rights for commercial gain. There is no evidence in the case file to suggest that the Respondent is commonly known by the disputed domain name or the name of the Complainant’s competitor, or that such competitor was involved in the registration of the disputed domain name. Rather, as per the unrebutted evidence in the case file, the Complainant’s competitor denies any relationship with the registrant of the disputed domain name. Under these circumstances, the Respondent’s use of the disputed domain name to direct users looking for the Complainant’s products to a website promoting the sale of goods – allegedly – of the Complainant’s competitor does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark.

Also, there is no evidence that the Respondent is commonly known by the disputed domain name. According to the evidence on the case file, a reference is included on the website at the disputed domain name that “a family owned business, PROLED COM SRL took the bold step of focusing exclusively on the design and installation of LED illumination when the technology was still in its infancy”. Apart from the mentioned statement, there is no evidence in the case file as to a possible registration of a company that includes PROLED in its name by the Respondent, but even if such registration exists, the Panel nonetheless considers that the Respondent cannot claim to have been “commonly known” by the disputed domain name under paragraph 4(c)(ii) of the Policy. This is because the circumstances indicate that the Respondent

(presumably) adopted a name including PROLED to take unfair advantage of the Complainant's rights, as further discussed in Section 6.2.C below.

Furthermore, the nature of the disputed domain name, being identical to the Complainant's trademark, carries a high risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because he did not respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The Complainant's registration and use of the relevant trademarks predate the date at which the Respondent registered the disputed domain name. Given the distinctiveness of the Complainant's trademark, and the fact that the disputed domain name resolved to a website directly competitive with the Complainant's service offering, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks, and to target those trademarks.

According to the un rebutted evidence in the case file, the disputed domain name was used to sell LED lighting luminaires and related products, in the same field as the Complainant. Under the circumstances of the case, this Panel considers, on the balance of probabilities, that paragraph 4(b)(iv) of the Policy applies. By using the disputed domain name, comprising the Complainant's distinctive trademark, in connection with products relating to the Complainant's industry, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

It appears that the disputed domain name no longer resolves to an active website. The current passive holding of the disputed domain name does not absolve the Respondent of bad faith registration and use, and, in fact, under the circumstances of this case is further evidence of bad faith registration and use. See [WIPO Overview 3.0](#), section 3.3.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

### **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 <proled.md> be transferred to the Complainant.

*/Mihaela Maravela/*

**Mihaela Maravela**

Sole Panelist

Date: May 11, 2022