

ADMINISTRATIVE PANEL DECISION

Otis Elevator Company v. Mr. Shariful Islam
Case No. D2023-0639

1. The Parties

The Complainant is Otis Elevator Company, United States of America (“United States”), represented by Cantor Colburn LLP, United States.

The Respondent is Mr. Shariful Islam, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <sigma-lift.com> is registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 10, 2023. On February 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 14, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the disputed domain name.

The Center verified that 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”).

Following the Center’s email of February 14, 2023 sent to the Registrar relating to the issue of April 16, 2023 expiry of the disputed domain name, the Registrar has in its February 15, 2023 dated email sent to the Center confirmed that it will “keep Registrar lock as long as domain is not expired and the UDRP process in on”, however “either the complainant or respondent need to renew the domain name before expiry”.

In its February 16, 2023 dated email the Center advised the Parties that the concerned Registrar indicated that one of the parties to the dispute need to renew the disputed domain name before expiry to ensure that it remains active after April 16, 2023 (*i.e.*, not expired). In its email the Center has expressly indicated that it accepts no responsibility for the consequences if the necessary steps to ensure the renewal of the disputed domain name (including payment of any applicable renewal fees) are not taken. Despite the advice of the

Registrar and the Center it appears that by the time of rendering of this decision none of the Parties took any action to renew the disputed domain name, which is therefore set to expire on April 16, 2023.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 15, 2023.

The Center appointed Zoltán Takács as the sole panelist in this matter on March 20, 2023. 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, founded in 1854 in Yonkers, New York, United States, is the world's largest manufacturer of elevators, escalators, moving walkways and other people moving products.

One of the Complainant's subsidiaries, Sigma Elevator Company of the Republic of Korea, which was established in 2000 operates in over 60 countries of the world through local distributors and sole agents.

The global portfolio of the Complainant's SIGMA trademark registrations includes the Bangladesh Trademark Registration No. 68740 registered since June 27, 2000, for elevators and lifts and related goods.

The disputed domain name was registered on April 16, 2022, and has been resolving to a website of a Chinese elevator company called Zhejiangfuji Import and Export Co., Ltd. and purported to be doing business under the name SIGMA Elevator Company., Ltd. The website at the disputed domain name significantly uses the Complainant's SIGMA trademark and the Complainant's signature official logo.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name, which incorporates the entirety of its SIGMA trademark, is confusingly similar to it, because the addition of the term "lift" to its trademark does not sufficiently distinguish the disputed domain name.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant claims that the Respondent's utilization of its SIGMA trademark and trade dress at the concerned website is intentional misleading of the consumers and as such evidence of bad faith registration and use of the disputed domain name.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if a complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced evidence of having registered rights in the SIGMA trademark and for the purpose of this proceeding the Panel establishes that the Bangladesh Trademark Registration No. 68740 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The disputed domain name incorporates the Complainant's SIGMA trademark in its entirety, which is evidently recognizable in the disputed domain name. The Respondent's addition of a hyphen and the term "lift" to the Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name.

The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant's trademark and that the first ground of the Policy is established.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent.

As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with the relevant evidence demonstrating its rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the SIGMA trademark.

The Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods and services. The Respondent is not commonly known by the disputed domain name. The Complainant has never authorized the Respondent to use its trademark in any way, and its prior rights in the SIGMA trademark precede the date of registration of the disputed domain name by over twenty years.

The Respondent failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

The Complainant has demonstrated that the website to which the disputed domain name has been resolving prominently utilizes the Complainant’s SIGMA trademark, as well as the Complainant’s signature official logo, and as a consequence the Respondent’s website effectively impersonates or falsely suggests endorsement by the Complainant.

UDRP panels have categorically held that use of a domain name for illegal activity, such as impersonation/passing of, or other types of fraud can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (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.

Although there is no explanation for the Respondent's registration of the disputed domain name, on the basis of facts stated by the Complainant and supported by the evidence submitted, the Panel is satisfied that the Respondent registered the disputed domain name in order to target the Complainant's SIGMA trademark.

The Complainant's SIGMA trademark is inherently distinctive for the corresponding goods, namely elevator, lifts and related goods and the Respondent reproduced the Complainant's trademark in the disputed domain name with inclusion of the term "lift" referring to the Complainant's core business. This, and the Respondent's use of the Complainant's trademark and signature official logo at the website under the disputed domain name makes it clear that the Respondent knew of the Complainant's relevance and the recognition of its SIGMA trademark in the relevant market at the time of registration of the disputed domain name.

The Respondent has been using the disputed domain name to intentionally direct Internet traffic to its website through misleading impression that is an official website of the Complainant's Sigma Elevator Company or otherwise authorized, sponsored or endorsed thereby. This conduct demonstrates the Respondent's intention to unlawfully profit from the use of the Complainant's trademark in the disputed domain name and gain illegitimate profit through false association within the meaning of paragraph 4(b)(iv) of the Policy.

The Respondent chose not to respond to the Complaint and rebut the Complainant's credible claims and assertions, which the Panel accepts and finds that the disputed domain name was registered and is being used in bad faith within the meaning of 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 disputed domain name <sigma-lift.com> be transferred to the Complainant.

In conjunction with the implementation of this decision pursuant to paragraph 4(k) of the Policy, the Panel draws the Registrar's attention to paragraph 3.7.5.7 of the Expired Domain Deletion Policy, which provides that "In the event that a domain which is the subject of a UDRP dispute is deleted or expires during the course of the dispute, the complainant in the UDRP dispute will have the option to renew or restore the name under the same commercial terms as the registrant".

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: April 3, 2023