

## **ADMINISTRATIVE PANEL DECISION**

Ralf Bohle GmbH v. Liu Zhongsen  
Case No. D2023-1211

### **1. The Parties**

The Complainant is Ralf Bohle GmbH, Germany, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is Liu Zhongsen, China.

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

The disputed domain name <schwalbesolde.com> is registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 20, 2023. On March 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 20, 2023, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 21, 2023, 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 amended Complaint on March 24, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on March 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 26, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on May 1, 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 is a German manufacturer of tires and other equipment and parts for bicycles and wheelchairs. The Complainant started manufacturing bicycle tires in 1973 under its brand name SCHWALBE, and is now present in the market in more than 40 countries around the world.

The Complainant is the owner of numerous trademark registrations worldwide for its SCHWALBE mark, including the following:

- International Trademark Registration No. 719983, for trademark SCHWALBE, registered on May 19, 1999, duly renewed and covering goods and services in classes 9 and 12;
- International Trademark Registration No. 1171528 for trademark SCHWALBE, registered on July 17, 2013, and covering goods and services in class 12;
- European Union Trademark Registration No. 011061322 for trademark SCHWALBE, registered on December 18, 2012, duly renewed and covering goods and services in classes 8, 9 and 12;
- United States of America Trademark Registration No. 2482677 for trademark SCHWALBE, registered on August 28, 2001, duly renewed and covering goods and services in class 12; and
- German Trademark Registration No. 39822240 for trademark SCHWALBE, registered on June 17, 1998, duly renewed and covering goods and services in class 9.

The Complainant is also the registrant of numerous domain names incorporating its SCHWALBE trademark, including:

- <Schwalbe.com> registered in October 24, 1995;
- <Schwalbetires.us> registered on June 1, 2002;
- <Schwalbe.nl> registered on November 25, 1999;
- <Schwalbe.it> registered on July 15, 2004;
- <Schwalbe.eu> registered on June 2, 2006;
- <Schwalbe.fr> registered on October 10, 2006; and
- <Schwalbe.bike> registered on January 28, 2014.

The disputed domain name was registered on November 10, 2022. The evidence in the Complaint is that the disputed domain name redirects to an active website seemingly offering SCHWALBE trademarked bicycle tires, parts and other equipment for bicycles. In the website's home page there is a SCHWALBE logo which is identical to the mark that is used at the Complainant's official website ("www.schwalbe.com").

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant submits and contends that:

The Complainant's trademark SCHWALBE is used globally since 1973 and is renowned in the fields of pneumatic tires and parts for bicycles and wheelchairs.

The disputed domain name is confusingly similar to the Complainant's SCHWALBE trademark. In this regard, the Complainant notes that the disputed domain name entirely incorporates the SCHWALBE mark, which is distinctive and well-known internationally and firmly associated with the Complainant, as recognized by previous UDRP panel decisions. The addition of the term "solde", corresponding to the French word that means "sale" does not prevent a finding of confusing similarity. Indeed, the additional term reinforces the proximity to the Complainant's mark and activities. In this regard, special consideration should be given to the fact that the website at the disputed domain name is in the French language, as France is a territory where the Complainant's SCHWALBE brand is represented through its dedicated subsidiary Schwalbe France SARL.

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent (i) is not affiliated with the Complainant; (ii) has not been authorized or somehow given consent by the Complainant to register any domain name incorporating such trademark; (iii) in any event is not authorized or licensed to use the SCHWALBE trademark; and (iv) is not commonly known by the by the name "schwalbe" nor "schwalbesolde".

The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods and services. The disputed domain name resolves to an active website seemingly offering the Complainant's products, and representing the Complainant's logo at the top of the webpage. In the absence of any license or permission from the Complainant to use its widely-renown trademark, no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably be claimed by the Respondent.

All products on the website had been offered for sale at a heavily discounted price, which circumstance suggests the Respondent's illegal activity in the form of selling counterfeit goods.

The Respondent employs a privacy shield to prevent the Complainant and the Panel from knowing the identity of the actual registrant of the disputed domain name, and the registrant's contact information provided appears to be false and nonsensical as no online search could indicate that the address and the Zip code provided exist.

The Respondent is engaged in a pattern of registration of domain names, which include the Complainant's SCHWALBE trademark in a previous UDRP case, see *Ralf Bohle GmbH v. Liu Zhongsen*, WIPO Case No. [D2023-0131](#). All the above circumstances are a clear indication of lack of legitimate interest on the Respondent's side in the disputed domain name.

The disputed domain name was registered in bad faith. The Respondent was aware of and targeted the Complainant's trademark when he/her registered the disputed domain name. The Respondent's concealment of his/her identity by using a proxy service and providing contact information that appears to be false/nonsensical, is also indicative of bad faith.

The disputed domain name is also used in bad faith to intentionally attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark.

Based on the above, the Complainant requests that the disputed domain name be transferred 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 instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark SCHWALBE based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant's trademark SCHWALBE with addition of the term "solde", followed by the generic Top-Level Domain ("gTLD") ".com".

The addition of the generic gTLD, such as ".com", is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test (see section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*, "schwalbesolde". As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. The disputed domain name entirely incorporates the Complainant's mark SCHWALBE and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); and *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in 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) does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that disputed domain name is confusingly similar to a mark in which the Complainant has rights. Therefore, the Complainant has established paragraph 4(a)(i) of the Policy.

## 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, even if it has acquired no trademark or service mark rights;
- (iii) it is 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.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following; (a) the Complainant holds prior rights in the globally registered and well-known SCHWALBE mark; (b) the Respondent has not been authorized to use the Complainant's trademark in any way, and is not commonly known by the disputed domain name; and (c) the disputed domain names resolve to a website which reproduces the Complainant's mark and logo without the Complainant's consent, and sells SCHWALBE labelled products at a heavily discounted price, which according to the Complainant would suggest that they are counterfeit products.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, previous UDRP 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 relevant evidence demonstrating 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.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain names under paragraph 4(c) of the Policy.

While the Complainant has pointed to the discounted prices of the goods offered at the website to which the disputed domain name resolves to reflect the potential counterfeit nature of the goods, the Panel needs not come to a determination on the nature of the goods being offered, noting that the website at the disputed domain name contains the SCHWALBE mark at the home page (that is identical to the mark that is used at the Complainant's official website) and reflect no information concerning the websites' relationship (or lack thereof) to the Complainant. See sections 2.8 and 2.13.2 of the [WIPO Overview 3.0](#). Further to the so-called "Oki Data test" enshrined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), even if the goods offered at the website to which the disputed domain name resolves were of a genuine nature, the disputed domain name cannot constitute fair use given its lack of disclaimers.

The Panel also finds that given that the disputed domain name is composed of the Complainant's distinctive trademark, along with the addition of the term "solde", the composition of the disputed domain name carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use, particularly given the impersonating nature of the content that exacerbates said risk of implied affiliation.

The Panel concludes that the Respondent deliberately chose to include the Complainant's SCHWALBE trademark in the disputed domain name, in order to achieve commercial gain by misleading third parties, and that such use cannot be considered as a legitimate noncommercial or fair use.

Based on the above, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

### **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 used in bad faith.

The SCHWALBE trademark is distinctive and well-known and the date of its first registration significantly precedes the date of registration of the disputed domain name. Moreover, given the use of the disputed domain name, the Panel concludes that the Respondent knew that the disputed domain name would be confusingly similar to the Complainant's trademark. The fact that the website at the disputed domain name, features the Complainant's SCHWALBE trademark and logo and allegedly offers the Complainant's trademarked goods, indicates that the Respondent targeted the Complainant when he/her registered the disputed domain name.

The above conduct constitutes opportunistic bad faith registration (see section 3.2.1 of the [WIPO Overview 3.0](#)), as well as bad faith use of the disputed domain name under the Policy. Indeed, the Respondent has used the disputed domain name to capitalize on the goodwill of the Complainant's SCHWALBE mark.

By directing the disputed domain name to a commercial website allegedly offering the Complainant's goods, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website (see section 3.1.3 of the [WIPO Overview 3.0](#)). Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith.

The Complainant points out that the Respondent is engaged in a pattern of domain names abusive registration which include the Complainant's SCHWALBE trademark (*Ralf Bohle GmbH v. Liu Zhongsen, supra*). This fact further supports a finding of bad faith.

Based on the above, the Panel finds that the Complainant has established also 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, <schwalbesolde.com>, be transferred to the Complainant.

*/Anna Carabelli/*

**Anna Carabelli**

Sole Panelist

Date: May 15, 2023