

## **ADMINISTRATIVE PANEL DECISION**

Ralf Bohle GmbH v. Zhu Caichao

Case No. D2023-1212

### **1. The Parties**

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

The Respondent is Zhu Caichao, China.

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

The disputed domain names <bikeschwalbe.com> and <schwalbetire.com> are registered with Gname.com Pte. Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English 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 names. On March 22, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 22, 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 in English on March 26, 2023.

On March 22, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant requested that English be the language of the proceeding on March 24, 2023. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on March 31, 2023. In accordance with the



Rules, paragraph 5, the due date for Response was April 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 21, 2023.

The Center appointed Jonathan Agmon as the sole panelist in this matter on April 27, 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 company headquartered in Reichshof, Germany, which manufactures tires and other equipment and parts for bicycles and wheelchairs. It was established in 1922 and has been manufacturing bicycle tires since 1973. The Complainant currently has a presence in more than 40 countries around the world and has international affiliates in Europe, the United Kingdom, and the United States of America.

The Complainant is the owner of numerous trademarks, including but not limited to the following:

- International Registration No. 719983 for ,  registered on May 19 1999;
- United States Patent and Trademark Office Registration No. 2482677 for  , registered on August 28, 2001;
- International Registration No. 1171528 for SCHWALBE, registered on July 17, 2013;
- European Union Trademark Registration No. 011061322 for SCHWALBE, registered on December 18, 2012;
- German Trademark Registration No. 39822240 for SCHWALBE, registered on June 17, 1998;

The Complainant has registered the domain name <schwalbe.com> on October 24, 1995, the domain name <schwalbetires.us> on June 1, 2002, and the domain name <schwalbe.bike> on January 28, 2014.

The Respondent registered the disputed domain names on November 11, 2022. The disputed domain names used to resolve to active websites that appeared to offer goods at heavily discounted prices, but they currently resolve to inactive websites.

The Complainant contacted the Respondent on February 7, 2023, by using the suggested contact form on the Registrar's website but no response was received.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant argues that the disputed domain names are confusingly similar to the Complainant's registered SCHWALBE mark as the disputed domain names comprise of the SCHWALBE mark with the suffixes "bike" and "tire" and the generic Top-Level Domain ("gTLD") ".com".

The Complainant also argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names as it has not licensed or permitted the Respondent to use any of its trademarks or register the disputed domain names. The Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services and is not making a legitimate noncommercial or fair use of the disputed domain name.

The Complainant further argues that the disputed domain names were registered and are being used in bad

faith for illegitimate commercial gain by creating a likelihood of confusion with the Complainant's SCHWALBE mark and thereby disrupting the business of the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary issues**

#### **A. Language of the Proceeding**

Paragraph 11 of the Rules provides that:

"(a) 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 language of the Registration Agreement for the disputed domain name is Chinese.

The Complainant requested that the language of the proceeding be English for the following main reasons:

- (i) the Complainant is a company located in Germany, and has no knowledge of the Chinese language;
- (ii) translating the Complaint into Chinese would cause an undue burden on the Complainant; and
- (iii) the disputed domain names consist exclusively of Latin characters, using the English words "bike" and "tire", which strongly suggest that the Respondent has knowledge of the English language; and
- (iv) the disputed domain names resolved to webpages where the content was exclusively in the English language, consisting of purchase offers for various bicycle tires and parts in USD, as the only currency accepted.

The Respondent did not comment on the language of the proceeding.

Having considered the above factors, the Panel determines that English should be the language of the proceeding. The Panel notes that the disputed domain name resolved to a website in English, that the Respondent has not participated in this proceeding, and that all of the Center's communications with the Parties have been sent in English and Chinese. The Panel also needs to ensure the proceeding is conducted in a timely and cost-effective manner. In addition, in the absence of an objection by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint into Chinese.

### **6.2 Substantive Issues**

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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the SCHWALBE mark.

The disputed domain names comprise the Complainant's SCHWALBE mark in its entirety with the addition of the prefix "bike" and suffix "tire" and the generic Top-Level Domain ("gTLD") ".com". It is well established that where the 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. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8. The Complainant's mark is clearly recognizable in the disputed domain names.

Further, it is well established that the adding of the gTLD ".com", as a standard registration requirement, is disregarded under the first element confusing similarity test ([WIPO Overview 3.0](#), section 1.11.1).

Therefore, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights and the element under paragraph 4(a)(i) of the Policy is satisfied.

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

Once the complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name ([WIPO Overview 3.0](#), section 2.1).

In the present case, the Complainant has demonstrated *prima facie* that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests. The Complainant provided evidence that it owned the SCHWALBE trademark registrations long before the date that the disputed domain names were registered, and that it is not affiliated with nor has it licensed or otherwise permitted the Respondent to use the Complainant's trademark (see *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)). The Complainant has also submitted evidence that the Respondent is not commonly known by the disputed domain names.

In addition, even where a domain name consists of a trademark plus an additional descriptive term, panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see [WIPO Overview 3.0](#), section 2.5.1). In the present case, the evidence submitted by the Complainant suggests that the Respondent has attempted to impersonate the Complainant to sell allegedly counterfeit products, which were offered at prices disproportionately below market price and were marketed under the Complainant's trademark and via the Complainant's copyrighted images and text, reinforcing the false suggestion of an affiliation with the Complainant, particularly given the lack of any disclaimer as to the websites' relationship (and lack thereof) to the Complainant. Panels have categorically held that the use of a domain name for illegal activity such as the sale of counterfeit goods can never confer rights or legitimate interests on a respondent (see [WIPO Overview 3.0](#), section 2.13.1). This Panel finds that such use of the disputed domain names is not considered fair use.

Further, the Respondent did not submit a Response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain names sufficient to rebut the Complainant's *prima facie* case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain names and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

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

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)).

The Complainant has submitted evidence that the Respondent registered the disputed domain names long after the Complainant registered its SCHWALBE trademarks. Given that the Complainant's trademarks have

been registered for a long time and the distinctive nature and notoriety of the SCHWALBE mark, it is highly unlikely that the Respondent did not know of the Complainant and its SCHWALBE mark prior to the registration of the disputed domain names. The disputed domain names incorporate the Complainant's SCHWALBE mark in its entirety with the additional descriptive terms "bike" and "tire", which the Panel finds is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. Previous UDRP panels have ruled that in such circumstances "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. [D2006-1095](#)).

The Complainant also submitted evidence that the disputed domain names, before being shut down by the registrar, resolved to active websites which appeared to offer goods at heavily discounted prices. The SCHWALBE mark appeared on the top left corner of the homepage of the websites. This shows that it is unlikely that the Respondent registered the disputed domain names without sight and knowledge of the Complainant's marks and it is implausible that there is any good faith use to which the disputed domain names may be put to. Previous panels have determined that the use of a domain name for illegitimate activity such as the sale of goods at heavily discounted prices is manifestly considered evidence of bad faith (see [WIPO Overview 3.0](#) section 3.1.4; *Swarovski Aktiengesellschaft v. WhoisGuard Protected / Peter D. Person*, WIPO Case No. [D2014-1447](#)).

It is also the Complainant's evidence that the Respondent could not have registered the disputed domain names without prior knowledge of the Complainant's marks as the Respondent's name has no connection with the Complainant's SCHWALBE marks which were registered. This is another indication of bad faith on the part of the Respondent (see *Boursorama SA v. Estrade Nicolas*, WIPO Case No. [D2017-1463](#)).

The Respondent did not submit a Response in this proceeding, which is a further indication of the Respondent's bad faith, which was considered by the Panel.

Based on the evidence presented to the Panel, including the confusing similarities between the disputed domain names and the Complainant's marks, the fact that the disputed domain names were used to direct users to websites which offered goods at heavily discounted prices, and the fact that no Response was submitted by the Respondent in response to the Complaint, the Panel draws the inference that the disputed domain names were registered and being used in bad faith, regardless of the current passive holding of the disputed domain name.

Accordingly, 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 names, <bikeschwalbe.com> and <schwalbetire.com>, be transferred to the Complainant.

*/Jonathan Agmon/*  
**Jonathan Agmon**  
Sole Panelist  
Date: May 11, 2023