

ADMINISTRATIVE PANEL DECISION

Villeroy & Boch AG v. NanShuang Ning

Case No. D2023-1221

1. The Parties

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

The Respondent is NanShuang Ning, China.

2. The Domain Name and Registrar

The disputed domain name <villeroyale.com> (“the Domain Name”) 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 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 22, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 23, 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 amendment to the Complaint on March 23, 2023.

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 April 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 25, 2023.

The Center appointed Dawn Osborne as the sole panelist in this matter on April 28, 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 has operated as a ceramic producer since 1748 and owns, *inter alia*, the following trade mark registrations:

- European Union Trade Mark No. 002475127 VILLEROY (filing date November 23, 2001, registration date March 3, 2005), classes 8, 11, 14, 19, 20, 21 and 24;
- European Union Trade Mark No. 010728996 VILLEROY (filing date March 15, 2012, registration date March 3, 2015), classes 8, 11, 19, 20 and 21;
- European Union Trade Mark No. 001840362 VILLEROY & BOCH (filing date September 6, 2000, registration date January 4, 2002), classes 11, 20 and 21;
- Germany Trade Mark No. DE30151151 VILLEROY (filing date August 27, 2001, registration date February 26, 2002), classes 6, 8, 11, 14, 19, 20, 21, 24 and 34;
- United Kingdom Trade Mark No. UK00902475127 VILLEROY (filing date November 23, 2001, registration date March 3, 2005), classes 8, 11, 14, 19, 20, 21 and 24;
- United Kingdom Trade Mark No. UK00910728996 VILLEROY (filing date March 15, 2012, registration date March 3, 2015), classes 8, 11, 19, 20 and 21;
- International Trade Mark 781051 VILLEROY (filing date February 27, 2002, registration date July 31, 2003) designating Albania, Armenia, Australia, Bosnia and Herzegovina, Bulgaria, Belarus, Switzerland, China, Croatia, Czech Republic, Estonia, Egypt, Georgia, Hungary, Italy, Japan, Democratic People's Republic of Korea, Liechtenstein, Lithuania, Latvia, Morocco, Republic of Moldova, North Macedonia, Norway, Poland, Romania, Russian Federation, Serbia, Singapore, Slovakia, Slovenia, Türkiye, Ukraine, Viet Nam, classes 8, 11, 14, 19, 20, 21 and 24.

The Domain Name registered on January 28, 2022 has been used for a site purporting to be an official site of the Complainant using its VILLEROY & BOCH logo (which is also a trade mark of the Complainant registered in Germany since 2012) as a masthead and material taken from the Complainant's web site without permission. The address given on the web site does not appear to exist.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarised as follows:

The Complainant is the owner of the mark VILLEROY registered, *inter alia*, in Germany since 2002 for ceramic goods with first use recorded as 1748.

The Domain Name registered in 2022 is confusingly similar to the Complainant's mark adding only the dictionary word "sale" and the generic Top-Level domain ("gTLD") ".com" which do not prevent such confusing similarity.

The Respondent has no rights or legitimate interests in the Domain Name, is not commonly known by it and is not authorised by the Complainant.

The Domain Name has been used for fraudulent purposes for a site bearing the Complainant's VILLEROY & BOCH mark in its logo form (also a registered trade mark in Germany) as a masthead and material copied from the Complainant's web site without permission. The address given on the web site attached to the

Domain Name does not exist. The Complainant has received complaints from Internet users that money is taken, but no products delivered. Scam warning sites rate the web site at the Domain Name as untrustworthy. This is opportunistic registration and use in bad faith of a well known mark. Use of a Domain Name to perpetuate a scam is bad faith per se.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Domain Name consists of the Complainant's VILLEROY mark (which is registered, *inter alia*, in Germany since 2002 for ceramic goods with first use recorded as 1748), the word "sale" and the gTLD ".com".

Previous UDRP panels have found confusing similarity when a respondent merely adds a dictionary word to a complainant's mark. The Panel agrees that the addition of the word "sale" to the Complainant's VILLEROY mark does not prevent confusing similarity between the Domain Name and the Complainant's trade mark pursuant to the Policy.

Accordingly, the Panel holds that the Domain Name is confusingly similar to the Complainant's VILLEROY registered mark.

As such the Panel holds that Paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Complainant has not authorised the use of its marks. There is no evidence or reason other than the web site complained of to suggest the Respondent is commonly known by the Domain Name.

The web site attached to the Domain Name uses the Complainant's VILLEROY & BOCH mark in its logo form as a masthead and material taken from the Complainant's web site without permission so that the Respondent's site appears to be an official site of the Complainant. The address given on the web site does not exist. The Panel finds this use is deceptive and passing off. As such it cannot amount to the *bona fide* offering of goods and services. The Panel notes the Complainant's assertion that it has received complaints from customers that money is being taken by the Respondent and no goods subsequently provided, but no evidence of this has been provided.

The Respondent has not answered this Complaint or rebutted the *prima facie* case evidenced by the Complainant as set out herein.

In addition, the Panel finds that the Domain Name carries a risk of implied affiliation with the Complainant, as it incorporates the Complainant's VILLEROY mark in its entirety with the addition of the word "sale".

As such, the Panelist finds that the Respondent does not have rights or a legitimate interest in the Domain Name and that the Complainant has satisfied the second limb of the Policy.

C. Registered and Used in Bad Faith

In the opinion of the Panel the use made of the Domain Name in relation to the Respondent's site is confusing and disruptive in that visitors to the site might reasonably believe it is connected to or approved by the Complainant as it purports to be an official web site of the Complainant using the Complainant's

VILLEROY & BOCH mark and logo as a masthead and material taken from the Complainant's web site without permission. Use of the Complainant's logo and material from the Complainant's site shows that the Respondent is aware of the Complainant and its rights, business and services.

Accordingly, the Panel holds that the Respondent has intentionally attempted to attract for commercial gain Internet users to its web site by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the web site likely to disrupt the business of the Complainant.

As such, the Panelist believes that the Complainant has made out its case that the Domain Name was registered and used in bad faith and has satisfied the third limb of the Policy under para 4(b)(iii) and (iv).

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 Domain Name <villeroyale.com> be transferred to the Complainant.

/Dawn Osborne/

Dawn Osborne

Sole Panelist

Date: May 11, 2023