

## **ADMINISTRATIVE PANEL DECISION**

Vorwerk International AG v. Jose Luis Martin

Case No. D2023-1419

### **1. The Parties**

Complainant is Vorwerk International AG, Switzerland, represented by Moeller IP, Argentina.

Respondent is Jose Luis Martin, Thailand.

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

The disputed domain name <thermomixthailand.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 3, 2023. On April 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 3, 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 (DomainsByProxy.com, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email to Complainant on April 4, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 5, 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 Respondent of the Complaint, and the proceedings commenced on April 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 26, 2023. The Center received an email from Respondent on April 26, 2023. The proceeding was suspended on May 4, 2023, and was reinstated on July 7, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on July 17, 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**

Founded in 1883 in Switzerland, Complainant is a manufacturer of various household appliances. Complainant has 12,000 employees and 578,000 “independent sales partners,” operating in 70 countries.

Complainant’s Thermomix division makes a “multifunctional kitchen appliance” called THERMOMIX, and Complainant’s sales of THERMOMIX products since 2020 exceeds EUR 1.584 billion.

Complainant holds more than 20 registrations for the mark THERMOMIX, the earliest of which dates back to 1999. Complainant also owns hundreds of domain names containing the THERMOMIX mark.

In 2017, Complainant entered into a Distribution Agreement with Respondent’s company, Novamix Co., Ltd. (“Novamix”), whereby Novamix was authorized to market and distribute Complainant’s THERMOMIX products in Thailand. Complainant signed the Distribution Agreement on March 1, 2017, and Respondent signed it for Novamix on April 24, 2017.

Article 13.4 of the Distribution Agreement stated that upon the Complainant’s request, the Respondent was to cancel or assign to the Complainant any “Internet domain name” including the Complainant’s trademarks, at any time and without being given a reason therefore.

The Domain Name was registered on February 28, 2017. The Domain Name was used to market Complainant’s THERMOMIX products in Thailand.

Complainant asserts that, in 2019, it “stopped the production of the reference products and, therefore, the distributor agreement has been terminated by the Complainant in the same year”. There is nothing in the record to reflect Complainant’s notification to Respondent in 2019 or thereafter formally terminating the Distribution Agreement. As will be noted below (in the “Parties’ Contentions” section), Respondent asserts that it never received an “official cancellation letter” from Complainant.

On November 11, 2022, Respondent sent Complainant an email, apparently asking Complainant to send Respondent some THERMOMIX “TM5” spare parts and some THERMOMIX “TM6” products for sale in Thailand. Six days later, on November 17, 2022, Complainant sent Respondent an email stating that the agreement between Complainant and Novamix had ended in 2019, and demanding that Respondent cease using the THERMOMIX mark in social media and transfer the Domain Name.

On March 1, 2023, Complainant sent Respondent another email, invoking Article 13.4 of the Distributor Agreement and demanding the transfer of the Domain Name. It does not appear that Respondent replied to these emails.

As of April 6, 2023, three days after the Complaint in this proceeding was filed and the same date as Respondent received official notice of this dispute, the Domain Name resolved to a website featuring the company name NOVAMIX, which was described as “Thermomix Thailand Official Distributor”. The site advertised Complainant’s THERMOMIX products.

Subsequently, the Domain Name was redirected to Complainant’s main website at <thermomix.com>.

#### **5. Parties’ Contentions**

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

Complainant contends that it has satisfied each of the three elements required under the Policy for a transfer of the Domain Name.

## B. Respondent

Respondent did not submit a formal Response. In an April 26, 2023 email to the Center, Respondent stated:

“After receiving your Notification of Complaint we would like to clear up some misunderstandings:

1. That the domain ‘www.thermomixthailand.com’ was approved by Thermomix representatives in 2017, in particular by David Coulbault and Sebastien Lambercy.
2. That in the documentation attached is missing the cancelation of our distribution agreement, since we already informed that we never received such official cancelation letter and there is no acknowledgement from our side.
3. That we refuse any charge related with this procedure, since this is an unilateral decision and action by Vorwerk International.
4. That we are open for a negotiation to transfer the domain in dispute.
5. That we never have deteriorated or damaged the image of Thermomix, but the opposite, as you could see in the content of the website.

As a proof of our good willing to reach an agreement, we have redirected the domain ‘www.thermomixthailand.com’ to ‘www.thermomix.com’.

Looking forward to hearing from you and in particular from Vorwerk International to set up a meeting and to discuss about the transfer conditions of the domain in dispute.”

## 6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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

The Panel concludes that Complainant has rights in the trademark THERMOMIX through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The entire mark THERMOMIX is incorporated into the Domain Name, and, despite the additional geographical indicator “Thailand”, the mark remains recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or

- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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 Panel need not address this element, given its decision below in the “Bad Faith” section.

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

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that this Complaint must fail because, at the time Respondent registered the Domain Name, he did so with Complainant’s express or tacit approval. The day before the Distribution Agreement was executed by Complainant, Respondent registered the Domain Name. It is fair to infer that the terms of this contract, including Article 13.4 relied on in this case by Complainant, were fully or almost fully agreed by the Parties as of February 28, 2017. As such, the Panel cannot conclude that the Domain Name was registered by Respondent in bad faith. Accordingly, the Complaint must fail.

In this regard, see *Sanosil AG v. Ammar Matouk*, WIPO Case No. [D2023-1174](#) (“The disputed domain name could only have been registered in bad faith if, at the time of registration, the Respondent had some form of abusive or malign intent, such as to divert business from the Complainant, to pass off third party goods as those of the Complainant, or otherwise to take unfair advantage of the Complainant’s rights in its SANOSIL mark.”).

Whether Respondent is in breach of the Distributorship Agreement by refusing to transfer the Domain Name to Complainant is an issue beyond the purview of the UDRP.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: July 31, 2023