

## **ADMINISTRATIVE PANEL DECISION**

### **GARO Aktiebolag v. Domain Manager**

### **Case No. D2023-4076**

#### **1. The Parties**

The Complainant is GARO Aktiebolag, Sweden, represented by Ports Group AB, Sweden.

The Respondent is Domain Manager, Australia.

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

The disputed domain name <garogroup.com> 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 September 28, 2023. On September 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 29, 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 (Domains By Proxy LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 4, 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 the same day.

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 October 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Parties of the Respondent’s default on November 14, 2023.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on December 4, 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.

Due to exceptional circumstances, the Decision due date was extended to January 19, 2024.

#### **4. Factual Background**

The Complainant is a Swedish company that provides goods and services related to electrical installations. It is the proprietor of numerous trademark registrations for its GARO mark, including European Union Trade Mark Registration No. 000690701 for GARO (device mark), registered on October 23, 2002 for goods in class 9.

The Complainant owns the domain names <garo.se>, registered on September 4, 1996, and <garogroup.se>, registered on August 31, 2016.

The disputed domain name was registered on March 18, 2004. The evidence in the record indicates that the disputed domain name previously resolved to sites with the following content:

- In 2008, a site operated by “The Garo Group,” describing itself as a “small women owned firm located in the San Francisco Bay Area” and states that it was founded in 1995 and offers consulting services. The site provides contact information (including a telephone number and email address);
- In 2011, a site operated by “The Garo Group,” describing itself as “a San Francisco Bay Area small firm that works with government, non-profits, universities and philanthropic organizations” and providing contact information for same;
- In 2012, a site headlined “Band Aids For Cambodia—A Garo Group’s Partner”
- In March 2013, a site operated by “The Garo Group,” describing itself as “a woman-owned consulting firm that partners with community based organizations, universities and foundations to implement community building programs;”
- In October 2013, a site operated by “The Garo Group” headlined “College Admissions Counseling for Athletes.” Similar content is recorded in 2014 and 2015, when the visual content of the site is upgraded to include thematic photographs;
- In January 2016, the disputed domain name no longer resolved to an active website;
- In 2020 and 2021, the disputed domain name was offered for sale as a “premium domain name” without a specific price listed;
- At the time of the filing of the Complaint and of this Decision, it was offered for sale for USD 15,000.

On June 26, 2023, the Complainant sent a cease-and-desist letter to the Respondent, but did not receive a response thereto.

No information is available about the Respondent.

#### **5. Parties’ Contentions**

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it has used the GARO mark since 1939, and has been using the <garogroup.se> domain name since 2016. The Respondent was therefore aware of the Complainant and its rights. The disputed domain name, which wholly incorporates the Complainant's well-known mark, has been offered for sale for several years for a price exceeding the costs of registration. It is being passively held in bad faith. The previous use was intended to divert the Complainant's customers.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the UDRP requires the Complainant to make out all three 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; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint 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. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the Complainant's GARO mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "group") may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds that there is no evidence available that the Respondent is commonly known by the disputed domain name, or that there are any circumstances or activities that would establish the Respondent's rights therein. There is no evidence of legitimate noncommercial use or a bona fide offering of goods or services at the relevant point in time, which is the present. See [WIPO Overview 3.0](#), section 2.11.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

- (i) circumstances indicating that the respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location. (Policy, paragraph 4(b)).

The disputed domain name was registered in 2004, two years after the registration of the Complainant's GARO mark in the European Union. Therefore, the Complainant's trademark rights pre-date the registration of the disputed domain name, which comprises the Complainant's GARO mark together with the descriptive term "group."

However, there is no evidence provided in support of the Complainant's assertion that its GARO mark is a well-known mark and that, on that basis, the Respondent knew or should have known about it at the time of registration of the disputed domain name.

The Panel must therefore attempt to discern whether the evidence available permits any inference that the Respondent was targeting the Complainant's trademark when registering the disputed domain name. The record indicates that from at least 2008 to 2016, the disputed domain name resolved to a website operated by an entity calling itself the Garo Group, located in California, United States, offering various types of consulting services related to government services, community organizations and college admissions counseling. The telephone number indicated on the website remained constant through those years. Although it is not possible from the evidence to evaluate the legitimacy of these businesses, the record does not provide evidence sufficient to support a finding that the Respondent targeted the Complainant at the time of registration of the disputed domain name. The Panel notes that, at the time of registration, the Complainant was operating in Sweden and the European market in the field of electrical products and services.

Noting the fact that the "Garo Group" website, to which the disputed domain name resolved, was disabled in 2016, the same year that the Complainant registered the <garogroup.se> domain name, the Panel considered whether the evidence available could support an inference that a new registration had been effected by a change of ownership behind the privacy shield. If such were the case, the Panel could have had a basis for finding that the Respondent had targeted the Complainant's mark, particularly given that the disputed domain name was made available for sale starting in 2020 at a price that seems likely in excess of the Respondent's costs. See [WIPO Overview 3.0](#), section 3.1.1.

Based on the available evidence, however, the Panel was unable to reach such a conclusion. The Panel does not find that the Respondent's use of a privacy service, by itself, leads to a finding that the disputed domain name was registered in bad faith either in 2004 or later. See [WIPO Overview 3.0](#), section 3.6. Crucially, the Complainant does not assert such an argument and accordingly has provided no evidence whatsoever that would allow the Panel to infer that the current Respondent is not the original registrant of the disputed domain name. According to UDRP practice, the kinds of evidence that could permit such an inference include a recent update to the registration as reflected in the Whois registration, along with recent use that unambiguously targets the complainant. See, for example, *Sleeptopia, Inc. v. Gregory Perez*, WIPO Case No. [D2023-1317](#) and *Pinterest, Inc. v. Pinerest.com c/o Whois Privacy Services Pty Ltd / Ian Townsend*, WIPO Case No. [D2015-1873](#).

On balance, therefore, the Panel finds that the Complainant has not provided evidence of bad faith registration of the disputed domain name. Since the third element of the Policy is a conjunctive requirement, the Panel will not consider bad faith use.

Based on the available record, the Panel finds the third element of the Policy has not been established.

## 7. Decision

For the foregoing reasons, the Complaint is denied, but without prejudice to the Complainant's right to refile a complaint and initiate a new UDRP proceeding in the event the Complainant develops new information not reasonably available at the time of the filing of the Complaint in this proceeding showing that the Respondent registered the disputed domain name in bad faith.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: January 19, 2024