

ADMINISTRATIVE PANEL DECISION

NETZSCH Pumpen & Systeme GmbH v. khalil Zahabi
Case No. DIR2024-0007

1. The Parties

The Complainant is NETZSCH Pumpen & Systeme GmbH, Germany, represented Clyde & Co., United Kingdom.

The Respondent is khalil Zahabi, Iran (Islamic Republic of) ("Iran").

2. The Disputed Domain Names and Registrar

The disputed domain names <netzsch-pars.ir> and <netzsch-pazh.ir> are registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 13, 2024. On May 13, 2024, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain names. On May 16, 2024, IRNIC 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 (Raybad Energy Pazh ای ژرنا دبی ار) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 17, 2024, 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 May 21, 2024. Hard copies of the Complaint were received by the Center on May 14, 2024.

The Center verified that the Complaint and the amendment to the Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the "Policy" or "irDRP"), the Rules for .ir Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 24, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was June 13, 2024. On June 17, 2024, the Center notified the Respondent's default.

The Center appointed Marilena Comanescu as the sole panelist in this matter on June 24, 2024. 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, a company registered under the laws of Germany, is developing, producing and distributing positive displacement pumps worldwide.

The Complainant, directly or through companies in its group¹, holds trademark registrations for NETZSCH, such as the following:

- the United States of America Trademark Registration number 5377366 for the mark NETZSCH (stylized), filed on September 18, 2015 and registered on January 16, 2018 covering goods and services in International classes 6, 7, 9, 17, 21, 37, 40, 41, 42; and

- the International Trademark registration number 1289724 for the mark NETZSCH (stylized), registered on September 18, 2015, designating, inter alia, Iran, and covering goods and services in International classes 6, 7, 9, 17, 21, 35, 37, 40, 41, 42; and

- the Estonia Trademark registration number 08964 for the mark NETZSCH (stylized), registered on March 8, 1994, filed on April 23, 1993.

The Complainant also has unregistered trademark rights for NETZSCH through extensive use.

The disputed domain name <netzschn-pars.ir> was registered on April 26, 2022, and the disputed domain name <netzschn-pazh.ir> was registered on June 25, 2022.

At the time of filing the Complaint, both the disputed domain names resolved to commercial websites, in Persian language (with options for English version), prominently displaying the Complainant's trademark and where purported spare parts of NETZSCH products were offered for sale, stating that the websites belong to Netzsch Pazh Production Group, which is owned by a third party (Raybad Energy Pazh Co.), unrelated to the Complainant.

Also, the websites under the disputed domain names were displaying the trademark NEMO, another registered trademark of the Complainant, with protection in Iran.

5. Parties' Contentions

A. Complainant

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

¹ Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8. In this regard, the Panel conducted its independent search through the search engine and noted that the listed owner of the provided trademark registrations for NETZSCH, as cited in this Decision, Erich Netzsch GmbH & Co. Holding KG, is part of the same companies group as the Complainant. The Panel also notes that the Complainant itself owns the trademark registration for NETZSCH as cited in this Decision.

Notably, the Complainant contends that it holds registered and unregistered rights in NETZSCH mark and it has used the mark worldwide, including in Iran; the disputed domain names blatantly replicate its registered name Netzsch and are identical or confusingly similar to its trademark; that the Respondent has no rights or legitimate interests in the disputed domain names; that the Respondent is not associated nor has the right to use or authority to use Netzsch name, or any of the Complainant's trademarks, or its registered name "NEMO" for any purpose, including and not limited to the marketing or advertising of products that are trademarked by the Complainant; that the Respondent registered and is using the disputed domain names in bad faith to attract, for commercial gain, Internet users to the Respondent's websites, or other physical premises in Iran by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or location or of a product or service of the Respondent's websites or location; the use of its trademarks, NETZSCH and NEMO, in the disputed domain names and on the corresponding websites is misleading to consumers and carries a significant risk of tarnishing the trademark and reputation of the Complainant.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain names are 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 the disputed domain names; and
- (iii) the disputed domain names have been registered or are being used in bad faith.

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 1.7².

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 mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are both 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, "-pars" and "-pazh", respectively, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

² Given the similarities between the Policy and the Uniform Domain Name Resolution Policy ("UDRP"), the Panel finds it appropriate to refer to UDRP jurisprudence, including reference to the [WIPO Overview 3.0](#).

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 names. 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 names such as those enumerated in the Policy or otherwise.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain names in connection with websites promoting and purporting to offer for sale spare parts for the Complainant’s NETZSCH and NEMO marked products. Panels have held that the resellers, distributors, or services providers using a domain name containing the Complainant’s trademark to undertake sales or repair services related to the complainant’s goods and services may be making a bona fide offering of goods and services and thus have a legitimate interest in such a domain name if cumulative conditions are met. Such conditions, include, inter alia (i) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and (ii) the respondent must not try to “corner the mark” in domain names that reflect the trademark. The websites under the disputed domain names do not provide accurate information about the relationship between the Respondent and the Complainant and, registering two domain names within a short period of time, together with the other elements in this case, may be considered an attempt to corner the Complainant’s mark on the Iranian market. [WIPO Overview 3.0](#), section 2.8.1.

Moreover, the Panel finds that the composition of the disputed domain names, together with the content, creates a risk of Internet user confusion.

The Panel finds the second element of the Policy has been established.

C. Registered or 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 or use of a domain name in bad faith.

In the present case, the Panel notes that the disputed domain names were registered in bad faith, with knowledge of the Complainant and its trademark particularly because they incorporate the Complainant’s distinctive mark, which predates the registration of the disputed domain names with at least seven years. Furthermore, the use of the disputed domain names reinforces such finding.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt “to attract, for commercial gain, Internet users to [the respondent’s] 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” is evidence of registration and use in bad faith.

Given that the disputed domain names incorporate the Complainant’s trademark, and the websites operated under the disputed domain names prominently display the Complainant’s trademarks NETZSCH and NEMO, purportedly selling spare parts for the Complainant’s products and do not contain accurate information regarding the (lack of) relationship between the Complainant and the Respondent, indeed in this Panel’s view, the Respondent has intended to attract Internet users accessing the websites corresponding to the disputed domain names who may be confused and believe that the websites are held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent’s commercial gain.

Paragraph 4(b)(ii) of the Policy provides another circumstance of bad faith registration and use when the respondent registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. The Panel finds that registering at least two disputed domain names incorporating the Complainant’s trademark can be considered a pattern of abusive conduct and registration of the disputed domain names in bad faith. [WIPO Overview 3.0](#), section 3.1.2.

The Respondent did not participate in this proceeding and thus failed to provide any argument in its favor. Having in view the other circumstances of this case, such fact constitutes further evidence of bad faith.

The Panel finds the third element of the Policy has been 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 <netzsch-pars.ir> and <netzsch-pazh.ir> be cancelled.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: July 8, 2024