

ADMINISTRATIVE PANEL DECISION

dm-drogerie markt GmbH + Co. KG v. Grygoriev Oleksandr Sergeevich
Case No. DUA2024-0005

1. The Parties

The Complainant is dm-drogerie markt GmbH + Co. KG, Germany, represented by Mamunya IP, Ukraine.

The Respondent is Grygoriev Oleksandr Sergeevich, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <denkmit.com.ua> is registered with SITIHOST LLC / TOB "CITIXOCT" (ua.cityhost-llc), (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on April 26, 2024. On April 29, 2024, the Center transmitted by email to the Registrar a request for Registrar verification in connection with the disputed domain name. On May 1, 2024, 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 (not published) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 3, 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 8, 2024.

On May 3, 2024, the Center informed the parties in English and Russian, that the language of the registration agreement for the disputed domain name is Russian and invited the Complainant to submit satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English; or submit the Complaint translated into Russian; or submit a request for English to be the language of the administrative proceedings.

The Complainant confirmed its request for English to be the language of the proceedings on May 6, 2024. The Respondent did not comment on the language of the proceedings.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of .UA Domain Name Dispute Resolution Policy (the “.UA Policy”), the .UA Rules for .UA Domain Name Dispute Resolution Policy (the “.UA Rules”), and the WIPO Supplemental Rules for .UA Domain Name Dispute Resolution Policy (the “WIPO Supplemental Rules”).

In accordance with the .UA Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint in both English and Russian, and the proceedings commenced on May 14, 2024. In accordance with the .UA Rules, paragraph 5(a), the due date for Response was June 3, 2024.



On May 15, 2024, the Respondent sent an informal email communication to the Center. On May 17, 2024, the Respondent submitted an email communication in Ukrainian marked “This is an official response” where he expressed its opinion on the use of the disputed domain name and attached the signed the Standard Settlement Form. On May 20, 2024, he sent a further email communication to the Center. On June 6, 2024, the Complainant filed a Supplemental Filing. On the same date, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Anton Polikarpov as the sole panelist in this matter on June 19, 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 .UA Rules, paragraph 7.

4. Factual Background

The Complainant is a German company that produces and sells cosmetics, healthcare items, household products, and food. The Complainant has been conducting its activities since 1973 and currently operates in the markets of numerous European countries selling through its own retail stores and online shops household chemicals under the range of commercially successful brands, in particular DENK MIT.

Carrying about the protection of intellectual property rights, the Complainant holds multiple trademark registrations for the word mark DENK MIT, its short form - DM and stylized/design marks featuring them which cover the European Union and other jurisdictions, including the following:

- German Trademark registration No. 39705768 for DENK MIT, registered on July 17, 1997, covering goods in Classes: 3, 5, 21;
- International Trademark No. 951886 for DENK MIT registered on December 13, 2007 (designating, inter alia, Ukraine), covering goods in Classes: 3, 5, 21;
- International Trademark No. 1274038 for  registered on March 11, 2015 (designating, inter alia, Ukraine), covering goods in Classes: 3, 5, 21;
- International Trademark No. 1793785 for DM registered on September 14, 2023 (designating, inter alia, Ukraine), covering goods and services in Classes: 09, 35, 36, 37, 38, 41, 42, 43, 44;
- International Trademark No. 1795148 for  registered on September 14, 2023 (designating, inter alia, Ukraine), covering goods and services in Classes: 9, 35, 36, 37, 38, 41, 42, 43, and 44.

Additionally, the Complainant claims that it owns several domain names incorporating the trademarks, in particular the domain name <dm.de>.

The disputed domain name was registered on May 17, 2013. The website associated with the disputed domain name as of the date of filing the Complaint, reproduced the Complainant’s trademarks and was offering for sale the Complainant’s products as well as third-party competing products.

Being informed about the above-described use of the disputed domain name, the Complainant undertook multiple efforts to contact the authorized person to address the trademark infringement. In particular, on March 14, 2017 Complainant's representative dispatched several letters to the email address provided on the website associated with the disputed domain name. These letters demanded the cessation of the infringement of the DENK MIT marks. Despite the demands, the adequate measures to cease the infringement were not taken.

5. Parties' Contentions

A. Complainant

The Complainant contends that all three cumulative requirements as provided for in paragraph 4(a) of the .UA Policy are satisfied in this case, in other words:

- the disputed domain name is identical to the trademarks in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the disputed domain name was registered and is being used in bad faith.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

The Respondent asserted in its substantive communication of May 17, 2024 that he had "officially bought [the Complainant's] products" and "promoted [its] brand in Ukrainian market." He also claims that the website at the disputed domain name was not presented as the Complainant's official website, notably the Complainant's logo was displayed in a font different from the Complainant's, no damage has been caused to the Complainant, and the "denkmit" element of the disputed domain name is a term translated [into English] as "think with". Lastly, he suggests that the Complainant could have pursued avenues for cooperation with the Respondent in the Ukrainian market.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Russian. Pursuant to the .UA Rules, paragraph 11(a), unless otherwise agreed by the Parties, the language of the administrative proceeding shall be the language of the Registration Agreement (which shall be in English, Russian or Ukrainian), subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In particular, it is established practice to take paragraphs 10(b) and 10(c) of the .UA Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the Parties and the maintenance of a cost-effective and swift avenue for resolving domain name disputes.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)")¹, section 4.5.1).

¹ In view of the similarities between the .UA Policy and the Uniform Domain Name Dispute Resolution Policy ("UDRP"), the Panel may refer to the [WIPO Overview 3.0](#) and UDRP decisions when relevant.

The Complainant filed the Complaint in English and requested English to be the language of this proceeding for several reasons, including the fact that: (i) the website of the Registrar contains a Registration Agreement in three languages: Ukrainian, Russian, and English; (ii) the website under the disputed domain name is an online store where customers can order household chemicals, cosmetics, children's goods, and other products. Despite the majority of the website's content being presented in the Russian language, there are also webpages in Ukrainian, although the disputed domain name is registered in Latin characters in its entirety. The term "denk mit", which is the only element of the disputed domain name, does not convey any meaning in the Ukrainian language; (iii) the names of some products featured on the website contain English designations, while the email addresses indicated on the website consist of English words, such as "client" or "director"; (iv) the phone number provided on the website under the disputed domain name for contacting the website's "management" is a German phone number. Additionally, the website allows users to select EUR as the currency for transactions; (v) English is one of the three languages of international communication, one of the most spoken languages in the world; (vi) the website frequently incorrectly displays the selected language, mixing section headings or titles in both English, Russian and Ukrainian.

The Panel has kept in mind that the Complainant has provided submissions regarding the proper language of proceedings, while no objection was made by the Respondent to the proceeding being conducted in English nor any request made that the proceedings be conducted in Russian, the language of the Registration Agreement, or Ukrainian, being the language of the Respondent's email communications. This was despite the Center notifying the Respondent in English and Russian that (i) the Respondent is invited to present his objection to the request that the proceedings being held in English and (ii) if the Center did not hear from the Respondent by a certain date, the Center would proceed on the basis that the Respondent had no objection to the Complainant's request that English be the language of the proceedings.

The Panel further pays attention to the facts that (i) the Respondent sent a substantive email communication in Ukrainian; (ii) the website allows users to select not only UAH, but also EUR as the currency for transactions; (iii) the Respondent signed the Standard Settlement Form presented in English. Considering this, there are grounds to state that the Respondent does not use Russian as the working language while is familiar with English.

That is why requiring the Complainant to translate the Complaint and all documents into Russian would impose an excessive burden on the Complainant and cause delay in contravention to paragraph 10(c) of the .UA Rules, which requires that the Panel shall ensure that the administrative proceeding takes place with due expedition. (See *Michael Kors (Switzerland) International GmbH. v. Minakova Maria*, WIPO Case No. [DUA2020-0002](#) finding that the registration agreement was in Russian, but that the proceeding should be conducted in English since the Panel has to balance the language requirement against the other considerations of ensuring that the proceeding takes place with due expedition and that the parties are treated fairly and given a fair opportunity to present their case. The Panel is of the view that the language requirement should not cause any undue burden on the parties or undue delay).

The Panel also finds applicable to this case the position on the use of English as a neutral language stated, in particular, in the case *Implantcast GmbH v. Beats*, WIPO Case No. [D2018-1833](#): "...the Panel notes that English does not appear to be the mother language of either party. Given the fact that the Complainant is based in Germany and the Respondent is based in the Republic of Korea, English would appear to be the fairest neutral language for rendering this decision".

Given that: (i) both Parties had ample opportunities to present their arguments on the language applicable to this administrative proceeding; (ii) English is a commonly used language; (iii) the case file does not contain any grounds to deny that English is a language known to the Respondent, the Panel concludes that, in the specific circumstances of this case, it is most appropriate to proceed in English, in line with the Complainant's request. This decision aligns with the objective of paragraph 11(a) of the .UA Rules, as conducting the proceedings in Russian could place the Complainant at a significant disadvantage.

In light of the considerations mentioned above, the Panel hereby determines, in accordance with paragraph 11(a) of the .UA Rules, that the language for the proceeding shall be English. The Panel further notes that it accepts the Respondent's substantive email communication filed in Ukrainian, even though Ukrainian is not the language of the registration agreement in this case.

6.2 Further Procedural Considerations

Paragraph 10 of the .UA Rules required from the Panel to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case and that the administrative proceeding takes place with due expedition; it also vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence.

Since the Respondent's mailing address is stated to be in Ukraine (whether this is indeed accurate is not clear), which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. With respect to the presentation of the Parties' arguments, the following should be noted: as it can be seen from the case file, the Center had employed reasonably available means calculated to achieve actual notice to the Respondent of the Complaint as specified by the .UA Rules. There is no evidence that the case notification email to the Respondent's email address registered with the Registrar was not successfully delivered. Thus, the Panel considers that the Respondent was duly informed of the commencement of administrative proceeding. Even more, in response to the Center's Notification of Complaint and Commencement of Administrative Proceeding, the Respondent sent several substantive email communications. Lastly, the Panel takes note of the change of use of the disputed domain name that occurred after the Respondent had been notified of the commencement of the present proceeding.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to the decision accordingly.

With respect to the Supplemental filings, the Panel finds it unnecessary to take into consideration the Complainant's Supplemental Filing.

Paragraph 12 of the .UA Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel (see the [WIPO Overview 3.0](#), section 4.6).

6.3. Substantive Elements of the .UA Policy

The Panel will now proceed to evaluate this matter in light of the Complaint, the Respondent's email communications, the .UA Policy, the .UA Rules, the WIPO Supplemental Rules, and other relevant legal authorities, as outlined in accordance with paragraph 15(a) of the .UA Rules.

Paragraph 15(a) of the .UA Rules anchors the Panel as to the principles the Panel is to use in determining the dispute: the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the .UA Policy, .UA Rules and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the .UA Policy directs that the Complainant must prove each 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; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) the disputed domain name has been registered or is 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 (see the [WIPO Overview 3.0](#), section 1.7).

Section 1.2.1 of the [WIPO Overview 3.0](#) makes clear that, where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

Based on the available record, the Panel finds that the Complainant has shown rights in respect of the trademark for the purposes of the .UA Policy. At the same time, the DENK MIT mark is reproduced in its entirety in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is identical to the mark held by the Complainant. Thus, the initial requirement of paragraph 4(a) of the .UA Policy should read as met.

B. Rights or Legitimate Interests

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

However, the Respondent has not provided any legitimate reason why it should be able to use the Complainant's trademarks in this manner.

As explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the evidence provided by the Complainant shows – and as admitted by the Respondent - the Respondent did offer DENK MIT branded goods for sale on the website at the disputed domain name; however, its offerings may not be characterized as bona fide as it fails to satisfy at least criteria 2 and 3 set out in *Oki Data Americas, Inc. v. ASD, Inc.* WIPO Case No. [D2001-0903](#).

More specifically, (i) the Respondent used the disputed domain name to promote and sell products from competing third-party brands, including “Calgon”, “Persil”, “Perwoll”, “Vanish”, “Silan” and others; (ii) the Respondent has failed to clearly disclose its lack of affiliation with the Complainant. Instead, it has copied the Complainant's figurative trademark, misleadingly implying an association with the Complainant.

Based on the relevant practice that has been established in connection with the implementation of the Oki Data test, the said actions does not align with the generally accepted principles. The use of the disputed domain name to direct consumers to the Respondent's website does not qualify as either a bona fide provision of goods or services or a legitimate noncommercial or fair use of the disputed domain name (see *Luigi Lavazza S.p.A. v. Ольховский Михаил Викторович / Ol'khovskij Mikhail Viktorovich*, WIPO Case No. [DUA2021-0017](#)).

As such, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name and the Complainant has satisfied the second element of the paragraph 4(a) of the .UA Policy.

C. Registered or Used in Bad Faith

According to paragraph 4(a)(iii) of the .UA Policy, it should be established that the disputed domain name has been registered or is being used in bad faith.

The evidence submitted by the Complainant shows that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to the website to which the disputed domain name used to resolve, by creating the impression among Internet users that said website was related to, associated with, or endorsed by the Complainant, which conduct constitutes bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#)).

As described above in the “rights or legitimate interests” section, the disputed domain name has been pointed to a website featuring DENK MIT marks and offering for sale, in particular, purported DENK MIT branded products, without publishing any clear and evident disclaimer as to the lack of affiliation with the Complainant.

The Respondent has not rebutted the assertions of bad faith made by the Complainant in this proceeding (See, e.g., *Compagnie Générale des Etablissements Michelin v. Regan Finch, Georgiana Blankenship*, WIPO Case No. [D2023-4672](#)).

Based on its evaluation of all evidence presented, the Panel finds that the Respondent is using the disputed domain name in bad faith pursuant to 4(b)(iv) of the .UA Policy, and the Complainant succeeds under paragraph 4(a)(iii) of the .UA Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the .UA Policy and 15 of the .UA Rules, the Panel orders that the disputed domain name, <denkmit.com.ua>, be transferred to the Complainant.

/Anton Polikarpov /

Anton Polikarpov

Sole Panelist

Date: July 1, 2024