

ADMINISTRATIVE PANEL DECISION

thyssenkrupp AG and thyssenkrupp Bilstein GmbH v. Koert van der Hoofd,
CarFantasy
Case No. D2023-1260

1. The Parties

The Complainants are thyssenkrupp AG, Germany (the “First Complainant”), and thyssenkrupp Bilstein GmbH, Germany (the “Second Complainant”), internally represented.

The Respondent is Koert van der Hoofd, CarFantasy, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <bilstein-shop.com> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 23, 2023. On March 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 24, 2023, the Registrar transmitted by email to the Center its verification response disclosing additional registrant and contact information for the disputed domain name to the named Respondent (REDACTED FOR PRIVACY/Car Fantasy) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 28, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on March 28, 2023.

The Center verified that the Complaint together with the amendment to the Complaint/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 the Respondent of the Complaint, and the proceedings commenced on March 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2023. The Response was filed with the Center on April 19, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on May 11, 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.

In view of the Respondent's claims that he, or his business, had been using the disputed domain name with the consent of the Complainants since 2012, the Panel issued Procedural Order No. 1 on June 2, 2023 pursuant to paragraph 12 of the Rules giving the Respondent an opportunity to submit documentary evidence corroborating these claims by June 9, 2022 and providing the Complainants with an opportunity for reply.

In the event, the date for the Respondent to submit a supplemental filing was extended by Procedural Order No. 2 to June 27, 2023. The Respondent submitted a supplemental filing on June 15, 2023.

At the Complainants' request, the time for the submission of its supplemental filing in reply, if any, was extended to July 5, 2023. On July 4, 2023, the Complainants submitted a supplemental filing.

4. Factual Background

As their names suggest, the Complainants are members of the ThyssenKrupp corporate group. (The Panel infers that the First Complainant is the parent of the group and the Second Complainant operates the "Bilstein" business.)

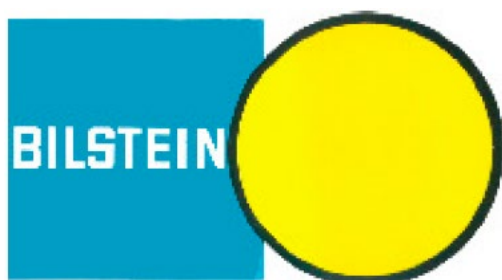
The Second Complainant manufactures and distributes around the world shock absorbers and related products for automobiles. The Second Complainant claims it has 4,100 employees around the world including production sites in Germany, the United Kingdom, Romania, the United States of America, China, and Mexico. According to the Complaint, the Second Complainant has for many years been a partner in high demand in motorsports and car tuning.

Amongst other things, the Second Complainant promotes its products from the website at "www.bilstein.com". The Second Complainant registered the domain name <bilstein.com> in 1996. According to this website, the Second Complainant can trace its origins back some 150 years. The Complaint also includes evidence that the Second Complainant has registered numerous other domain names based on "bilstein".

The Complaint also includes evidence that the First Complainant owns several trademarks based on BILSTEIN. For present purposes, it is sufficient to note two International Registrations:

- (a) The earliest registration in evidence is International Registration No. 383704, BILSTEIN and device, which has been registered since September 30, 1971 in respect of a range of goods in International Classes 6, 7, 8, and 12 including, amongst other things, automobile parts and accessories; and
- (b) International Registration No. 1025467, BILSTEIN, which has been registered since November 4, 2009 in respect of parts for motor vehicles and associated products in International Class 12.

Each of these International Registrations designated numerous countries and relied on an earlier basic registration in Germany, respectively, Nos. DT 884359 and DE 30 2009 027 812.1/12. The trademark registered through International Registration No. 383704 is:



The disputed domain name resolves to a website which offers for sale, or appears to offer for sale, shock absorbers and accessories or parts under or by reference to the brand name BILSTEIN. The website prominently features the Complainants' trademarks BILSTEIN and versions of the BILSTEIN and device mark. The website makes heavy use of blue and gold or yellow colouring very closely resembling the colour scheme used by the Complainants. According to the Response, the Respondent only sells the Complainants' products through this website.

The website at the bottom of the landing page states "Copyright 2014 Car Fantasy". It also includes the Respondent's telephone number. After the Complaint was filed, the Respondent amended the website to add to the logo at the top of the page "powered by Car Fantasy". The logo itself, both before and after the Complaint was filed is a BILSTEIN device mark followed by " • SHOP".

According to the Respondent, he registered the disputed domain name in 2011 and has been using it since 2012 in association with his business. The Respondent claims that the Complainants have been advertising in his "Car Fantasy" catalogue since 2012 and the disputed domain name has been printed across the bottom of the advertisements.

The Respondent's supplemental filing includes images of the advertisements appearing in Car Fantasy catalogues in or for 2012 – 2013, 2015 – 2016, 2017 – 2018, 2021 and 2022. The supplemental filing also includes an email thread in 2017 in relation to advertising in the Respondent's catalogue between the Respondent, his supplier – KSC Import and an employee in the Complainants' marketing department (with an email address [redacted]@thyssenkrupp.com).

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainants must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (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 and is being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

As the Registrar has confirmed that the language of the registration agreement is English, it is also the language of the proceeding. See paragraph 11 of the Rules. The Panel notes also that both Parties have made their submissions in English.

A. Identical or Confusingly Similar

The Complainants have proven that the First Complainant owns numerous registered trademarks; two representative examples of which have been included above.

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.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

It is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. See for example, [WIPO Overview 3.0](#), section 1.10. The device elements in International Registration No. 383704 are significant and memorable. However, the Panel does not consider that the verbal element BILSTEIN is so overborne by those device elements that the usual rule should not be applied in this case.

Disregarding the ".com" gTLD and the device elements, therefore, the disputed domain name consists of the Complainants' registered trademarks and the term "shop". As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainants' trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainants have established that the disputed domain name is confusingly similar to the Complainants' trademark and the requirement under the first limb of the Policy is satisfied.

B. Registered and Used in Bad Faith

In the circumstances of this case, it is appropriate to consider the third requirement under the Policy next.

Under the third requirement of the Policy, the Complainants must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

There is no issue between the Parties that the Respondent was well aware of the Complainants' trademark when registering the disputed domain name.

In both the Complaint and their supplemental filings, the Complainants state that the Respondent registered the disputed domain name without their authorisation. The Respondent on the other hand contends he registered and has been using the disputed domain name with the knowledge and consent of the Complainants.

The Respondent claims that advertisements featuring the disputed domain name have been placed by the Complainants, or with their approval, in his catalogue since 2012. The Respondent's supplemental filing includes several examples of these advertisements. The Respondent's supplemental filing also includes email correspondence with the Complainants' marketing department in 2017 about the advertisement in that year's catalogue. As the Respondent contends, these advertisements do feature the disputed domain name.

According to the Respondent, he is not in a position to provide emails for earlier years any more as they have been deleted. Bearing in mind how long ago the events were, that is not an implausible claim.

It is not clear from the record that the Respondent did register the disputed domain name in 2011 with the approval of the Complainants. It does appear tolerably clear (at least for the purposes of a proceeding on the papers under the Policy), however, that the Respondent has been using the disputed domain name with the knowledge of the Complainants' marketing department since 2012.

In their supplemental filing, the Complainants acknowledge that KSC is a legitimate importer into the Netherlands of their products. However, they state that it does not, and did not previously ever have authority to authorise the Respondent to register the disputed domain name. The Complainants also deny that they had a direct business relationship with the Respondent.

The Complainants do not directly address the involvement of their marketing department in 2017 and earlier. However, they do say it is significant that the Respondent has not provided evidence of email communications after 2017. According to the Complainants, the advertisements in the Respondent's catalogue after 2017 use superseded forms of the Complainants' trademark. In contrast, authorised dealers use the new trademarks and sign a corresponding permission agreement, the indication being that the Respondent has not been authorised to use the disputed domain name after 2017.

The Complainants also state that they have received complaints from customers who have made purchases through the Respondent's website and then contacted the Complainants complaining, for example, about delayed deliveries. According to the Complainants, this shows confusion and "irritation" (the Panel infers, damaging the reputation of the trademark).

The matters set out in the preceding two paragraphs in particular may well go to whether or not the Respondent has rights or legitimate interests in the disputed domain name and, potentially, whether the disputed domain name was registered and is being used in bad faith under the Policy.

Generally, a distributor would not usually be entitled to register its supplier's trademark within a domain name without the supplier's express or implied consent. Depending on other factors, such a registration could even qualify as bad faith under the Policy. See also [WIPO Overview 3.0](#) at section 2.8 and cases cited therein.

In circumstances where the Respondent has been using the disputed domain name with, it appears, the knowledge and acquiescence of the Complainants' marketing department going back apparently to at least 2012 (around or shortly after the disputed domain name was registered), the Panel does not consider the Complainants have established the Respondent registered the disputed domain name in bad faith. Bearing in mind the limitations of a proceeding on the papers, the Panel is not prepared to disregard the Respondent's claims of good faith in circumstances where he has apparently been using the disputed domain name with the knowledge of representatives of the Complainants for many years without objection and, indeed, apparent approval. The issues these dealings raise go beyond those arising under the Policy.

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

C. Rights or Legitimate Interests

As the Complaint must fail, no good purpose would be served by considering this requirement under the Policy.

6. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: July 25, 2023