

ADMINISTRATIVE PANEL DECISION

Sandvik Intellectual Property AB v. Emil Yakubov
Case No. D2023-1722

1. The Parties

The Complainant is Sandvik Intellectual Property AB, Sweden, represented by SILKA AB, Sweden.

The Respondent is Emil Yakubov, Russian Federation.

2. The Domain Names and Registrar

The disputed domain names <sandvik-coromant.com>, <sandvik-coromant.info>, <sandvik-coromant.shop>, <sandvikcoromant.shop>, and <sandvikcoromant.online> (the “Disputed Domain Names”) are registered with Registrar of Domain Names REG.RU LLC (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2023 in respect of the Disputed Domain Name <sandvik-coromant.com>. On April 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the mentioned Disputed Domain Name. On April 21, 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 (Protection of Private Person) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 25, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

The Registrar also indicated that the language of the registration agreement is Russian. On April 25, 2023, the Center sent an email communication to the Parties in both Russian and English inviting 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.

On April 25, 2023, the Complainant reiterated its request included in the Complaint for English to be the language of the administrative proceedings. On April 26, 2023, the Respondent requested that the proceedings be conducted in Russian. The Respondent also sent an informal email communication to the Center on the same date. On April 27, 2023, the Respondent sent other informal email communications indicating that it was willing to support the Complainant’s “valid request”.

On May 2, 2023, the proceedings were suspended until June 1, 2023 upon the Complainant's request. On the same date, the Respondent sent a further informal email communication to the Center indicating its ownership over all five Disputed Domain Names amongst others, and its will to transfer them to the Complainant. On May 4, 2023, the Complainant sent an email to the Respondent attaching the Standard Settlement Form and asking the Respondent to countersign this form. On May 5, 2023, the Respondent sent an email communication to the Center enclosing a signed Standard Settlement Form in which he agreed to transfer, *inter alia*, all five Disputed Domain Names to the Complainant.

On May 8, 2023, the Center transmitted by email to the Registrar and the Parties a Notice of Settlement, requesting (i) the Registrar to transfer the Disputed Domain Name <sandvik-coromant.com> to the Complainant; (ii) the Complainant to provide confirmation on the transfer prior to the expiry of the current suspension period. On May 9, 2023, the Complainant sent an email communication to the Center, highlighting that the settlement concerned multiple domain names, not only the Disputed Domain Name <sandvik-coromant.com>. In response, the Center, in its email dated May 12, 2023, noted that other domain names were not subject to the current UDRP proceeding, therefore, the Parties might wish to give instructions to the Registrar directly regarding the transfer of such domain names. Thereafter, the Complainant and the Respondent sent email communications back and forth regarding the transfer of domain names.

On June 1, 2023, the Complainant requested that the proceedings be reinstituted and filed an amended Complaint in which it included all five Disputed Domain Names. The proceedings were reinstituted on June 5, 2023.

On June 5, 2023, the Center transmitted by email to the Complainant a request for confirmation on whether the settlement in respect of the Disputed Domain Name <sandvik-coromant.com> has been implemented. On the same day, the Respondent sent an informal email communication to the Center stating "yes, go ahead". Shortly after the Respondent's email, the Complainant sent an email communication to the Center, confirming that the settlement in respect of the Disputed Domain Name <sandvik-coromant.com> has not been implemented and requesting the Center to continue the proceeding. On June 6, 2023, the Center transmitted by email to the Registrar a request for confirmation on whether the Registrar has taken any step to implement the transfer of the Disputed Domain Name <sandvik-coromant.com>. In response to the Center's request, the Registrar noted that it has provided transfer code to the Complainant and has not received any feedback from the Complainant. On June 7, 2023, the Complainant requested the Center to disregard the settlement and continue the proceeding. Accordingly, the Center, on the same day, transmitted by email to the Registrar a request for lock in respect of the Disputed Domain Name <sandvik-coromant.com>.

In another thread, on June 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the four Disputed Domain Names <sandvik-coromant.info>, <sandvik-coromant.shop>, <sandvikcoromant.shop>, and <sandvikcoromant.online>. On June 6, 2023, the Registrar transmitted by email to the Center its verification response, confirming that the Respondent was the registrant of the mentioned Disputed Domain Names and its contact details.

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 the Respondent of the Complaint, and the proceedings commenced on June 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 28, 2023. On June 8, 2023, the Respondent sent an email communication to the Center attaching a new Standard Settlement Form signed on his side which included five Disputed Domain Names. On June 13, 2023, the Center transmitted by email to the Complainant a request for confirmation on the settlement as proposed by the Respondent. In response to the Center's request, the Complainant, in its email communication dated June 14, 2023, asked the Center to proceed with

the current UDRP proceeding. On June 30, 2023, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter July 10, 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

The Complainant is a subsidiary of Sandvik AB, a Sweden-based company. Founded in 1862, Sandvik AB is a high-tech global engineering group that specializes in mining, rock excavation, rock processing, metal cutting, materials technology, and provides optimized products, solutions based on digitalization, innovation and sustainable engineering. According to its 2022 Annual Report, the Sandvik group had approximately 40,400 employees and revenues of more than SEK 112,332 million, with a portfolio of 7,000 patents and investments in R&D of approximately SEK 4,471 million.

The Complainant is the owner of numerous trademark registrations that consist of or contain the word SANDVIK COROMANT for engineering machines, tools-related products and services in Classes 07, 08, 09 and 37, among others, in various jurisdictions throughout the world, including, but not limited to the United States of America Trademark Registrations No. 3198394 (combined), No. 3198395 (combined) registered on January 16, 2007, and International Trademark Registrations No. 1160354, No. 1337878 (figurative) registered on January 14, 2013 and November 25, 2016 respectively, designating, *inter alia*, the Russian Federation, where the Respondent resides.

Additionally, the Complainant is the registrant of domain name <coromant.com> registered on September 23, 1996, under which the Complainant operates the subdomain <sandvik.coromant.com> displaying information about the SANDVIK COROMANT-branded products.

The Disputed Domain Names <sandvik-coromant.com>, <sandvik-coromant.info>, <sandvik-coromant.shop> and <sandvikcoromant.shop> were registered on August 29, 2022, while the remaining one <sandvikcoromant.online> was registered on April 24, 2023. As evidenced by the Complainant, the Disputed Domain Name <sandvik-coromant.com> used to resolve to a website displaying the trademark SANDVIK COROMANT and offering for sale a number of products under this trademark. As of the date of this Decision, four Disputed Domain Names <sandvik-coromant.com>, <sandvik-coromant.info>, <sandvikcoromant.shop>, and <sandvikcoromant.online> resolve to parked hosting websites of the Registrar, while the remaining one <sandvik-coromant.shop> resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant contends that the Disputed Domain Names are confusingly similar to its SANDVIK COROMANT trademark because:

- The Complainant is the owner of the SANDVIK COROMANT trademark across various jurisdictions.

- The Disputed Domain Names reproduce in full the SANDVIK COROMANT trademark, with only the addition of a hyphen, which does not alleviate the close similarities between the trademark and the Disputed Domain Names.

- The addition of generic Top-Level Domains ("gTLD") ".com", ".info", ".online" and ".shop" is inconsequential to determine similarities between the SANDVIK COROMANT trademark and the Disputed Domain Names.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

The Complainant argues that none of the circumstances stated in paragraph 4(c) of the Policy applies in this case:

- The Complainant has not granted any license, consent, permission to the Respondent to use the SANDVIK COROMANT trademark in association with the Disputed Domain Names.

- The Respondent does not hold any trademark rights in the Disputed Domain Names or the terms "sandvik-coromant".

- There is no evidence that the Respondent has been commonly known by the Disputed Domain Names or the terms "sandvik-coromant". Instead, majority of the Google search results of the Disputed Domain Names or such term are related to the Complainant.

- This is a typosquatting case since the Disputed Domain Names are identical to the Complainant's subdomain <sandvik.coromant.com> except of a mere hyphen symbol.

- The Disputed Domain Name <sandvik-coromant.com> used to resolve to a website displaying the Complainant's SANDVIK COROMANT trademark and offering for sale a number of products related to the Complainant and its field of activity.

Such website also included certain images and information aiming at misleading Internet users into thinking that it was operated by or affiliated with the Complainant.

These show that the Respondent registered the Disputed Domain Names to capitalize the reputation and goodwill of the Complainant's trademark.

Therefore, the Complainant argues that the Respondent's use of the Disputed Domain Name <sandvik-coromant.com> cannot be considered a *bona fide* use and it does not meet the cumulative requirements of the *Ok i Data* test.

- In light of the above and the fact that the Disputed Domain Names comprise entirely the Complainant's SANDVIK COROMANT trademark and are very similar to the Complainant's subdomain, the Disputed Domain Names carry a high risk of implied false affiliation with the Complainant and its activities.

- The Complainant's trademark SANDVIK COROMANT has been widely used internationally and online. Hence, it is unlikely that the Respondent was unaware of the trademark and the Complainant's business when it registered the Disputed Domain Names reproducing entirely the trademark.

- In view of all these circumstances, the Complainant finds highly unlikely that the Respondent intended to use the Disputed Domain Names for any legitimate or fair use.

(iii) The Disputed Domain Names were registered and are being used in bad faith.

The Respondent's registration of the Disputed Domain Names in bad faith:

- The Disputed Domain Names were registered in 2022 and 2023, whereas the Complainant's trademark SANDVIK COROMANT has been registered internationally for many years (including in Russian Federation, country where the Respondent resides). Hence, prevalence of the Complainant and its trademark on search engines and on the web makes it implausible that the Respondent was unaware of them when registering the Disputed Domain Names.
- The Disputed Domain Names incorporate the Complainant's well-known trademark and the Disputed Domain Name <sandvik-coromant.com> purportedly offered for sale SANDVIK COROMANT-branded products. These support inference that the Respondent registered the Disputed Domain Names in bad faith.

The Respondent's use of the Disputed Domain Names in bad faith:

- The Respondent is using the Complainant's trademark SANDVIK COROMANT in order to intentionally attempt to attract for commercial gain Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website or goods or services offered on it, given that:
 - The Disputed Domain Name <sandvik-coromant.com> used to resolve to a website displaying the Complainant's SANDVIK COROMANT trademark and including certain images and information aimed at misleading Internet users into thinking that the website was operated by or affiliated with the Complainant. Such website also did not contain any disclaimer on its relationship with the Complainant.
 - The Disputed Domain Names comprise in full the SANDVIK COROMANT trademark and are very similar to the Complainant's subdomain <sandvik.coromant.com>.
- The Respondent's use of a privacy service is an additional indication for a finding of bad faith registration and use.
- The Disputed Domain Name <sandvik-coromant.com> has been set up with MX records, which suggests that the Respondent intended to create and use email address. Given the close similarity between that Disputed Domain Name and the Complainant's trademark, subdomain <sandvik.coromant.com>, these MX records amount to a further inference of bad faith under the Complainant's view.
- The Disputed Domain Names differ from the Complainant's subdomain <sandvik.coromant.com> by a single symbol, which itself is evidence of the Respondent's bad faith registration, use of the Disputed Domain Names and the Respondent's knowledge of the Complainant and its trademark rights.

With the said arguments, the Complainant requests that the Disputed Domain Names be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Procedural Issues

(i) The Respondent's Identity

The Panel notes that at the time the Complaint was filed on April 19, 2023, the Respondent was identified as "Protection of Private Person". On April 21, 2023 and June 6, 2023, the Registrar revealed the underlying registrant of five Disputed Domain Names as "Emil Yakubov". The Center sent an email communication to the Complainant on April 25, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On June 1, 2023, the Complainant filed an amended Complaint, adding the underlying registrant disclosed by the Registrar.

(ii) Addition of Domain Names

The Complaint was originally submitted regarding one Disputed Domain Name <sandvik-coromant.com>. The Complainant then filed an amended Complaint, adding further four Disputed Domain Names <sandvik-coromant.info>, <sandvik-coromant.shop>, <sandvikcoromant.shop>, and <sandvikcoromant.online> which were all registered under the name of the Respondent. Such amended Complaint was submitted on June 1, 2023, prior to the Notification of Complaint dated June 8, 2023. The addition of domain names prior to the Notification of Complaint is guided under section 4.12.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)").

In the present case, the Panel finds that all Disputed Domain Names involve the Complainant's SANDVIK COROMANT trademark and have been registered by the same registrant, Emil Yakubov. Hence, the addition of four Disputed Domain Names <sandvik-coromant.info>, <sandvik-coromant.shop>, <sandvikcoromant.shop>, and <sandvikcoromant.online> to the present proceeding is accepted.

(iii) Language of the Proceeding

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement is Russian.

As the Complaint was filed in English, the Center, in its notification dated April 25, 2023, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Russian or (iii) a substantiated request for English to be the language of the proceeding by April 28, 2023.

On April 25, 2023, the Complainant submitted a request that English be the language of the proceeding. On April 26, 2023, the Respondent submitted an email request in Russian, requesting that Russian should be the language of the proceeding.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Similarly to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, *e.g.*, *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

- (i) the fact that the Complainant, a Sweden-based entity, does not appear to be able to communicate in Russian and therefore, if the Complainant was required to have the documents translated into Russian, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;
- (ii) the Disputed Domain Names itself contain the English TLDs “info”, “online” and “shop”; the Respondent, during the proceeding, sent email communications and signed the Standard Settlement Forms in English; these suggest that the Respondent has knowledge of the English language and would be able to communicate in English.

Therefore, for the purpose of easy comprehension of the Complainant of the Panel’s decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel’s obligation under paragraph 10(c) of the Rules, which provides that “the Panel shall ensure that the administrative proceeding takes place with due expedition”, the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

B. Consent to Transfer

In accordance with paragraph 4(a) of the Policy, in order to decide on the remedy sought by the Complainant, each of the following three elements will be examined:

- (i) the domain names registered by the respondent are 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 with respect to the domain names; and
- (iii) the domain names have been registered and are being used in bad faith.

However, considering section 4.10 of [WIPO Overview 3.0](#), the Panel notes that consent to transfer by the respondent can provide a basis for an order for transfer without a need for substantive consideration of the UDRP grounds.

In the case at hand, the Panel finds that, during the proceeding, the Respondent constantly showed his will to transfer five Disputed Domain Names to the Complainant. Particularly:

- In its email dated May 2, 2023, the Respondent admitted its ownership over the Disputed Domain Names and stated that “This is my freewill that I agree to transfer the following domains to you [...] Waiting for your reply. Then I will proceed with my registrar on how I can transfer those domain names and if it is even possible today to do that.”.
- On May 5, 2023, the Respondent sent a signed Standard Settlement Form in which he agreed to transfer, *inter alia*, all five Disputed Domain Names to the Complainant.
- From May 5, 2023 to May 29, 2023, the Respondent sent some email communications to the Complainant, trying to transfer the Disputed Domain Names to the Complainant.
- On June 8, 2023, the Respondent sent to the Center a new Standard Settlement Form signed on his side which included five Disputed Domain Names.

In addition, the Complainant requested the Center to re-institute the proceedings and disregarded the settlement just because of the technical problem, *i.e.* “the registrar has difficulties implementing the settlement agreement” as noted in its email dated June 14, 2023.

In light of the foregoing and in line with section 4.10 of the [WIPO Overview 3.0](#) stated above, the Panel immediately orders the transfer of the Disputed Domain Names to avoid unnecessary delay of the case.

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 <sandvik-coromant.com>, <sandvik-coromant.info>, <sandvik-coromant.shop>, <sandvikcoromant.shop> and <sandvikcoromant.online> be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: July 24, 2023