ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Prepreg - Advanced Composite Materials, Joint Stock-Company v. A. K. (KINZYABU06708)
Case No. D2023-4326

1. The Parties

The Complainant is Prepreg - Advanced Composite Materials, Joint Stock-Company, Russian Federation, represented by Vash Patent IP Agency, Russian Federation.

The Respondent is A. K. (KINZYABU06708), Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <fibarm.org> (the "Domain Name") is registered with Ascio Technologies Inc. Danmark – Filial af Ascio technologies, Inc. USA (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 18, 2023. On October 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 19, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (UNKNOWN) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 20, 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 amended Complaint on October 25, 2023.

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 October 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 20, 2023.

The Center appointed Olga Zalomiy as the sole panelist in this matter on November 24, 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 joint stock company located in Moscow, Russian Federation in the construction industry. The Complainant owns several trademark registrations for the FIBARM mark, such as:

- Russian Federation registration No. 443969 for the FIBARM ФИБАРМ mark, registered on September 7, 2011;
- Russian Federation registration No. 523834 for the FIBARM mark, registered on October 3, 2014; and-
International Registration No. 1181513 for FIBARM ФИБАРМ mark, registered on August 20, 2013.

The Complainant also owns domain names that include its trademark, such as <fibarm.com> and <fibarm.ru>.

The Respondent is a Russian national, who is director and the sole member of a Russian limited liability company DIPCHEL.

On December 7, 2021, the Arbitrazh (commercial) Court of the City of Moscow, Russian Federation, decided a dispute between the Complainant and the Respondent's company, DIPCHEL ("ДИПЧЕЛ"), regarding the use of the Complainant's FIBARM mark in the domain name <fibarm24.ru>. This domain was used for a website marketing and selling products under the Complainant's FIBARM trademark. The court ruled in favor of the Complainant, preventing DIPCHEL from using the term "fibarm" in the domain name <fibram24.ru>. Six days later, the Respondent registered the Domain Name.

The Domain Name directs to a website in the Russian language offering for sale external reinforcement systems under the FIBARM mark. The website under the Domain Name contains contact information which includes the Complainant's mailing address, but a different contact email and phone number.

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 Domain Name.

Notably, the Complainant contends that the Domain Name is confusingly similar to the Complainant's marks because the "FibArm" element of the Complainant's trademarks is identical to the second-level domain of the Domain Name. The Complainant argues that the Respondent has no rights or legitimate interests in the Domain name because the Complainant did not consent to the Respondent's use of the Complainant's trademarks in the Domain Name; the Domain Name was registered several years after the Complainant's registration of the FIBARM trademarks; and the Respondent does not use the Domain Name for a *bona fide* offering of goods and services because it is using the Domain Name for unauthorized commercial activities trading on the fame of the Complainant's marks. The Respondent is using the Domain Name, which is identical to the Complainant's marks, to direct to a website selling goods under the Complainant's trademark. The Domain Name is also similar to the Complainant's domain names. The Respondent's use of the Domain Name is considered in bad faith, given that the Respondent, as the owner of DIPCHEL LLC, was previously restricted from incorporating the term "fibarm" in its domain name. The Respondent is using the Domain Name with the intent of causing a likelihood of confusion with the Complainant's trademarks.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the Domain Name:

(i) the 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 Domain Name; and
(iii) the Domain Name has been registered and 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), section 1.7.

Based on the available record, the Panel finds 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 Domain Name consists of the Complainant's FIBARM mark and the generic Top-Level Domain ("gTLD") ".org".

The Panel finds the entirety of the mark is reproduced within the Domain Name. Accordingly, the Domain Name is identical to the FIBARM mark for the purposes of the Policy. WIPO Overview 3.0, section 1.7. The applicable gTLD should be disregarded under the confusing similarity test as a standard registration requirement. WIPO Overview 3.0, section 1.11.1.

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 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 Domain Name such as those enumerated in the Policy or otherwise.

In this case, there is no evidence to support that the Respondent has been commonly known by the Domain Name. The Domain Name is registered under the name of A. K. It is undisputed that the Respondent lacks any trademark registrations for the Domain Name. The Complainant asserts, and the Respondent does not contest, that the Complainant has not granted the Respondent any license or permission to use the FIBARM trademark in domain names or for any other purpose.

There is no evidence to suggest that the Respondent is using the Domain Name for a legitimate offering of goods or services or making a noncommercial or fair use of it, because the Respondent is using the Domain Name to direct to a website that offers for sale FIBARM products.

Previous UDRP panels have recognized that resellers or distributors using domain names containing the complainant's trademark to undertake sales of the complainant's goods may be making a *bona fide* offering of goods and thus have a right or legitimate interest in such domain names in some situations. Outlined in the Oki Data case[1], the following cumulative requirements must be satisfied for the respondent to make a *bona fide* offering of goods and services:

(i) the respondent must actually be offering the goods or services at issue;
(ii) the respondent must use the site to sell only the trademarked goods or services;
(iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
(iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The Panel finds the Respondent has failed to meet the Oki Data test outlined above. The website at the Domain Name displays the Complainant's trademark and offer for sale goods under the FIBARM mark. The website at the Domain Name display's the Complainant's mailing address as the contact address for the website owner, which creates an impression of an affiliation between the Complainant and the Respondent.

Furthermore, the Panel considers that the composition of the Domain Name carries a high risk of implied affiliation with the Complainant (see WIPO Overview 3.0, section 2.5.1).

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.

In the present case, the Panel notes that the Respondent registered the Domain Name in bad faith because the Respondent registered the Domain Name with the full knowledge of the Complainant and its trademarks based on the court's decision against his company. After the Respondent's company was barred from using the Complainant's FIBARM trademark, the Respondent registered the Domain Name incorporating the Complainant's mark.

The Panel also finds that the Respondent is using the Domain Name in bad faith because the Respondent is using the 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 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. See Policy, paragraph 4(b)(iv). Specifically, the Respondent is using the Domain Name to direct to the website offering for sale FIBARM products. The website provides no indication that it is not affiliated with the Complainant. Instead, the website lists the Complainant's mailing address as the contact address for the website owner.

[1] *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

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 Domain Name <fibarm.org> be transferred to the Complainant.

/Olga Zalomiy/
Olga Zalomiy
Sole Panelist
Date: December 5, 2023