ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Kingfisher International Products Limited v. XieLi
Case No. D2024-4945

1. The Parties

The Complainant is Kingfisher International Products Limited, United Kingdom ("UK"), represented by Bird & Bird LLP, UK.

The Respondent is XieLi, China.

2. The Domain Name and Registrar

The disputed domain name <erbauertools.com> is registered with Realtime Register B.V. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 29, 2024. On November 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 2, 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 originally-named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 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 amended Complaint on December 4, 2024.

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 December 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 27, 2024.

The Center appointed Anita Gerewal as the sole panelist in this matter on January 6, 2025. 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 an international home improvement company and is part of the Kingfisher group. It offers products and services to consumers and trade professionals who shop in stores and via e-commerce channels. The Complainant's website is "www.kingfisher.com" (the "Kingfisher Website").

The Complainant operates under retail banners including B&Q, Castorama, Screwfix, TradePoint and Erbauer. Under its exclusive own brand Erbauer, the Complainant produces a variety of tools, power tools and tool accessories. Erbauer products are sold by the Complainant exclusively through its home improvement retailer brands, Screwfix and B&Q, from both their physical retail stores and via their websites. The Complainant has built up enormous goodwill and reputation in the Kingfisher and Erbauer brands with its customers over many years.

The Complainant is the owner of numerous ERBAUER trademark registrations, including:

- European Union Trade Mark number 002642551 for the word mark ERBAUER registered on September 23, 2003 in classes 7, 8 and 37;

- UK Trade Mark ("UKTM") number 00913506704 for the word mark ERBAUER registered on March 26, 2015 in classes 6, 7 and 12;

- UKTM number 00002474395 for the figure mark 

registered on June 6, 2008 in classes 7 and 8;

- UKTM number 00801443087 for the word mark ERBAUER registered on June 5, 2019 in classes 1, 4, 6, 7, 8, 9, 11, 12, 18, 20 and 25;

- UKTM number 00003337455 for the word mark ERBAUER registered on November 30, 2018 in classes 1, 4, 6, 7, 8, 9, 11, 12, 18, 20 and 25;

- UKTM number 00902642551 for the word mark ERBAUER registered on September 23, 2003 in classes 7, 8 and 37;

The Respondent is the registrant of the disputed domain name <erbauertools.com>. The disputed domain name was registered on June 14, 2024.

The disputed domain name resolves to a website that is designed to look like the official Erbauer website, offering Erbauer products for sale and depicting the Complainant's trademarks.

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 disputed domain name.

Notably, the Complainant contends that the disputed domain name comprises of the word "Erbauer" and the term "tools". The word 'tools' is an ordinary word, which is entirely descriptive and non-distinctive of the products sold under the Erbauer brand. The disputed domain name is therefore identical or highly similar to

the Complainant's trademark. All of the Complainant's trademarks were registered before the disputed domain name, which was registered on June 14, 2024.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant and has not been authorized by the Complainant to use the Complainant's trademark. The fact that the disputed domain name incorporates the Complainant's trademark in its entirety and without any other distinctive element, and that the disputed domain name resolves to a website which displays the Complainant's trademark in its entirety, is in itself evidence that Respondent does not have rights and legitimate interests in the disputed domain name.

The Complainant submits that the disputed domain name was registered and has been used in bad faith. The Complainant contends that the disputed domain name resolves to a website that is presented in such a way to appear that it is the official Erbauer website, by displaying Complainant's trademark, as well as pictures of the Complainant's products copied from the Complainant's site. The Respondent's website does not contain a disclaimer notifying the public that the website is not affiliated with the Complainant. The Complainant contends that this website has been designed as a means to deceive Internet users into believing that the disputed domain name and its website are associated with the Complainant.

Further, the Complainant contends that it has reasons to believe that the Respondent is engaged in fraudulent activities. The Complainant contends that the Respondent may not be selling Erbauer products at all and that the Respondent is operating a scam website based on the following reasons:

(i) The terms and conditions webpage on the website has a reference to 'DessHead Ltd' and the Complainant cannot find any indication that DessHead Ltd is a real company. Further, online searches for it suggests that 'DessHead Ltd' owns and operates other scam websites;

(ii) The website purports to advertise Erbauer products for sale at prices which are much lower than those for which Erbauer products are sold by the Complainant; and

(iii) The physical address given on the 'Contact' webpage of the website is plainly a residential address.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, the Complainant must establish each of the following elements:

(i) The disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights;
(ii) The Respondent has no rights or legitimate interest in respect of the disputed 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.

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 entirety of the mark is reproduced within the disputed domain name and the Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.7.

Although the addition of other descriptive term, here "tools", 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 name 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.

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 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 disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes the composition of the disputed domain name, which combines the Complainant's trademark with the term "tools", suggesting an affiliation with the Complainant. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. WIPO Overview 3.0, section 2.5.1

Panels have held that the use of a domain name for illegal activity, here claimed as applicable to this case: phishing, impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. WIPO Overview 3.0, section 2.13.1.

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 disputed domain name many years after the Complainant first registered its ERBAUER mark. The disputed domain name contains the Complainant's trademark in its entirety, and merely adds the descriptive term "tools", which refers to the products sold by the Complainant. This would be an indication that the Respondent registered the disputed domain name with knowledge of the Complainant's trademark, with an intention to attract Internet users by creating a likelihood of confusion with the Complainant's mark. The Panel also notes that the disputed

domain name resolves to a website that is presented in such a way to appear that it is the official Erbauer website, by displaying Complainant's trademark, as well as pictures of the Complainant's products copied from the Complainant's site, and potentially operating as a scam website. This sort of intentional copying serves as strong evidence that the Respondent was fully aware of the Complainant's rights at all material times and further that the Respondent has adopted and used the disputed domain name to target the Complainant's business. The Panel finds that the disputed domain name constitutes an abusive registration which was registered and is being used in bad faith in order to take advantage of the significance of the Complainant's trademark.

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.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: phishing, impersonation/passing off, or other types of fraud, constitutes bad faith. WIPO Overview 3.0, section 3.4. *Genuine Parts Company, National Automotive Parts Association LLC v. Zhu Xi,* WIPO Case No. D2024-4191.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 disputed domain name <erbauertools.com> be transferred to the Complainant.

/Anita Gerewal/
Anita Gerewal
Sole Panelist
Date: January 20, 2025