

ADMINISTRATIVE PANEL DECISION

Otis Elevator Company v. Grado Cero Publicidad SA de CV GCP071217A66
Case No. D2024-5181

1. The Parties

The Complainant is Otis Elevator Company, United States of America (United States), represented by Balder IP Law, SL, Spain.

The Respondent is Grado Cero Publicidad SA de CV GCP071217A66, Mexico.

2. The Domain Name and Registrar

The disputed domain name <othyssone.com> is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 17, 2024. On December 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 17, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 18, 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 23, 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 January 2, 2025. In accordance with the Rules, paragraph 5, the due date for Response was January 22, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 23, 2025.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on January 29, 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 has been manufacturing, repairing and maintaining elevators and escalators since its founding in the United States in 1853. The Complainant began installing elevators in Mexico in 1884 with an installation in the Chapultepec Palace.

By 1903, the Complainant had established manufacturing plant in the United States, Canada, the United Kingdom, Germany, and France, and offices or agencies in Africa, Australia, Argentina, Chile, and Mexico; the last through Compañía Mexicana de Electricidad SA in Mexico City. The Complainant incorporated a subsidiary for its operations in Mexico, Elevadores Otis SA De CV, in 1949 and has been conducting its business in Mexico through that entity since then.

According to the Complaint, in 2023 the Complainant (or its group) had USD 14.2 billion in sales, has over 71,000 employees worldwide, maintains more than 2.3 million “customer units” and had more than 2.3 billion travelers in its lifts and escalators. In 2009, the Complainant was a global market leader with 25 per cent market share; the Complainant, Schindler Holding Ltd, ThyssenKrupp Elevator AG, and KONE Corporation accounting for some 66 per cent of the global elevator and escalator industry. The four companies were reported still to be the dominant brands in 2021.

The Complainant’s subsidiary, Elevadores Otis is one of the five dominant players in Mexico in 2015.

The Complainant’s products have been installed in many of the world’s iconic buildings including the Burj Khalifa, the Petronas Towers, the Eiffel Tower, and the Empire State Building.

The Complaint includes a selection of advertisements placed by the Complainant using its OTIS trademark and, in Mexico, of press mentions or discussion. The Complainant has also been promoting its products and services from the website at “www.otis.com”, the domain name being registered in 1994.

The Complaint includes evidence that the Complainant holds numerous registered trademarks. These include:

- (1) Mexican Registered Trademark No 7546, OTIS which was registered on September 24, 1907 in respect of electrical apparatus, machines and parts thereof in International Class 7;
- (2) Mexican Registered Trademark No 1044263, OTISLINE, which was registered on May 30, 2008 in respect of maintenance and repair of elevators and escalators in International Class 37; and
- (3) Mexican Registered Trademark No 1093455, OTIS ELITE, which was registered on April 7, 2009 in respect of maintenance and repair of electrical equipment in International Class 37.

There is also evidence of registrations of a number of figurative trademarks and numerous registrations of OTIS ONE around the world including International Registration No 1423194 and European Union Registered Trademark No 017591637, both of which were registered on April 24, 2018 for relevant goods and services in International Classes 7, 9, 37, and 42. The registration in Mexico, No 2597778, was registered on September 11, 2023 in respect of installation, maintenance and repair services for a wide range of products including elevators and escalators, all in International Class 37.

The disputed domain name was registered on September 28, 2012.

The disputed domain name resolves to a website promoting the services of OThyssONE Elevadores based in Monterey Mexico which appears to offer sale and services in respect of elevators, electric escalators and automatic doors.

It also appears that the Respondent is an advertising and design studio.

The Complainant has sent two cease and desist letters to OThyssONE Elevadores in December 2022 and May 2023. Both went unanswered.

5. Discussion and Findings

No response has been filed.

As a preliminary matter and noting evidence that the Respondent's address confirmed by the Registrar appears to be a private residential home, the Complainant contends that the Respondent registered the disputed domain name as an agent for OThyssONE Elevadores which is the company using the disputed domain name.

This may or may not be correct, neither the Respondent nor OThyssONE Elevadores has chosen to respond so the nature of their relationship (if any) or the basis on which the disputed domain name resolves to a website promoting OThyssONE Elevadores is unclear.

However, the Center sent the Complaint and Written Notice to both (a) the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules and (b) the contact email address posted on the website to which the disputed domain name resolves.

Bearing in mind this additional step taken by the Center and the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent and the person actually using the disputed domain name have both been given a fair opportunity to present its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant 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 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 and is being used in bad faith.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

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 proven ownership of numerous registered trademarks for OTIS and also OTIS ONE. The Panel accepts that the Complainant's trademark, OTIS, (at least) is very well-known around the world including in Mexico.

The comparison of the disputed domain name to the Complainant's trademark simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., [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.

In a YouTube video posted on February 13, 2023 (that is shortly after the disputed domain name was registered) to promote its products and services,¹ OThyssONE Elevadores pronounced its name "Otis One" and in fact named its channel "Otis One".

Disregarding the ".com" gTLD, therefore, the disputed domain name sounds the same as the Complainant's trademark OTIS ONE is pronounced.

Further, the Complainant points out that visually the disputed domain name can be seen as a composite of its trademark and the trademark of one of the Complainant's competitors, "ThyssenKrupps".

Simply adding the common word "one" to the Complainant's primary trademark in such circumstances is not sufficient to preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. In addition, if there were any doubt, the contents of the website to which the disputed domain name resolves and the YouTube video confirm the potential for confusion. [WIPO Overview 3.0](#), section 1.15.

Accordingly, the Panel finds that the disputed domain name is also confusingly similar to the Complainant's OTIS trademark.

The requirement under the first limb of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or

¹ "<https://www.youtube.com/watch?v=3F3sZrlzuEA>"

(iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

While 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 often impossible 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. 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.

The Respondent registered the disputed domain name 159 years after the Complainant began using the OTIS trademark and 128 years after the Complainant first began using its trademark in Mexico. The Respondent also registered the disputed domain name 105 years after the Complainant had registered its OTIS trademark in Mexico in relation to the relevant goods.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

From the available record, neither the Respondent nor OThyssONE Elevadores appear to hold any registered trademarks for the disputed domain name.

The disputed domain name is not derived from the Respondent's name. While it is derived from OThyssONE Elevadores' corporate name, that name was adopted long after the Complainant had registered and was using its trademark OTIS in Mexico. As the name also appears to be a “mash-up” of the Complainant's well-known name and trademark and the name of one of the Complainant's major competitors, it cannot seriously be contended that the name has been adopted in good faith.

While “Otis” may be a personal name, there is no evidence of any “Otis” being involved with either the Respondent or OThyssONE Elevadores. Rather, it seems much more likely that the disputed domain name and the associated company name were adopted to mislead the public into thinking they were dealing with the Complainant or someone associated with the Complainant or the Complainant and ThyssenKrupps.

Even if there were someone named “Otis” involved, the people backing the Respondent and OThyssONE Elevadores could not have been unaware of the Complainant's reputation in its trademark and the likelihood that people would be misled into dealing with OThyssONE Elevadores on the mistaken assumption that it was either the Complainant or associated with the Complainant in some way.

In these circumstances, the use of the disputed domain name to offer for sale goods and services that compete with the Complainant's products would not usually qualify as a good faith offering of goods and services nor as a legitimate noncommercial or fair use for the purposes of paragraph 4(c)(iii) of the Policy.

The Complainant also points out that the website claims that OThyssONE Elevadores has contracts with suppliers including the Complainant but the Complainant states that is not the case. If this claim is false, that would be a further basis for misleading customers into dealing with OThyssONE Elevadores rather than the Complainant.

The Respondent, or rather OThyssONE Elevadores, appears to have been using the disputed domain name since 2012 or 2013. Generally speaking, “delay” does not preclude the bringing of a Complaint or confer rights or legitimate interests. [WIPO Overview 3.0](#), section 4.17.

There may be cases where a respondent can show detrimental reliance on the delay so as to preclude assertion of the Complainant's rights. Typically, more than mere delay is required. Moreover, no such claim has been advanced by the Respondent, or OThyssONE Elevadores, in this case. Nor has the Respondent, or OThyssONE Elevadores, claimed some special defence under Mexican law which would confer some form of immunity or entitlement on them.

In these circumstances, the Panel finds that the Complainant has established a prima facie case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. Neither the Respondent nor OThyssONE Elevadores, however, has sought to rebut that prima facie case or advance any claimed entitlement. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant 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., *Group One Holdings Pte Ltd v. Steven Hafto*, WIPO Case No. [D2017-0183](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The Panel accepts that the Complainant's trademark, OTIS, (at least) is very well-known around the world including in Mexico. It seems very unlikely that the Respondent or OThyssONE Elevadores were not aware of the Complainant's trademark when adopting the disputed domain name. This is reinforced by the YouTube video.

As there does not appear to be any reason for the Respondent's, or OThyssONE Elevadores', adoption of the disputed domain name other than its resemblance to the Complainant's trademark, or the names and trademarks of both the Complainant and ThyssenKrupps, the Panel finds therefore that the disputed domain name was registered in bad faith – to be used to attract customers and potential customers to OThyssONE Elevadores' website in the mistaken belief that it was, or was associated with, the Complainant.

Further, the use of the disputed domain name in connection with a website dealing in goods and services which are identical to those offered by the Complainant under the Complainant's trademark constitutes use in bad faith where there is in fact no connection with or permission from the Complainant.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 <othyssone.com> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: February 12, 2025