

Decision for dispute CAC-UDRP-104512

Case number	CAC-UDRP-104512
Time of filing	2022-04-22 08:55:45
Domain names	ksbah.com, ksb-ah.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	KSB SE & Co. KGaA
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Complainant representative

Organization	Convey srl
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Respondent

Organization	Anhui Kai Shi Pump Co., Ltd.
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the Disputed Domain Names.

IDENTIFICATION OF RIGHTS

The Complainant is KSB SE & Co. KGaA is a leading supplier of pumps, valves and related systems for building services, industry and water transport, waste-water treatment and power plant processes. Founded in Frankenthal, Germany, in 1871, the sign KSB is the acronym of the founders' surnames: Johannes Klein, Friedrich Schanzlin and Jakob Becker. Today, the company has a presence on all continents with its own sales and marketing organizations, manufacturing facilities and service operations. With sales revenue running over 2 billion euros in 2019, the KSB Group is one of the leading suppliers of pumps, valves and related service worldwide. Nowadays KSB employs more than 15,000 people with 190 service centers and around 3,500 service specialists. Its main manufacturing facilities are located in Germany and France, Europe is the main market. The second-largest market is the Region Asia / Pacific, followed by the Region Americas and the Region Middle East / Africa. Outside Europe, KSB's biggest production sites are in Brazil, China, India and the USA.

The Complainant has become one of the most important supplier of technically advanced pumps, valves and services in China where, since 1994, he has set up seven company branches, employed about 900 professional staff and established more than thirty service centres.

The Complainant is the owner of the trademark KSB, with several international and national trademark registrations worldwide, including the following:

- INT. TM n° 452821, Cl. 35, 37, 42 designating also China;
- INT. TM n° 662585, Cl. 06, 07, 09, 11, 37, 41, 42 designating also China;
- INT. TM n° 809284, Cl. 06, 07, 09, 11, 37, 41, 42;
- INT. TM n° 407021, Cl. 06, 07, 11, 17 designating also China;
- INT. TM n° 1466266, Cl. 37, 38, 41, 42 designating also China;
- INT. TM n° 1463039, Cl. 37, 38, 41, 42 designating also China; and
- INT. TM n° 679050, Cl. 06, 07, 09, 11, 37, 41, 42 designating also China.

In order to protect and promote its trademark KSB on the Internet, Complainant registered various domain names consisting of or comprising the word “KSB” under several different TLDs, including, inter alia, <ksb.com>, <ksb.cn> and <ksb.com.cn>.

The official website <https://www.ksb.com/>, generates a significant number of visits by Internet users. The Complainant is also active on the main Social Media, like Facebook, Twitter, Youtube and LinkedIn.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant brings to the Panel’s attention the evidences, provided also in the complaint, that the Respondent is a competitor of the Complainant, i.e. Anhui Kai Shi Pump Co., Ltd. The Respondent registered the Disputed Domain Names, including the Complainant’s trademark, in order to profit from the reputation of the trademark KSB and, in light of the use of the acronym AH for the province of Anhui, prima facie to pass off as a Complainant’s branch in that province of China.

As soon as the Complainant became aware of the Respondent’s registrations, confusingly similar to its registered trademark KSB, it instructed its representative to address to the owner of the Disputed Domain Names a cease and desist letter in order to notify him of the infringement of the Complainant’s trademark rights, requesting the immediate cease of any use of the Disputed Domain Names (the Disputed Domain Names have not been redirected to active websites), and their transfer to the Complainant. A cease and desist letter was then sent on February 02, 2022 via the form online corresponding to the links indicated as emails in the whois of the Disputed Domain Names.

In light of the absence of a reply and the failure to comply with the request for transfer the Disputed Domain Names, the Complainant instructed its representative to file the present Complaint in order to obtain the transfer of the Disputed Domain Names under its ownership and control.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Disputed Domain Names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

PROCEDURAL FACTS

The Complainant requests that the language of this administrative proceeding be English pursuant to UDRP Rule 11(a): Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative 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. Complainant makes this request in light of the potential Chinese language Registration Agreement of the Disputed Domain Names involved at this Complaint.

Paragraph 10 of the UDRP Rules vests a Panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios were summarized into WIPO Jurisprudential Overview 3.0, 4.5.1.

In this particular instance, the Complainant tried to request change of languages of proceedings in light of Chinese language Registration Agreement by showing that 1) The Disputed Domain Names are composed by the Complainant's trademark KSB and the English acronym of the province of the Respondent's registered address "ah"; 2) The Respondent is prima facie the holder of the domain name <kspump.com> pointed to <http://kspump.com/> which website offered for sale the Complainant's products and was in English; 3) Moreover, a translation of the Complaint to Chinese would entail significant additional costs for the Complainant and delay in the proceedings. Relevant decisions have been cited to support the Complainant's positions.

In light of the scenarios and equity, the Panel is of the view that conducting the proceeding in English is unlikely to heavily burden the Respondent, and it is likely that the Respondent can understand the English language based on a preponderance of evidence test. Without further objection from the Respondent on the issue, the Panel will proceed to issue the decision in English.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or confusingly similar

The Complainant contends that the Disputed Domain Names <www.ksbah.com> and <www.ksb-ah.com> are confusingly similar to the Complaint's trademark "KSB". The Complainant, KSB SE & Co. KGaA, is a leading supplier of pumps, valves and related systems for building services, industry and water transport, waste-water treatment and power plant processes. Founded in Frankenthal, Germany, in 1871, the sign KSB is the acronym of the founders' surnames: Johannes Klein, Friedrich Schanzlin and Jakob Becker. The Complainant is the owner of the trademark KSB, with several international and national trademark registrations worldwide. In order to protect and promote its trademark KSB on the Internet, Complainant registered various domain names consisting of or comprising the word "KSB" under several different TLDs, including, inter alia, ksb.com, ksb.cn and ksb.com.cn.

The domain names <ksbah.com> and <ksb-ah.com>, which were registered on 19 March 2018 according to the WHOIS, incorporate the Complainant's trademark KSB in combination with suffix "ah" or "-ah". The added suffixes are closely related to the Respondent's registered address of principle business – Anhui province in China (ah is the English acronym of Anhui). As the Complainant demonstrated, it is well established that the addition of a non-distinctive element such as geographical indicator, is insufficient in itself to negate confusing similarity between a trademark and a domain name (See Red Bull GmbH v. PREGIO Co., Ltd., WIPO Case No. D2006-0909). In this case, the addition of the letters "ah" to the trademark KSB in the Disputed Domain Names are even more problematic because KSB consumers would have been misled to believe that the Disputed Domain Names are used with the Complainant's authorization in China.

The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Names.

The Panel therefore concludes that the Disputed Domain Names are confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in the present case has not licensed or authorized the Respondent to register or use the trademark or the Disputed Domain Names. There is no evidence that the Respondent is known by the Disputed Domain Names or owns any corresponding registered trademarks including the terms “KSB” and/or “KSBAH”.

In this case, because the Respondent has used a proxy service in registering the Disputed Domain Names, additional information of the Respondent needs to be discovered. The uncovered identity of the Respondent, an entity named “Anhui Kai Shi Pump Co., Ltd.” operates pump businesses similar to that of the Complainant. However, the Respondent’s business has no connection with the Complainant’s brand. The Complainant contends that no evidence suggests that the Respondent has been known in any way by the Disputed Domain Names. The Complainant did not grant any license or authorization to the Respondent to register or use the Disputed Domain Names, nor the use of the Complainant’s trademark on pages of the disputed websites.

In addition, The Respondent does not appear to have used the Disputed Domain Names in connection with active websites at any time since the registrations. Currently, the Disputed Domain Names do not resolve to active websites. Therefore, the Respondent has not used the Disputed Domain Names or names corresponding to the Disputed Domain Names in connection with a bona fide offering of goods or services.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the Disputed Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

Registration of the disputed domain name in bad faith – As far as registration goes, UDRP Panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Complainant’s trademark registrations predate the registration of the Disputed Domain Names. The fact that the Complainant’s trademark is well-known in the pump and valve businesses and that the Respondent has failed to present any credible evidence-backed rationale for registering the Disputed Domain Names implied that the Respondent may have had knowledge of the Complainant’s trademark at the time of registration. The Complainant has been using the trademark KSB in China since 1994 when KSB Shanghai Pump Co., Ltd. was established as a joint venture between Shanghai Electric Group and KSB Group. In addition, the added term “ah” seems to indicate that the Respondent is aware of the Complainant’s presence in China. Given that the Respondent’s address implies that the Respondent resides in China, it is reasonable to conclude that the Respondent registered the Disputed Domain Names with the knowledge of the Complainant’s trademark and/or brand influence in China.

Use of the Disputed Domain Names in Bad Faith – Currently, the Disputed Domain Names resolve to inactive websites. According to the doctrine of passive holding the non-use of a domain name would not prevent a finding of bad faith (see e.g. paragraph 3.3 of the WIPO Jurisprudential Overview 3.0; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003). The Respondent is not making any active use of the Disputed Domain Names. At the same time, the Respondent is one competitor of the Complainant’s and could have registered the Disputed Domain Names to divert internet users to its own websites. According to paragraph 4(b)(iv) of the Policy, “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”, if found by the Panel, shall be considered evidence of registration and use of the domain name in bad faith. The fact that the Respondent is a competitor of the Complainant and that the Disputed Domain

Names have not been in active use indicates that the likely confusion caused by such offer could lead to illegitimate commercial gain to the Respondent.

Moreover, a cease and desist letter was sent to the Respondent on 2 February 2022 and the Respondent never responded. Prior panels have also held that a failure to respond to a cease and desist letter can be evidence of bad faith (see e.g., HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062).

Therefore, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the Complainant has proved that Disputed Domain Names were registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **KSBAH.COM**: Transferred
2. **KSB-AH.COM**: Transferred

PANELLISTS

Name	Carrie Shang
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DATE OF PANEL DECISION 2022-05-22

Publish the Decision
