

ADMINISTRATIVE PANEL DECISION

SIEMENS AG v. Kyoung S Park

Case No. D2022-3749

1. The Parties

The Complainant is SIEMENS AG, Germany, represented by Müller Fottner Steinecke Part mbB, Germany.

The Respondent is Kyoung S Park, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <simatic.net> is registered with TurnCommerce, Inc. DBA NameBright.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 7, 2022. On October 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 7, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 7, 2022.

The Center appointed Warwick Smith as the sole panelist in this matter on November 16, 2022. 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 German corporation, well-known internationally in a number of industrial fields, including the field of automation technology.

In or about 1958, the Complainant coined the expression “Simatic” as a trade mark for its automation technology products. The mark was formed by combining the “SI” from “Siemens”, and the “matic” from the word “automatic”. The Complainant says that it has been using the SIMATIC mark for over 50 years in association with its automation technology products (including controller apparatus and related software for automation).¹

With the Complaint, the Complainant produced a copy of the “About us” section of its Korean language website at <new.siemens.com/kr/ko>, accompanied by an English translation. The “About us” section notes that the Complainant’s commercial activities in the Republic of Korea began in the 1950s, when the Complainant participated in reconstruction and infrastructure projects after the Korean War. The Complainant’s website also refers to the Complainant’s “Worldwide presence”, and notes that “For more than 170 years the name Siemens has been synonymous with internationality and worldwide presence.”

The Complainant relies on the following registered trade marks:

- SIMATIC, registered in the Republic of Korea on April 18, 1994, for various goods in international class 9 (Korean registered mark no. 4002887640000);
- SIMATIC, registered in the Republic of Korea on June 20, 1994, for various services in international classes 41 and 42 (Korean registered mark no. 4100241550000);
- International registration no. 473868 of the mark SIMATIC, registered on December 27, 1982, for various goods and services in international classes 7 and 9;
- International registration no. 599684 of the mark SIMATIC, registered on April 1, 1993 by the Complainant’s predecessor, Siemens Aktiengesellschaft, for various goods and services in international classes 9, 16, 41, and 42.

The disputed domain name was registered on December 23, 2015. At the time the Complaint was filed, it resolved to a parking website (the Respondent’s website), where the disputed domain name was offered for sale for USD 9,600.00. The Respondent’s website contained the German language statement:

“Sie können die Domain
simatic.net für 9600 USD vom Inhaber kaufen.”

The translation of that expression provided in the Complaint is:

“You may buy this domain for USD 9600 from the owner”.

The copy of the Respondent’s website produced by the Complainant was said to be a copy of a pay-per-click landing page, with links to websites of third parties that are also active in the field of automation technology. However, copies of the links to the third party websites to which the Respondent’s website resolved were not produced with the Complaint.

¹ A screen shot of the Complainant’s (English language) website at <new.siemens.com> that was produced with the Complaint, contains the statements: “60 years ago SIMATIC was born as the cornerstone of our automation history. . .”, and “In 1958, the history of SIMATIC begins – and with it, an industrial revolution. . .”.

In accordance with normal practice, the Panel visited the Respondent's website on November 21, 2022. The landing page contained a statement that the webpage was generated by the Respondent using Sedo Domain Parking, and advised that the disputed domain name was for sale at an asking price of USD 9,600. Click-on links on the Respondent's website included links to third party websites, one of which offered "Obsolete or New Automation Parts" from "Reputable Vendors". Another link appeared to be to the site of a Siemens distributor of electric motors and converters. The text above the link referred to ". . . A single source of supply. Trusted brands."

The Complaint refers to a number of previous cases decided by the Center in which the Respondent has been ordered to transfer disputed domain names to the complainants. The Complainant provided nine examples of such cases, spanning the period from 2000 (e.g., WIPO Case No. [D2020-3543](#), relating to the domain names <immomaxx.com> and <immomaxx.net>).

The Complainant referred to the following passage from the panel decision in the "<immomaxx.com>" case:

"Complainant has provided evidence that Respondent has registered several thousand domain names. Respondent has previously been the subject of a finding of abusive domain name registration and use that involved offering for sale a domain name incorporating the trademark of a third party. See *Omega Pharma Innovation & Development NV v Kyoung S Park*, WIPO Case No. [D2020-0849](#)."

The Complainant has not licensed or authorized the Respondent to use its SIMATIC mark, whether in a domain name or otherwise.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical to its SIMATIC mark. It says that the public will automatically recognize that mark within the disputed domain name, and will likely associate the disputed domain name with the Complainant.

The Complainant has no connection with the Respondent, and the Respondent has not been making any legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Respondent selected the disputed domain name with intent to generate financial profit from selling the disputed domain name, and to cause damage to the Complainant.

The Respondent has no rights or legitimate interests in respect of the disputed domain name, which was registered for the sole purpose of disrupting the Complainant's business, causing the Complainant harm, and providing a commercial gain for the Respondent.

The Complainant relies on the previous cases decided under the Policy, where the Respondent has been found guilty of cybersquatting, in support of a contention that the Respondent has engaged in a pattern of registering reputed third party trade marks. In this case, the registration of the disputed domain name has prevented the Complainant from registering its SIMATIC mark as a domain name in the .net gTLD.

The circumstances establish that the disputed domain name was registered and is being used by the Respondent in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a Complainant is required to establish each of the following –

- (i) the domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (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

The Panel is satisfied that the Complainant is the registered proprietor of the SIMATIC mark, in numerous jurisdictions. That is sufficient to establish that it has rights in the SIMATIC mark for the purposes of paragraph 4(a)(i) of the Policy.

The consensus view of UDRP panels on the issue of confusing similarity where a complainant's mark is incorporated within a disputed domain name, is described as follows in [WIPO Overview 3.0](#):²

“Where the relevant trade make is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. . . .”

In this case, no other terms have been added – the disputed domain name consists solely of the expression “simatic” plus the “.net” generic top level domain. As the “.net” gTLD is not taken into account in the comparison required by paragraph 4(a)(i) of the Policy,³ the disputed domain name is considered to be identical to the Complainant's SIMATIC mark.

For the forgoing reasons, the Complainant has made out its case under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a number of circumstances which, without limitation, may be effective for a respondent to demonstrate that it has rights to, or legitimate interests in, a domain name for the purposes of paragraph 4(a)(ii) of the Policy. The circumstances are:

- (i) Before any notice to [the respondent] of the dispute, use by [the respondent] 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) Where [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 trade mark or service mark rights; or
- (iii) Where [the respondent is] making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly direct consumers or to tarnish the trade mark or service mark at issue.

² The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 1.8.

³ [WIPO Overview 3.0](#) notes at section 1.11 that the gTLD is a standard registration requirement, and as such is disregarded when applying the confusing similarity test under paragraph 4(a)(i) of the Policy.

[WIPO Overview 3.0](#) states the following on the burden of proof under paragraph 4(a)(ii) of the Policy:

“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.”

In this case, the disputed domain name is identical to the Complainant’s SIMATIC mark, and the Complainant has not licensed or authorized the Respondent to use that mark, whether in a domain name or otherwise. There is nothing to suggest that the Respondent (or any entity associated with the Respondent) is or has been commonly known by the disputed domain name, so there can be no claim to a right or legitimate interest under paragraph 4(c)(ii) of the Policy. Nor is there any evidence to suggest that the Respondent might have a credible claim to a right or legitimate interest under paragraph 4(c)(i) or 4(c)(iii).

Looking first at paragraph 4(c)(i), it is clear from the nature of the Respondent’s website, with its specific reference to the Complainant, and its links to third party websites featuring automation technology products that are apparently marketed in competition with the Complainant’s products, that the Respondent has somehow been aware of the Complainant and its automation technology products, and in the absence of any statement by the Respondent to the contrary, the inference is that the Respondent was aware of the Complainant’s SIMATIC mark and chose the disputed domain name to attract to the Respondent’s website Internet users who would mistakenly expect or assume that the Respondent’s website must be owned by the Complainant (or at least associated with or endorsed by the Complainant).

Such use could never qualify as a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. First, the mere use of a landing page with an identical domain name and competing links such as this does not involve any *bona fide* offering of goods or services *by the respondent*. The fact that the Respondent is offering to sell the disputed domain name reinforces that point. Secondly, the use of the Complainant’s mark to mislead Internet users into believing that any website at the disputed domain name will be owned or endorsed by (or associated or affiliated with) the Complainant, could not be a *bona fide* use.

Turning to paragraph 4(c)(iii), the Respondent’s website is clearly commercial in nature, and the disputed domain appears to have been used to misleadingly direct consumers to the Respondent’s website with intent to make a commercial gain. That use of the disputed domain name could never have been a “fair” use.

The foregoing factors in combination are sufficient to establish a *prima facie* case under paragraph 4(a)(ii) of the Policy. The evidential burden of showing rights or legitimate interests in respect of the disputed domain name therefore shifts to the Respondent. In the absence of any Response, the Respondent has failed to discharge that evidential burden, and the Complainant’s *prima facie* proof must prevail. The Complainant has accordingly made out its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, the following circumstances, without limitation, are deemed (if found by the Panel to be present) to be evidence of the registration and use of a domain name in bad faith –

- (i) Circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder’s documented out-of-pocket costs directly related to the domain name; or

(ii) The holder has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or

(iii) The holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) By using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the holder's website or location or of a product or service on the holder's website or location.

The Complainant has also proved this element of the Complaint.

In the absence of any Response, the high likelihood is that the Respondent registered the disputed domain name with full knowledge of the Complainant and its SIMATIC mark, and with the intention of trading off the Complainant's reputation in that mark. The Respondent's website is commercial in nature, and links to third party websites would not have been provided if doing so did not result in commercial gain (whether in the form of pay-per-click revenue, or otherwise).

In the Panel's view, the circumstances fall squarely within paragraph 4(b)(iv) of the Policy. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's SIMATIC mark, as to the source, sponsorship, affiliation or endorsement of the Respondent's website or the third party automation products marketed on it.

That finding is sufficient to resolve the Complaint in the Complainant's favor. It may be that there has also been bad faith registration and use under paragraphs 4(b)(i) and/or 4(b)(ii), but in view of the Panel's finding of bad faith registration and use under paragraph 4(b)(iv), it is unnecessary to make any findings under those sub-paragraphs.

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, <simatic.net>, be transferred to the Complainant.

/Warwick Smith/

Warwick Smith

Sole Panelist

Date: December 2, 2022