

ADMINISTRATIVE PANEL DECISION

Phoenix Contact GmbH & Co. KG v. Karavla MARIJA
Case No. D2023-1053

1. The Parties

The Complainant is Phoenix Contact GmbH & Co. KG, Germany, represented by Taylor Wessing LLP, Germany.

The Respondent is Karavla MARIJA, Serbia.

2. The Domain Name and Registrar

The disputed domain name <phoenixcontactshop.com> (the “Disputed Domain Name”) is registered with NETIM SARL (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2023. On March 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 13, 2023, 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 (Unkown / REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 13, 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 March 14, 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 March 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 7, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on April 13, 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 incorporated in Germany and operates a business founded by the Complainant's predecessor in 1923. The Complainant has traded under the name "Phoenix Contact" since 1982. The Complainant's group distributes a wide range of components, systems, and solutions in the area of electrical engineering, electronics, and automation. It employs some 20,000 people worldwide and its products and services are available in around 100 countries. It had annual sales of around EUR 3 billion in 2022.

The Complainant owns a number of registered trademarks for PHOENIX CONTACT – see for example International Trademark Registration No. 1125907 registered on October 28, 2011. These trademarks are referred to as the "PHOENIX CONTACT trademark" in this decision.

The Complainant's main website is at "www.phoenixcontact.com".

The Disputed Domain Name was registered on November 16, 2022. It resolves to a website (the "Respondent's Website") which is a replica of a website operated by a company called Phoenix Products LLC (the genuine website of that company being located at "www.phoenixcompany.com"). Phoenix Products LLC provides goods and services which at least to some extent compete with those of the Complainant. Prior to filing the present Complaint, the Complainant's representatives sent a letter of complaint to Phoenix Products LLC. A response was received from lawyers acting for that company indicating it did not own the Disputed Domain Name, was not responsible for the content of the Respondent's Website, and wished to prevent the Respondent's activity continuing.

5. Parties' Contentions

A. Complainant

The Complainant says that the Disputed Domain Name is confusingly similar to the PHOENIX CONTACT trademark. The addition of the non-distinctive dictionary word "shop" does not distinguish the Disputed Domain Name.

The Complainant says the Respondent has no rights or legitimate interests in the term "Phoenix Contact" or "phoenixcontactshop". Using the Disputed Domain Name to link to a website that is a replica of a third party competitor's website is not a *bona fide* offering of goods or services under the Policy – and, therefore, the Respondent cannot demonstrate rights or legitimate interests under paragraph 4(c)(i) of the Policy.

In consequence the Complainant alleges that the Disputed Domain Name was registered and is being used in bad faith. It says that absent any proffered or logical alternative explanation the Respondent has no legitimate reason for selecting the Disputed Domain Name and using it to attract traffic to a website which replicates that of the Complainant's competitor Phoenix Products, LLC. It follows that the registration and use are in bad faith.

B. Respondent

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

6. Discussion and Findings

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with 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;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the PHOENIX CONTACT trademark. The Panel finds the Disputed Domain Name is confusingly similar to this trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is recognizable in the disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7).

It is also established that the addition of a term (such as here, the word “shop”) to a disputed domain name does not prevent a finding of confusing similarity under the first element (*PRL USA Holdings, Inc. v. Spiral Matrix*, WIPO Case No. [D2006-0189](#)).

It is also well established that the generic Top-Level Domain (“gTLD”), in this case “.com”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the PHOENIX CONTACT trademark. The Complainant has prior rights in the PHOENIX CONTACT trademark which precede the Respondent’s registration of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do*

The Hustle, LLC v. Tropic Web, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish his rights or legitimate interests in the Disputed Domain Name. Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

In the present circumstances, the Panel accepts on the evidence that the third party company Phoenix Products LLC was not responsible for the registration of the Disputed Domain Name or the content of the Respondent's Website. Nothing is known about the Respondent apart from his name and address. However, his actions cannot have been coincidental and he must have deliberately chosen the Disputed Domain Name because of its likely association with the Complainant, particularly given the Complainant's ownership and use of the nearly identical domain name <phoenixcontact.com>. Why he then directed it to a replica of the website of a company that competes with the Complainant is a matter of speculation but appears to be intended to cause user confusion. As addressed by the panel in *Bayer AG v. dasofun adura*, WIPO Case No. [D2023-0385](#), "[o]n the balance of probabilities, the Panel is satisfied that the Respondent most likely registered the disputed domain name to impersonate the Complainant and therefore for a dishonest purpose. That the Respondent is currently framing another's website does not mean that the Respondent cannot put this dishonest plan into practice at any time. As suggested by the Complainant, one may view the disputed domain name, in the hands of the Respondent, as an unjustifiable threat hanging over the head of the Complainant and thus constituting a current and continuing abusive use of the disputed domain name". While the Respondent may have replicated the website of a third party Phoenix company in an attempt to establish legitimacy, the Panel cannot conceive of any legitimate use the Respondent could make of the Disputed Domain Name.

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (i) circumstances indicating that you have registered or you have 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) 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.

In the present circumstances the Panel concludes that irrespective of the Respondent's motives it is more likely than not that at least factor (iii) above applies as it is clearly likely that the use of the Disputed Domain Name in connection with the Respondent's Website will be disruptive to the Complainant's business. The Panel also notes that the Respondent has not filed a Response and has not presented any case of good faith that he might have. The Panel infers that none exists.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <phoenixcontactshop.com> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: April 27, 2023