



NATIONAL ARBITRATION FORUM

DECISION

Andreas Stihl AG & Co. KG v. Domaincar c/o Perthshire Marketing
Claim Number: FA0604000682426

PARTIES

Complainant is **Andreas Stihl AG & Co. KG** ("Complainant"), represented by **Jan Zecher**, of **Gleiss Lutz Rechtsanwaelte**, Maybachstr. 6, Stuttgart 70469, Germany. Respondent is **Domaincar c/o Perthshire Marketing** ("Respondent"), Trident Chambers, Wickhams Cay 1, P.O. Box 146, Road Town, Tortola, VG.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**stihll.com**> and <**wwwstihl.com**>, registered with **Dstr Acquisition Vii, Llc**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on April 19, 2006; the National Arbitration Forum received a hard copy of the Complaint on April 24, 2006.

On May 1, 2006, Dstr Acquisition Vii, Llc confirmed by e-mail to the National Arbitration Forum that the <**stihll.com**> and <**wwwstihl.com**> domain names are registered with Dstr Acquisition Vii, Llc and that Respondent is the current registrant of the names. Dstr Acquisition Vii, Llc has verified that Respondent is bound by the Dstr Acquisition Vii, Llc registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On May 2, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of May 22, 2006 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@stihll.com and postmaster@wwwstihl.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On May 25, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

Complainant requests that the domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

- [i.] Complainant owns, *inter alia*, the following registered trademarks:
- German trademark no. 603,076 "Stihl" with priority of October 1st, 1948, registered and used for, *inter alia*, "saws" in international class 7 (i. e., saws other than hand-operated),
 - European Community Trademark no. 1,978,626 "STIHL" with priority of November 30, 2000, registered and used for, *inter alia*, "motor saws",
 - International Trademark no. 165.777 "Stihl" with priority of October 1st, 1948, registered and used for, *inter alia*, "saws" in international class 7 (i. e., saws other than hand-operated) and claiming protection for, *inter alia*, Belgium, Netherlands, Luxemburg, France, Italy, Austria, Portugal, Switzerland and Spain,
 - U.S. Trademark no. 855,458 "STIHL" with priority of December 16, 1965, registered and used for, *inter alia*, "saws" in international class 7 (i. e., saws other than hand-operated).

- [ii.] The trademark “STIHL” is a world-wide famous trademark. It has been used for chain saws in the business of Complainant and its legal predecessors since 1926. In the last ten years, Complainant and its legal predecessors have sold annually several millions of chain saws, brush cutters, cutting-off machines, power-operated hedge clippers and blowers under the trademark world-wide. In the same time, Complainant spent millions of dollars on advertising and promoting power-operated tools for forestry and agriculture bearing the trademark in a wide range of media throughout the world. The trademark ”STIHL” enjoys world-wide reputation.

[5.] **FACTUAL AND LEGAL GROUNDS**

This Complaint is based on the following factual and legal grounds:

- [a.] The domain names “stihll.com” and “wwwstihl.com” are confusingly similar to the trademark “STIHL” of Complainant.

- [i.] The domain name “stihll.com” consists of the elements “stihll” and the element “com”. The characteristic element of the domain name “stihll.com” is the element “stihll”.

The element “com” is irrelevant when comparing domain names to trademarks. *See Nevada State Bank v. Modern Ltd.*, [FA204063](#) (NAF December 6, 2003)(holding that generic top-level domains are irrelevant when considering a domain name is identical or confusingly similar).

The element “stihll” is phonetically identical and orthographically very similar to the trademark “STIHL”. There are only small differences in capitalization and spelling.

The element “stihll” does not use capitals, the trademark “STIHL” does use capitals. However, this difference does not make a real difference as the Internet Domain Name System (DNS) does not allow for capitalization of domain names. *See Central Pacific Bank v. ansony*, [FA99379](#) (NAF October 15, 2001) (stating that capitalization is not considered when addressing the similarities between domain names and marks contained within them)

Furthermore, the element “stihll” is spelled with two “l”, the trademark “STIHL” is spelled with one “L”. However, Respondent’s intentional introduction of a typographical error into Complainant’s famous trademark fails to create a distinguishable domain name. Deliberately introducing slight deviations into famous trademarks renders the domain name confusingly similar. *See Marriott International, Inc. v. Seocho*,

[FA149187](#) (NAF April 28, 2003) (finding that intentionally introducing a typographical error into a famous trademark fails to create a distinguishable domain name). See also *Victoria's Secret v. Zuccarini*, [FA95762](#) (NAF November 18, 2000) (finding that, by misspelling words, a respondent does not create a distinct mark but nevertheless renders the domain name confusingly similar to complainant's trademarks).

- [ii.] The domain name "wwwstihl.com" consists of the elements "www", "stihl" and "com". The characteristic element of the domain name "wwwstihl.com" is the element "stihl".

The element "com" is irrelevant when comparing domain names to trademarks. See above.

The element "www" is purely descriptive for a web site on the World Wide Web. Besides, it takes advantage of a typing error that users commonly make when searching on the Internet by eliminating the period between the "www" and "stihl". Doing so fails to create a distinguishable domain name. See *ABC Distributing, Inc. v Alex Fedorov*, [FA94787](#) (NAF June 12, 2000)(finding the domain name "wwwabcdistributing.com" to be confusingly similar to the trademark "ABC DISTRIBUTING"). See also *Bank of America Corporation v InterMos*, [FA95092](#) (NAF August 1st, 2000)(holding that the domain name "wwwbankofamerica.com" is confusingly similar to the trademark "BANK OF AMERICA").

- [b.] Respondent has neither rights nor legitimate interests in respect of the domain names. Neither has Respondent used the domain names before notice of the dispute for a *bona fide* offering of goods or services, nor has it been commonly known by the domain names, nor has it a legitimate noncommercial or fair use of the domain names.
- [i.] Respondent's domain names were registered on December 13, 2004. Since then, Respondent has been using the domain names for running web sites with a search engine and hundreds of "sponsored links" to commercial web sites advertising chain saws of different brands, amongst them of Husqvarna, one of the main competitors of Complainant. For this purpose, Respondent also uses pop-up advertisements.
- [ii.] Respondent's exploitation of typing errors of Internet users looking for a web site of Complainant is an unauthorized capitalization of Complainant's trademark "STIHL" and fails to create rights in the domain names. See *Marriott International, Inc. v. Seocho*, [FA149187](#) (NAF April 28, 2003) (finding that using the domain "marrriot.com" for information and services related to travel, casinos and hotels created no rights in the domain name). Also see *Bank of America Corporation v. Ling Shun Shing*,

[FA132447](#) (NAF December 30, 2002) (finding that using the domains “bankofamericana.com”, “bankifamerica.com”, “bankofamereica.com” and “bankofamericca.com” with relation to financial services did not qualify as a bona fide offering of goods and services).

- [iii.] Complainant never had a business relation with Respondent. Complainant did not even know about the Respondent. Complainant never instructed or authorized Respondent to register the domain names.
 - [iv.] A search in the trademark registers of the German Patent and Trademark Office, the European Office for Harmonisation in the Internal Market, the World Intellectual Property Organization and the U.S. Patent and Trademark Office produced no trademarks of Respondent. This fact allows the *prima facie* conclusion that Respondent has no rights or legitimate interests in the domain names. Compare *Pioneer v. Kim Dong-Gum*, [FA112486](#) (NAF July 11, 2002) (Finding no rights or legitimate interests in a domain name after a trademark search produced neither trademarks nor trademark applications of the respondent).
- [c.] Respondent acted in bad faith when registering and using the domain names.
- [i.] Respondent has, by using the domain names, attempted to attract, for commercial gain, Internet users to Respondent’s web sites by creating a likelihood of confusion with Complainant’s trademarks as to the source, affiliation or endorsement of Respondent’s web sites. Respondent deliberately incorporated slight typographical errors into Complainant’s famous trademark. This allows the conclusion that Respondent knew about Complainant’s trademark and tried to unfairly and opportunistically benefit from the goodwill associated with Complainant’s trademark by intercepting and siphoning off traffic from its intended destination. This constitutes bad faith under Par. 4 (b) (iii) and (iv) UDRP. See *Marriott International, Inc. v. Seocho*, [FA149187](#) (NAF April 28, 2003). See also *Bank of America Corporation v. Ling Shun Shing*, [FA132447](#) (NAF December 30, 2002).
 - [ii.] As the domain names incorporate Complainant’s famous trademark “STIHL” and merely add typographical errors, it is inconceivable that Respondent could make any use of the disputed domain names without creating a false impression of association with Complainant. As every use of the domain names would inevitably create a confusion of the public, bad faith under Policy ¶4 (a) (iii) is on hand. See *State Farm Mutual Automobile Insurance Company v. Darrin Bagnuolo*, [FA399349](#) (NAF February 21, 2005)(finding bad faith in an unused domain when it was inconceivable that respondent could make any use of the disputed domain name without creating a false impression of association with

complainant). See also *Phat Fashions v. Kruger*, [FA96193](#) (NAF December 29, 2000) (finding bad faith even though respondent had not used the domain name because every use of the domain name would inevitably have created a confusion of the public).

- [iii.] Respondent has engaged in a pattern of conduct of registering domain names that use famous trademarks owned by others. Apart from the domain names that are the subject of this complaint, Respondent has deliberately chosen numerous other famous trademarks like “STATEFARM INSURANCE”, “EDUCATION PLACE”, and “WHITNEY BANK” to incorporate into domain names. This fact also is *prima facie* evidence of bad faith behavior. See *DJR Holdings, LLC v. Paul Gordon*, [FA141813](#) (NAF March 4, 2003) (finding that deliberately choosing famous trademarks to incorporate into domain names in several cases establishes a pattern of conduct under Par. 4 (b) (ii) UDRP). Also see *America Online, Inc. v. iDomainNames.com*, [FA93766](#) (NAF March 24, 2000) (finding that registering numerous domain names which on their face infringe on famous marks evidences bad faith).
- [iv.] There have been numerous arbitral decisions against Respondent for misuse of famous trademarks for illegitimate purposes. The NAF’s decision register alone lists half a dozen arbitral decisions regarding 17 domain names against Respondent. The WIPO’s decision register lists a further arbitral decision against Respondent. In all cases except one, the disputed domain names of Respondent were transferred to the respective complainant. This fact is *prima facie* evidence that Respondent acted in bad faith when registering the domain names that are the subject of this Complaint. See *Microsoft Corporation v. Party Night, Inc. et. al.*, [D2003-0501](#) (WIPO August 18, 2003) (finding that many arbitral and judicial decisions rendered against a complainant is evidence of a behavior which is the misuse of famous marks for illegitimate purposes).
- [v.] The findings in the case *Humana, Inc. v. Unasi Inc. a/k/a Domaincar* suggest that Respondent is the *alter ego* of Unasi Inc., a pathological typosquatter probably known to the Panel that is responsible for dozens of arbitral proceedings regarding hundreds of domain names (the decision register of NAF lists 39 arbitral decisions against Unasi Inc. alone). See *Humana, Inc. v. Unasi Inc. a/k/a Domaincar*, [D2006-0119](#) (WIPO March 6, 2006).

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, Andreas Stihl AG & Co. KG, has been in the business of manufacturing and selling chain saws since 1926. Complainant holds several trademark registrations

throughout the world with various trademark authorities for the STIHL mark, including the German trademark authority (Reg. No. 603,076 issued October 1, 1948), the European Union trademark authority (Reg. No. 1,978,626 issued November 30, 2000), and the United States Patent and Trademark Office (“USPTO”) (Reg. No. 855,458 issued August 27, 1968).

Respondent registered the <stihl.com> and <wwwstihl.com> domain names on December 13, 2004. Respondent is using the disputed domain names to redirect Internet users to Respondent’s commercial website that features links to third-party websites advertising different brands of chain saws that compete with Complainant.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

Complainant has submitted evidence of its registration of the STIHL mark with trademark authorities throughout the world. The Panel finds such evidence establishes Complainant’s rights in the mark pursuant to Policy ¶4(a)(i). *See Koninklijke KPN N.V. v. Telepathy Inc.*, D2001-0217 (WIPO May 7, 2001) (finding that the Policy does not require that the mark be registered in the country in which the respondent operates; therefore it is sufficient that the complainant can demonstrate a mark in some jurisdiction); *see also Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum

Feb. 18, 2004) (“Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark.”).

Respondent’s <stihll.com> and <wwwstihl.com> domain names are confusingly similar to Complainant’s STIHL mark because Respondent’s domain names incorporate Complainant’s mark in its entirety and add letters and the generic top-level domain “.com.” The addition of letters to Complainant’s mark does not negate the confusing similarity between the disputed domain names and Complainant’s mark. Thus, the Panel finds the disputed domain names are confusingly similar to Complainant’s mark pursuant to Policy ¶4(a)(i). See *Reuters Ltd. v. Global Net 2000, Inc.*, D2000-0441 (WIPO July 13, 2000) (finding that a domain name which differs by only one letter from a trademark has a greater tendency to be confusingly similar to the trademark where the trademark is highly distinctive); see also *Bank of Am. Corp. v. InterMos*, FA 95092 (Nat. Arb. Forum Aug. 1, 2000) (finding that the respondent’s domain name <wwwbankofamerica.com> is confusingly similar to the complainant’s registered trademark BANK OF AMERICA because it “takes advantage of a typing error (eliminating the period between the www and the domain name) that users commonly make when searching on the Internet”).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant established it has rights and legitimate interests in the mark contained in its entirety in the disputed domain names. Complainant has alleged Respondent does not have rights in the disputed domain names. Under Policy ¶4(a)(ii), the burden is on Complainant to prove Respondent does not have rights or legitimate interests in the disputed domain names, and once Complainant has made a *prima facie* case, the burden then shifts to Respondent to show it does have rights or legitimate interests pursuant to Policy ¶4(c). See *Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (once the complainant asserts that the respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the respondent to provide “concrete evidence that it has rights to or legitimate interests in the domain name at issue”); see also *Compagnie Generale des Matieres Nucleaires v. Greenpeace Int’l*, D2001-0376 (WIPO May 14, 2001) (“Proving that the Respondent has no rights or legitimate interests in respect of the Domain Name requires the Complainant to prove a negative. For the purposes of this sub paragraph, however, it is sufficient for the Complainant to show a *prima facie* case and the burden of proof is then shifted on to the shoulders of Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interests in respect of the domain name in question.”).

Respondent is using the <stihll.com> and <wwwstihl.com> domain names to redirect Internet users to Respondent’s commercial website that features links to competing third-party websites. Respondent’s use of domain names that are confusingly similar to

Complainant's STIHL mark to redirect Internet users interested in Complainant's chainsaw products and services to a website that offers links to chainsaw products and services in competition with Complainant is not a use in connection with a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i), or a legitimate noncommercial or fair use of the domain name pursuant to Policy ¶4(c)(iii). *See 24 Hour Fitness USA, Inc. v. 24HourNames.com-Quality Domains For Sale*, FA 187429 (Nat. Arb. Forum Sep. 26, 2003) (holding that Respondent's use of the <24hrsfitness.com>, <24-hourfitness.com> and <24hoursfitness.com> domain names to redirect Internet users to a website featuring advertisements and links to Complainant's competitors could not be considered a *bona fide* offering of goods or services or a legitimate noncommercial or fair use); *see also DLJ Long Term Inv. Corp. v. BargainDomainNames.com*, FA 104580 (Nat. Arb. Forum Apr. 9, 2002) ("Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services because Respondent is using the domain name to divert Internet users to <visual.com>, where services that compete with Complainant are advertised.").

Complainant asserts, without contradiction from Respondent, Respondent is neither commonly known by the <stihll.com> or <wwwstihl.com> domain name, nor authorized to use domain names featuring Complainant's mark. Thus, the Panel finds Respondent is not commonly known by the disputed domain names pursuant to Policy ¶4(c)(ii). *See Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) a respondent is not a licensee of a complainant; (2) complainant's prior rights in the domain name precede that respondent's domain name registration; (3) that respondent is not commonly known by the domain name in question); *see also Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interests where a respondent was not commonly known by the mark and never applied for a license or permission from a complainant to use the trademarked name).

The Panel finds Respondent lacks rights and legitimate interests in the disputed domain names because Respondent's addition of letters and the prefix "www" to Complainant's mark constitutes typosquatting. Thus, the Panel finds that Respondent's typosquatting is evidence that Respondent lacks rights and legitimate interests pursuant to Policy ¶4(a)(ii). *See Diners Club Int'l Ltd. v. Domain Admin*****It's all in the name******, FA 156839 (Nat. Arb. Forum June 23, 2003) (holding that respondent's <wwwdinersclub.com> domain name, a typosquatted version of complainant's DINERS CLUB mark, was evidence in and of itself that respondent lacks rights or legitimate interests in the disputed domain name vis-à-vis complainant); *see also Black & Decker Corp. v. Khan*, FA 137223 (Nat. Arb. Forum Feb. 3, 2003) (finding no rights or legitimate interests where the respondent used the typosquatted <wwwdewalt.com> domain name to divert Internet users to a search engine webpage, and failed to respond to the complaint).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

Complainant alleged Respondent acted in bad faith by registering and using domain names that contain Complainant's registered mark in its entirety. Respondent is using the <stihll.com> and <wwwstihl.com> domain names to redirect Internet users to Respondent's commercial website that features links to competing third-party websites. The Panel finds such use constitutes disruption and is evidence of bad faith registration and use under to Policy ¶4(b)(iii). *See S. Exposure v. S. Exposure, Inc.*, FA 94864 (Nat. Arb. Forum July 18, 2000) (finding the respondent acted in bad faith by attracting Internet users to a website that competes with the complainant's business); *see also Puckett v. Miller*, D2000-0297 (WIPO June 12, 2000) (finding that the respondent diverted business from the complainant to a competitor's website in violation of Policy ¶4(b)(iii)).

Based on the uncontested evidence presented by Complainant, the Panel infers Respondent receives click-through fees for diverting Internet users to a website offering links to competing chainsaw products and services. Respondent's domain names incorporating Complainant's mark are capable of creating confusion as to Complainant's affiliation with the disputed domain names and resulting website. Thus, Respondent's use of the <stihll.com> and <wwwstihl.com> domain names is tantamount to bad faith registration and use pursuant to Policy ¶4(b)(iv). *See Kmart v. Khan*, FA 127708 (Nat. Arb. Forum Nov. 22, 2002) (finding that if the respondent profits from its diversionary use of the complainant's mark when the domain name resolves to commercial websites and the respondent fails to contest the complaint, it may be concluded that the respondent is using the domain name in bad faith pursuant to Policy ¶4(b)(iv)); *see also Drs. Foster & Smith, Inc. v. Lalli*, FA 95284 (Nat. Arb. Forum Aug. 21, 2000) (finding bad faith where the respondent directed Internet users seeking the complainant's site to its own website for commercial gain).

Respondent has also engaged in a pattern of registering "typosquatting" domain names as shown by the thirteen other cases Respondent has been a party to (and has lost almost all of them). This is number fourteen. This pattern is further evidence of bad faith and suggests Respondent's business model is to purchase and re-sell typosquatting domain names.

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <stihll.com> and <wwwstihl.com> domain names be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: June 8, 2006

[Click Here](#) to return to the main Domain Decisions Page.

[Click Here](#) to return to our Home Page

NATIONAL ARBITRATION FORUM