Decision for dispute CAC-UDRP-100638

Case number	CAC-UDRP-100638
Time of filing	2013-08-15 11:59:43
Domain names	blanx.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	COSWELL S.p.A.

Complainant representative

Organization	PORTA, CHECCACCI & ASSOCIATI s.p.a.

Respondent

Name	MR. JINSOO YOON

OTHER LEGAL PROCEEDINGS

The panel was not informed of other legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks that consist of the word BLANX, which is not disputed by the Respondent:

- the Italian trademark BLANX, filed on 26 June 1990 and registered under number 0000544783 for products of classes 3 and 5;

- the Community Trademark BLANX (figurative), filed on 2 November 2000 and registered under number 1936541 for dentifrices of class 3;

- the International trademark BLANX (figurative), registered on 5 December 2000 under number 751 413 for toothpastes of class 3, designating many countries, including the Republic of Korea.

FACTUAL BACKGROUND

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

Complainant is the holder of the worldwide used and registered brand Blanx, to distinguish a toothpaste and a related line of mouth care products. The first registration and use of the mark dates back as early as June 1990, in Italy. The mark is also registered as CTM (among others: 1936541 of 2 Nov. 2000). The brand is well known in Italy (attachment 6) and is establishing goods knowledge among consumers in Europe and outside, including South Korea, where the product is exported continuously since 2004 (except for the year of 2008).Complainant is also owner of International Registration No. 751413; 911659 (Blanx nanorepair), and 916039 (Blanx Biorepair) designating South Korea, the home country of the Respondent.
BLANX.COM is clearly identical to BLANX registered and used by Complainant and the domain name would confuse consumers who will refer to that domain name as the ".com" gTLD is often used for International brand like Blanx is.
The Registrant, Mr.Yoon Jonsoo, who is a Korean citizen, registered the domain Blanx.com – that is identical to trademark Blanx, on 21 Jan. 2004 and hence after Complainant's first registration. Such registration was performed in bad faith with the intention to sell back the domain name to the trademark owner, Coswell. This is confirmed by the exchange of e-mails between October 2011 and May 2012, followed by an offer performed by Coswell at the on-line auction that can be activated from the website residing on www.blanx.com domain name. At present the domain name is reported to be still on sale. In 2011 the Korean applicant asked Coswell for a compensation of 50'000 Euro and replied in an impolite way stressing the fact that they are the trademark holders.
The registrant has no apparent interest in holding the domain name, as it is on sale and it has be on sale continuously since at least as early as of October 2011 until today. The web page appearing at the domain name does not show any business related to the word BlanX. Therefore, it is evident and clear the registration by him was performed for re-sale purposes and in bad faith. The registrant neither uses, nor to Coswell's knowledge has made demonstrable preparations to use www.blanx.com domain name in connection with a bona fide offering of goods or services. See ICANN Policy paragraph 4(c) (i). As demonstrated by the home page/pages of the www. Blanx.com web site, the sites contain no content or information related to registrant's manufacture, or to any other manufactures (if any) bearing the mark Blanx. Hence, the registrant is not known by or to use Blanx on the internet in connection with a legitimate or fair use. See Broadcom Corp. v. Intellifone Corp., FA 96356 (Nat. Arb. Forum Feb. 5, 2001) (finding no rights or legitimate interests because the respondent is not commonly known by the disputed domain name or using the domain name in connection with a legitimate or fair use);
The Complainant stresses that the Policy, paragraph 4(c) (i) provides that a use is legitimate if, prior to commencement of the dispute, the Respondent used the domain name or a name corresponding to the domain name in connection with the bona fide offering of goods or services. Although concerned with the activities of an authorized reseller, respected UDRP decision in this regard is that of Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903, where it was held that, to be bona fide within paragraph 4(c)(i), the offering must meet several minimum requirements, being that:
- the Respondent must actually be offering the goods or services at issue;
- the Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods;
- the site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site; and
- the Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.
The factors developed in the Oki Data case have been adopted by a number of subsequent UDRP panels. Ferrari S.P.A., Fila Sport S.P.A., v. Classic Jack, WIPO Case No. D2003-0085; Experian Information Solutions, Inc. v. Credit Research, Inc., WIPO Case No. D2002-0095; and have also been applied in cases, such as this one, where there was no contractual relationship between the Complainant and the Respondent. See Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent, WIPO Case No. D2004-0481; Philip Morris Incorporated v. Alex Tsypkin, WIPO Case No. D2002-0946.
Here the disputed domain name, which is identical to the Complainant's mark, is being used to provide sponsored links and to promote the sale of commercial products and services apparently unconnected with the Complainant in any way, or at the least, drive Internet traffic through the site attracted by the disputed domain name, identical to the brand Blanx.
A click on the sale button opens an "offer window" where it is reported that "because of the price, the domain requires a special handling" and in the right side we see that Monthly "Google keyword search volume" is of 27750 searches, which are performed in connection with Complainants' renown Blanx dentifrice . In fact, Google.it finds 700'000 entries corresponding to Blanx and that first results pertain to Complainants' brand.

The infringement of Complainant's rights is of the type provided for by the Uniform Domain Name Dispute Resolution Policy (As Approved by ICANN on October 24, 1999)

(a) the domain name is identical or confusingly similar to a trademark and/or service mark in which the complainant has rights; and
(b) the other party has no rights or legitimate interests in respect of the domain name; and
(c) the domain name has been registered and is being used in bad faith.

a) it is proven by the fact that Complainant's mark is registered worldwide and used in a lot of countries, including Korea. In view of these circumstances, there is no reasonable possibility that the domain name was selected by Respondent for any purpose other than a brazen attempt to create a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site. Such an attempt is evidence of the registration and use of a domain name in bad faith. See ICANN Policy paragraph 4(b)(iv); see also Albrecht v. Natale, FA 95465 (Nat. Arb. Forum Sept. 16, 2000) (finding bad-faith registration and use where the Respondent's domain name is composed entirely of the Complainant's name and there is no reasonable possibility that the name KARLALBRECHT.COM was selected at random).
b) has been demonstrated above;
c) Moreover, Respondent's Blanx.com redirects the users to other web sites that sell competing and unrelated services. This practice strongly suggests that Respondent commercially benefits from this diversion by receiving pay-per-click fees from advertisers when Internet users follow the links on its web sites. As such, Respondent is unfairly and opportunistically appropriating the goodwill associated with Complainant's Blanx marks. These circumstances strongly evidence Respondent's bad-faith registration and use of the domain names. Respondent is using the domain name to intentionally attract, for commercial gain, Internet users to her website or other on-line location belonging to third parties, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of her web site or location or of a product or service on her web site or location see Diners Club International Ltd. v O P Monga (Nat. Arb. Forum May. 22, 2006),. This constitutes bad faith registration and use pursuant to Policy 4(b)(iv). See Allen-Edmonds Shoe Corp. v. joseph FA 624511 (Nat. Arb. Forum Feb. 28, 2006), citing, inter alia, 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); see also Associated Newspapers Ltd. v. Domain Manager, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) ("Respondent's prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to Policy paragraph 4(b)(iv) because the domain name provided links to Complainant's competitors and Respondent presumably commercially benefited from the misleading domain name by receiving "click-through-fees.").

Respondent registered the domain name on January 21, 2004, and therefore has been passively holding the disputed domain name for more than 9 years. Panels have held that the passive holding of a domain name for as little as six months provides evidence that a respondent lacks rights or legitimate interests in the domain name. See Am. Online, Inc. v. Kloszewski, FA 204148 (Nat. Arb. Forum Dec. 4, 2003) ("Respondent's passive holding of the <aolfact.com> domain name for over six months is evidence that Respondent lacks rights and legitimate interests in the domain name."); see also Pharmacia & Upjohn AB v. Romero, D2000-1273 (WIPO Nov. 13, 2000) (finding no rights or legitimate interests where the respondent failed to submit a response to the complaint and had made no use of the domain name in question). Thus, Respondent's passive holding of the disputed domain name does not constitute a bona fide offering of goods or services pursuant to Policy paragraph 4(c)(i), or a legitimate noncommercial or fair use of the domain name pursuant to Policy paragraph 4(c)(iii), because Respondent has failed to make any use of the domain name since registering it eight years ago.

Therefore, having ascertained 1) the identity of the domain name BLANX.COM to the mark BLANX of the Complainant; 2) the confusing identity of the domain names BLANX.COM registered by Yoon Jonsoo with the rights deriving from the trademarks registered in Italy and abroad by the Complainant; 3) the renown associated with the word BLANX as well appreciated dentifrice sold in Italy and abroad, Korea included, by the Complainant; 4) the illegality of the Registrant Yoon Jonsoo in registering the domain name BLANX.COM; 5) the bad faith of Yoon Jonsoo, the Claimant, identified by the data as

above indicated asks for the re-assignment of the domain WWW.BLANX.COM to the Complainant.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is 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 Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

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

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The panel examined the multiple trademark registrations of the Complainant (listed above) and is satisfied that the Complainant has rights in the trademark BLANX, including in Korea, where the Respondent is residing. The Respondent did not challenge this allegation.

The challenged Domain Name is confusingly similar to the Complainant's trademarks BLANX. The only difference is that the (figurative) trademarks are characterized by the letter X which is bigger than the letters BLAN. Phonetically, the trademarks are identical to the Domain Name.

2. In lack of any Response from the Respondent, the panel agrees with the Complainant that the Respondent has no rights or legitimate interests in respect of the Domain Name. There is no indication that the Respondent owns rights or has a legitimate interest in the sign BLANX. The Respondent is not related in any way to the Complainant's business and is not known under the name BLANX.

3. The Panel is satisfied that the Respondent registered the disputed Domain Name and is using it in bad faith. The panel finds that the offer for sale of the Domain Name to the Complainant for 50.000 EUR constitutes evidence of bad faith. The Respondent did not dispute this allegation.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BLANX.COM**: Transferred

PANELLISTS

Name	**Tom Heremans**

DATE OF PANEL DECISION 2013-09-22

DATE OF PANEL DECISION [illegible]

Publish the Decision