Decision for dispute CAC-UDRP-100719

Case number	CAC-UDRP-100719
Time of filing	2013-12-05 14:11:42
Domain names	magnapool.net

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Zodiac Group Australia Pty Ltd

Complainant representative

Organization	Nameshield (Anne Morin)

Respondent

Organization	Maytronics Australia

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies on numerous registrations for trademarks, comprising the keyword “magnapool”, including the International trademark registration 961115 for the word mark “magnapool”, registered on 17 July 2007 in classes 7, 9 and 11. The Complainant is also the holder of and actively uses the domain name “magnapool.com”, created on July 17, 2006.

The Panel notes that the trademark registrations invoked by the Complainant are registered by third parties, namely Poolrite Research Pty Ltd. and Evolve Supply Chain Pty Ltd. However, the Complainant provided a deed of assignment of the rights on these trademark registrations to the Complainant on August 2, 2013. This assignment of rights authorizes the Complainant to invoke the assigned rights in the framework of proceedings such as the present administrative proceedings (See WIPO Case No. D2000-1619, Backstreet Boys Productions, Inc. v. John Zuccarini, Cupcakeparty, Cupcake Real Video, Cupcake-Show, and Cupcakes-First Patrol; WIPO Case No. D2005-0529, Sinbar v. Jin Hyun). Therefore, the Panel considers that the Complainant has rights in the abovementioned trademark registrations.

FACTUAL BACKGROUND

The Complainant, Zodiac Group Australia Pty Ltd., is a company incorporated under the laws of Australia. Complainant is the licensee of numerous trademark registrations, comprising the keyword “magnapool”. These trademarks include the

International trademark registration 961115 for the word mark “magnapool”, registered on 17 July 2007 in classes 7, 9 and 11 (hereafter “Magnapool trademarks”).

The Complainant uses these trademarks inter alia in relation to its care solutions and securing pools business, for which the Complainant and its Magnapool trademarks are well-known.

The Respondent registered the disputed domain name “magnapool.net” on September 2, 2013. The disputed domain name is currently not being used and resolves to a parking page.

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

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
2. The 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.

The Panel has therefore dealt with each of these requirements in turn.

Confusing similarity of the Domain Name with existing rights

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant

is the licensee of the Magnapool trademarks, which are used in connection with its care solutions and securing pools business, it is clearly established that there is a trademark in which the Complainant has rights.

The Panel considers the disputed domain name <magnapool.net> to be identical to the Magnapool trademarks. The Panel is of the opinion that the suffix ".NET" does not distinguish the Domain Name from the Complainant's trademarks (See CAC Case No. 100656, T-2 d.o.o. v. Matevž Turk).

Accordingly, the Complainant has made out the first of the three elements that it must establish.

No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that respondent has no rights or legitimate interests in respect of the domain names.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the Domain Name in order to shift the burden of proof to the Respondent. (See: Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 (championinnovation.com); Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 (croatiaairlines.com); Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 (belupo.com).)

The Panel notes that the Respondent has not been commonly known by the Domain Name and that the Respondent has not acquired trademark or service mark rights. Respondent's use and registration of the Disputed Domain Name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Moreover, the Panel is of the opinion that the Respondent is not making a legitimate non-commercial or fair use of the Domain Name. In fact, the Respondent has not been using the domain name since it resolves to a parking page. Such use is not a bona fide use. See e.g. NAF/FA190644 (nicklausgolf.com - "Respondent's use of a domain name confusingly similar to Complainant's mark(s) to divert Internet users to websites unrelated to Complainant's business does not represent a bona fide offering of goods or services under Policy 4(c)(i) or a legitimate noncommercial or fair use under Policy 4(c)(iii)"); NAF/FA93554 (bigdog.com – finding no legitimate use when respondent was diverting consumers to its own web site by using complainant's trademark(s)); NAF/FA96356 (broadcom2000.com - 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); NAF/FA96209 (galluppll.com - finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); NAF/FA740335 (cigaraficionada.com - finding that the respondent was not commonly known by the "cigaraficionada.com" domain name); NAF/FA881234 (stlawu.com - concluding that the respondent has no rights or legitimate interests in a disputed domain name where there is no evidence in the record indicating that the respondent is commonly known by the disputed domain name); WIPO/D2000-0020 (saint-gobain.net – finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); WIPO/D2000-0403 (charlesjourdan.com – finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

These verified allegations are sufficient to make out a prima facie case and shift the burden of response to Respondent. In the absence of a rebuttal by Respondent and based on the case file, the Panel considers that the second requirement of Paragraph 4(a) of the Policy is, therefore, satisfied (See CAC Case No. 100707, Mount Gay Distilleries Limited v. shan gai gong zuo shi; WIPO Case No. D2007-0368, Teva Pharmaceutical USA, Inc. v. US Online Pharmacies; WIPO Case No. D2003-0796, Grupo Televisa, S.A., Televisa, S.A. de C.V., Estrategia Televisa, S.A. de C.V., Videoserpel, Ltd. v. Party Night Inc., a/k/a Peter Carrington).

Bad faith

Complainant must prove on the balance of probabilities that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (See BellSouth Intellectual Property Corporation v. Serena, Axel, WIPO Case No. D2006-0007, where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trademarks in question, the inclusion of the entire trademark in the domain name, and the similarity of products implied by addition of telecommunications services suffix ("voip") suggested knowledge of the complainant's rights in the trademarks).

In the present case, the Disputed Domain Name has been registered on 2 September 2013. All trademarks invoked by the Complainant have been registered in 2007. Moreover, it appears that the Respondent's organization is a direct competitor of the Complainant. Additionally, both the Complainant and the Respondent are located in Australia. The Complainant also shows that a Google search for the term "magnapool" provides links only in connection with the Complainant. It can therefore be concluded that the Respondent was or at least had to be aware of the Complainant's business and related trademarks.

The passive holding of a domain name amounts to bad faith when it is difficult to imagine any plausible future active use of the domain name by the Respondent that would be legitimate and not infringing the Complainant's well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v. Polanski, WIPO Case No. D2000-1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000-0438; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

Other circumstances that evidence bad faith registration and use in the event of passive use of the domain name are:
- the fact that Complainant's trademark has a strong reputation and is widely used,
- the absence of evidence whatsoever of any actual or contemplated good faith use,
- the taking of active steps by a Respondent to conceal its identity or the provision of false contact details (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

In the present case, the Complainant demonstrates that its Magnapool trademarks have a strong internet presence. Given the fact that the Respondent's organization is a direct competitor of the Complainant, the Panel considers that it is impossible to imagine any plausible future active use of the domain name by the Respondent that would be legitimate and not infringing the Complainant's well-known mark or unfair competition and consumer protection legislation.

Moreover, the Panel notes that the written notice of the Complaint to the Respondent returned back to the Czech Arbitration Court as undelivered. This is a sign that the Respondent has provided false contact details, which is a further indication of bad faith registration and use (See e.g. WIPO Case No. D2006-1107, Ebay Inc. v. Wangming).

Finally, the fact that the Respondent did not answer to the Complainant's cease and desist letter constitutes additional evidence of the Respondent's bad faith.

Considering the above, the Panel finds that the Complainant has made out the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MAGNAPOOL.NET**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2014-01-17

Publish the Decision