Decision for dispute CAC-UDRP-100953

Case number	CAC-UDRP-100953
Time of filing	2015-03-20 11:13:30
Domain names	AMPLIFON-UK.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	AMPLIFON S.p.A.

Complainant representative

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

Respondent

Name	MR. DAVID STEWART

IDENTIFICATION OF RIGHTS

The Complainant relies on numerous registrations for trademarks, comprising the keyword “amplifon”, including:

the International trademark registration 572171 for the word mark “amplifon”, registered on 29 May 1991 in classes 9 and 10;
the Community trademark registration 1342708 for the word mark “amplifon”, registered on 13 November 2000 in classes 9, 10 and 42;
the South African trademark registration 2005/00477 for the word mark “amplifon”, registered on 10 January 2005 in class 10.

The Complainant is also the holder of and actively uses the domain name “amplifon.co.uk”, created on 27 July 2006.

FACTUAL BACKGROUND

The Complainant, Amplifon S.p.A., is a multinational company which holds numerous trademark registrations comprising the keyword “amplifon” (hereafter the “Amplifon trademarks”). Complainant uses its trademarks inter alia in relation to its hearing aid devices sales and services, for which Complainant and its Amplifon trademarks are known.

Respondent registered the disputed domain name “amplifon-uk.com” (hereafter the “Domain Name”) on 11 November 2014. The Domain Name is currently not being used and resolves to an error page.

PARTIES CONTENTIONS

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 holder of the Amplifon trademarks, which are used in connection with its hearing aid devices sales and services, it is clearly established that there is a trademark in which the Complainant has rights.

The Domain Name contains the Complainant's "amplifon" word mark in its entirety and combines it with a hyphen, the geographic identifier "uk" and the ".com" suffix.

It is consensus view that, for assessing identity or confusing similarity, the ".com" suffix has to be disregarded. See e.g., Belron Hungary Kft. Zug Branch v. Jaroslav Pittner, CAC 100894, <CARGLASS-SERVICE.COM>, <CARGLASS-SERVICE.NET>, <CAR-GLASS-SERVIS.COM>, <CARGLASS-SERVIS.COM>.

The addition of descriptive or generic terms to a name for which a right is recognized or established by national and/or Community law does not take away the confusing similarity. See e.g. Monster Finance Limited, Rahat Kazmi v. Monster Worldwide Ireland Limited, CAC 5376, <monsterfinance.eu>; Allianz AG v. Gailtaler Computerklinik, CAC 3207, <allianz-online.eu>.

In the instant case, the Panel considers that the addition of "-uk" to the Complainant's "amplifon" word mark creates confusing similarity between the Complainant's Amplifon trademarks and the Domain Name.

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 the Respondent has no rights or legitimate interests in respect of the domain name.

It is established in 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 submitted any evidence it acquired trademark or service mark rights in respect of the name "amplifon". Respondent's use and registration of the Domain Name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed or exists.

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 an error page. Such use is not a bona fide use. See e.g. 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); Compagnie de Saint Gobain v. Com-Union Corp, WIPO Case No. 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); Charles Jourdan Holding AG v. AAIM, WIPO Case No. 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 proof to the Respondent. In the absence of a rebuttal by the Respondent and based on the online case file, the Panel considers that the second requirement of Paragraph 4(a) of the Policy is, therefore, satisfied. See Mount Gay Distilleries Limited v. shan gai gong zuo shi, CAC 100707; Teva Pharmaceutical USA, Inc. v. US Online Pharmacies, WIPO Case No. D2007-0368; 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, WIPO Case No. D2003-0796.

Bad faith

The Complainant must prove on the balance of probabilities that the 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 Domain Name has been registered on 11 November 2014. Numerous trademarks invoked have been registered by the Complainant well before that date, including in South Africa where the Respondent resides. 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 (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

In the present case, the Complainant demonstrates that its Amplifon trademarks have a strong internet presence. The Respondent did not provide any evidence whatsoever of any actual or contemplated good faith use. Therefore, 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.

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. **AMPLIFON-UK.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2015-05-04

Publish the Decision