Decision for dispute CAC-UDRP-101388

Case number	CAC-UDRP-101388
Time of filing	2016-12-09 10:59:44
Domain names	goprodome.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	GoPro, Inc.

Complainant representative

Name	JUDr. Matěj Sedláček

Respondent

Organization	Dome Housing SCP

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of the following registrations of the trademark “GOPRO”:

US trademark No. 3032989 with priority date 17 February 2004 in respect of photographic equipment, namely, digital cameras, cases and housings for cameras and camera straps;

EU trademark No. 006750368 with priority date 13 March 2008 in respect of, inter alia, photographic equipment, namely film cameras and digital cameras, cases, housings, and accessories for cameras, and camera straps;

EU trademark No. 012621901 with priority date 21 February 2014 in respect of, inter alia, photographic equipment, namely cameras, digital cameras, video cameras; and cases, housings, and accessories for cameras of various kinds

The Complainant also has common law rights in the trademark “GOPRO”.

FACTUAL BACKGROUND

The Complainant was founded in 2002 and is an award-winning producer of cameras, accessories and technology. Its

products are now sold in 25,000 stores in over 100 countries worldwide and via a website at www.gopro.com.

The Respondent registered the disputed domain name on 25 January 2016 and is using it for a website which promotes and sells an accessory product for use with the Complainant's cameras under the name "GoPro Dome". This product enables a combined photograph or video to be taken of elements above and below the surface. The product is not made or placed on the market by or under the control of the Complainant.

The home page of the Respondent's website carries a banner comprising a photograph, showing the Respondent's product and what it achieves, and superimposed wording. The primary text in the largest fonts on the left half of the photograph reads "GoPro Dome / Both worlds joined together!" Below this two buttons are labelled "for GOPRO 3, 3+ & 4 / BUY NOW $84.90" and "for GOPRO 5 / PRE-ORDER $69.90".

At the bottom right of the photograph there is a statement in smaller font in a lighter shade of the dominant colour of the photograph, which says: "'Dome' is a genuine company not related to GoPro Inc."

On 12 April 2016 an employee of the Complainant asked the Respondent to send the Complainant one of its products to try it out. On 27 July 2016 the Complainant sent the Respondent a cease and desist letter.

Prior to the correspondence mentioned above, the Respondent's website had carried the disclaimer in a less prominent position, and had also displayed images taken from the Complainant's website. The disclaimer was moved to its present position and the images taken from the Complainant's website were removed to meet some of the Complainant's objections. However, the Respondent did not comply with the Complainant's demand to transfer the disputed domain name and further communications between the parties did not achieve a resolution of the dispute.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

THE COMPLAINANT:
The Complainant contends that the disputed domain name is confusingly similar to its registered trademark, "GOPRO".

The Complainant states that it has not authorised the Respondent to use its mark and that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant further alleges that the Respondent creates the false impression that its product is made by the Complainant or that it is affiliated with the Complainant. According to the Complainant, the Respondent has intentionally attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship affiliation or endorsement of the website or the product promoted on it. The Complainant contends that this is evidence that the disputed domain name was registered and is being used in bad faith in accordance with paragraph 4(b)(iv) of the UDRP.

THE RESPONDENT:

The Respondent does not dispute that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The Respondent states that it has invested in good faith in developing its business of supplying an accessory product for use with the Complainant's cameras and claims that it is using the Complainant's "GOPRO" mark in the disputed domain name to describe the intended use of the product. According to the Respondent this is consistent with US and EU trademark law.

The Respondent further refers to the decision in WIPO Case No. D2001-0903, Oki Data Americas, Inc. v ASD, Inc. and

submits that it satisfies all of the conditions identified in this decision (and subsequent decisions following it) for a reseller of the Complainant's products or a seller of accessory products to have a legitimate interest in respect of the disputed domain name that incorporates the Complainant's mark.

The Respondent denies that it has acted in bad faith and points out that the Complainant asked it to send one of its products to the Complainant for testing, without raising any objection to the disputed domain name, some 3 months before sending a cease and desist letter.

RIGHTS

It is clear that the Complainant has registered and unregistered rights in the mark "GOPRO" in respect of cameras and related equipment and services.

The Panel considers that the disputed domain name is confusingly similar to this mark. The disputed domain name differs from the mark only in the addition of the word "dome", which is descriptive of a shape, and the generic top level domain suffix. Many Internet users would assume that the disputed domain name locates a website relating to products of the Complainant, for example a particular line of such products.

In any event, the Respondent has not disputed that the first requirement of the Policy is satisfied.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the disputed 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 Panel considers that the second requirement of the Policy should be addressed in the circumstances of this case by reference to the criteria identified in the decision in WIPO Case No. D2001-0903, Oki Data Americas, Inc. v ASD, Inc. This approach has been followed in numerous cases decided under the Policy by WIPO Panels and also in several cases by CAC Panels: see, for example, Case No. 100788 Stellar Ltd v David Egelmeers and Case No. 101248 Novo Nordisk A/S v Luca Radu.

According to the Oki Data decision,

"To be 'bona fide,' the offering must meet several requirements. Those include, at the minimum, the following:

- Respondent must actually be offering the goods or services at issue. …

- 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, if, in fact, it is only one of many sales agents. …

- 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 Panel is satisfied that the first, second and fourth of these criteria are met in this case. However, it is necessary to consider more closely the third criterion.

In the Panel's view the disclaimer is inconspicuous, even after it was moved to a more prominent position following the cease and desist letter. Despite being alerted to its presence and looking for it, having read the parties' submissions, the Panel had difficulty finding it. Furthermore, even if seen and read, the disclaimer does not make it clear that the product

offered on the website is not made by or under the control of the Complainant. It merely states that Dome (whatever it is) is a separate company from the Complainant and is not the same as GoPro; it does not, though, also indicate that the product, despite using GoPro in its name, is not licensed or otherwise approved by the Complainant.

Indeed, the extensive use of the name “GoPro Dome” throughout the website as if it is a single brand reinforces the (erroneous) impression given by the disputed domain name that the website is selling a product of the GoPro company, or licensed or authorised by the GoPro company, and not merely a product that works in conjunction with products of the GoPro company.

In addition, the failure of the Respondent to provide a clearer and more conspicuous disclaimer even after receiving the Complainant’s cease and desist letter indicates a desire on the part of the Respondent to continue to benefit from Internet users being given the false impression that the product promoted and sold on the Respondent’s website is a product of the Complainant.

The Panel does not regard the use of the “GOPRO” mark in the name of the Respondent’s product as compatible with US or EU trademark law. It is confusing and unnecessary to indicate the intended use of the Respondent’s product. It does not constitute fair use for the purposes of US trademark law or use in accordance with honest and fair commercial practices within the meaning of EU trademark legislation. Rather, the use of the GoPro mark in the name for Respondent's product appears to be trademark infringement, rather than a fair nominative use. This consideration provides further support for finding that the second requirement of the Policy is satisfied in this case.

In these circumstances the Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

BAD FAITH

As discussed above, the Panel considers the disputed domain name and the general presentation of the Respondent’s website are such as to create the false impression that the product promoted on the website is a product of the Complainant, and not merely a product of a different company which works in conjunction with products of the Complainant.

In the Panel’s view, this must have been intentional on the part of the Respondent. The Respondent obviously knew of the Complainant and the reputation of its GoPro mark, but decided to adopt and use the name “GoPro Dome” as a single brand both in the disputed domain name and in the name of the product. The Respondent provided and retained a plainly inadequate disclaimer even after receipt of the Complainant’s cease and desist letter.

In these circumstances, the Panel considers that the Respondent has intentionally attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant’s mark as to the source or endorsement of the website or the product promoted on it.

Under paragraph 4(b)(iv) of the UDRP, this constitutes evidence that the disputed domain name was registered and is being used in bad faith. More generally, the Panel considers that the disputed domain name was registered and is being used in conjunction with the branding of the Respondent’s product in order to give the false impression that this is a product of the Complainant and thereby appropriate the Complainant’s goodwill to promote its sale.

The Complainant has, to the satisfaction of the Panel, shown the disputed 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 Complainant submitted comments on the Response. The Respondent submitted a motion to strike the Complainant’s additional submission or to permit the Respondent to file its own additional submission.

The Panel considered that the Complainant’s comments on the Response did not contain any point of substance that could

not reasonably have been included in the Complaint. Accordingly, the Panel did not admit the Complainant's additional comments. In these circumstances, there was no need to give further consideration to the Respondent's motion.

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

The disputed domain name incorporates the Complainant's mark in its entirety. The Respondent does not dispute that it is confusingly similar to the mark.

The Respondent is using the disputed domain name for a website that promotes and sells a product intended to be used with the Complainant's cameras. Three of the four criteria identified in the Oki Data decision are satisfied. However, the remaining criterion is not satisfied, since the Respondent's disclaimer is inadequate to make it clear to Internet users that this is not a product of the Complainant, particularly when taken in conjunction with the presentation of the website and the use of the Complainant's mark into the name of the Respondent's product. In these circumstances the Respondent's offering has not been bona fide and the Respondent has not acquired a right or legitimate interest in respect of the disputed domain name.

The Respondent has deliberately incorporated the Complainant's mark into the disputed domain name and the name of its product so as to create the false impression that this is a product of the Complainant, and not merely a product of a different company which works in conjunction with products of the Complainant. Paragraph 4(b)(iv) of the Policy applies. Taking into account all the circumstances, the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GOPRODOME.COM**: Transferred

PANELLISTS

Name	**Jonathan Turner, David H. Bernstein, Geert Valere GLAS**

DATE OF PANEL DECISION 2017-02-09

Publish the Decision