Decision for dispute CAC-UDRP-101418

Case number	**CAC-UDRP-101418**
Time of filing	**2017-01-19 12:47:10**
Domain names	**perspirex.shop, perspirex.online**

Case administrator

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

Complainant

Organization	**Riemann Trading ApS**

Complainant representative

Organization	**BrandIT GmbH**

Respondent

Name	**Ba Nguyen Thi Kim Hoang**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademark registrations across various jurisdictions, including Vietnam, where the Respondent is located, inter alia International registration no. 770743 PERSPIREX, registered on November 21, 2001 for goods in classes 3 and 5.

FACTUAL BACKGROUND

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

AMENDMENT TO COMPLAINT - ADDITIONAL DOMAIN <LANKHUMUIPERSPIREX.COM> ADDED:

At the time of preparing the original complaint with the case number 101415, the domain <lankhumuiperspirex.com> was registered to Cong ty Co Phan Mat Bao. However, the Complainant was notified on February 7, 2017 that the registrant for this domain had changed, and it was now registered to Ba Nguyen Thi Kim Hoang, the same registrant as for the domains listed under case number 101418. Therefore, it was agreed with the CAC to terminate the proceedings for case 101415 and to add the domain <lankhumuiperspirex.com> to this complaint. At the time of writing, on February 10, 2017, this disputed

domain name is an inactive site. The arguments supporting transfer of the disputed domain names as set out below remain the same other than noting that the disputed domain name <lankhumuiperspirex.com> is also to be considered as part of this complaint.

LANGUAGE OF PROCEEDINGS REQUEST:

If the language of the Registration Agreement of any of the disputed domain names is a language other than English, according to the applicable Registrar(s), the Complainant hereby files a language of proceeding request that the language of the proceeding should be English based on the following facts:

The Respondent has not replied to the cease and desist letter (“C&D letter”), nor responded that they did not understand the content of the letter. This conduct has a relevancy when deciding on the language of the proceeding, as it was stated on WIPO Case no. D2015-0298 where the “The Respondent did not reply to the Complainant's request, therefore it did not express in any way that it cannot answer the allegations since it does not understand English.”

The disputed domain names all contain the trademark PERSPIREX, which is owned by the Complainant that is a manufacturer of specialised skin care products with a global presence, which is headquartered in Denmark and whose company´s language is English. In fact, the Complainant operates under the domain names <riemann.com>, <perspirex.com> & <p20.com> with website content predominantly displayed in English. Therefore, the Respondent is aware of the Complainant´s business language in English by using similar information into the disputed domain names.

Finally, the translating of the Complaint would cause unnecessary delay in this matter and the Complainant would be unfairly disadvantaged by being forced to translate, as the translation would raise high costs.

i) ABOUT THE COMPLAINANT AND THE BRAND PERSPIREX

Riemann Trading ApS was founded in 1979 in Denmark by Claus Riemann, who had the vision of creating products with an “objectively identifiable effect”. The company currently focuses on two successful niche brands, an antiperspirant “Perspirex”, and a sunscreen “P20”.

Riemann sells its products in different markets worldwide, including Asia (please see www.perspirex.com). For instance, Riemann sells Perspirex in Malaysia and Singapore through its authorized distributor called OneNine57 Pte Ltd, please see http://www.perspirex.com/ where information about local country distributors can be found.

ii) ABOUT THE TRADEMARK PERSPIREX

The Complainant is the owner of the well-known registered trademark PERSPIREX as a word mark in classes 03 and 05 in numerous countries all over the world including Vietnam being listed as a designation. Inter alia the international trademark registration no. 7707433 registered in 2001.

The international trademark registration of PERSPIREX predates the registration of the Domain Names. Due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, particularly in the highly effective antiperspirant market.

The Complainant has registered more than 37 domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term “PERSPIREX”, for example, <perspirex.com> (created on March 7, 1997), <perspirex.dk> (created on March 11, 1997), <perspirex.co.uk> (created on June 10, 2014) and <perspirex25ml.com> (created on April 22, 2016). The Complainant uses these domain names to connect to a website through which it informs potential customers about its PERSPIREX mark and its products. See Annex 5 for the whois extracts of the the Complainant’s aforementioned domain name registrations.

LEGAL GROUNDS:

i) THE DOMAIN NAMES ARE CONFUSINGLY SIMILAR

The disputed domain names:
• perspirexrollon.com (registered 24.08.16);
• perspirexvn.com (registered 14.08.15);
• perspirexvn.net (registered 14.08.15);
• perspirex.shop (registered 22.09.16);
• perspirex.online (registered 24.08.16); and
• lannachperspirex.com (registered 24.08.2016)
all directly and entirely incorporate the Complainant's well-known, registered trademark PERSPIREX. The addition of the generic Top-Level Domains (gTLD) ".com", ".net", ".shop" and ".online" do not add any distinctiveness to the disputed domain names. See as an example the WIPO Overview on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.2., as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following "In addition, it is generally accepted that the addition of the top-level suffix in the domain names (e.g., ".com") is to be disregarded under the confusing similarity test".

Further, two of the disputed domain names incorporate the PERSPIREX trademark coupled with the letters "vn", which is the commonly known country code for Vietnam, where the Respondent is located. Another couples the PERSPIREX trademark with the term "roll on", while another with the term "lan nach" which is Vietnamese for "roll on". Clearly, the term "roll on" is very closely associated with the Complainant's Perspirex deodorant products. This exaggerates the impression that the Respondent is somehow affiliated with the Complainant, and the Respondent is somehow legitimately doing business using the Complainant`s trademark. For the above reasons, all of the Domain Names should be considered as confusingly similar to the registered trademark PERSPIREX.

ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAMES

The Complainant claims that it has not found that the Respondent is commonly known by the disputed domain names. The WHOIS information "Ba Nguyen Thi Kim Hoang" is the only evidence in the WHOIS record, which relates the Respondent to the disputed domain names. The Respondent has not by virtue of the content of the websites associated with the disputed domain names, nor by its use of the disputed domain names shown that they will be used in connection with a bona fide offering of goods or services.

There is no evidence that the Respondent has a history of using, or preparing to use, the disputed domain names in connection with a bona fide offering of goods and services. It is clear that the Complainant has become a distinctive identifier associated with the term "PERSPIREX" and that the intention of the disputed domain names is to take advantage of an association with the business of Complainant.

THE WEBSITES

As at January 12, 2017, the Respondent has connected the disputed domain names to inactive pages.

Some Panels have found that the concept of passive holding may apply even in the event of sporadic use, or of the mere "parking" by a third party of a domain name as it happens in the current case. See as an example WIPO Overview 2.0, paragraph 3.2.

In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmellows the Panel established that the registration and passive holding of a domain name which has no other legitimate use and clearly references the Complainant's trademark may constitute registration and use in bad faith. In the current case it is clear that Respondent has

registered the disputed domain names in bad faith by intentionally adopting the Complainant's widely known mark in violation of the Complainant's rights.

Further, the inaction in relation to a domain name registration can also constitute a domain name being used in bad faith and any attempt to actively use the disputed domain names would lead to confusion as to the source, sponsorship of the Respondent´s web site among the internet users who might believe that the web site is owned or in somehow associated with the Complainant.

As at January 12, 2017, the Respondent has connected the following Domain Name to an active website:
• <perspirexvn.com> – this is a website which has the look and feel of an official PERSPIREX website. The Respondent is using the disputed domain names to attract internet users to its website where the Respondent claims to be selling PERSPIREX products from Denmark. A common misunderstanding with authorized or non-authorized distributors is that they also believe that they can freely register domain names incorporating the trademark name of the products they are offering services on. It must be noted that the Complainant does not have any agreement or association with the Respondent. The website's layout including the PERSPIREX logo appears prominently on the top left and strongly suggests that there is a connection with the Complainant. Given that the prominent use of the Complainant's trademark on the Respondent's website strongly suggests that there is a connection with the Complainant. The general look and feel by adopting the Complainant's logo and imagery supports a finding that the Respondent would like to come across as the Complainant. This is far from the truth and the Complainant is actively pursuing several parties based in Vietnam who are making unauthorized use of the Complainant's registered trademarks. The use of the word PERSPIREX in the disputed domain names and also in the text of the website multiple times strongly suggest that here is some official or authorized link with the Complainant for the purposes of selling the products within Vietnam. It is abundantly clear that the Respondent knew about the existence of the PERSPIREX trademark. In the light of the Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903, the use of a trademark as a domain names by an authorized or non-authorized third party is only to be regarded as a bona fide offering of goods or services within the meaning of paragraph 4(c) of the Policy if the following conditions are satisfied:

• 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, if, in fact, it is only one of many sales agents;
• the respondent must not try to corner the market in all domain namess, thus depriving the trademark owner of reflecting its own mark in a domain name.

As mentioned previously, the Respondent fails at least two of these tests, namely:
• Firstly, we note that there is no distribution agreement between the Complainant and the Respondent.
• Secondly, the Respondent does not publish a disclaimer on the challenged pages. On the website connected to disputed domain name there is no statement disclaiming a relationship or association with the Complainant. The website includes at the bottom of the website the following sentence: "Copyright – Perspirex VN", which does not in any way satisfy this disclaimer requirement.
• Thirdly, The Respondent is depriving the Complainant of reflecting its own mark in the disputed domain names.
• Finally, the Respondent presents themselves as the trademark owner by using the Complainant`s official PERSPIREX trademark (word mark). Further, packaging images and a photograph on the website connected with the disputed domain name are seemingly identical to images used by the Complainant on the official <perspirex.com> website.

The Respondent's use of the disputed domain names creates an overall impression that they are the Complainant. In the present case, the Respondent does meet at least two of the Oki Data criteria. It is undeniable that the Respondent was aware of the Complainant's marks prior to the acquisition of the disputed domain names and the establishment of the Respondent's website. The Respondent has made no claims to either having any relevant prior rights of its own, or to having become commonly known by the disputed domain names. Clearly,the Respondent is not known by the disputed domain names, nor does the Respondent claim to have made legitimate, non-commercial use of the disputed domain names.

In the present case, the Respondent has been granted several opportunities to present compelling arguments that it has rights in the disputed domain names but has failed to do so. This behavior coupled with the use of the disputed domain names cannot be considered as legitimate use of the disputed domain names.

iii) THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

It has to be highlighted that the Complainant's trademark registrations predate the registration of the disputed domain names and the Respondent has never been authorized by the Complainant to register the disputed domain names. In light of the website content associated with one of the disputed domain names, it is clear that the Respondent was aware of the Complainant's trade mark at the time of registration and, therefore, the disputed domain names were registered in bad faith.

As at October 20, 2016 the disputed domain names were all registered under the name Ton Quan Hieu, with the email address quanghieu.ton@gmail.com. A cease and desist letter was sent to that registrant, but no answer was received.

As at January 2017, when this Complaint was being prepared, the registrant details according to the whois record had changed - however it must be noted that the oficial email address provided remained the same. For this reason, the Complainant again tried to contact the Respondent on January 13, 2017 through a cease and desist letter, noting the disputed domain names. The letter was sent to the email address listed in the whois record. In the cease and desist letters the current and previous registrant (noting both whois records include the same email address), the Complainant advised the Respondent that the unauthorized use of its trademarks within the disputed domain names violated their trademark rights and the Complainant requested a voluntary transfer of the disputed domain names. However, no official reply was received to the second correspondence either.Respondent has simply disregarded such communication. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the UDRP process. It has been mentioned in earlier cases that the failure of a respondent to respond to a cease and desist letter, or a similar attempt at contact, has been considered relevant in a finding of bad faith, e.g., News Group Newspapers Limited and News Network Limited v. Momm Amed Ia, WIPO Case No. D2000-1623; Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598; and America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460.

THE WEBSITE

From the Complainant's point of view, the Respondent intentionally chose the disputed domain names based on the registered and well-known trademark in order to generate more traffic to its own business. Nowhere does the Respondent disclaim an association between itself and the Complainant. One of the disputed domain names is currently connected to website claiming to sell the Complainant's products, consequently, it is clear the Respondent is using the disputed domain names to intentionally attempt to attract, for commercial gain, internet users to the website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

Moreover, The Respondent takes advantage of the PERSPIREX trademark by intentionally attempting to attract visitors to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or a product or service on the Respondent's website or location.

From the Complainant's point of view, the Respondent intentionally chose the disputed domain names based on a registered and well-known trademark in order to only use it for non-legitimate purposes.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 disputed domain names (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are 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 disputed Domain Names all incorporate the Complainant's highly distinctive and well established trademark PERSPIREX. It is well established that a domain name that wholly incorporates a trademark may be confusingly similar to such trademark for purposes of the Policy despite the addition of generic terms, such as "vn" (Vietnam's country code), "lan nach" (Vietnamese for "roll on"), "roll on" or "lan khu mui" (Vietnamese for "lyrics").

2. The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain names. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent did not deny these assertions in any way and therefore failed to prove any rights or legitimate interests in the disputed domain names.

3. The Panel is satisfied that the Respondent registered the disputed domain names with full knowledge of the Complainant and its rights in the trademark PERSPIREX as such trademark is highly distinctive and as the Respondent used one of the disputed domain names in connection with a website claiming to sell the Complainant's products. The Panel is also satisfied that the disputed domain names have been used in bad faith under paragraph 4(b)(iv) of the Policy (<perspirexvn.com>) and the principles of passive holding (<perspirexrollon.com>, <perspirexvn.net>, <perspirex.shop>, <perspirex.online>, <lannachperspirex.com>, and <lankhumuiperspirex.com>), respectively.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PERSPIREX.SHOP**: Transferred
2. **LANNACHPERSPIREX.COM**: Transferred
3. **LANKHUMUIPERSPIREX.COM**: Transferred
4. **PERSPIREX.ONLINE**: Transferred
5. **PERSPIREXROLLON.COM**: Transferred
6. **PERSPIREXVN.COM**: Transferred
7. **PERSPIREXVN.NET**: Transferred

PANELLISTS

Name	**Peter Müller**

DATE OF PANEL DECISION 2017-03-27

Publish the Decision