Decision for dispute CAC-UDRP-101555

Case number	CAC-UDRP-101555
Time of filing	2017-06-02 10:29:21
Domain names	oneillboardshorts.com

Case administrator

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

Complainant

Organization	O'Neill Brand S.à r.l

Respondent

Organization	DVLPMNT Marketing, Inc.

OTHER LEGAL PROCEEDINGS

The Complainant has not provided any information about other legal proceedings. Indeed, the Complainant's letter to the Respondent of 26 April 2017 states that (the Complainant) 'will reserve the right to initiate further action including but not limited to filing an UDRP' if a 'satisfying response' is not received. Nonetheless, in the absence of any evidence to the contrary, the Panel proceeds on the basis that no other proceedings which relate to the disputed domain name are pending or have been decided.

IDENTIFICATION OF RIGHTS

The Complainant has listed, and provided documentary evidence regarding, the following trademark registrations (in the name of Sisco Textiles or O'Neill Incorporated).

International registration no. 572361, registered on May 31, 1991
US registration no. 1339268, registered on June 4, 1985
US registration no. 1069298, registered on July 12, 1977
US registration no. 1183040, registered on December 22, 1981
EUTM registration no. 008499782, registered on May 17, 2010

FACTUAL BACKGROUND

The Complainant O'Neill Brand S.à r.l. holds a worldwide exclusive license (from Sisco Textiles N.V., the legal owner of the trademark rights noted above) to license intellectual property rights regarding the O'Neill brand, and in 1997 registered the domain name <ONEILL.COM>.

"O'Neill" is a brand used in respect of apparel and the like, related to surfing, skiing and so forth. The Complainant contends that 'the O'Neill designs are renowned for their sporty and trendy look and fit and are highly popular throughout the world' and that the brand has been in use since 1952.

PARTIES CONTENTIONS

No administratively compliant Response has been filed. The Case Administrator has reported that the written notice has not been returned (nor the advice of delivery), and cannot determine whether it has in fact been received. The Administrator did receive confirmation that e-mails sent to all identifiable addresses were successfully relayed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown 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).

The Complainant has identified a number of relevant marks (see for instance Community Trade Mark 008499782, currently active and in force since 2010, in a number of classes, such as class 25 'clothing, footwear, headgear; sportswear apparel and casual clothing [...]'). These marks relate to the string O'NEILL. This is not identical to the disputed domain name <ONEILLBOARDSHORTS.COM>. Nonetheless, is it confusingly similar?

The first question relates to the difference between ONEILL and O'NEILL - that is, the apostrophe. The Complainant's submission is silent on this question. The apostrophe is a significant feature of English grammar, and cannot be completely ignored. However, the Panel is aware that the domain name system as initially designed envisages a narrow range of permissible characters, essentially confined to the letters and numbers typically used in English along with a small number of punctuation marks. In many respects, this is narrower than the international trademark system. Although the introduction of internationalised domain names in respect of some TLDs has addressed this historic oversight in a number of areas, the Panel can take note of how cases in which similarity turns on the handling of the apostrophe have been determined. (Interestingly, it seems that this specific question has not yet been the subject of a Panel decision within the CAC in respect of the UDRP, although there have been a number of cases concerning somewhat related issues such as the replacement of a space with a hyphen). Looking more broadly, however, the Panel can observe that the presence or absence of an apostrophe, while potentially of grammatical or linguistic significance, can still mean that visual similarity is established (see WIPO D2017-0726 <LOWWS.COM>; D2016-1221 <BILLYBOBS.COM>) and that such similarity is confusing (see for instance NAF 203944 <KIELS.COM>).

A second question relates to the difference between ONEILL and ONEILLBOARDSHORTS. In terms of similarity, it is well established that the addition of a generic or descriptive term to that term in which a Complainant has rights is often no barrier to a finding of confusing similarity. The Complainant submits that, in this case, the descriptive term ('board shorts') increases the prospect of confusing similarity, because it is one of the products commonly sold under the name O'Neill. A helpful set of examples of this phenomenon is set out in a decision of a CAC Panel in respect of .eu (interpreting in this context a comparable requirement as under the UDRP): Case 06295 <BENEFITCOSMETICS.EU> and well summarised in CAC 101296 <MAERSK-CARGO.COM> as where a 'domain name consists of the Complainant's well-known mark together with a word descriptive of its primary service and the generic top level domain suffix'.

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 name (within the meaning of paragraph 4(a)(ii)of the Policy).

In this respect, the lack of any participation on the part of the Respondent makes it difficult for the Panel to identify a relevant right or legitimate interest.

The Complainant has declared that the Respondent has no connection or affiliation with it and has not received any license or consent, express or implied, to use the O'Neill Trademarks.

As noted, the Respondent has not provided any evidence to the contrary, and the Panel has not been able to identify any relevant rights or legitimate interests. As such, this second element has also been satisfied.

BAD FAITH

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).

The most relevant aspect of paragraph 4(a)(iii) of the Policy that arises in this Case is that set out in paragraph 4(b)(iv) of the Policy: that the Respondent has 'intentionally attempted to attract, for commercial gain, Internet users to [the] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the] web site or location or of a product or service on [the] web site or location'. To a certain extent, evidence of other factors (e.g. prevention of registration or an intention to sell for valuable consideration in respect of the Complainant or its competitors) is also adduced.

In particular, the Complainant has described how the web page at the disputed domain name 'consists of two lists of pay-per-click links, one of which displays advertisements pertaining to the keyword "boardshort", third-parties websites and to other brands as such as Quiksilver, Hurley or Billabong'. As such, the intention to attract users for commercial gain is reasonably clear.

The Respondent has taken no positive steps, to the knowledge of the Panel, to displace the possible likelihood of confusion. Moreover, the deliberate registration of a name combining a version of the name in which rights are held, along with a descriptive term specifically relating to the subject matter of said rights, creates a clear presumption of knowledge and intention.

For the sake of completeness, the Panel does note that the disputed domain name was registered by the Respondent in 2006. Where a Respondent registers a domain name prior to the establishing of the rights of the Complainant, bad faith is more difficult to establish. In the present case, however, the Complainant has held a range of registrations continuously and well in advance of this date, even if certain of the registrations included in the Complaint postdate the registration of the disputed domain name.

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.

The Panel nonetheless records its dissatisfaction with certain aspects of the Complaint, which appear to have been reproduced without editing from previous correspondence between the Parties. The Complaint states that 'Finally, the record shows that your company is engaged in a pattern of registering domain names that bear striking resemblance to third parties' trademarks'. However, the Complaint ought to be addressed to the Panel and not to the Respondent. While it is appropriate for prior correspondence to be re-used, this ought to be done in a way that makes for a clear set of legal submissions for the use of and addressed to the Panel. Moreover, the Complainant's failure to declare, for instance, that no other proceedings are pending or active, is not helpful.

PRINCIPAL REASONS FOR THE DECISION

The reasons for the decision are as set out under the various components, above.

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed Domain Name <ONEILLBOARDSHORTS.COM>. On the other hand, it is clear that the Complainant has rights in respect of the trademark O'NEILL. In light of the evidence presented regarding the use of the disputed domain name by the Respondent, and the legal findings as set out above, the Panel can find that the disputed domain name is being operated in bad faith. The requirements for the acceptance of a Complaint under paragraph 4 of the UDRP have therefore been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ONEILLBOARDSHORTS.COM**: Transferred

PANELLISTS

Name	**Dr Daithi Mac Sithigh**

DATE OF PANEL DECISION 2017-07-12

Publish the Decision