Decision for dispute CAC-UDRP-101544

Case number	CAC-UDRP-101544
Time of filing	2017-07-18 10:32:13
Domain names	FABER-APPLIANCE-REPAIR.ONLINE

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Faber S.P.A.

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	Websitefor1000

OTHER LEGAL PROCEEDINGS

To the knowledge of the Panel, there is no other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registerd owner of FABER trademarks, which are protected on a worldwide basis, and especially in India.

The Complainant owns rights on the following trademarks:

- Indian trademark FABER (word and device) No 723816 in class 11 filed on June 17, 2006
- Indian trademark FABER No 1684284 in classes 11, 21 filed on June 5, 2008
- Indian trademark FABER (word and device) No 355037 in class 21 filed on November 30, 2016
- International registration FABER No 1343497 in classes 11, 21 filed on November 30, 2016

The disputed domain name was created on May 3, 2017 and resolves to a website "Faber Repair Services".

FACTUAL BACKGROUND

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

i) ABOUT COMPLAINANT AND THE BRAND FABER

The Complainant, Faber S.P.A. is the owner of the FABER trademarks.

Back in 1955 Abramo Galassi established Faber Plast srl. He wanted to invent something new and to grow. With three partners and the help of a single worker he turned plastic into objects for the house. Mr Galassi's business pioneered a whole new world when it invented the kitchen hood in 1963. Since then, Faber has transformed the hood from a humble furnishing accessory into an essential item of kitchen equipment – safe, stylish and functional.

In August 2004, the Swiss Franke Group became the main shareholder of Faber SpA and confirmed the common vision and strong synergies between the two groups. In 2005 Faber was fully integrated into the Franke Group, where it plays an important role as Business Unit.

Today, the Faber Group of industries operates in 8 countries and on 3 continents with a global leadership and outlook.

Indian Business Activities

FABER is India's No.1 Hoods and Hobs brand. In total, over 250 employees produce more than 300 products in the Pune plant with current production capacity of 150,000 hoods, 100,000 hobs and 50,000 other kitchen appliances per annum.

Recognizing the importance of an extensive network towards scripting a long-term success story, Complainant has over 2,000 retail counters for sales and service across India.

A crucial element of Complainant's strategy is to establish a long-term presence in India. The company made an initial investment of Rs. 50 crore in its manufacturing plant in Sanaswadi, Pune which has been operational since 2012. This investment represented the biggest investment the group had made outside Europe at the time. The new plant meets the global standards of FABER on productivity, throughput, quality, finishes and safety. The plant uses futuristically designed state-of-the-art equipment and will be the export hub for Asia Pacific and Middle East regions.
FABER also relocated its one of the R&D bases from Europe to India in 2012.

The Complainant has also invested significantly to promote the FABER trademark and brand in the Indian market, including through this quality television commercial:

Complainant enjoys a high degree of renown around the world, including in India where Respondent is domiciled.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

LEGAL GROUNDS:

i) THE DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain <faber-appliance-repair.online> (hereinafter referred to as the "disputed domain name"), registered on May 3,

2017, directly and entirely incorporates Complainant's well-known, registered trademark FABER. The addition of the generic Top-Level Domains (gTLD) ".online" does not add any distinctiveness to the disputed domain name (see WIPO Jurisprudential Overview 3.0, paragraph 1.11.2). The disputed domain name incorporates the FABER trademark coupled with the English words "appliance" and "repair", terms which are closely connected to Complainant´s business. These references exaggerate the impression that Respondent is somehow affiliated with Complainant, and Respondent is somehow doing business using Complainant`s trademark. See also 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 name (e.g., ".com") is to be disregarded under the confusing similarity test". This reasoning should apply here and the disputed domain name should be considered as confusingly similar to the registered trademark FABER.

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

Complainant has not found that Respondent is commonly known by the disputed domain name. The WHOIS information "Zohib Shaikh" is the only evidence in the WHOIS record, which relates Respondent to the disputed domain name. Respondent has not by virtue of the content of the website, nor by its use of the disputed domain name shown that they will be used in connection with a bona fide offering of goods or services. When entering the terms "FABER" and "INDIA" on Google engine search, returned results point to Complainant and its business activity. The Respondent could easily perform a similar search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by Complainant and that the Complainant has been using its trademarks extensively in India.

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

THE WEBSITE

At the time of filing this complaint, Respondent was using the disputed domain name to attract internet users to its website where Respondent states that it is respectively "Faber Service Center", "Faber Repair Service" and "Faber Service Center Mumbai", "Faber Appliane Repairs" (typo in "Appliance" deliberately reproduced as shown on the website). A common misunderstanding with authorized or non-authorized repair centers is that they also believe that they can freely register domain names incorporating the trademark name of the products they are offering services on. In the current case, Respondent is not an authorized repair center. The use of the trademark FABER prominently throughout website on at least 12 occasions strongly suggests that there is a connection with Complainant. Moreover, the use of the word FABER (i) in the disputed domain name and (ii) also on multiple occasions in the website text further created the impression that there is some official or authorized link with Complainant in relation to repairs and services, especially in the Indian market. As noted previously, the trademark FABER is a well-known trademark in India and given the references to this mark on the website, it is clear that Respondent knows about it's existence.

In addition, the website invited visitors to contact Respondent via the telephone number 8080808861 or the "Enquiry Form" accessible on every page. See WIPO Case No. D2015-1024 Steven Madden, Ltd. v. Daniel Monroy where Respondent collected personal information from Internet users visiting the website (name, phone number, email address, age etcetera) who filled out a form, where the Panel noted that: "users presumably would not provide such data unless they believe they are dealing with Complainant or with a representative of Complainant….since personal data are a valuable commodity, eliciting such data as described is not a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers, pursuant to Policy paragraph 4(c)(iii)". This finding should also apply here declaring that Respondent's attempt to "phish" for users' personal information is neither a bona fide offering of goods and services nor a legitimate noncommercial or fair use pursuant to Policy.
Following Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903, the use of a trademark as a domain name 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 names, thus depriving the trademark owner of reflecting its own mark in a domain name.

As mentioned previously, the Respondent fails these tests, namely:

• Firstly, Respondent is not offering the Complainant's products or services through the disputed domain name, but rather appears to be offering an appliance repair and maintenance service;
• Secondly, Respondent does not publish a disclaimer on the challenged pages. On the website connected to disputed domain name there is no a proper statement disclaiming a relationship or association with Complainant;
• Thirdly, Respondent is depriving the Complainant of reflecting its own mark in the disputed domain name; and,
• Finally, Respondent presents themselves as the trademark owner by using Complainant`s official FABER trademark (word mark).

Respondent's use of the disputed domain name created an overall impression that they are the Complainant. In the present case, Respondent does meet all the Oki Data criteria. It is undeniable that Respondent was aware of Complainant's marks prior to the acquisition of the disputed domain name and the establishment of Respondent's website. 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 name. Clearly, Respondent is not known by the disputed domain name, nor does Respondent claim to have made legitimate, non-commercial use of the disputed domain name.
Respondent has been granted several opportunities to present some compelling arguments that it has rights in the disputed domain name but has failed to do so. This behavior coupled with the use of the disputed domain name cannot be considered as legitimate use of the disputed domain name.

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

THE DOMAIN NAMES WERE REGISTERED IN BAD FAITH

It has to be highlighted that Complainant's trademark registrations predate the registration of the disputed domain name and Respondent has never been authorized by Complainant to register the disputed domain name. Moreover, the active business presence, growth and success of Complainant in the Indian market in the last years shows that it seems to be unlikely that Respondent was not aware of the unlawful registration of the disputed domain name.

THE DOMAIN NAME IS BEING USED IN BAD FAITH

Complainant tried to contact Respondent on May 19, 2017 through a cease and desist letter. Reminders were sent on May 29, 2017 and June 6, 2017. The letter was sent to the email address that was listed in the whois record at the time the cease and desist letter was sent; i.e. May 19, 2017. In the cease and desist letter, Complainant advised Respondent that the unauthorized use of its trademarks within the disputed domain name violated their trademark rights and Complainant requested a voluntary transfer of the disputed domain name. However, no reply was received. Respondent simply disregarded such communications. Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant filed this 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

In the WIPO case no. D2014-1010 M. & B. Marchi e Brevetti Srl - Limited Liability Company v. A Gurbulak As / Webbilisimhizmetleri / Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Zafer Gurbulak concerning among others the domain names <ankaraaristonservisi.net>, <ankaraaristonservisleri.com>, <ankaraaristonservisleri.net> where similar circumstances to the current case were established, the Panel noted that:

“The Respondent's active websites associated with the disputed domain names appear to offer repair services for Ariston branded products. Therefore, the Respondent was aware of the Complainant's trademark ARISTON at the time the disputed domain names were registered.”

“The fact that the Respondent’s active website uses the Complainant’s trademark ARISTON multiple times in bold letters and states that the Respondent provides original spare parts with “ARISTON Service Assurance” suggests that the respondent is affiliated with the Complainant when it is actually not the case. The Panel has noted the presence of a small disclaimer on the active website but finds it insufficient in the circumstances, especially given that it is very general and does not make specific reference to the Complainant. In the circumstances, and as indicated before, the Panel considers that the use made of the active websites associated with the disputed domain names does not qualify as a bona fide offering of goods or services under the Policy.”

The same circumstances apply in this case. Further, Respondent has never been granted permission to register the disputed domain name. Respondent was taking advantage of the FABER trademark by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s products, services, website or location.

From the Complainant’s point of view, Respondent intentionally chose the disputed domain name based on registered and well-known trademark in order to generate more traffic to its own business. Nowhere does Respondent disclaim an association between itself and Complainant. The disputed domain name is currently connected to a service center website, consequently, Respondent is using the disputed domain name to intentionally attempt to attract, for commercial gain, internet users to the website, by creating a likelihood of confusion with Complainant’s trademarks as to the source, sponsorship, affiliation or endorsement of its website. This conduct has been considered as bad faith under the Policy, and other WIPO decisions have also arrived to the same conclusion, for example Philip Morris Incorporated v. Alex Tsypkin, WIPO Case No. D2002-0946, where the Panel stated:

“It follows from what has been said about legitimacy that the Panel is satisfied that Respondent is using the disputed domain name intentionally to attempt to attract, for commercial gain, Internauts to his web site by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation or endorsement of his web site. Pursuant to Policy paragraph 4(b)(iv), this constitutes evidence of both bad faith registration and bad faith use, for the purposes of paragraph 4(a)(iii).

In the WIPO case no. D2015-0579 AB Electrolux v. Guangzhou Nan Guang Electrical Appliances Co.Ltd. concerning the domain name zanussi-china.com with similar circumstances as the current case, the Panel noted that:

“The Respondent is using the Domain Name for a website with an orange and black livery, which displays the mark ZANUSSI in a large, black font in the banner and photographs of the Complainant's group's ZANUSSI products... The Panel accepts the Complainant's evidence that the Respondent's website is liable to mislead customers into believing that it is a website of the Complainant or authorized by it. This evidence is well-substantiated by the nature of the Domain Name, the absence of any statement that the Respondent is not authorized by the Complainant's group, the prominent ZANUSSI mark in the banner, the orange and black livery, and the pictures of the Complainant's group's products. Furthermore, having regard to all the circumstances, the Panel considers that it was the Respondent's intention so to mislead customers.”

Similarly, in the WIPO case no D2014-0487 Aktiebolaget Electrolux v. electroluxmedellin.com, Domain Discreet Privacy Service / Luis Rincon where analogous circumstances were at hand the Panel stated:

“The continuing use of the disputed domain name is clearly confusing to online users who will be attracted by the inclusion of the word ELECTROLX in the disputed domain name, and who will therefore believe that they are accessing a website that is in some way associated with or authorized by the Complainant. This is not the case, and the consumer confusion is further strengthened by the fact that there are services for Electrolux products advertised on the Respondent's website without any disclaimer of association with the Respondent.”

The Respondent takes advantage of the FABER 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.

Complainant has conducted thorough searches to try to establish whether Respondent would have any rights in the name through Google searches. Complainant did not find that the Respondent has any registered rights in the names or has become known under the name.

Finally, Complainant’s trademark registrations predates Respondent’s domain Name registration. These cumulative factors clearly demonstrates that Respondent should be considered to have registered and to be using the disputed domain name in bad faith as stated at the WIPO case No. D2016-0456 Amis Paris v. Amiparis, Amipa, where the Panel found out the following:

“Based on the evidence presented to the Panel, including the late registration of the disputed domain name which includes to the Complainant’s marks, the confusing similarity between the Complainant’s trademark and the disputed domain name, the Respondent’s failure to reply to the cease-and-desist letter, the failure of the Respondent to respond to the Complaint and the Respondent’s passive holding of the disputed domain name, the Panel draws the inference that on balance the disputed domain name has been registered and is being used in bad faith.”

To summarize, FABER is a well-known trademark in the kitchen appliances industry including India where Respondent is located and where the website associated with the disputed domain name is operating under several related variants of the phrase “Faber Repair Service Center”. It is clear on the evidence that Respondent was aware of the rights Complainant has in the trademark and the value of said trademark, at the point of the registration. Inference of bad faith registration and use of the disputed domain name is also given by the fact that Respondent never replied to Complainant’s cease and desist letter nor reminders. It is reasonable to assume that if Respondent did have legitimate purposes in registering and using the disputed domain name it would have responded to defend it’s rights. In addition, Respondent did not meet the Oki Data principles on all elements: lack of a distinctive disclaimer; Respondent can be regarded to corner the market preventing Complainant from operating the disputed domain name; and they represent themselves as the trademark owner by displaying Complainant’s trademark at least 12 times on the website. Consequently, Respondent should be considered to have registered and to be using the Domain Name in bad faith.

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 clearly established its registered rights in the FABER trademark.

The disputed domain name <faber-appliance-repair.online> is composed of the FABER trademark to which the terms “appliance” and “repair” are added.

These terms are generic terms designating the services which are offered on the website, in relation with the FABER branded products, or with other products. They do not differentiate the disputed domain name from the FABER trademark, nor does the addition of the gTLD “.online”, which means that the services are offered “online” .

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).

As set forth by paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent's rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to the respondent of the dispute, its use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent did not respond neither to the C&D letters nor to the Complaint. Consequently it did not provide any evidence or circumstances to establish that it has rights or legitimate interests in the disputed domain name, according to paragraph 4(c) of the Policy.

The Respondent did not make a bona fide offering of goods or services or a noncommercial use of the disputed domain name.

The Respondent has no personal right on FABER. It has not been licensed or authorized to use the FABER trademark or to register the disputed domain name. It uses the disputed domain name to resolve to a website the content of which does not mention any disclaimer. The FABER trademark is reproduced on this website, which offers appliance and repair services for FABER branded products and also for cooking ranges, without clear limitation to FABER cooking ranges .

It means that the website is used to offer services for the trademarked goods and possibly for other branded products, without even disclosing the Registrant's relationship with the trademark holder. It invites the internet users to contact the Respondent by telephone or by using the "inquiry form" available on each page of the website. Using this "inquiry form" enables the Respondent to collect personal data from internet users who may believe that they are contacting the FABER trademark owner or any other duly authorized third party.

Accordingly, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has 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).

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by the Panel to be evidence of bad faith registration and use of a domain name. It provides that:

"For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the

mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location."

The Complainant relies on the well-known character of the FABER trademark in India, where the Respondent is domiciled.

Given the use of the disputed domain name, the Respondent could not ignore the Complainant's rights in the FABER trademark when it registered the disputed domain name <faber-appliance-repair.online>.

The Panel finds that the disputed domain name was registered in bad faith to disrupt the Complainant's business and possibly harm its reputation.

The Panel finds that by using the domain name, Respondent intentionally attempted to attract, for commercial gain, Internet users to its 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 its web site or location or of a product or service on its web site or location", in the meaning of paragraph 4(b) (iv) of the Policy.

Therefore, the condition set out by paragraph 4(a)(iii) of the Policy has been met by the Complainant.

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

The disputed domain name is composed with the Complainant's FABER trademark, adding generic termes which do not avoid any likelihhod of confusion.

The Respondent has no personal right on FABER. It has not been licensed or authorized to use the FABER trademark or to register the disputed domain name. It uses the disputed domain name to resolve to a website the content of which does not mention any disclaimer.

Given the use of the disputed domain name, the Respondent could not ignore the Complainant's rights in the FABER trademark when it registered the disputed domain name <faber-appliance-repair.online>.

The Panel finds that the disputed domain name was registered in bad faith to disrupt the Complainant's business and possibly harm its reputation.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FABER-APPLIANCE-REPAIR.ONLINE**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2017-08-23

Publish the Decision