Decision for dispute CAC-UDRP-101612

Case number	CAC-UDRP-101612
Time of filing	2017-09-15 10:54:34
Domain names	steiffteddybears.xyz

Case administrator

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

Complainant

Organization	Margarete Steiff GmbH

Complainant representative

Organization	SKW Schwarz

Respondent

Organization	Code Zone Inc.

OTHER LEGAL PROCEEDINGS

The panel is not aware of any other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

- EU Trade Mark registration No 000007443 ‘Steiff’; Nice classes 18, 25, 28, registered 3 February 1998
- International Registration No 947107 ‘Steiff’ (Japan, Republic of Korea, Norway, USA; Switzerland, China, Russian Federation, Ukraine); Nice classes 3, 9, 12, 20, 21, 24, 26, 27, 28; registered 13 September 2007
- International Registration No 1240894 ‘Steiff’ (EU, Japan; China, Switzerland); Nice class 35; registered 13 January 2015
- International Registration No 933947 ‘Steiff KNOPF IM OHR’ (Japan, Norway, USA; Switzerland; China; Russian Federation); Nice classes 09, 12, 20, 21, 24, 26, 27, 28; registered 10 May 2007
- Canadian Trademark registration No 1333244-00 ‘Steiff’; Nice classes 18, 22, 24, 28; registered 16 February 2010
- German Trademark registration No 724750 ’Steiff Teddybär’; Nice Class 28; registered 24 May 1958

FACTUAL BACKGROUND

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

The Complainant contents that the the disputed domain registration infringes the Complainant’s trademarks and right to the

company name and presents the following argumentation:

The disputed domain name is confusingly similar to the Complainant's trademarks and company name since it contains the word 'Steiff'. The component 'teddybears.xyz' can be neglected as it is merely a descriptive term for the Complainant's most famous product. The distinctive character of the domain name is thus coined by the word 'Steiff'.

I. Lack of Rights or legitimate Interests

Nothing indicates that the Respondent has any rights or legitimate interests in respect of the disputed domain name. The Respondent has neither been authorized by the Complainant to register the disputed domain name, nor has the Respondent acquired a legitimate right to use Steiff – trademarks by any preceding or current business activity. The website uploaded under the domain name steiffteddybears.xyz is merely a collection of links to individual offers on Ebay and random content relating to teddy bears. The Respondent undoubtedly seeks to make financial gains from these links. The display of such content does not constitute a legitimate use. The sole purpose of the disputed domain name registration is to create a danger of confusion in order to commercially exploit the reputation of the name and trademark 'Steiff'. Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, 2017, section 2.9; WIPO Case: Lardi Ltd v. Belize Domain WHOIS Service Lt in Case No. D2010-1437). Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name (Oki-data test – see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, 2017, section 2.8). However, the Respondent is not rendering any of such services as it merely shows a collection of links to Ebay. Even if the Oki-Data criteria were applied, the Respondent does not meet the criteria.

(1) The Respondent must actually be offering the goods or services at issue.
The Respondent does not sell teddy bears but provides a list of links. Panels have found that PPC websites do not normally meet the Oki Data requirements as they do not themselves directly offer the goods or services at issue (Johnson & Johnson v. Ebubekir Ozdogan, WIPO Case No. D2015-1031, <desitin-pisik-kremi.com> and <listerineturkiye.com>; PRL USA Holdings, Inc. v. LucasCobb, WIPO Case No. D2006-0162; Beyoncé Knowles v. Sonny Ahuja, WIPO Case No. D2010-1431, <beyoncefragrance.com>).

(2) The Respondent must use the site to sell only the trademarked goods.
Toys of different origin can be found on the website, for example:
• ANTIQUE GERMAN TEDDY BEAR 1910s ART BING BEAR CHARACTER BEAR 15.8
• ANTIQUE BING TEDDY BEAR 1910s HUGE 31.5 HUNCHBACK CHARACTER BEAR VERY RARE
• ANTIQUE TEDDY BEAR 1920s MOHAIR FUR & HUNCHBACK RARE WEIERSMÜLLER
• ANTIQUE TEDDY BEAR 1910s HUNCHBACK CHARACTER TEDDY BEAR SAILOR
• ANTIQUE BING TEDDY BEAR 1910-1920s HUNCHBACK CHARACTER BEAR VERY RARE NECKBAND

(3) The site itself must accurately disclose the respondent's relationship with the trademark owner.
No such information is disclosed on the website.

II. Bad Faith

By using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, 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 respondent's website or location or of a product or service on the respondent's website or location. To facilitate assessment of whether this has occurred, and bearing in mind that the burden of proof rests with the Complainant, UDRP paragraph 4(b) provides that this scenario constitutes evidence of a respondent's bad faith. The

Respondent seeks to attract the consumers' attention to its website using the famous and most distinctive trade mark and company name of 'Steiff'. The trade mark and company name are unfairly exploited for the Respondent's commercial interest. This is underlined by the fact, that not only Steiff products but also other plush toys are shown on the website.

The warning letter of the Complainant pointing out the legal situation and setting a reasonable deadline for the transfer of the domain remained unanswered. The Respondent therefore not only refused to comply with the Complainants demands, but did not bring forward any legal or factual arguments to his defense. This indicates that the registration was conducted in bad faith (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, 2017, section 3.2.1).

A copy of the response including any annexes has been sent or transmitted to the Complainant, in accordance with Paragraph 2(b) of the Rules.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

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).

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).

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

I. RIGHTS

The disputed domain name is confusingly similar to the Complainant's registered trademarks since it reproduces the Complainant's mark 'Steiff', merely adding the generic expression "'teddy bears'" at the end, which merely describes the Complainant's most famous product.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any reply. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the disputed domain name.

"As mentioned above in section 3, the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed domain name, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists. WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>"

Furthermore, apparently the Respondent did not reply to the C&D letter sent by the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant´s allegations and evidence with regard to the Respondent´s registration and use of the disputed domain name in bad faith.

Paragraph 4(b) (iiii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of a product or service on its website or location.

The Complainant's Steiff trademark was well known precisely for "teddy bears", well before the registration of the disputed domain name. The Respondent's registration of the disputed domain name wholly incorporating a well-known thirdparty mark is, in the Panel´s view, indicative of bad faith.

Currently, the Respondent´s website is not active, but the Complainant has proven that in the past not only Steiff products but also other plush toys are shown on the website. Therefore, the Complainant´s trade mark and company name are unfairly exploited for the Respondent’s commercial interest.

As mentioned in Andrey Ternovskiy dba Chatroulette v. Alexander Ochki, WIPO Case No. D20170334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see AT&T Corp. v. Amjad Kausar, WIPO Case No. D20030327)."

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **STEIFFTEDDYBEARS.XYZ**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2017-10-30

Publish the Decision