Decision for dispute CAC-UDRP-101692

Case number	CAC-UDRP-101692
Time of filing	2017-10-04 08:55:48
Domain names	TWMERRELL.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Wolverine World Wide Inc.

Complainant representative

Organization	Seyfarth Shaw LLP

Respondent

Organization	Pumo Network Digital Technology Co., Ltd

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant's subsidiary, Wolverine Outdoors, Inc., is the owner of the following trade mark registrations:

- MERRELL (United States), Reg. No. 1835495, registered on 10 May 1994 (class 25 for “hiking boots and climbing boots”);

- MERRELL (United States), Reg. No. 3368041, registered on 15 January 2008 (class 35 for “retail store services featuring footwear, clothing, bags, and accessories.”);

- MERRELL (Taiwan), Reg. No. 688035, registered on 16 August 1995 (class 25 for “hiking boots, climbing boots and cross country ski boots.”);

- MERRELL (Taiwan), Reg. No. 1684364, registered on 1 January 2015 (class 25 for “footwear, namely, boots, shoes and sandals.”); and

- MERRELL (Taiwan), Reg. No. 1347266, registered on 16 January 2009 (class 35 for “retail store services featuring footwear,

socks, and footwear uppers, shoe heels, shoe fasteners, shoe laces, shoe buckles, and fittings of metal for shoes and boots; clothing, clothing accessories and belts; bags and buckles for bags, zip fasteners for bags, suitcases handles, and locks for bags.").

FACTUAL BACKGROUND

The Complainant is an American footwear company founded in 1981. The Complainant owns over 300 trade mark and service mark registrations around the world, including in Taiwan, which incorporate MERRELL and MERRELL-formative marks in connection with, among other things, footwear and retail store services featuring footwear. The Complainant's MERRELL trade marks have been in use since at least 1982 in the United States in connection with hiking and climbing boots. The Complainant was granted its first Taiwanese trade mark registration for MERRELL in connection with footwear in 1995 (Reg. No. 688035).

The Complainant's main website is available at www.merrell.com (the domain name <merrell.com> has been registered to the Complainant since 1995). The Complainant also offers its products at the website www.merrell.com.tw (the domain name <merrell.com.tw> has been registered to the Complainant since at least 2002).

The Respondent appears to be a company providing web hosting and domain registration services.

The disputed domain name <twmerrell.com> (the Domain Name) was registered on 23 May 2014. At the time of filing of the Complaint, it was resolving to a website offering footwear for sale, including the Complainant's products as well as products of the Complainant's competitors.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant asserts that the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights. The Complainant states that the Domain Name is confusingly similar to the Complainant's trade mark as it contains the Complainant's MERRELL mark in its entirety. The Complainant submits that the letters "TW" in the Domain Name are merely geographically descriptive of Taiwan and that it normally indicates the trade mark owner operates the website for activities in that country. The Complainant therefore submits that because "TW" merely describes the location in which the Respondent purports to sell the Complainant's goods, and because the inclusion of "TW" will only serve to mislead consumers into believing the Complainant uses the website for its activities in Taiwan, the Domain Name is confusingly similar to Complainant's MERRELL trade mark.

The Complainant further asserts that the Respondent has no rights or legitimate interests in the Domain Name. In this regard, the Complainant states that no express or implied license has ever been granted to Respondent to use the Complainant's MERRELL trade mark. The Complainant also asserts that the Respondent is not and has never been an authorized seller or distributor of the Complainant's products, including those bearing the MERRELL trade mark.

The Complainant states that the Respondent is not commonly known by the name "Merrell" in accordance with paragraph 4(c)(ii) of the Policy. In this regard, the Complainant highlights that the Respondent's detail in the WhoIs gives no indication that the Respondent has ever been known by the name "MERRELL" or by any name or trade mark similar to or related in any way to the MERRELL Marks.

The Complainant also asserts that the Respondent's use of the Domain Name is clearly commercial because the website offers the Complainant's goods for sale. Furthermore, it argues that such use cannot be characterized as fair because the Respondent's website prominently displays the Complainant's MERRELL trade mark which is likely to mislead consumers into believing that they have reached the Complainant's website or that the website is affiliated with or authorized by Complainant when such is not the case. The Complainant states that the Respondent's actions evidence the Respondent's

intent to misleadingly divert consumers for commercial gain. The Complainant suggests that the Respondent is passing itself off as the Complainant and that that cannot be considered evidence of a bona fide offering of goods or services. The Complainant also states that even in the case of legitimate independent sellers, prior panels have found that an accurate disclosure of the registrant's relationship with the trade mark owner is one of several "minimum" requirements for a bona fide offering. See, e.g. Oki Data Americas, Inc. v. ASD, Inc., D2001-0903 (WIPO November 6, 2001). The Complainant submits that the Respondent is not a recognized seller of the Complainant's products and, furthermore, the Respondent has deliberately failed to represent its relationship with the Complainant. Therefore, the Complainant argues that the Respondent's offering of goods or services is not bona fide.

The Complainant asserts that the Domain Name was registered and is being used in bad faith. In this regard, the Complainant argues that by using the Domain Name, the Respondent has intentionally attempted to attract potential customers of the Complainant's MERRELL products to its website for commercial gain, in accordance with paragraph 4(b)(i) of the Policy. Furthermore, the Complainant asserts that the Respondent's website states that it is owned by "MERRELL Licensing LLC," which falsely suggests that the Respondent's use is under license from the Complainant, or that the Respondent has the right to license the Complainant's trade mark, neither of which are true. The Complainant also underlines that the Respondent also displays the MERRELL trade mark throughout its website. Therefore, it argues that the Respondent is intentionally trading on the goodwill associated with the Complainant's MERRELL trade mark for commercial gain.

The Complainant also argues that the Respondent is using the Domain Name to intentionally disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, as the Respondent is using the Domain Name to resolve to a website offering to sell the Complainant's products without authorization using the Complainant's mark. The Complainant asserts that, regardless of whether the Respondent is selling the Complainant's products or counterfeit products, the Respondent is disrupting the Complainant's business by attempting to compete with the Complainant's own sales in Taiwan.

Finally, the Complainant states that on 22 August 2017, the Complainant sent a letter to the Respondent notifying the Respondent of the Complainant's prior trade mark rights and requesting that the Domain Name be transferred to Complainant but no response was received by the Complainant.

RESPONDENT:

The Respondent states that it is a company based in Taiwan that provides web hosting and domain name registration services. The Respondent asserts that it is not the owner of the Domain Name and that the owner registered it through its service. The Respondent states that the owner information appearing on WhoIs is wrong due to a technical error, as the Respondent should appear only as the technical contact, not the owner. The Respondent explains that it was unable to modify the owner details given the status on the WhoIs by the Czech Arbitration Court but that it has the contact information of the real owner. Furthermore, the Respondent states that the website "www.twmerrell.com" is not located on its server and that it is impossible for it to provide any trading records of the website.

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 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 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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the Domain Name, the Complainant must prove the following three elements:

(i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules provides that the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable. Furthermore, paragraphs 10(b) and 10(d) of the Rules provide that the Panel shall ensure that the parties are treated with equality and shall determine the admissibility, relevance, materiality, and weight of the evidence.

Taking the aforementioned provisions into consideration, the Panel finds as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Panel to consider first whether the Complainant has established relevant trade mark rights. The Complainant has provided evidence that its subsidiary has registered trade mark rights in MERRELL in connection with footwear. The Panel is therefore satisfied that the Complainant has established relevant trade mark rights.

The Panel is also required under paragraph 4(a)(i) of the Policy to examine whether the Domain Name is identical or confusingly similar to the Complainant's trade mark. The Domain Name incorporates the Complainant's MERRELL trade mark together with the letters "tw" under the “.com” generic Top-Level Domain (“gTLD”). Prior panels deciding under the Policy have held that “when a domain name wholly incorporates a complainant’s registered mark that is sufficient to establish identity or confusing similarity for purposes of the Policy”. See Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525.

Furthermore, the addition of the letters “tw”, which is a common abbreviation for Taiwan, does not serve sufficiently to distinguish or differentiate the Domain Name from the Complainant’s MERRELL trade mark, as it is descriptive of a geographical location. See Pfizer Inc. v. PrivacyProtect.org / li, be, WIPO Case No. D2011-0667 (<twviagra.com>). The fact that the Complainant markets its footwear products in Taiwan (including through its website www.merrell.com.tw) further adds to the confusion.

The gTLD “.com” is generally disregarded under the identity or confusing similarity test as it is a functional element.

The Panel therefore finds that the Domain Name is identical to the Complainant's trade mark. The Complainant has therefore satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following non-exhaustive list of circumstances that may suggest that a respondent has rights or legitimate interests in a domain name, including:

“(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

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

A complainant is required to make a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name in question. If, however, the respondent fails to come forward with such relevant evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Complainant has asserted that no express or implied license has ever been granted to Respondent to use the Complainant's MERRELL trade mark. The evidence is also clear that the Respondent does not have any relationship with the Complainant.

There is no evidence either that the Respondent is commonly known by the Domain Name, in accordance with paragraph 4(c)(ii) of the Policy.

The Panel further finds that the use of the Domain Name which incorporates the Complainant's trade mark to resolve to a website offering the Complainant's products as well as products of the Complainant's competitors cannot be considered either a bona fide offering of goods or services or a legitimate non-commercial or fair use of the Domain Name, in accordance with paragraphs 4(c)(i) and 4(c)(iii) of the Policy as the Complainant's trade mark is being used to bait Internet users and then switch them to products of its competitors. See Nikon, Inc. v. Technilab, WIPO Case No. D2000-1774 (finding that use of Nikon-related domain names to sell Nikon and competitive cameras is not a legitimate use).

The Respondent has stated that it is not the true owner of the Domain Name but merely provides domain name registration services and that due to a technical error, it appears listed in the WhoIs as the registrant of record. However, the Panel does not need to reach a conclusion on whether the Respondent is the true owner or not as the Respondent is the registrant of record and, as such, the Respondent is responsible for the Domain Name.

The Panel finds that the Complainant has made a prima facie showing of the Respondent's lack of rights or legitimate interests in the Domain Name and that the arguments put forward by the Respondent are insufficient to rebut such a showing. The Panel therefore finds that the Respondent has no rights or legitimate interests in the Domain Name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

"(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 trade mark 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 trade mark 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 online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The evidence put forward by the Complainant shows that the Complainant's trade mark significantly predates the registration date of the Domain Name and has been used extensively in connection with footwear, including in Taiwan, where the Respondent appears to be based. Given this, the Panel finds that the Respondent was likely aware of the Complainant's rights at the time of registration of the Domain Name, and thus registered it seeking to take advantage of the Complainant's rights, as strongly suggested by the fact that the Domain Name was subsequently used to resolve to a website offering the Complainant's products for sale. The fact that the Respondent states that it is a domain name registration service and not the true owner of the Domain Name is not of significance as the Policy has been "designed so that a remedy can be obtained (where warranted) whether or not the identity of the Respondent is known. If a Complaint is filed against the registrant of record, the Complaint may proceed and succeed even if the true owner is not described completely and fully". See Two Way NV/SA v. Moniker Privacy Services, LLC / [4079779]: Domain Administrator , WIPO Case No. D2012-2413.

The Panel also finds that the Respondent's use of the Domain Name reproducing the Complainant's trade mark to resolve to a website dedicated to internet users in Taiwan offering the Complainant's products as well as products of the Complainant's competitors for sale constitutes a perfect illustration of bad faith use as the Respondent is intentionally attempting 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, within the meaning of paragraph 4(b)(iv) of the Policy. See Nikon, Inc. v. Technilab, WIPO Case No. D2000-1774 ("the use of the <nikoncamera.com> domain name for a site that sold Nikon products and those of its competitors constitutes an improper use of Complainants' mark to attract Internet users to Respondent's site for commercial gain by creating a likelihood of confusion as to source, sponsorship, affiliation or endorsement of the site").

The Panel therefore finds that the Respondent registered and is using the Domain Name in bad faith. The Complainant has therefore satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TWMERRELL.COM**: Transferred

PANELLISTS

Name	**David Taylor**

DATE OF PANEL DECISION 2017-12-12

Publish the Decision