Decision for dispute CAC-UDRP-101792

Case number	**CAC-UDRP-101792**
Time of filing	**2017-12-06 08:35:44**
Domain names	**DAVIDOFF.INK**

Case administrator

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

Complainant

Organization	**Zino Davidoff SA**

Complainant representative

Organization	**BrandIT GmbH**

Respondent

Organization	**Huang Jie / Huang Jie**

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 name.

IDENTIFICATION OF RIGHTS

Complainant is the owner of the registered trademarks DAVIDOFF, inter alia as a word mark and device in numerous countries all over the world including in China where the Respondent resides including the trade marks detailed below. These trademark registrations predate the registration of the Disputed Domain Name in 2017.

Trademark: DAVIDOFF – CHINESE TRANSLATION
Registration no: G467510 for DAVIDOFF
Classes: 14, 15, 16, 18, 20, 21, 25 & 33
Date of registration: 27.01.2012
Type of registration: National

Trademark: DAVIDOFF (IR)
Registration no: 467510
Classes: 3, 14, 15, 16, 18, 20, 21, 25 33 & 34.

Date of registration: 27.01.1982
Type of registration: IR

FACTUAL BACKGROUND

Complainant is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation. Complainant's brands have been continuously used and marketed for over 30 years.

Complainant is the owner of the registered trademark DAVIDOFF as a word mark and device in numerous of countries all over the world including in China where the Respondent resides. These trademark registrations predate the registration of the Disputed Domain Name.

Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "Davidoff" and "Zino Davidoff" see for example, see for example, <zinodavidoff.com> (created on 2002-12-16) < zinodavidoff.asia> (created on 2007-02-27), < davidoff.cafe> (created on 2016-08-23).

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The contentions of the Complainant can be summarised as follows:

i) LANGUAGE OF PROCEEDINGS REQUEST:

Complainant filed a language of proceedings request that the language of the proceeding should be English based on the following facts:

a) The disputed domain name includes the Complainant's mark DAVIDOFF. Complainant is a Swiss company operating internationally whose business language is English;
b) Respondent has registered many domains with words in English, it is unlikely that Respondent is not at least familiar with the English language
c) the Domain Name is in Latin script rather than Chinese script
d) In addition, Respondent has chosen to register the domain name under the Top Level domain name ".ink" which is a commercial new gTLD and an English term, and is applicable to a broader audience than merely China. A more suitable TLD if only addressing the Chinese market would be the .cn extension. The proceedings will likely be put through unnecessary trouble and delay if Chinese were made the language of the proceeding and there would be no discernible benefit to the parties or the proceeding, in the circumstances, that may be gained by maintaining the default language.

ii) ABOUT COMPLAINANT AND THE BRAND DAVIDOFF

Complainant is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation. Complainant's brands have been continuously used and marketed for over 30 years and in 1984 Complainant launched perfumery and cosmetics and since then Complainant has launched watches, clothing, cognac, leather goods, glasses, writing instruments, coffee etc. and the business has been continuously expanded and the scope of the goods

bearing the DAVIDOFF becomes wider and wider.

Complainant's activity in China

Complainant and its trademarks enjoy a high reputation around the world due to Complainant's long-term use and publicity. Complainant has continually and heavily invested in publicizing and advertising its trademarks around the world including China where Respondent is domiciled. Complainant's goods are also often sold on the flights to and from China and appear among others in in-flight catalogues and magazines. Therefore numerous passengers (including a number of Chinese passengers) have a very convenient way to directly access Complainant's goods.

Complainant also publicizes and promotes its brands by sponsoring and organizing a variety of activities and events. China is one of Complainant's fastest-growing and major markets. In 2012, Complainant had around two hundred stores/counters throughout China's major cities (such as: Beijing Lufthansa Shopping Center, Beijing Joy City; Shanghai Parkson Grand Gateway Plaza; Shenzhen Glory Plaza, CITIC Plaza); Tang King Shopping Mall in Xi'An; Zhong Hang Jiu Fang Shopping Mall in Chengdu; New World Dept. Store in Yancheng; Xing Li Ying Hai Yuanlong Dept. Store in Guiyang; Yin Tai Dept. Store in Hangzhou; and Complainant's products occupy a significant share of China's market, which further proves the high reputation and goodwill enjoyed by Complainant and its trademarks

Overview of trademark registrations:

Trademark: DAVIDOFF – CHINESE TRANSLATION
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Type of registration: National

Trademark: DAVIDOFF (IR)
Registration no: 467510
Classes: 3, 14, 15, 16, 18, 20, 21, 25 33 & 34.
Date of registration: 27.01.1982
Type of registration: IR

Trademark: ZINO DAVIDOFF (IR)
Registration no: 467511
Classes: 3, 14, 15, 16, 18, 20, 21, 25 33 & 34.
Date of registration: 27.01.1982
Type of registration: IR

Complainant is the owner of the registered trademarks DAVIDOFF & ZINO DAVIDOFF as a word mark and device in numerous of countries all over the world including in China where the Respondent resides. These trademark registrations predate the registration of the Disputed Domain Name.

Due to extensive use, advertising and revenue associated with its trademarks worldwide, Complainant enjoys a high degree of renown around the world, including in China where Respondent is located. Complainant has previously successfully challenged several DAVIDOFF domain names through UDRP processes e.g. WIPO Case no: D2013-0410 Zino Davidoff SA vs. Yang Yong concerning the domain <davidoffperfumes.com>; WIPO Case no: D2015-2318 Zino Davidoff SA vs. Tang Bin concerning the domain <davidofftea.com>; WIPO Case no: D2016-1027 Zino Davidoff SA vs. Guan Rang Guang concerning the domain <davidoshore.date>

Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "Davidoff" and "Zino Davidoff" see for example, see for example, <zinodavidoff.com> (created on 2002-12-16) < zinodavidoff.asia> (created on 2007-02-27), < davidoff.cafe> (created on

2016-08-23). Complainant is using the domain names to connect to a website through which it informs potential customers about its trademarks and its products and services

LEGAL GROUNDS:

i) THE DOMAIN NAME IS IDENTICAL

The domain name www.davidoff.ink (hereinafter referred to as the “Domain Name”), registered on 06.10, 2017, directly and entirely incorporates Complainant’s well-known, registered trademarks DAVIDOFF & ZINO DAVIDOFF. The addition of the generic Top-Level Domains (gTLD) “.ink”, does not add any distinctiveness to the Domain Name. The Domain Name totally incorporates the trademark DAVIDOFF. 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. The Domain Name should be considered to be identical to the registered trademark DAVIDOFF.

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

Respondent is commonly known by the Domain Name. The WHOIS information “Huang Jie” is the only evidence in the WHOIS record, which relates Respondent to the Domain Name .When entering the terms “ZINO DAVIDOFF”, “DAVIDOFF” and “CHINA” (where Respondent is located) in the Google search engine, the returned results point to Complainant and its business activity).

The Respondent could have easily performed a similar search before registering the Domain Name and would have quickly learnt that the trademarks are owned by Complainant and that the Complainant has been using its trademarks in several parts of the world, not to mention that DAVIDOFF is a well known mark in any case. Respondent has not by virtue of the content of the website, nor by its use of the Domain Name shown that they will be used in connection with a bona fide offering of goods or services. It is clear that the term DAVIDOFF has become distinctive and that the intention of the Domain Name is to take advantage of an association with the Complainant’s business.

THE WEBSITE

At the time of the filing of this Complaint, the Domain Name does not resolve to an active 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 Domain Name. Clearly, the Respondent is not known by the Domain Name, nor does the Respondent claim to have made legitimate, non-commercial use of the Domain Name. Moreover, Complainant had never authorized the Respondent to use its trademark in any form.

Respondent has been granted several opportunities to present some compelling arguments that it has rights in the Domain Name but has failed to do so. This behavior coupled with the use of the Domain Name cannot be considered as legitimate use of the Domain Name.

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

THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

It has to be highlighted that Complainant’s trademarks predate the registration of the Domain Name and Respondent has never been authorized by Complainant to register the Domain Name. It is inconceivable that the unique combination of DAVIDOFF in the Domain Name is not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights.

THE DOMAIN NAMES ARE BEING USED IN BAD FAITH

Complainant tried to contact Respondent on November 20, 2017 through a cease and desist letter. The letter was sent to the

email address listed in the whois record and to the email address listed on the website associated with the Domain Name. In the cease and desist letter, Complainant advised Respondent that the unauthorized use of its trademarks within the Domain Name violated their trademark rights and Complainant requested a voluntary transfer of the Domain Name. Since no reply was received, Complainant sent a reminder on 20.11.2017. As a consequence, the following reply was received on the same day by Respondent:

"...

Dear Claire Kowarsky

DavidoffDavidoffDavidoffDavidoffDavidoff

Thank you very much for your efforts and efforts for our cooperationBest wishes for you

---

Elman Huang

Business Director
M & A trader

..."

Below the translation in English using Google Translator:

“
Mail has been received, thank you for your sincere communication! I'm a fan of Davidoff, and it's my hobby to bookmark Davidoff's domain name, not to the detriment of Davidoff. If Davidoff hopes to acquire the domain name, I'd love to work together. You also know that I bought this domain also cost a little fee, Davidoff company if you also sincerely hope to be able to make a more reasonable proposal”.

Afterwards, Complainant asked for a price and only after some emails, Respondent indicated the following at his email dated 22.11.17:

"...

Dear Claire Kowarsky

5Davidoff

Thank you very much for your efforts and efforts for our cooperationBest wishes for you

---

Elman Huang

Business Director
M & A trader

..."

Below the translation in English using Google Translator:

“Thanks again for your hard work and sincere communication! I asked my friends, they gave advice is 50,000 yuan, I do not know whether this is in line with the Davidoff company's plan, I hope you can help us interact more reasonable programs”.

Please note that 50,000 yuan is aprox 7,600USD. This conduct has been considered in previous cases as an additional evidence of bad faith due to the Respondent´s intention to unduly profit from the Complainant´s rights. Please see WIPO Case No. D2016-0771 Facebook, Inc. vs. Domain Admin. Privacy Protection Service Inc. d/b/a Privacy Protection.org/ Ông Trần Huỳnh Lâm, where the Panel found that:

“It also submits that the Respondent's offer to transfer the disputed domain name in return for a payment of USD 100,000 is a "strong indication" of the Respondent's intention to unduly profit from the Complainant's rights and constitutes additional evidence of bad faith”.

Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file a complaint according to the UDRP process.

THE WEBSITE

As noted previously, the Domain Name currently does not resolve to an active website.

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.

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 Complainant's trademark may constitute registration and use in bad faith. In the current case it is clear that Respondent has registered the Domain Name in bad faith by intentionally adopting Complainant’s widely known mark in violation of 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 Domain Name 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.

Finally, Complainant’s International and Chinese trademark registrations predate Respondent’s Domain Name registration and the cease and desist letter was answered with a price for the transfer in excess of reasonable out of pocket expenses. These cumulative factors clearly demonstrate that Respondent should be considered to have registered and to be using the Domain Name in bad faith.

PATTERN OF CONDUCT

A pattern of conduct can involve multiple UDRP cases with similar fact situations or a single case where the respondent has registered multiple domain names which are similar to trademarks. Here, it has to be highlighted that the Respondent using its official email address hjdear@126.com, as indicated in WHOIS Lookup record, has registered aprox. 396 domain names including well-known brands such as <armani.ink>, <bacardi.ink>, <bentley.ink> and <calvinklein.site> Such pattern of abusive conduct constitutes evidence of bad faith.

Moreover, The Respondent takes advantage of the DAVIDOFF 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 Domain Name based on a registered and well-known trademark in order to only use it for non-legitimate purposes. The conduct of the Respondent in registering domains incorporating other well-known trademarks demonstrates systematic bad faith behavior.

To summarize, the trademark DAVIDOFF is a well-known mark worldwide, including in China where the Respondent is located. Respondent bears no relationship to the trademarks and the Domain Name has no other meaning except for referring to Complainant's name and trademark. There is no way in which the Domain Name could be used legitimately by the Respondent. Inference of bad faith registration and use of the Domain Name may also be made from by the fact that the Respondent replied to the Complainant's cease and desist letter requesting an unreasonably high price for the Domain Name. Further, the domain name is being passively held, an additional element of bad faith in accordance with the applicable cases described at this Complaint. Finally, the Respondent has shown a bad faith pattern of conduct through the registration of hundreds of domain names containing other well-known marks.

Consequently, the 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 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

Procedural aspects - Language of the Proceedings

The Panel accepts the Complainant's submissions regarding the language of the proceeding. The Respondent communicated with the Complainant in English and has registered other domain names with words in English and so appears to have a working knowledge of the English language. Having considered all the circumstances of the case the Panel determines that English is the language of the Proceedings.

Identical or Confusingly Similar

Complainant has established that it has prior rights in the trademark DAVIDOFF.

The Panel agrees that merely adding the gTLD .ink to the disputed domain name is not sufficient to distinguish the disputed domain name from the trade mark owned by the Complainant. The disputed domain name is identical to the Complainant's DAVIDOFF trade mark for the purposes of the Policy.

Rights or Legitimate Interests

Complainant has not authorised the Respondent to use the Complainant's trade mark. The Respondent is not commonly known as 'Davidoff'. The disputed domain name has not been used as so there is no bona fide offering of goods and services or any non commercial or fair use of the disputed domain name. Respondent has no rights or legitimate interests in the disputed domain name.

Registered and Used in Bad Faith

The Respondent has offered to sell the disputed domain name to the Complainant for a sum in excess of out of pocket costs of registration of the disputed domain name. The Respondent has also registered a number of other domain names containing the famous marks of third parties indicating a pattern of conduct designed to prevent trade mark owners from registering corresponding domain names containing their marks and/or to sell domain names for profit. As such the Respondent has registered and used the disputed domain name in bad faith under 4 (b)(i) and (ii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DAVIDOFF.INK**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2018-01-04

Publish the Decision