Decision for dispute CAC-UDRP-101768

Case number	CAC-UDRP-101768
Time of filing	2017-11-20 09:59:55
Domain names	doarz.com, duerta.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Mundipharma AG

Complainant representative

Organization	Stobbs

Respondent

Organization	Home of Domains

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of:

a) EUTM no. 017014143 DOARZ in class 5, filed on 24 July 2017 at 14:49:04 UTC and registered on November 6, 2017;

b) EUTM no. 017067571 DUERTA in class 5, filed on 2 August 2017 at 10:53:26 UTC and registered on November 15, 2017.

FACTUAL BACKGROUND

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

The Complainant is the owner of:

a) EUTM no. 017014143 DOARZ in class 5, filed on 24 July 2017 at 14:49:04 UTC;
b) EUTM no. 017067571 DUERTA in class 5, filed on 2 August 2017 at 10:53:26 UTC.

These trademark applications were filed a few hours prior to the registration of the disputed domain names, which were registered as follows:

a) doarz.com registered on 24 July 2016 at 21:29:12 UTC;
b) duerta.com registered on 2 August 2017 at 17:11:56 UTC.

The Complainant, Mundipharma, intends to use these marks in relation to a pharmaceutical preparation for providing pain relief.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain names are identical or confusingly similar to the DOARZ and DUERTA trademarks, that the Respondent has no rights or legitimate interests in respect of the disputed domain names, and that the disputed domain names have been registered and are being used in bad faith.

Specifically the Complainant submits:

1) that the disputed domain names doarz.com and duerta.com are identical to the Complainant's trademarks DOARZ and DUERTA, noting that it is well-established that the top-level domain name '.com' may be disregarded for the purpose of assessing whether the domain is identical or confusingly similar to the Complainant's trademark rights;

2) that the Respondent does not have any rights or legitimate interest in the disputed domain names.

The Respondent has no rights in relation to the DOARZ or DUERTA elements that form the domain name strings that are the subject of this complaint.

The Complainant further asserts that the trademarks DOARZ and DUERTA are made-up words devised by the Complainant's branding consultants specifically for the Complainant. They are not dictionary words, and they did not exist prior to being devised for the Complainant. There is no believable or realistic reason for registration or use of the disputed domain names other than to take advantage of the Complainant's rights. The only reason the Respondent could have for registering these domains is to prevent the Complainant from registering these domains and to attempt to sell them either to the Complainant or to a competitor at a profit. This does not constitute a legitimate interest in the domain names.

The Respondent is not making any legitimate or fair use of the disputed domain names.

The Respondent's use of the domains show that they are not using it in relation to a bona fide offering of goods and services.

The Respondent is not commonly known by the names DOARZ or DUERTA. The Respondent has no trade mark registrations for DOARZ or DUERTA;

3) that the disputed domain names have been registered and used in bad faith.

The Complainant submits that the registration of the disputed domain names that are the subject matter of this complaint are a classic example of a bad faith registration in accordance with paragraph 4(b) of the Uniform Domain Name Dispute

Resolution Policy.

As set out above, the disputed domain names were registered mere hours after the Complainant applied to register their trademarks, as follows:

a) EUTM no. 017014143 DOARZ filed on 24 July 2017 at 14:49:04 UTC;
b) doarz.com registered on 24 July 2016 at 21:29:12 UTC (less than seven hours later).

a) EUTM no. 017067571 DUERTA filed on 2 August 2017 at 10:53:26 UTC;
b) duerta.com registered on 2 August 2017 at 17:11:56 UTC (less than six and a half hours later).

The EUIPO makes newly-filed trade mark applications visible on its online database immediately after filing, meaning that the Respondent could have become aware of the Complainant's trade mark applications prior to registering the domains.

The fact that both of the disputed domain names were registered within a few hours of the trademarks being filed suggests a suspicious pattern of behavior. It cannot be a coincidence that these two domains (reflecting the Complainant's unique trademarks) were each registered mere hours after the corresponding trade mark applications were filed. The only plausible explanation for the registration of both of these domains in such quick succession after the filing of the trademarks is that the Registrant was monitoring trademark applications filed by the Complainant and registering the corresponding domains in order to prevent the Complainant from registering them and then sell them to the Complainant at an inflated price, or in order to use the domains/sell them to a competitor in order to disrupt the Complainant's business.

A search of the Oxford Dictionary (oxforddictionaries.com) reveals no matches for either DOARZ or DUERTA. Neither of these is a dictionary word. It is simply not credible that the Respondent came up with these two names independently and, purely coincidentally, registered them as domains just hours after the Complainant's trademark applications were filed. The only plausible explanation for the Respondent having registered these two specific domains on the two dates in question is that they were prompted by the Complainant's trade mark applications.

In accordance with paragraph 4(b)(i) the Complainant submits that there are circumstances indicating that the Respondent has registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registrations to the Complainant who is the owner of the trademarks, or to a competitor of the Complainant, for a valuable consideration in excess of their documented out-of pocket costs directly related to the disputed domain names.

The screenshots annexed to the complaint show that the disputed domain names are being offered for sale at a cost of $950 each, a sum far in excess of the Respondent's likely out-of-pocket costs for registering these domains. This provides clear evidence in support of the fact that these are bad faith registrations in accordance with paragraph 4(b)(i). It is quite clear that the Respondent is looking to gain a figure in excess of their documented out-of-pocket expenses for the sale of the domain names.

In accordance with paragraph 4(b)(ii) the Complainant submits that the Respondent has registered the disputed domain names in order to prevent the owner of the trademarks from reflecting the marks in a corresponding domain name, and that the Respondent has engaged in a pattern of such conduct.

In accordance with paragraph 4(b)(ii) the domain registrant has clearly prevented the Complainant from owning domain names that reflect their unique trademarks. In accordance with paragraph 4(b)(iii) the Complainant further submits that the Respondent has registered the disputed domain names primarily for the purpose of disrupting the business of the Complainant.

In addition, the Complainant submits that there are circumstances that indicate that by using the disputed domain names

the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other online location, thus creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location.

Finally, the Complainant's representatives sent two cease-and-desist letters to the Respondent on October 19, 2017, setting out the Complainant's rights in their DOARZ and DUERTA trademarks and requesting the transfer of the domains. No response was received. Thus the Respondent failed to take this opportunity to explain why they had registered the disputed domain names or to outline their rights and/or legitimate interests in the disputed domain names. The Complainant thus claims that this is an indication that they have no such rights or legitimate interests, and that the disputed domain names were registered and are being used in bad faith.

The disputed domain names are not being used in any way, and are simply parked and are being offered for sale. This further indicates that the Respondent has no legitimate interests in these domains, and that they have been registered and are being used in bad faith.

It is clear from all the circumstances that the disputed domain names have been registered and are being used in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain names, paragraph 4(a) of the Policy requires that the Complainant must demonstrate to the Panel that:

(i) The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain names; and

(iii) The disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Jurisprudential Overview 3.0), as a general rule, the term “trademark or service mark” as used in paragraph 4(a)(i) of the Policy encompasses both registered and unregistered (sometimes referred to as common law) marks. Also the filing/priority date, date of registration, and date of claimed first use are not considered relevant to the first element test. These factors may however bear on a panel’s further substantive determination under the second and third elements. While the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights, such rights must be in existence at the time the complaint is filed. However, the fact that a domain name may have been registered before a complainant acquired trademark rights does not by itself preclude a complainant’s eligibility to file a UDRP case, nor a panel’s finding of identity or confusing similarity under the first element test.

In fact, where a domain name has been registered before a complainant has acquired trademark rights, only in exceptional cases would a complainant be able to prove a respondent’s bad faith.

Finally, a pending trademark application would not by itself establish trademark rights within the meaning of paragraph 4(a)(i) of the Policy.

* * *

The disputed domain names are identical to the Complainant’s DOARZ and DUERTA marks for the purposes of the Policy, since the top-level domain name suffixes are not relevant to the determination of identity or confusing similarity. Whether the Complainant has established trademark or service marks rights for purposes of maintaining a UDRP complaint is more problematic. In fact, the Complainant has attached to the complaint two extracts from the Official EUTM database; the first one shows that the Complainant owns a registered trademark for DOARZ, while the second extract shows that the Complainant owns only a trademark application for DUERTA.

As held consistently by Panels, a trademark application is not in itself sufficient evidence of a trademark or service mark in which the Complainant has rights, since applications are often opposed or may be refused for lack of distinctiveness. The only types of right that amount to trademark rights are, in addition to registered marks, unregistered or common law trademark rights.

However, before rendering its decision, the Panel checked the status of this trademark, the information publicly available, and the relevant dates of the present proceeding. As a consequence the Panel noted that:

1 The formal date of commencement of the administrative proceeding in accordance with paragraph 4(f) of the Policy is November 20, 2017; and that

2 EUTM DUERTA no. 017067571 was registered on November 15, 2017.

The Panel thus concludes that the Complainant has established trademark or service marks rights for purposes of maintaining a UDRP complaint, and it has therefore fulfilled its burden of proof to show that "the domain names are identical to a trademark or service mark in which the Complainant has rights" (paragraph 4(a)(i) of the Policy).

B. Rights or Legitimate Interests

This Panel finds that the Complainant has made a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain names. The Respondent has no connection to or affiliation with the Complainant, and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant’s trademark. The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain names, nor any use in connection with a bona fide offering of goods or services. In addition, the

Respondent does not appear to be commonly known by the disputed domain names or by similar names. Moreover, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain names.

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

C. Registered and Used in Bad Faith

The disputed domain names were registered only few hours after the Complainant's trademarks were filed, and therefore before the Complainant acquired the trademark rights granted by their registration.

As a consequence, it is relevant here to understand whether or not bad faith can be found where a domain name was registered before the complainant acquired trademark rights.

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Jurisprudential Overview 3.0), where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent.

Nevertheless, merely because a domain name is initially created by a registrant other than the respondent before a complainant's trademark rights accrue does not however mean that a UDRP respondent cannot be found to have registered the domain name in bad faith.

In fact, as an exception to the general proposition described in paragraph 3.8.1, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Such scenarios, described in paragraph 3.8.2, Domain names registered in anticipation of trademark rights, include the registration of a domain name: (iv) following the complainant's filing of a trademark application.

The Panel finds that based on the record, the Complainant has demonstrated the Respondent's bad faith pursuant to the Policy.

Based on the evidence put forward by the Complainant, the Panel is of the opinion that the Respondent was aware of the Complainant's trademark registrations and rights to the DOARZ and DUERTA marks when it registered the disputed domain names.

The Respondent's registration of the two disputed domain names only a few hours after the filing of the Complainant's trademarks DOARZ and DUERTA, on the balance of probabilities, cannot be seen as a mere coincidence.

In addition, the Respondent has not responded to (nor denied) the assertions made by the representatives of the Complainant in their two cease-and-desist letters, nor to the assertions made by the Complainant in this proceeding.

Finally, the screenshots annexed to the complaint show that the disputed domain names are being offered for sale at a cost of $950 each, a sum far in excess of the Respondent's likely out-of-pocket costs for registering these domains. This provides further evidence in support of the fact that these are bad faith registrations in accordance with 4(b)(i) of the Policy.

Given the present facts and circumstances and on the balance of probabilities, the Panel views that the Respondent's conduct constitutes bad faith registration and use under paragraphs 4(a)(iii) and 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has 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. **DOARZ.COM**: Transferred
2. **DUERTA.COM**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2018-01-05

Publish the Decision