Decision for dispute CAC-UDRP-101808

Case number	**CAC-UDRP-101808**
Time of filing	**2017-12-11 10:32:10**
Domain names	**mede1a.com**

Case administrator

Name	**Aneta Jelenová (Case admin)**

Complainant

Organization	**Medela AG**

Complainant representative

Organization	**BrandIT GmbH**

Respondent

Name	**Donna Lucius**

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings of which the Panel is aware.

IDENTIFICATION OF RIGHTS

Overview of trademark registrations:

Trademark: MEDELA
Registration no: 73708221
Classes: 9,10
Date of registration: 11.01.1988
Type of registration: US

Trademark: MEDELA
Registration no: 450881
Classes: 9, 10, 17
Date of registration: 14.02.1980
Type of registration: IR

Trademark: MEDELA

Registration no: 41002044
Classes: 3, 5, 9, 10, 11, 18, 21, 25, 40, 41, 44
Date of registration: 11.07.2008
Type of registration: IR

FACTUAL BACKGROUND

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

i) ABOUT COMPLAINANT AND THE BRAND MEDELA

Medela Holdings AG (hereinafter “Complainant”) was founded in 1961 by Olle Larsson and is headquartered in Switzerland. Under the leadership of Olle Larsson’s son Michael, Complainant has become a global player in breastfeeding products and medical vacuum technology thanks to continued research, innovation and the evaluation of customers' needs. Complainant has 18 subsidiaries in Europe, North America and Asia. Medela distributes its products in more than 100 countries, either directly or through independent partners. Complainant has a staff of 1,740 worldwide.

With more than 50 years supporting moms and babies, Complainant is more than just the #1 recommended breast pump brand. They also have a full line of nursing and pumping products designed to make every breastfeeding journey a success.

Complainant’s activity in United States

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 the United States where Respondent is domiciled. Medela is the US’ number 1 breast pump brand (according to QuintilesIMS ProVoice Survey; Nov-Oct 2016)

Complainants's US-based manufacturing and development facility is headquartered in McHenry, Illinois with an additional facility in Elgin, Illinois. Every year, more than one million mothers in the U.S. rely on Complainant's technology. For more than 30 years in the US, Complainant has focused on providing the best in research-based breast milk feeding products and clinical education to support moms' breast milk feeding journey.

See http://www.medelabreastfeedingus.com for more information about Complainant’s activities in the US.

Complainant is the owner of the registered trademark MEDELA as a word mark and device in numerous of countries all over the world including in the US 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 the United States where Respondent is located.

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 “medela” see for example, see for example, <medela.com> (created on 1996-02-24) <medela.net> (created on 2002-06-19), <medelabreastfeedingus.com> (created on 2007-11-11). Complainant is using the domain names to connect to websites through which it informs potential customers about its trademarks and its products and services, see Annex 2. for examples of domains owned by Complainant.

The Complainant held that the trademark MEDELA is a well-known mark worldwide, including in the United States where the Respondent is located. He stated that 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 is also given by the fact that the Respondent never replied to the Complainant's cease and desist letter nor reminders. 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 registering other domain names containing typo variants of other well-known marks.

Consequently, the Respondent should be considered to have registered and to be using the Domain Name in bad faith according to the Complaint.

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).

The domain name mede1a.com which was registered on October 25, 2017 (hereinafter referred to as the "Domain Name"), incorporates a confusingly similar version of Complainant's well-known, registered trademark MEDELA. The Domain Name is a typo-variant domain name, where the numeral "1" has been used to replace the similar looking letter "l". This is a common strategy used in the registration of fraudulent domain names, often used for phishing attacks.

In the WIPO Panel decision noD2012-0890 Boehringer Ingelheim Pharma GmbH vs. Co. KG v. Name Redacted the Panel found the typo squatting domain to be very similar to the trademark of the Complainant, both phonetically and visually, which may well give rise to the possibility, if not likelihood, that Internet users will think that the owner of the Domain Name, is in fact the owner of the Complainant's mark to which it is similar, or that there is some form of association between the Respondent and the Complainant. This is particularly so given that the Internet user may not even realise, at least initially, that they have mistyped the Complainant's name.

The addition of the generic Top-Level Domain (gTLD) ".com", does not add any distinctiveness to the Domain Name. The Domain Name incorporates a confusingly similar version of the MEDELA trademark coupled with a relevant gTLD. This exaggerates the impression that Respondent is somehow affiliated with Complainant, and Respondent is somehow doing business using Complainant`s trademark. Please see for example WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11., as well as the 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 Domain Name should be considered as confusingly similar to the registered trademark MEDELA.

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).

The Panel has not found that Respondent is commonly known by the Domain Name. The WHOIS information "Donna Lucius" is the only evidence in the WHOIS record, which relates Respondent to the Domain Name. When entering the terms "MEDELA" and "United States" (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 more than 100 countries around the world, not to mention that MEDELA 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 Complainant has become a distinctive identifier associated with the term MEDELA and that the intention of the Domain Name is to take advantage of an association with the Complainant's business.

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).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 MEDELA in the Domain Name is not a deliberate and calculated attempt to improperly benefit from the Complainant's rights.

Complainant tried to contact Respondent on November 16, 2017 through a cease and desist letter. The letter was sent to the e-mail address listed in the whois record and to the e-mail 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 reminders on November 20, 2017 and November 24, 2017. Respondent has simply disregarded such communications. 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.

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

Regarding typosquatting, Panels have found that the misspelling of the Complainant´s well-known mark is usually considered as an indicia of bad faith registration and use. See for instance the following decisions; WIPO/D2001-0094 regarding the domain name <www.plaboy.com> and WIPO/D2000-1623 regarding the domain name <www.pag3.com>

The requirement of the Policy of a domain name "being used in bad faith" is not limited to positive actions (please see Beiersdorf AG v. Web4comm Srl Romania, WIPO Case No. DRO2005-0002). Applied to this case, even if the Domain Name does not resolve to an active website it should be noted that passive holding does not preclude a finding of bad faith. The Respondent has not offered an explanation as to why the Domain Name was chosen. There is no apparent legitimate reason for the use of the Domain Name. As a result, therefore, the Respondent has used the Domain Name for the purpose of capitalizing on the reputation of Complainant.

Furthermore, the Respondent acts in a 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 JHUNTER0385@OUTLOOK.COM, as indicated in WHOIS Lookup record, has registered aprox. 16 domain names including typo variants of well-known brands such as <HAW0RTH.COM>, <MIL1WARDBROWN.COM> and <NILFISK-DN.COM>. for information about the Domain Names registered by Respondent using its official email address. Such pattern of abusive conduct constitutes evidence of bad faith according to paragraph (6) (ii) of the Policy and this behavior was declared as bad faith registration according to WIPO case No. D2015-1932 Bayer AG of Leverkusen v. huang cheng of Shanghai where the Panel stated that "The Respondent is engaged in registering domain names containing famous marks… This is evidence of a pattern in the misappropriation of well-known marks which cannot be regarded as registration and use in good faith".

Moreover, The Respondent takes advantage of the MEDELA 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.

Thus, 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 behaviour.

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 Respondent uses a domain name which is substantially similar to the trademark in question, a well-known trademark even in the US. There's no reason for a legitimate use by the Respondent. He never replied to letters of the Complainant. He has a common strategy of registering several domain names with typo variants of well-known marks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MEDE1A.COM**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2018-01-10

Publish the Decision