Decision for dispute CAC-UDRP-101788

Case number	CAC-UDRP-101788
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Domain names	FABER-SERVICE-CENTRE-MUMBAI.INFO

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Faber S.P.A.

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	website

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant, Faber S.P.A. is the owner of the FABER trademarks.

Today, the Faber Group of industries operates in 8 countries and on 3 continents with a global leadership and outlook.

Indian Business Activities

FABER is India's No.1 Hoods and Hobs brand. In total, over 250 employees produce more than 300 products in the Pune plant with current production capacity of 150,000 hoods, 100,000 hobs and 50,000 other kitchen appliances per annum.

Recognizing the importance of an extensive network towards scripting a long-term success story, Complainant has over 2,000 retail counters for sales and service across India.

A crucial element of Complainant’s strategy is to establish a long-term presence in India. The company made an initial investment of Rs. 50 crore in its manufacturing plant in Sanaswadi, Pune which has been operational since 2012. This investment represented the biggest investment the group had made outside Europe at the time. The new plant meets the

global standards of FABER on productivity, throughput, quality, finishes and safety. The plant uses futuristically designed state-of-the-art equipment and will be the export hub for Asia Pacific and Middle East regions.

FABER also relocated its one of the R&D bases from Europe to India in 2012.

The Complainant's official sales and service locator and website in India is www.faberindia.com.

The Complainant has also invested significantly to promote the FABER trademark and brand in the Indian market, including through this quality television commercial:

FABER 1470366 6 IN (Indian Registration), registered on July 14, 2006
FABER (LOGO) 723816 11 IN, registered on June 17, 2006
FABER 1684284 11,21 IN, registered on June 5, 2008
FABER (FIGURATIVE) 355037 21 IN, registered on November 30, 2016
FABER 1343497 11,21 IR (International Registration), registered on November 30, 2016

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 India where Respondent is domiciled.

FACTUAL BACKGROUND

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

ABOUT COMPLAINANT AND THE BRAND FABER

The Complainant, Faber S.P.A. is the owner of the FABER trademarks.

Back in 1955 Abramo Galassi established Faber Plast srl. He wanted to invent something new and to grow. With three partners and the help of a single worker he turned plastic into objects for the house. Mr Galassi's business pioneered a whole new world when it invented the kitchen hood in 1963. Since then, Faber has transformed the hood from a humble furnishing accessory into an essential item of kitchen equipment – safe, stylish and functional.

In August 2004, the Swiss Franke Group became the main shareholder of Faber SpA and confirmed the common vision and strong synergies between the two groups. In 2005 Faber was fully integrated into the Franke Group, where it plays an important role as Business Unit.

Today, the Faber Group of industries operates in 8 countries and on 3 continents with a global leadership and outlook.

Complainant, through it's parent company Franke Technology and Trademark Ltd, has registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "FABER", for example, <faber.online> (created on August 19, 2015), <faberindia.co.in> (created on September 18, 2007), faberonline.net (created on December 15, 1999), and <faberspa.com> (created on December 14, 1999). Complainant uses these domain names to connect to websites through which it informs potential customers about its FABER mark and its products and services.

LEGAL GROUNDS:

i) THE DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain faber-service-centre-mumbai.info (hereinafter referred to as the "Domain Name"), registered on May 3, 2017, directly and entirely incorporates Complainant's well-known registered trademark FABER. The addition of the generic Top-Level Domains (gTLD) ".info" does not add any distinctiveness to the Domain Name (see WIPO Jurisprudential Overview 3.0,

paragraph 1.11.2). The Domain Name incorporates the FABER trademark coupled with the English words “Service Centre Mumbai”, terms which are closely connected to Complainant´s business in respect to describing the service aspect as applicable to the important geographical area of Mumbai. These references exaggerate the impression that Respondent is somehow affiliated with Complainant, and Respondent is somehow doing business using Complainant`s trademark. See also 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 FABER.

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

Complainant has not found that Respondent is commonly known by the Domain Name. The WHOIS information “Registration Private” is the only evidence in the WHOIS record, which relates Respondent to the Domain Name. 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. When entering the terms “FABER” and “INDIA” on Google engine search, returned results point to Complainant and its business activity. The Respondent could easily perform 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 extensively in India.

There is no evidence that Respondent has a history of using, or preparing to use, the Domain Name in connection with a bona fide offering of goods and services. It is clear that Complainant has become a distinctive identifier associated with the term “FABER” and that the intention of the Domain Names is to take advantage of an association with the Complainant’s business.

THE WEBSITE

At the time of filing this complaint, Respondent was using the above Domain Name to attract internet users to its website where Respondent prominently states “Welcome to Faber Appliances Repairs and Services”. A common misunderstanding with authorized or non-authorized repair centers is that they also believe that they can freely register domain names incorporating the trademark name of the products they are offering services on. In the current case, Respondent is not an authorized repair center. The use of the trademark FABER prominently throughout website on strongly suggests that there is a connection with Complainant. Moreover, the use of the word FABER (i) in the Domain Name and (ii) also on multiple occasions in the website text further created the impression that there is some official or authorized link with Complainant in relation to repairs and services, especially in the Indian and Mumbai market. As noted previously, the trademark FABER is a well-known trademark in India and given the references to this mark on the website, it is clear that Respondent knows about it’s existence.

In addition, the website invited visitors to contact Respondent via the telephone numbers 8080804760/ 022 6060 4446 or the “Get Instant Callback” Form. See WIPO Case No. D2015-1024 Steven Madden, Ltd. v. Daniel Monroy where Respondent collected personal information from Internet users visiting the website (name, phone number, email address, age etcetera) who filled out a form, where the Panel noted that: “users presumably would not provide such data unless they believe they are dealing with Complainant or with a representative of Complainant….since personal data are a valuable commodity, eliciting such data as described is not a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers, pursuant to Policy paragraph 4(c)(iii)”. This finding should also apply here declaring that Respondent’s attempt to “phish” for users’ personal information is neither a bona fide offering of goods and services nor a legitimate non-commercial or fair use pursuant to Policy.

Following Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903, the use of a trademark as a domain name by an authorized or non-authorized third party is only to be regarded as a bona fide offering of goods or services within the meaning of paragraph 4(c) of the Policy if the following conditions are satisfied:

• the respondent must actually be offering the goods or services at issue;

• the respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods;
• the site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents;
• the respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.
As mentioned previously, the Respondent fails these tests, namely:
• Firstly, Respondent is not offering the Complainant's products or services through the Domain Name, but rather appears to be offering an appliance repair and maintenance service;
• Secondly, Respondent does not publish a disclaimer on the challenged pages. On the website connected to Disputed Domain Name there is no a proper statement disclaiming a relationship or association with Complainant, rather the only wording is "© Faber Appliances Repairs";
• Thirdly, Respondent is depriving the Complainant of reflecting its own mark in the Domain Name; and,
• Finally, Respondent presents themselves as the trademark owner by using Complainant`s official FABER trademark (word mark).

Respondent's use of the Domain Name created an overall impression that they are the Complainant. In the present case, Respondent does meet all the Oki Data criteria. It is undeniable that Respondent was aware of Complainant's marks prior to the acquisition of the Domain Name and the establishment of Respondent's website. 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, Respondent is not known by the Domain Name, nor does Respondent claim to have made legitimate, non-commercial use of the Domain Name.

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 NAMES WERE REGISTERED IN BAD FAITH

It has to be highlighted that Complainant's trademark registrations predate the registration of the Domain Name and Respondent has never been authorized by Complainant to register the Domain Name. Moreover, the active business presence, growth and success of Complainant in the Indian market in the last years shows that it seems to be unlikely that Respondent was not aware of the unlawful registration of the Domain Name.

THE DOMAIN NAME IS BEING USED IN BAD FAITH

Complainant tried to contact Respondent on November 3, 2017 through a cease and desist letter. Reminders were sent on November 13, 2017 and November 20, 2017. The letter was sent to the e-mail address that was listed in the whois record at the time the cease and desist letter was sent; i.e. November 03, 2017. 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. However, no reply was received. Respondent simply disregarded such communications. Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant filed this complaint according to the UDRP process. 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.

The Respondent has never been granted a permission to register the Domain Name. Respondent was taking advantage of the FABER trademark by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's products, services, website or location.

From the Complainant's point of view, Respondent intentionally chose the Domain Name based on registered and well-known trademark in order to generate more traffic to its own business. Nowhere does Respondent disclaim an association between itself and Complainant. The Domain Name is currently connected to a service center website, consequently, Respondent is using the Domain Name to intentionally attempt to attract, for commercial gain, internet users to the website, by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website. This conduct has been considered as bad faith under the Policy, and other WIPO decisions have also arrived to the same conclusion, for example Philip Morris Incorporated v. Alex Tsypkin, WIPO Case No. D2002-0946.

Finally, Complainant's trademark registrations predates Respondent's Domain Name registration. These cumulative factors clearly demonstrates that Respondent should be considered to have registered and to be using the Domain Name in bad faith as stated at the WIPO case No. D2016-0456 Amis Paris v. Amiparis, Amipa, where the Panel found out the following:

"Based on the evidence presented to the Panel, including the late registration of the disputed domain name which includes to the Complainant's marks, the confusing similarity between the Complainant's trademark and the disputed domain name, the Respondent's failure to reply to the cease-and-desist letter, the failure of the Respondent to respond to the Complaint and the Respondent's passive holding of the disputed domain name, the Panel draws the inference that on balance the disputed domain name has been registered and is being used in bad faith."

In the recent case involving the same Complainant and a similar fact scenario, CAC Case No. 101544 concerning the Domain name <faber-appliance-repair.online> the Panel stated:

"The disputed domain name is composed with the Complainant's FABER trademark, adding generic termes which do not avoid any likelihood of confusion.

The Respondent has no personal right on FABER. It has not been licensed or authorized to use the FABER trademark or to register the disputed domain name. It uses the disputed domain name to resolve to a website the content of which does not mention any disclaimer.

Given the use of the disputed domain name, the Respondent could not ignore the Complainant's rights in the FABER trademark when it registered the disputed domain name <faber-appliance-repair.online>.

The Panel finds that the disputed domain name was registered in bad faith to disrupt the Complainant's business and possibly harm its reputation."

To summarize, FABER is a well-known trademark in the kitchen appliances industry including India where Respondent is located and where the website associated with the Domain Name is operating the prominent heading of "Faber Appliances Services and Repairs". It is clear on the evidence that Respondent was aware of the rights Complainant has in the trademark and the value of said trademark, at the point of the registration. Inference of bad faith registration and use of the Domain Name is also given by the fact that Respondent never replied to Complainant's cease and desist letter nor reminders. It is reasonable to assume that if Respondent did have legitimate purposes in registering and using the Domain Name it would have responded to defend it's rights. In addition, Respondent did not meet the Oki Data principles on all elements: lack of a distinctive disclaimer; Respondent can be regarded to corner the market preventing Complainant from operating the Domain Name; and they represent themselves as the trademark owner by displaying Complainant's trademark on the website. Consequently, Respondent should be considered to have registered and to be using the Domain Name in bad faith.

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 faber-service-centre-mumbai.info (hereinafter referred to as the “Domain Name”), registered on May 3, 2017, directly and entirely incorporates Complainant’s well-known, registered trademark FABER. The addition of the generic Top-Level Domains (gTLD) “.info” does not add any distinctiveness to the Domain Name (see WIPO Jurisprudential Overview 3.0, paragraph 1.11.2).

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).

It has to be highlighted that Complainant’s trademark registrations predate the registration of the Domain Name and Respondent has never been authorized by Complainant to register the Domain Name. Moreover, the active business presence, growth and success of Complainant in the Indian market in the last years shows that it seems to be unlikely that Respondent was not aware of the unlawful registration of the Domain Name.

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

1. The three essential issues under the paragraph 4(a) of the UDRP Policy are whether:

i. the disputed domain name is 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 with respect to the disputed domain name; and

iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant has clearly proven that he is a long standing and successful company in the business environment, namely plastics for house. It is clear that its trademarks and domain name “FABER” are well-known.

The disputed domain name is identical or confusingly similar.

b) The Complainant states that the disputed domain name is confusingly similar to its trademark. Indeed, the trademark is

incorporated in its entirety in the disputed domain name.

The Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It has to be stressed that it was proven that there are no fair rights of the Respondent to the disputed domain name. The Respondent is not generally known by the disputed domain name, and has not acquired any trademark or service mark rights in the name or mark.

The disputed domain name was registered with an intention to attract customers of another well known domain name/registered trademark holder. Therefore there cannot be seen any legitimate interest of the Respondent.

The disputed domain name has been registered and is being used in bad faith.

d) From the IP Law perspective, it is clear that the Complainant's trademark and website were used by the Complainant long time before the disputed domain name was registered and used. It is therefore concluded that the disputed domain name was registered with an intention to attract customers of another well-known domain name/registered trademark holder.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FABER-SERVICE-CENTRE-MUMBAI.INFO**: Transferred

PANELLISTS

Name	**Dr. Vít Horáček**

DATE OF PANEL DECISION 2018-01-11

Publish the Decision