Decision for dispute CAC-UDRP-101786

Case number	CAC-UDRP-101786
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Domain names	deisel.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	DIESEL S.p.A

Complainant representative

Organization	Brandstock Domains GmbH

Respondent

Organization	Whois Privacy Corp.

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has sufficiently demonstrated to be owner of:

1. TRADEMARKS:

Numerous trademarks registered worldwide consisting of the distinctive and fancy term "DIESEL", inter alia:

- European trademark DIESEL No. 743401 dated February 9, 1998, duly renewed, and designating goods in international classes 11, 19, 20 and 21;
- European trademark DIESEL No. 6209183, dated August 7, 2007, duly renewed and designating goods and services in international classes 09 and 41;
- International trademark DIESEL No. 467393 dated February 16, 1982, duly renewed, and designating goods in international classes 18 and 25;
- International trademark DIESEL No. 689627, dated February 19, 1998, duly renewed, and designating goods in international classes 11, 19, 20 and 21;
- International trademark DIESEL No. 659762, dated August 23, 1996, duly renewed, and designating goods in international

classes 29, 30, 32 and 33.

2. DOMAIN NAMES:

Numerous domain names registered under gTLDs and ccTLDs, incorporating the term "DIESEL", among which the Complainant's main website "diesel.com" registered since 1996 and ranked among the most visted websites in the US.

FACTUAL BACKGROUND

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

About the Complainant

Diesel S.p.a. (hereinafter “Diesel” or “the Complainant”) is an Italian retail clothing company known worldwide and founded in 1978.

Since its creation in 1978, Diesel has experienced extraordinary growth and has evolved from being a leading pioneer in denim into the world of premium casual wear, becoming a true alternative to the established luxury market.

Diesel products are sold on all continents through a network of 5000 retail stores worldwide and employs approximately 3000 people in 80 countries. Diesel’s turnaround in 2012 was 1,5 billion euros.

In 2008, Diesel associated with the well-known brand Adidas to distribute jeans under the label “Adidas Originals Denim by Diesel”, in an aim to maintain the notoriety of the brand and attract younger customers. In 2009, Diesel associates with the L’Oréal group to launch perfumes under the names “Fuel for Life” and “Only the brave”.

A. The domain name is identical or confusingly similar

The disputed domain name is <deisel.com>.

The disputed domain name is highly similar to the main domain name and earlier trademarks of the Complainant, as only the second and third letter are inverted:

Complainant’s trademarks: D I E S E L
Complainant’s domain name: D I E S E L . C O M
Disputed domain name: D E I S E L . C O M

All letters of the Complainant’s trademark and domain names are visible in the disputed domain name. The Complainant contends that this case is a clear case of typo-squatting where the infringing domain name is one letter less than or different from the Complainant's mark. Such attempts have been disapproved of in various WIPO decisions (e.g. Telstra Corp. Ltd. v. Warren Bolton Consulting Pty. Ltd. D2000-1293; Playboy Enterprises International Inc. v. SAND Webnames-For Sale D2001-0094). These decisions were more recently confirmed by Société Nationale des Chemins de fer Français - SNCF v. Damian Miller / Miller Inc., Case No. D2009-0891), and very recently by CAC decision No. 101715 on the domain name <arcelormittla.com>.

The Complainant contends that the disputed domain name is highly similar, to the point of confusion, to the earlier trademark DIESEL. Indeed, the internet user who pays average attention to the domain name is very likely to be confused between the domain names <diesel.com> and <deisel.com>.

B. The Respondent has no rights or legitimate interests in respect of the domain name

The Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the Complaint. Indeed, the Respondent is not commonly known by the disputed domain name and has acquired

no trademark or service mark rights related to the “DIESEL” or “DEISEL” terms.

Firstly, the Respondent is not commonly known by the disputed domain name. The Respondent has acquired no trademark or service mark related to the DIESEL or DEISEL terms. The Complainant has conducted trademark searches and found no DIESEL or DEISEL trademark or right owned by the owner of the disputed domain name.

Secondly, the Respondent has not been authorized to use a domain name highly similar to the Complainant’s trademark without any license or authorization from the Complainant’s company, which is a strong evidence of the lack of legitimate interest. See WIPO Case No. D2012-1336; LEGO Juris A/S v. Ibnu Firdaus.

Thirdly, the Respondent’s use of the disputed domain name or preparation to use the domain name demonstrate no intent to use it in connection with a bona fide offering of goods or services. On the contrary, the disputed domain name has not been used in any way whatsoever, except as a parking page. To the best of the Complainant’s knowledge, the Respondent has not intended or made preparations to use the disputed domain name in connection with a bona fide offer of goods or services.

The current page to which the disputed domain name points is a pay-per-click parking page of commercial links to products identical or similar to those of the Complainant. Under UDRP rules, Panels unanimously consider that associating a domain name similar to a trademark with a webpage displaying commercial link and ads does not grant the Respondent legitimate interest in the disputed domain name:

Even if the Respondent is currently receiving no revenue from the pay-per-click links on the parking page, it is very difficult to believe that a domain name of this nature would not have been registered for some commercial purpose of benefit to the Respondent. The current page offers the disputed domain name for sale. Therefore, it appears clear that the Respondent had in mind commercial gain of the domain name.

Fourthly, since the adoption and extensive use by the Complainant of the trademark DIESEL predates the first entry of the disputed domain name, the burden is on the Respondent to establish the Respondent's rights or legitimate interests the Respondent may have or have had in the domain names. See PepsiCo, Inc. v. Amilcar Perez Lista d/b/a Cybersor, WIPO Case No. D2003-0174..

None of the circumstances which set out how a respondent can prove his rights or legitimate interests, are present in this case. In light of all the elements mentioned above, the Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the Complaint.

Given that the Complainant has made a prima facie case that the Respondent lacks legitimate rights or interest in the disputed domain name, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name.

C. The domain name was registered and is being used in bad faith

Firstly, the Complainant states that the DIESEL trademarks are so widely well-known that it is inconceivable that the Respondent ignored the Complainant’s earlier rights on the term DIESEL.

It is clear that the Respondent had the Complainant’s name and trademark in mind when registering the disputed domain name. The Respondent’s choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant’s trademark. Indeed, a simple search for the terms “diesel” and “deisel" on an online search engine yields results only related to the Complainant and in particular the first result is www.diesel.com. Therefore, at the very least, the Respondent knew or should have known that, when registering and using the disputed domain name, he would do so in violation of the Complainant’s earlier rights.

Secondly, the Complainant contends that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting or otherwise transferring it to the Complainant or any other third party.

Indeed, the disputed domain name is being offered for sale. This information is clearly stated at the right of the page to which the disputed domain name points. The fact that a domain name highly similar to a famous trademark has been put on sale has been considered a bad faith element by previous Panels.

Thirdly, the registrant uses a well-known privacy service in order to keep its identity secret. The use of such service, although not actionable per se, is a further evidence of bad faith registration and use.

WIPO Overview 2.0 explicitly states that panels have found that the apparent lack of so-called active use of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding registration, and vice versa.

As discussed in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, the relevant issue is not limited to whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name “being used in bad faith” is not limited to positive action; inaction is within the concept.

It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant’s trademarks which enjoys strong reputation, plus other facts, such as above described non-use of the disputed domain name and Respondent’s engagement in typosquatting, are sufficient to establish bad faith under the 4(a)(iii) of the Policy. See for example CAC decision in case No. 101687 against the domain name <arcelormittol.com>.

In light of all the elements above, the Complainant contends that the domain name was registered and is being used in bad faith by the Respondent. The combination of all the elements listed and detailed above unequivocally show that the Respondent has acted in bad faith when registering and using the disputed domain name, in line with the UDRP doctrine developed under Paragraph 4(a)(iii) of the UDRP Policy.

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).

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

According to paragraph 4(a) of the UDRP Policy the Complainant is required to prove each of the following three elements to obtain the transfer of the disputed domain names:
(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

I. RIGHTS OF THE COMPLAINANT AND IDENTITY OR CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in the trademark "DIESEL" since 1982. The Complainant's trademark was registered prior to the registration of the disputed domain name, on October 1, 2002, and is widely well-known.

In assessing identity or confusing similarity the Panel finds that both the disputed domain name and the Complainant's "DIESEL" mark consist of 6 letters and the only difference between them is the inversion of the letters "i" and "e". UDRP Panels consider that a domain name consisting of a common, obvious, or intentional misspelling of a trademark is confusingly similar to the relevant mark for purposes of the first element of the UDRP Policy (so called typosquatting). Examples of such typos include (i) adjacent keyboard letters, (ii) substitution of similar-appearing characters (e.g., upper vs lower-case letters or numbers used to look like letters), (iii) the use of different letters that appear similar in different fonts, (iv) the use of non-Latin internationalized or accented characters, (v) the inversion of letters and numbers, or (vi) the addition or interspersion of other terms or numbers (see paragraph 1.9 WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition “WIPO Jurisprudential Overview 3.0”).

UDRP Panels also agree that the top-level domain (TLD), in this case <.COM>, is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant’s trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the disputed domain name is confusingly similar to the Complainant's mark. The similarity of the disputed domain name to the Complainant's marks is likely to lead to confusion and/or association for the Internet users.

Accordingly, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the UDRP Policy.

II. LACK OF RIGHTS OR LEGITIMATE INTERESTS

It is a consensus view of UDRP Panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see paragraph 2.1 of the WIPO Overview 3.0: "[...] where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.")

The Panels finds that the Respondent lacks rights or legitimate interests in the disputed domain name for the following reasons.

The Respondent is Whois Privacy Corp. The Complainant states that: i) it has no relationship with the Respondent whatsoever; ii) the Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or any other mark identical or confusingly similar to such mark.

There is no evidence that the Respondent Whois Privacy Corp: i) has been commonly known by the disputed domain name or ii) has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name points to a parking page containing pay-per-click links related to the Complainant and to its activity (clothing); such use is not to be considered a bona fide offering of goods or services. Indeed, applying UDRP paragraph 4(c), Panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

The Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the UDRP Policy.

III. BAD FAITH REGISTRATION AND USE

This Panel finds that the disputed domain name has been registered and is being used in bad faith for the following cumulative circumstances.

The Respondent has used a privacy or proxy registration service. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used, including whether the Respondent is operating a commercial and trademark-abusive website, may however impact the Panel's assessment of bad faith (see paragraph 3.6 of the WIPO Overview 3.0).

The Respondent has registered the disputed domain name, which is a mispelling (inversion of the letters "i" and "e") of the Complainant's prior trademark and, hence, confusingly similar to such mark. Given the distinctiveness and reputation of the Complainant's trademark and activity, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation.

Considering the use of the disputed domain name it is clear for this Panel that the Respondent had the Complainant and its mark in his mind when he registered the domain name. The disputed domain name resolves to a parking page displaying PPC links such as "Diesel jeans", "Diesel Shoes", "Mens Clothing", "Womens Fashion Clothes".

The employment of an intentional misspelling during the registration by the Respondent corroborated by the use of the disputed domain name for infringing website content (PPC links related to the Complainant and its business) shows the intention of the Respondent to confuse Internet users seeking or expecting the Complainant. Thus, by registering and using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website or a product or service on his website.

In addition, the website to which the disputed domain name points displays a script asserting that the disputed domain name is for sale. It is, therefore, likely that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of Complainant for valuable consideration in excess of his documented out-of-pocket costs directly related to that domain name.

Considering each and all of the above-mentioned circumstances, this Panel finds that the Complainant has discharged the burden of proof under paragraph 4(a)(iii) of the UDRP Policy and the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DEISEL.COM**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2018-01-19

Publish the Decision