Decision for dispute CAC-UDRP-101783

Case number	CAC-UDRP-101783
Time of filing	2018-01-09 09:31:36
Domain names	steiffbearsus.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Margarete Steiff GmbH

Complainant representative

Organization	SKW Schwarz

Respondent

Name	Thelma Nisbet

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has registered numerous trademarks, including:
- EU Trade Mark registration No 000007443 'Steiff'; Nice classes 18, 25, 28, registered 3 February 1998;
- International Registration No 947107 'Steiff' (Japan, Republic of Korea, Norway, USA; Switzerland, China, Russian Federation, Ukraine); Nice classes 3, 9, 12, 20, 21, 24, 26, 27, 28; registered 13 September 2007;
- International Registration No 1240894 'Steiff' (EU, Japan; China, Switzerland); Nice class 35; registered 13 January 2015;
- International Registration No 933947 'Steiff KNOPF IM OHR' (Japan, Norway, USA; Switzerland; China; Russian Federation); Nice classes 09, 12, 20, 21, 24, 26, 27, 28; registered 10 May 2007;
- Canadian Trademark registration No 1333244-00 'Steiff'; Nice classes 18, 22, 24, 28; registered 16 February 2010;
- German Trademark registration No 724750 'Steiff Teddybär'; Nice Class 28; registered 24 May 1958.

The Complainant uses the company name and numerous Steiff-trademarks extensively, especially for plush toys, kidswear, and respective retail services. Moreover, the Complainant holds the domain names www.steiff.com and www.steiffusa.com.

FACTUAL BACKGROUND

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

Factual Background

The Complainant is German toy manufacturer Margarete Steiff GmbH. Recently, the Complainant had to discover that the domain name <steiffbearsus.com> had been registered without its consent.

The Complainant is one of the best known producers of teddy bears and other plush toys in the world. In an article taken from the international news website www.aol.com, attached to the Complaint as an annex, Steiff is described as 'world-famous' and a 'toy-giant'. The Complainant submits also an article from the website of the British newspaper 'The Daily Mail' that illustrates Steiff's world fame. Guests from all over the world come to visit the remote little town of Giengen an der Brenz in southern Germany, where the Complainant is headquartered, to visit the Steiff Museum dedicated to the world of the famous plush toys and the company history.

The business of the Complainant was founded in 1880. In 1893 the company was registered in the commercial register as 'Margarete Steiff, Felt Toy Factory Giengen/Brenz'. It has since then been known simply as 'Steiff'.

The Complainant has registered numerous trademarks, including EU Trade Mark registration No 000007443 'Steiff' and International Registration No 947107 'Steiff'.

The Complainant uses the company name and numerous Steiff-trademarks extensively, especially for plush toys, kidswear, and respective retail services. Moreover, the Complainant holds the domain names www.steiff.com and www.steiffusa.com.

Recently, The Complainant had to discover that the domain name <steiffbearsus.com> had been registered without its consent. According to the current WHOIS DATA, the Respondent holds the domain name under identity 'Thelma Nisbet'.

The disputed domain registration infringes the Complainant's trademarks and right to the company name.

The disputed domain name is confusingly similar to the Complainant's trademarks and company name since it contains the word 'Steiff'. The component 'bearsus.com' can be neglected as it is merely a descriptive term for the Complainant's most famous product. The distinctive character of the domain name is thus coined by the word 'Steiff'.

I. Lack of Rights or legitimate Interests

The Complainant contends that nothing indicates the Respondent has any rights or legitimate interests in respect of the disputed domain name. The Respondent has neither been authorized by the Complainant to register the disputed domain name, nor has the Respondent acquired a legitimate right to use Steiff – trademarks by any preceding or current business activity. The website uploaded under the disputed domain name is a selling site with different products of Motorcycle Helmets, clothing, footwear and jewelry of different brands. The display of such content does not constitute legitimate use. The sole purpose of the domain name registration is to create a danger of confusion in order to commercially exploit the reputation of the name and trademark 'Steiff' which is a fraudulent act. 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 capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, 2017, section 2.9; WIPO Case: Lardi Ltd v. Belize Domain WHOIS Service Lt in Case No. D2010-1437). This holds true even more so, if the Respondent is actually selling goods which have nothing to do with the Complainant's goods and capitalizes the Complainant's good name.

Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name (Oki-data test – see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, 2017, section 2.8). However, the Respondent is not rendering any of such services as it merely sells products of different trade marks.

II. Bad Faith

By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 of a product or service on the Respondent's website or location. To facilitate assessment of whether this has occurred, and bearing in mind that the burden of proof rests with the Complainant, UDRP paragraph 4(b) provides that this scenario constitutes evidence of a Respondent's bad faith. The Respondent seeks to attract the consumers' attention to its website using the famous and most distinctive trade mark and company name of 'Steiff'. The trademark and company name are unfairly exploited for the Respondent's commercial interest.

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). Specifically, the Complainant has proved a number of relevant trademark registrations for STEIFF-formative marks.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, met its prima facie burden to show 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). Specifically, the Respondent appears only to use the disputed domain name to redirect traffic to a commercial website with no relevance to the Complainant, its marks or products. The Respondent has not appeared to rebut any of the Complainant's allegations or evidence.

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). Specifically, the use of a well-known mark in a domain name, simply to drive traffic to another commercial website, trades on the goodwill of that well-known mark, and constitutes bad faith under 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

Respondent appears only to use the disputed domain name to redirect traffic to a commercial website with no relevance to the Complainant, its marks or products. The Respondent has not appeared to rebut any of the Complainant's allegations or evidence. The use of a well-known mark in a domain name, simply to drive traffic to another commercial website, trades on the goodwill of that well-known mark, and constitutes bad faith under the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **STEIFFBEARSUS.COM**: Transferred

PANELLISTS

Name	**Mike Rodenbaugh**

DATE OF PANEL DECISION 2018-02-05

Publish the Decision