Decision for dispute CAC-UDRP-101947

Case number	CAC-UDRP-101947
Time of filing	2018-04-03 09:06:54
Domain names	kask-helmet.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	KASK S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Name	xiao shu fang

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various "KASK" (with design) trademarks, including the international trademark registration no. 1163154, registered on March 7, 2013, for various goods in international classes 9 and 28 (hereinafter the “trademark“). The Respondent’s home country China is one of the countries covered by this international trademark registration.

The disputed domain name was registered on November 15, 2017, i.e. the Complainant’s trademark predates the registration of the disputed domain name.

FACTUAL BACKGROUND

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

The Complainant is a company registered in Italy, with subsidiaries in the USA (KASK America Inc.) and Australia (Kask Australia Pty Ltd.). The company was founded in 2004 and is specialized in developing, designing and manufacturing safety helmets for, inter alia, skiing, cycling, mountaineering, or horse riding. The Complainant has won various design prices for its helmets. KASK helmets are worn by “Team Sky”, a professional cycling team that successfully competes in well-known international cycling tournaments. The Claimant has spent considerable advertising effort in promoting the mark “KASK”,

thereby acquiring the trademark's goodwill.

The Respondent uses the disputed domain name for a website offering for sale various items for cyclists, such as gloves, glasses, saddles and clothes. This web shop operated by the Respondent also offers "KASK" branded helmets and helmets featuring other brands of the Complainant's competitors. The Complainant contends that all helmets offered in the Respondent's web shop – whether under the "KASK" brand or under one of the competing brands – are counterfeit products. This contention is supported by the following quote from the Respondent's web shop: "We have ourself factory, and produce the single punch tablet press machine by ourself. We promise to offer the best service!"

As soon as the Complainant became aware of the Respondent's registration and use of the disputed domain name it instructed its representative to send a cease and desist letter to the Respondent, requesting the immediate cease of any use, and the transfer, of the disputed domain name. This cease and desist letter was sent by email on March 8, 2018. The Respondent did not reply.

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 the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

According to Article 11(a) of the Rules, "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

The language of the Registration Agreement is Chinese. The Complainant, however, has requested that the language of the proceeding be English instead of Chinese.

The Panel uses its discretionary authority to decide that the language of the proceedings shall be English for the following reasons:

(a) The Respondent's website for which the Respondent has used the disputed domain name is in English language. The primary currency offered to potential buyers in the online shop on this website is USD.

(b) The disputed domain names comprises the English language word "helmet", which is descriptive for the products offered by Respondent on the corresponding website.

(c) The Respondent received the Complainant's e-mail communications as well as this complaint under the UDRP Policy in English language and failed to reply. The Respondent did not express in any way that he cannot answer the allegations

because of language issues.

(d) The Complainant has submitted its Complaint and supporting evidence in English. If the Complainant were required to submit all documents in Chinese, the administrative proceeding would be unduly delayed and the Complainant would have to incur substantial expenses for translation.

PRINCIPAL REASONS FOR THE DECISION

Apart from the descriptive suffix “-helmet” the disputed domain name is identical to the Complainant’s protected brand name “KASK”. It is therefore confusingly similar to the Complainant’s “KASK” trademark (within the meaning of paragraph 4(a)(i) of the Policy).

The Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain names, nor is the Respondent commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent. The Panel notes that the Respondent was operating its business (i.e. the web shop) to offer goods or services under the disputed domain name before receiving notification of this dispute. The Panel accepts, however, the Complainant’s contention that the products offered by the Respondent are counterfeit products. It is well-settled that such knowingly infringing use of a trademark to offer counterfeit products is not a bona fide offering of goods and services within the meaning of paragraph 4(c)(i) of the Policy.

Given the Respondent’s offering of “KASK” branded cycling helmets on the website it is evident that the Respondent had the Complainant's trademark in mind when registering the disputed domain name. In the absence of a Response, the Panel infers that by 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 this website and the Respondent’s products offered on it (within the meaning of paragraph 4(b)(iv) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **KASK-HELMET.COM**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2018-05-16

Publish the Decision