Decision for dispute CAC-UDRP-101980

Case number	**CAC-UDRP-101980**
Time of filing	**2018-05-25 13:16:36**
Domain names	**davidoffeyewear.com**

Case administrator

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

Complainant

Organization	**Zino Davidoff SA**

Complainant representative

Organization	**BrandIT GmbH**

Respondent

Organization	**Cheng Fei**

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings the Panel is aware of which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is - among others - the owner of the international trademark registration No. 467510 "DAVIDOFF", granted in 1982 and duly renewed, as well as of other national trademark registrations all around the world, including China (Respondent's country of origin).

FACTUAL BACKGROUND

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

Complainant is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation. The brands of the Complainant have been continuously used and marketed for over 30 years and the latter has a strong presence and a significant interest in the Chinese market.

The Respondent has registered the disputed domain name on March 24, 2018. Such domain entirely incorporates the Complainant's trademark, with the addition of the generic term "eyewear".

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name and is not related in any way with the Complainant's business. The Respondent is not affiliated with DAVIDOFF, nor authorized by such company in any way. In addition, the Complainant affirms it currently does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use, or apply for registration of the disputed domain name by the Complainant.

The Complainant contends that the disputed domain name has been registered and being used in bad faith, considering that - after having sent a C&D letter to the Respondent - the latter replied asking for Euro 1.300,00 to sell the disputed domain name.

The disputed domain name points to a blank page and the Respondent did not provide any explanation concerning the registration (and the passive use) of the disputed domain name.

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

1. The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to the Complainant's trademarks (within the meaning of paragraph 4(a)(i) of the Policy). In particular, the Panel finds that the disputed domain name is identical to the Complainant's trademark "DAVIDOFF".

In this regard, it shall be reminded how several previous UDRP panels have held that the addition of a generic term associated to a trademark does not create a new or different right to the mark, nor diminish confusing similarity.

On the contrary, given the business field in which the Complainant operates, the addition of the generic term "eyewear" even increase the risk of confusion for consumers, as they might believe that Respondent is somehow affiliated with Complainant and/or Respondent is somehow doing business using Complainant's trademark.

2. 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 finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of,

or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent, which did not file any Response to the complaint of Zino Davidoff SA.

As a matter of fact, there are no arguments why the Respondent could have own rights or legitimate interests in the disputed domain name. "DAVIDOFF" definitely is a distinctive sign used by the Complainant as business name and trademark in order to denote its products and services. Therefore, the Panel accepts the contentions of the Complainant that the Respondent has no such rights or legitimate interests in the disputed domain name.

3. The Complainant has, to the satisfaction of the Panel, shown the disputed domain name to have been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

As stated above, the Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

In the absence of a Response and given the reputation of the Complainant and its trademarks, the Panel infers that the Respondent had the Complainant's trademarks "DAVIDOFF" in mind when registering the disputed domain name.

As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use (WIPO - D2000-0003 - Telstra Corporation Limited v. Nuclear Marshmallows and WIPO - D2000-0400 - CBS Broadcasting, Inc. v. Dennis Toeppen).

Furthermore, the fact that the Respondent replied to the Complainant's C&D letter by requesting Euro 1.300,00 for the sale of the disputed domain name clearly demonstrates the real purpose of the Respondent, which registered with the sole aim to prevent the legitimate trademark owner from reflecting its mark in corresponding domain name and consequently resell it at a substantially higher price than the out-of-pocket costs.

Consequently, the Panel believes that the same was registered and is being (passively) used in bad faith, in order to prevent the Complainant from reflecting the mark in the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DAVIDOFFEYEWEAR.COM**: Transferred

PANELLISTS

Name	**Tommaso La Scala**

DATE OF PANEL DECISION 2018-07-02

Publish the Decision