Decision for dispute CAC-UDRP-102038

Case number	CAC-UDRP-102038
Time of filing	2018-05-31 09:24:11
Domain names	pinoycinemaxx.com

Case administrator

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

Complainant

Organization	Cinemaxx Holdings GmbH

Complainant representative

Organization	Lubberger Lehment

Respondent

Name	Dennis Taylo

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of many trademark registrations consisting and/or containing the term “CINEMAXX” in particular international registration No. 778651 “CINEMAXX” registered on 20.6.2001 for goods and services in classes 7, 9, 11, 14, 16, 18, 25, 26, 28, 30, 33, 35, 36, 38, 39, 41 and 42 (and also German figurative trademark registration no. 302012054484, registered on 04.02.2013 for goods and services in classes 41, 14, 16, 21, 24, 25, 26, 28, 29, 30, 31, 32, 33, 34, 35, 43, so called CINEMAXX-Logo).

FACTUAL BACKGROUND

According to the Complainant’s non-contested allegations, it has been operating a well-known cinema chain in Germany for decades and is considered as one of the market leaders in the German but also in the European cinema business. It has 33 movie centres with 289 screens and roundabout 73,000 seats. All movie centres use the name “CINEMAXX” for all their activities as well as the “CINEMAXX-LOGO” The Complainant was founded under the trademark CinemaxX in 1989 and the first trademark has been registered in 1990. Since then it has expanded its activity massively. Already in 1997, it had over ten cinema centres in Germany and started the European expansion. The Complainant has over 2,000 employees in Germany and Denmark and uses its CinemaxX centres not only for showing movies but also for various cultural and social activities.

Its theatres are placed at the most prominent locations such as Potsdamer Platz in Berlin (which serves as an official location for the annual worldwide famous “Berlinale”), Dammtor in Hamburg and Isartor in Munich.

The disputed domain name was registered by the Respondent on 17.09.2017. It results from the Complainant’s documented allegations that it resolved to a website displaying the Complainant’s trademarks (in particular the CINEMAXX-Logo as a 1:1-copy) and offering services in the same business area of activity of the Complainant, promoted as follows: “WATCH MOVIE ONLINE, JUST SIT BACK AND RELAX”.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant is holder of several “CINEMAXX”-trademarks which have been used in connection with its cinema business. The Complainant contends the well-known character of its trademark “CINEMAXX” in Germany, due to its enormous success and presence of its business. The Complainant contends that the disputed domain name is almost identical with its trademark as it consists of the identical term “cinemaxx” (with the distinctive double “xx”) and the non-distinctive suffix “pinoy”, that is descriptive and stands for Philippine population. The suffix “pinoy” does not change the overall impression created by the dominating element “cinemaxx”. This is even enforced by using the famous CINEMAXX-Logo as a 1:1 copy on their Website, clearly highlighting the independent significance of the part “CINEMAXX”. As a result, the disputed domain name could easily mislead and make consumers believe that the domain belongs to the Complainant. This is even more true when considering that the consumer discovers the famous CINEMAXX-Logo on the Website. The English-held Website clearly aims to address the international public that knows the famous CINEMAXX-brand of the Complainant to attract their attention. The Complainant provided evidence that the following wording “WE DO NOT OWN EVERY VIDEOS WE PLAYED” has been stated in the website to which the domain resolved. It contends that stating the above, the Respondent revealed himself the illegal copyright infringing character of his services. As the website to which the disputed domain name resolves offers movie streaming services, this misleading nature of the domain is even more applicable because this service is nearly identical with the Complainant’s famous business. Furthermore, the illegal nature of the website hardly damages the value of the Complainant’s trademark.

The Complainant further provided evidence that the same content has been found also on a corresponding Facebook-Page. The Complainant addressed Facebook asking the deletion of pinoycinemaxx-Facebook-page due to trademark infringement and Facebook already shot this Facebook-Page down.

The Complainant further contends that the Respondent has no prior rights or legitimate interests in the disputed domain name, since the Respondent is not the owner of any trademarks consisting of the term “cinemaxX”. Furthermore, the Respondent has never been authorised by the Complainant to use its trademarks or seek registration of any domain name incorporating its trademarks. The registration of the protected trademarks preceded the registration of the disputed domain name. Therefore, the burden of proof lies with the Respondent to demonstrate that such rights or legitimate interests exist at all.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith for the following reasons. First of all, the registration of a well-known trademark as a domain name is a clear indication of bad faith itself. The Respondent was certainly aware of the Complainant’s “CinemaxX” trademarks at the time of registering the disputed domain name. This becomes clear when considering the 1:1-copy of the famous “CINEMAXX”-Logo prominently depicted on the website to which the disputed domain name resolves. The behaviour in bad faith likewise becomes clear when looking at the design of the website to which the disputed domain name resolves and of corresponding Facebook-Page. This website untruthfully pretends to belong to the Complainant and provided its identical famous CINEMAXX-Logo. The Respondent obviously only uses the trademark “CINEMAXX” with the aim to redirect Internet users who are searching for the Complainant’s website. This finding is even more true when considering the content being available on the website to which the disputed domain name resolves. This offers illegal streaming services, that is clearly linked to the Complainant’s business. Therefore, the Respondent obviously tries to bring their illegal services on to the costumer under the well-known

“CINEMAXX”-trademark of the Complainant. Finally, the Respondent concealed its identity by not providing any contact information. Attempts to hide the domain holder’s identity indicate bad faith as well.

RESPONDENT:

The Respondent replied to the Complainant’s contentions stating that: “i dont have intent to use the cinemaxx name because pinoycinemax is not available in namecheap thats why i use pinoycinemaxx with double xx. i already delete the said domain. im very sorry. i didnt know or i didnt aware that there is a cinemaxx company in germany. i already delete the content and soon i will delete the domain name.”.

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.
Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

(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 in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

2.
Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of various trademarks for and/or including the term “CINEMAXX”, in particular international registration No. 778651 “CINEMAXX” registered on 20.6.2001 for goods and services in classes 7, 9, 11, 14, 16, 18, 25, 26, 28, 30, 33, 35, 36, 38, 39, 41 and 42 (and also German figurative trademark registration no. 302012054484, registered on 04.02.2013 for goods and services in classes 41, 14, 16, 21, 24, 25, 26, 28, 29, 30, 31, 32, 33, 34, 35, 43). These trademarks predate the creation date of the disputed domain name, which is 17.09.2017.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant’s trademark where the

disputed domain name incorporates the complainant's trademark in its entirety (e.g. Virgin Enterprises Limited v. Registration Private, Domains by Proxy, LLC / Name Redacted, WIPO Case No. D2018-0645; "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Elliot Elliot, WIPO Case No. D2018-0213; F. Hoffmann-La Roche AG v. Jason Barnes, ecnopt, WIPO Case No. D2015-1305; Compagnie Générale des Etablissements Michelin v. Christian Viola, WIPO Case No. D2012-2102; Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070; The Chancellor, Masters and Scholars of the University of Oxford v. Oxford College for PhD Studies, WIPO Case No. D2015-0812; Rhino Entertainment Company v. DomainSource.com, WIPO Case No. D2006-0968; SurePayroll, Inc. v. Texas International Property Associates, WIPO Case No. D2007-0464). This Panel shares this view and notes that the Complainant's registered trademark CINEMAXX is fully included in the disputed domain name.

Furthermore, and according to UDRP panel consensus, the applicable generic Top-Level Domain ("gTLD") suffix ".com" in the disputed domain name is to be disregarded under the confusing similarity test.

Finally, it is the view of this Panel that the addition of the term "PINOY" - that is descriptive and stands for Philippine population - is not sufficient to exclude the confusing similarity between the disputed domain name and the Complainant's trademarks. In numerous UDRP Decisions, panels have found that the addition of a descriptive or geographical terms to a distinctive trademark does not diminish the distinctiveness of the trademark (see, "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Wallin Fransson, WIPO Case No. D2018-0214; F. Hoffmann-La Roche AG v. Jason Barnes, WIPO Case No. D2015-1305; AT&T Corp. v. WorldclassMedia.com, WIPO Case No. D2000-0553; and Sanofi-Aventis v. Andrey Volkovich, WIPO Case No. D2010-1230; see also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), at section 1.8).

Hence, this Panel finds that the disputed domain name is confusingly similar to the Complainants' trademarks CINEMAXX pursuant to the Policy, paragraph 4(a)(i).

3.
Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. It is important to note that the mere registration of a domain name does not give rise to a "legitimate interest" (see "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Wallin Fransson, WIPO Case No. D2018-0214, F. Hoffmann-La Roche AG v. Jason Barnes, WIPO Case No. D2015-1305; Sanofi-Aventis v. Domain Admin/ Andrey Volkovich, WIPO Case No. D2010-2009).

In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a prima facie case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has thus remained unchallenged, the Complainant has not authorized the Respondent's use of the trademarks CINEMAXX, e.g., by registering the disputed domain name comprising said mark entirely. Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, the disputed domain name resolved to a website displaying the Complainant's trademarks (in particular the CINEMAXX-Logo as a 1:1-copy) and offering services in the same business area of activity of the Complainant, promoted as follows: "WATCH MOVIE ONLINE, JUST SIT BACK AND RELAX".

Since this use is clearly commercial, it cannot be considered a legitimate, noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. Furthermore, such use cannot be qualified a bona fide offering of goods or

services since it rather has a high propensity to mislead and divert consumers according to paragraph 4(c)(i) of the Policy.

It is acknowledged that once the Panel finds such prima facie case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see WIPO Overview 3.0, section 2.1). Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

4.
According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainants' mark as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that the Respondent has used the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to a website, by creating a likelihood of confusion with CINEMAXX trademarks as to the source, sponsorship, affiliation or endorsement of its website. According to the Complainant's non-contested allegations the disputed domain name resolved to a website displaying Complainant's trademarks and offering/promoting services in the same business area of activity in which the Complainant is active. The Respondent did therefore benefit from any confusion between the Respondent and the Complainant that arose from the similarities in the disputed domain name and services offered by the Complainant and offered by the Respondent. Therefore, it is highly likely that the Respondent received revenue from Internet users who happen to come across the Respondent's disputed domain name and website by means of confusion with the CINEMAXX trademarks (see Multi Media, LLC v. Domain Admin, Whois Privacy Corp., WIPO Case No. D2016-1039; Cembra Money Bank AG v. Original-Kreditbox AG limited, Cinar Abdulhamit, WIPO Case No. D2015-0885; The Chancellor, Masters and Scholars of the University of Oxford v. Almutasem Alshaikhissa, WIPO Case No. D2014-2100; The Chancellor, Masters and Scholars of the University of Oxford v. Oxford College for PhD Studies, WIPO Case No. D2015-0812).

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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. **PINOYCINEMAXX.COM**: Transferred

PANELLISTS

Name	**Dr. Federica Togo**

DATE OF PANEL DECISION 2018-07-09

Publish the Decision