Decision for dispute CAC-UDRP-102078

Case number	CAC-UDRP-102078
Time of filing	2018-07-03 09:28:36
Domain names	mammutstore.online, mammutoutlet.online, mammutsale.online, cheapmammut.online, mammutoutlet.top, discountmammut.online, mammutshop.online, mammutjackets.online

Case administrator

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

Complainant

Organization	Mammut Sports Group AG

Complainant representative

Organization	Lubberger Lehment

Respondent

Name	Xian Wei Fa

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings related to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant is the owner of a number of International trademark registrations covering various jurisdictions including the following examples:

- International Trademark Registration No. 646924 for MAMMUT with a priority date of November 7, 1995 covering classes 6, 9, 18, 20, 22, 25, 28; and

- International Trademark Registration No. 978626 for MAMMUT with a priority date of August 4, 2008 covering classes 39, 41 and 43.

FACTUAL BACKGROUND

The following facts asserted by the Complainant and not contested by the Respondent:

The Complainant is a leading and successful supplier of alpine, climbing, and outdoor equipment with a history going back more than 150 years. It generates annual turnovers of more than 200 million Swiss francs. The Complainant’s products are

sold bearing the trademark MAMMUT and such products are distributed under absolute standards in terms of quality and innovation. As a result of its long, extensive and successful use, the MAMMUT trademark has become famous in the sector of outdoor equipment and clothing.

The following disputed domain names resolve to a fake online retail store and this store has copied, without permission, the MAMMUT trademark and logo, original product images, and banner advertisements from the Complainant's own website:

<mammutstore.online>
<mammutoutlet.online>
<mammutsale.online>
<cheapmammut.online>

Collectively, the "resolving disputed domain names".

Other of the disputed domain names are currently inactive and do not resolve to any website content:

<mammutoulet.top>
<discountmammut.online>
<mammutshop.online>
<mammutjackets.online>

Collectively, the "non-resolving disputed domain names".

The disputed domain names came to the Complainant's attention by way of consumer complaints and the Complainant's subsequent research. These complaints typically involved a situation in which consumers tried to order alleged MAMMUT products from one of the resolving disputed domain name's websites and such orders either never arrived, despite the credit card being charged for a purchase, or the consumer's credit card was charged with a higher amount than expected for the items received.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of the disputed domain names 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 names (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 names have 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.

Furthermore, the Complainant has requested consolidation of all of the disputed domain names into this single case pursuant to UDRP par. 4(f) and UDRP Rules 3(c) and 10(e). The Whois records for all but one of the disputed domain names identifies the Respondent as “Xian Wei Fa” but one of the disputed domain names (<mammutoulet.top>) identifies a different Respondent’s name as “Li Wei Wei”. Nevertheless, the Complainant has asserted that all of the disputed domain names are owned by, or are under the effective control of a single person or entity, or a group of individuals acting in concert. In support of this assertion, the following similarities as between the <mammutoulet.top> domain name and the other disputed domain names are cited:

- many elements of the Whois records are identical such as the postal address, the phone numbers, and the fax numbers;

- the name and address of the administrative, technical, and billing contacts is identical and is identified as Nexperian Holding Ltd. (“Nexperian”); and

- all of the disputed domain names are held at the same registrar.

Past UDRP decisions have held that multiple domain names may be consolidated into a single case where they are all subject to common control and, having regard to all of the relevant circumstances, where consolidation would be procedurally efficient, fair and equitable to all parties. HUGO BOSS Trade Mark Management GmbH & Co v. Charles Carranza and William Tillery, Case No. 101901 (CAC, April 5, 2018). Further, specific commonalities have been cited by other panels in upholding consolidation requests of this nature. See, e.g., PRADA S.A. v. xie xiaomei / zhang yuanyuan / zhou honghai / zhouhonghai / Zhou Hong Hai / Honghai Zhou / deng wen / xie peiyuan / Jianghong Wang / xie caida / liu min / du linmei, Case No. D2016-0799 (WIPO, June 22, 2016) (26 disputed domain names consolidated into a single case where the evidence demonstrated "the use of the same Registrar and DNS and the pointing of the disputed domain names to substantially identical web sites.")

In the present case, the various factors identified by the Complainant lead to the reasonable conclusion that the disputed domain names are, in fact, commonly controlled and should be consolidated.

A final factor influencing this procedural point is the lack of any communication whatsoever from the Respondent despite the Provider having taken reasonable measures to establish contact. One could argue that a single owner might ignore service of a UDRP complaint. However, it seems far more likely that, were the disputed domain names actually owned by different individuals or entities, at least one of them would have responded to the attempts at communication in this dispute.

On a balance of the probabilities - the accepted standard of proof in UDRP cases - this Panel concludes it is more likely than not that all of the disputed domain names are under common ownership or control. Furthermore, having regard to all of the relevant circumstances, consolidation in this case is procedurally efficient, fair, and equitable to all parties.

PRINCIPAL REASONS FOR THE DECISION

Trademark Rights and Identity or Confusing Similarity:

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term MAMMUT for goods and services classes covering outdoor equipment and clothing. Further, the Complainant is the owner of the <mammut.com> domain name that incorporates its trademark. All of the above were created and registered prior to the creation dates of each of the disputed domain names. As such, the Panel finds that the Complainant possesses rights in its MAMMUT trademark.

Next, UDRP Panels have consistently held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011). In fact, the addition of a term that specifically relates to the Complainant’s goods or services is particularly apt to increase the likelihood of confusion with the

Complainant.

In the present case, each of the disputed domain names consists of the MAMMUT trademark followed by one of the descriptive words “outlet”, “store”, “sale”, “cheap”, “shop” or “discount”. As Complainant’s activities include the sale of its outdoor equipment and clothing through channels such as shops and online, or on-sale at a discount, the use of these words may serve to reinforce the confusing similarity between each of the disputed domain names and the Complainant’s trademark. J. Choo Limited v. lee rose / Whois Agent, Whois Privacy Protection Service, Inc, Case No. D2016-1229 (WIPO, August 23, 2016) (in finding the domains <jimmychoopumps.com> and <jimmychooshoessales.com> to be confusingly similar to the complainant's JIMMY CHOO trademark, the panel noted that "consumers would simply consider the words 'shoessales' and 'pumps' to indicate the type of goods being sold and that they are being offered for reduce [sic] prices.")

In light of the above, the Panel concludes that the Complainant possesses rights to the MAMMUT trademark and that each of the disputed domain names is confusingly similar to such mark.

Rights or Legitimate Interest:

Paragraph 4(a)(ii) of the Policy directs an examination of the facts to determine whether a respondent lacks rights or legitimate interest in the disputed domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interest.

The first example, under Paragraph 4(c)(i), is where “before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services”. Here, four of the disputed domain names resolve to a page offering outdoor equipment and clothing bearing the MAMMUT trademark. The Complainant claims, without rebuttal from the Respondent, that these websites are fake online shops and that the Nexperian company mentioned in the Whois records for each of the disputed domain names is known for scams and frauds through online shops. To support this assertion, the Complainant submits into evidence a number of e-mails it has received from customers who claim to have been victims of the websites that resolve from some of the disputed domain names as well as a third-party article in which Nexperian is described as operating fraudulent online stores or websites. The Respondent has not submitted a response in this case and so these assertions go unrebutted. In view of the activities undertaken by the Respondent at the websites of the resolving disputed domain names, the Respondent has not used these disputed domain names in connection with a bona fide offering of goods or services under Paragraph 4(c)(i). Philipp Plein v. Yuriy Shi, Case No. 101583 (CAC, August 18, 2018) (no bona fide offering of goods or services found where “the pictures of the items displayed in the fake website are pictures of original Philipp Plein garments, which have been clearly taken from the official website … in violation of the Complainant copyright.”) Even if the goods offered at Respondent's websites are, in fact, genuine MAMMUT products which are then shipped to customers, the websites do not satisfy the test for bona fide use of a trademark in a domain name under Oki Data Americas, Inc. v. ASD, Inc., Case No. D2001-0903 (WIPO, November 6, 2001). Here the websites are, according to customer complaints, not actually selling the Complainant’s goods and they provide no disclosure of the Respondent's lack of any relationship with the trademark owner.

As for the non-resolving disputed domain names, the lack of any website content or other use cannot, by definition, constitute a bona fide offering of goods or services and, thus, cannot support a claim of any rights or legitimate interests in a domain name. Guess? IP Holder L.P. and Guess?, Inc. v. xi long chen, FA 1786533 (FORUM June 15, 2018) (“The disputed domain name resolves to a parked [inactive] page with the message, “website coming soon!” The Panel finds that this use does not amount to a bona fide offering or good or services or a legitimate noncommercial or fair use per Policy 4(c)(i) & (iii) and Respondent does not have rights or legitimate interests with respect of the domain name.”).

The second example, under Paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant has made an unrebutted prima facie case showing that the various names used by the Respondent in the Whois records for the disputed domain names are Xian Wei Fa, Li Wei Wei, and Nexperian Holding Ltd. None of these names bear any similarity to the word Mammut. There is no other evidence in the record to suggest that the Respondent is commonly known by any of the disputed domain names or that has it acquired any trademark rights relevant thereto. As

such, this sub-section of the Policy is of no help to the Respondent.

As to the third example, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the MAMMUT trademark. Respondent is using the resolving disputed domain names to host websites at which products are allegedly offered for sale. This is certainly not noncommercial. It also cannot be considered fair as it does not fit in to any accepted category of fair use such as news reporting, commentary, political speech, education, nominative or generic use, etc. The non-resolving disputed domain names fare no better as they host no content at all and so this fails to rebut the assertion that their use is not legitimately noncommercial or fair.

In light of the above analysis, this Panel finds that the facts of this case do not demonstrate that the Respondent has any rights or legitimate interest in any of the disputed domain names.

Bad Faith:

Finally, the Complainant must prove, by a preponderance of the evidence, that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Hallmark Licensing, LLC v. EWebMall, Inc., Case No. D2015-2202 (WIPO, February 12, 2016) ("The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.")

Bad faith registration and use has often been found where a respondent intentionally attempts to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of Respondent's website. Policy, paragraph 4(b)(iv).

Here it is beyond question that the Respondent was on actual notice of the Complainant's rights in its MAMMUT trademark. This trademark has been used extensively around the world and has become famous long prior to the dates on which the disputed domain names were created. The trademark is also used on the websites of the resolving disputed domain names in relation to products that are offered by the Complainant.

Next, with no response or other form of rebuttal from the Respondent, the Panel is entitled to draw such inferences from the Respondent's default as it considers appropriate. Rules, par. 14(b). As such, the Panel accepts the Complainant's supported and unrebutted assertions that the websites of the resolving disputed domain names "pretend to be original online shop belonging to the Complainant … in order to then scam the costumers [sic] by way of credit card fraud." The Complainant has submitted into evidence screenshots of these websites and claimed that they copy "original product images and advertising banners from the Complainant's Website". Also submitted are copies of e-mails from customers who have alleged that they ordered products from the Respondent's websites and either were over-charged for such products or, in some cases, have had their credit card charged but did not receive any products at all. Such activity has been held to support a finding of bad faith registration and use. Ashley Furniture Industries, Inc. v. BSI Inc, Claim No. FA 1213011 (FORUM, August 7, 2008) (bad faith found where "[t]he <ashleynorth.com> domain name redirects to a website that appears to pass itself off as Complainant. Respondent's domain name resolves to a website that imitates the ASHLEY logo and graphic scheme and attempts to obtain customers' credit card information by letting them place fake orders for Complainant's products"); Intesa Sanpaolo S.p.A. v. null, Case No. 101616 (CAC, October 18, 2017) (bad faith registration and use found where "the domain name was connected to a webpage clearly created in order to steal the confidential banking information of Complainant's clients. That is undeniable evidence of 'phishing', a form of Internet fraud that aims to steal valuable information such as credit card numbers, social security numbers, user Ids and passwords."). In such cases it is clear that the domain name was chosen specifically to create a likelihood of confusion for the purpose of commercial gain by the registrant.

As for the non-resolving disputed domain names, there is no evidence in the record to indicate that they have been used at all. However, the scenarios of paragraph 4(b) of the Policy are not exclusive. Beginning with Telstra Corporation Limited v. Nuclear Marshmallows, Case No. D2000-0003 (WIPO, February 18, 2000), many UDRP panels have held that, after considering all the circumstances of a given case, it is possible that a "[r]espondent's passive holding amounts to bad faith."

The Telstra decision states that “paragraph 4(b) recognizes that inaction (e.g., passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith…. [I]n considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent’s behaviour.”). See also, Autoshop 2 Di Battaglia Ferruccio C. S.N.C. v. Willamette RF Inc., WIPO Case No. D2004-0250 (collecting cases citing Telstra); and Chartered Professional Accountants of Canada v. Zakaria Frouni, FA 1795339 (FORUM August 6, 2018) (“Respondent is simply passively holding the disputed domain name. Respondent’s inactive use of the disputed domain name constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.”) The Panel notes that the Complainant has submitted screenshots of the non-resolving disputed domain names’ websites, which display the message “The site has not been found” and little more. Accordingly, the Panel concludes that, upon considering all of the facts of this case, including copying the Complainant’s famous trademark and non-use of the non-resolving disputed domain names for over 12 months, the conclusion that Respondent registered and uses the non-resolving disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy is will supported.

Finally, the Complainant submitts a list of about twenty domain names that copy other well-known trademarks (e.g. <victoriassecretsale.store>; <stuartweizmansale.online>; and <jimmychoooutlet.online>, among others) and which list Nexperian Holding Limited in the Whois records. Registration of domain names which incorporate third party marks may indicate bad faith under paragraph (b)(ii) of the Policy. However, as the evidence submitted in this case provides adequate support for a finding of Respondent’s bad faith registration and use of the disputed domain names, it is not necessary to consider whether the Respondent has engaged in a pattern of conduct based upon citation of the additional domain names held by Nexpierian.

In light of the above analysis, this Panel finds that the Respondent has registered and used the disputed domain names in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all of the elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MAMMUTSTORE.ONLINE**: Transferred
2. **MAMMUTOUTLET.ONLINE**: Transferred
3. **MAMMUTSALE.ONLINE**: Transferred
4. **CHEAPMAMMUT.ONLINE**: Transferred
5. **MAMMUTOUTLET.TOP**: Transferred
6. **DISCOUNTMAMMUT.ONLINE**: Transferred
7. **MAMMUTSHOP.ONLINE**: Transferred
8. **MAMMUTJACKETS.ONLINE**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2018-08-14

Publish the Decision