Decision for dispute CAC-UDRP-102226

Case number	CAC-UDRP-102226
Time of filing	2019-01-09 10:05:42
Domain names	oursainsburys.xyz

Case administrator

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

Complainant

Organization	Sainsbury's Supermarkets Ltd.

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Name	hdsin oko

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademark registrations:

- SAINSBURY´S EU Registration no. 1027002, filed on 23 December 1998 and registered on 24 July 2001, for goods and services in classes 3, 4, 5, 6, 8, 9, 10, 11, 12, 15, 16, 18, 20, 21, 24, 25, 27, 28, 30, 31, 32, 33, 34, 35, 36, 38, 41 and 42;

- SAINSBURY´S EU Registration no. 4627361, filed on 9 September 2005 and registered on 25 May 2007, for goods and services in classes 12, 29 and 41;

- SAINSBURY´S EU Registration no. 1812957, filed on 17 August 2000 and registered on 3 April 2002, for services in class 35;

- SAINSBURY´S EU Registration no. 15418478, filed on 10 May 2016 and registered on 19 October 2016, for goods and services in classes 3, 4, 5, 8, 9, 10, 11, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 32, 33, 35, 36, 37, 39, 41 and 43.

FACTUAL BACKGROUND

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

I. Complainant's Background

A. About J Sainsbury plc

J Sainsbury plc is a public limited company incorporated in the United Kingdom, whose shares are publicly traded on the London Stock Exchange. The Company is domiciled in the United Kingdom.

J Sainsbury plc's businesses are organised into operating segments, including two retail segments – one for food and another for general merchandise and clothing, as well as segments for financial services (Sainsbury's Bank plc and Argos Financial Services entities) and property investment through joint ventures (collectively, the J Sainsbury plc "Group"). The strategic focus of the Group has been helping customers live well for less since 1869. Its current vision is to be the most trusted retailer where people love to work and shop. Its goal is to make its customers' lives easier every day by offering great quality and services at fair prices.

Sainsbury's has grown to become one of the UK's largest food retailers since 1869 with over 600 supermarkets, 800 convenience stores, and nearly 250,000 online orders every week. See https://about.sainsburys.co.uk/ Sainsbury's Argos is one of the UK's leading digital retailers, offering more than 60,000 products online and in-store to 29 million store customers and nearly a billion online visitors every year. See https://www.about.sainsburys.co.uk/ As a business with a global footprint, J Sainsbury plc's values help it to drive lasting, positive change in the UK and internationally. More detailed reports and presentations is available from the Group at https://about.sainsburys.co.uk/.

B. Complainant's Relationship with the Group

Sainsbury's Supermarkets Ltd. ("Complainant") is a private limited company incorporated and domiciled in England and Wales (Registered company number 03261722), a wholly-owned subsidiary of J. Sainsbury plc, and part of the J Sainsbury plc Group. Several direct and indirect subsidiaries of Complainant include entities with "Sainsbury's" in its name registered or incorporated in Hong Kong, China, and England.

II. The disputed domain name is confusingly similar to a mark in Which Complainant has established rights

The SAINSBURY'S brand has a strong reputation particularly as a British brand for many years prior to when the domain was registered. Complainant has established rights in SAINSBURY'S mark in a wide variety of classes. Representative registrations in support includes Registered EUTM 001027002 for SAINSBURY'S in Classes 3-6, 8-12, 15-16, 18, 20-21, 24-25, 27-28, 300-36, 38, 41-42, issued 24/07/2001, filed 23/12/1998; Registered EUTM 004627361 for SAINSBURY'S issued 24/05/2007, filed 09/09/2005 in Classes 12, 29, 41; Registered EUTM for SAINSBURY'S 001812957 in Class 35 issued 03/04/2002, filed 17/08/2000; Registered EUTM 015418478 for SAINSBURY'S, issued 19/10/2016, filed 10/05/2016 in Classes 3-5, 8-11, 16, 18, 20-21, 24-25, 27-33, 35-37, 39, 41, 43.

Beyond the fact that the Complainant is a wholly-owned subsidiary of J. Sainsbury plc, part of the J Sainsbury plc Group, and the trademark SAINSBURY'S is fully included in its corporate name, as the legal holder of issued trademark registrations for the SAINSBURY'S brand, J Sainsbury plc has expressly acknowledged that Complainant has the right to conduct proceedings relating to its registered trademarks. The acknowledgement also includes the right to decide, in Complainant's sole discretion what action if any to take in respect of any infringement or alleged infringement of its marks in any medium or passing off. Id. The fact that this permission was granted after registration of the disputed domain name is immaterial because the rights associated with the mark have been in place and fully protected. It is no different than holding rights to enforce a mark by virtue of an assignment. Therefore, for purposes of this proceeding, Complainant's demonstrated authorisation to bring this proceeding based on J Sainsbury plc's issued registrations establishes its rights in the mark for purposes of Policy Par. 4(a)(i). Cf. Grupo Televisa, S.A. et al. v. Party Night Inc. a/k/a Peter Carrington, WIPO Case No. D2003-0796 ("Paragraph 4(a)(i) of the Policy requires, as one element to be proved, that the domain name be identical or confusingly similar to a trademark or service mark in which Complainant has rights. These words do not require that

Complainant be the owner of the mark and would include, for example, a licensee of the mark."); Toyota Motor Sales U.S.A. Inc. v. J. Alexis Prods. WIPO Case No. D2003-0624 (nonexclusive license and close corporate relationship sufficient to confer standing under Policy); Komatsu Deutschland GmbH v. Ali Osman / ANS, WIPO Case No. D2009-0107 (finding complainant is a beneficiary of the mark, is an indirect wholly owned subsidiary of the owner of the mark, and operates under the trademark in its name) ("As a result of these facts, the Panel finds that the Complainant has a sufficient basis to rely on rights in the...mark for the purposes of the complaint").

The disputed domain name is comprised of the relevant trademark recognisable within the disputed domain name, with the addition of a descriptive prefix 'our', which is a generic possessive pronoun like the word 'your' that cannot distinguish the domain under the first element. Cf. WIPO Case. No. D2007-0736, <yourvalium.com>. And omitting the punctuation in the mark is irrelevant because it cannot be registered in a domain name. E.g., FORUM FA1504001613262 (removal of the apostrophe in KELLOGG'S trademark disregarded). The addition of ".xyz", the generic Top-Level Domain ("gTLD"), is a technical requirement of every domain name registration." WIPO D2016-2087, <grouponers.xyz>.

Therefore, the first element is demonstrated.

III. The Respondent does not have any rights or legitimate interest in the disputed domain name

According to the WHOIS record, Respondent is not commonly known by a name corresponding to the disputed domain name.

Respondent registered the disputed domain name to specifically profit from its trademark significance by attempting to divert traffic from those looking for the corporate portal login to either apply for a vacancy with Sainsbury's, manage their benefits or other payroll or human resources related functions for Sainsbury's colleagues. Respondent incorporated the disputed domain name for the Sainsbury's official login page into the title of the site on the disputed domain name to target search results for those looking to access the official Sainsbury's login page to be diverted to the disputed domain name. When Sainsbury's targeted colleagues click on the link, they are diverted to a website stuffed with information on how to log in and use the Sainsbury's official site with a website navigation menu displaying "Sainsburys Employees Benefits", "Sainsburys Careers" and "All About Sainsbury's" all diverting traffic to different pages on the domain instead, and alongside a Sainsbury's logo for the official login page.

Every AdSense account with Google has a unique identifier called a "publisher ID" that is located in the HTML source code of the publisher's website. Respondent's website was enrolled with the unique identifier "ca-pub-7687796627147485", so that Respondent can profit from placing targeted ads next to the content to automatically earn money when ads are seen or clicked. Google's policies prohibit misrepresentative content that misleads users by the content they engage with online by misrepresenting, misstating, or concealing information, including the primary purpose of the web property. Examples of prohibited content includes enticing users to engage with content under false or unclear pretenses, "phishing" for users' information, or falsely implying having an affiliation with, or endorsement by, another individual, organization, product, or service.

The website is filled with misrepresentative content. It states, "My Sainsbury's is a most trusted retailer company where people love to work and shop for many things" and Respondent embedded a hyperlink from "My Sainsbury's" in this sentence to http://www.oursainsburys.xyz/ indicating that Respondent's website is a most trusted retailer company when referring to Complainant's business. Respondent's website misrepresents that "OurSainsbury's employees can log into their own accounts through the online website..." with a hyperlink from "OurSainsbury's" to the site of the Domain. Complainant's employees cannot login to an account on Respondent's domain. This hardly constitutes a legitimate use of the disputed domain name.

Respondent also created a comment forum where Respondent requires users to enter their email address and name to reply with comments in connection with employee benefits and applying for vacancies or a career with Sainsbury's. Respondent assures that the email address will not be published, but has no right to process this information for Respondent's own benefit misrepresenting the site as Sainsbury's. It is not clear whether this is intentional or just a function of the template

used to set up the site, but Respondent has no legitimate interest in processing such information regardless of whether the intent was only to profit from the Google ads through blackhat SEO. The blog entries inviting comments were all posted by "Srinivasvarma" (id.) while the disputed domain name was registered to "hdsin oko". Even if unique Google publisher ID or the comments by "Srinivasvarma" belong to different people other than the Respondent, Respondent ultimately controls the disputed domain name, and is responsible for the use being made.

IV. The disputed domain name has been registered and is being used in bad faith

The content on the disputed domain name demonstrates Respondent had Complainant's mark in mind when the disputed domain name was registered.

The Whois contact details likely contain false and inaccurate information: A search for "sdoksko sdokskod" in Arunachal Pradesh did not retrieve any results. The postal code in India also retrieved no results. The phone number "+0.919199199" does not appear to be a valid number. The Gmail account that registered the disputed domain name uses a completely different first and last name from that of the registrant.

A search for Respondent's unique identifier "ca-pub-7687796627147485" embedded in the disputed domain name and enrolled with Google AdSense yielded numerous websites targeting corporate employee login pages in the same manner as the site on the disputed domain name. Some of these websites use cloaking techniques such as framing the official login page of the targeted brand where a user actually enters their username and password.

Registering and using well-known trademarks such as Sainsbury's, to use for "blackhat SEO" to divert users searching to login to specific human resources and benefits related sites, or to apply for job vacancies, to divert people to deceptively monetized related content (and certainly then inviting them to submit their first and last names and email addresses through the site) constitutes bad-faith registration and use. By using the disputed domain name, the Respondent has clearly intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, 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.

There are also signs that Respondent's SEO blackhat techniques may include use of spam forums with the help of spambots. Without having the disputed domain name transferred to Complainant's management and control, there is a foreseeable risk that remaining in the hands of Respondent, the disputed domain name will not only continue to cause confusion through misrepresentations from which Respondent profits and attempts to collect first and last name combined with email addresses, but will be used in furtherance of more serious fraud-enabling activities, including possibly call center fraud and identity theft, among others.

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

I. RIGHTS

The disputed domain name is confusingly similar to SAINSBURY´S registered trademarks on which the Complainant's has rights, since it reproduces the mark 'SAINSBURY´S', merely adding the generic expression "OUR" at the beginning.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the disputed domain name.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D20020856:

"As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists." WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, from the trademark search submitted by the Complainant can be seen that the Respondent does not own any trade mark registration with that name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant´s allegations and evidence with regard to the Respondent´s registration and use of the disputed domain name in bad faith.

Paragraph 4(b) (iiii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent 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 complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of a product or service on its website or location.

The Complainant's SAINSBURY´S trademark is well-known as one of the UK's largest food retailers, well before the registration of the disputed domain name. The Respondent's registration of the disputed domain name wholly incorporating a well-known third-party mark is, in the Panel´s view, indicative of bad faith.

Furthermore, the Respondent's website has the false appearance of being the official website of SAINSBURY´S and pretends to offer benefits to its employees by requesting their e-mails and other personal information. It also contains sponsored links.

As mentioned in Andrey Ternovskiy dba Chatroulette v. Alexander Ochki, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see AT&T Corp. v. Amjad Kausar, WIPO Case No. D2003-0327)."

Finally, the Whois contact details seem to be false, what contributes to confirm bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **OURSAINSBURYS.XYZ**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2019-02-06

Publish the Decision