Decision for dispute CAC-UDRP-102279

Case number	**CAC-UDRP-102279**
Time of filing	**2019-01-31 11:57:05**
Domain names	**filehippoa.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**FileHippo s.r.o.**

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**whois agent**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- the EU trademark FILEHIPPO (Registration No. 008893745) dated February 18, 2010;
- the UK trademark FILEHIPPO (Registration No. UK00002514818) dated April 28, 2009;

Moreover, the Complainant is also the owner of the official website www.filehippo.com which is firstly registered by a company named Media Limited transferred to Avast Software s.r.o and finally transferred again to the Complainant on December 10, 2017 as a result of the Intellectual Property Assignment Agreement submitted as an annex of the Complaint as well.

FACTUAL BACKGROUND

The Complainant holds several trademark registrations for “FILEHIPPO” and the Complainant also holds a domain name including the sign “FILEHIPPO” as <www.filehippo.com >.

On November 27, 2017, the Respondent registered the disputed domain name <filehippoa.com>. The domain name is currently available which shows that there is use at the disputed domain name. When visiting the disputed domain name, it is evident that “FILEHIPPO” trademark, which is registered trademark of the Complainant, is being used on the top of the page.

Thereon, the Complainant has filed the present complaint.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant is holder of the domain name <www.filehippo.com> created on November 1, 2004 which is curated software download site. It has a section that contains a list of most recently updated computer programs, and another section which lists the most popular downloads. The computer programs are organized into categories and the Complainant’s website contains information about computer programs as well as articles containing recent technology news. The aim of the website is to provide users the newest versions of software. According to the records of SimilarWeb which track the traffic of the websites, the Complainant´s domain <www.filehippo.com> is monthly visited by approximately 34,500,000 visitors.

The Complainant is also the owner of aforesaid “FILEHIPPO” trademarks which are registered also for software, freeware, installation, maintenance of software.

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE COMPLAINANT’S TRADEMARKS “FILEHIPPO“

The Complainant argues that the trademark of the Complainant has its own distinctive character since it has no generic meaning and it is created by adding the “hippo“ phrase which is an abbreviation for “hippopotamus“ to the phrase “file“ which means “suite“. The trademark of the Complainant also gain its well-known status by its 14-year-long contentious use on the goods and services on which the trademark has been registered and it has 34,500,000 monthly visitors.

It is more than obvious that the disputed domain name is confusingly similar to the Complainant’s trademarks “FILEHIPPO”, as it differs only for the addition of letter “A” in the end of the trademark which is not able to change overall impression and does not eliminate the confusing similarity with the older trademarks of the Complainant. Similar cases mentioned by the Complainant are as follows: EAuto, L.L.C. v. EAuto Parts, WIPO Case No. D2000-0096, Caterpillar Inc. v. Off Road Equipment Parts, WIPO Case No. FA0095497.

Additionally, the top level domain names as “.com”, “.org”, “.tv” or “.net” does not affect the similarity examination, in accordance with the decisions of Magnum Piercing, Inc. v D. Mudjackers and Garwood S. Wilson, Sr. WIPO Case No. D-2000-1525; Hugo Boss A.G. v. Abilio Castro, WIPO case No. DTV2000-0001; Radale Inc. v. Cass Foster, WIPO case No. DBIZ2002-00148. Carlsberg A/S v. Brand Live television, WIPO case No. DTV-2008-0003.

Finally, the Complainant argues that an ordinary consumer will believe that the disputed domain name registered by the Respondent is owned by the Complainant or its partner and will access the website only due to its misleading character assuming that the download service is provided directly by the Complainant or alternatively by its partners and therefore will except high quality software without any malwares. Since the Respondent is identically using the logo and trade dress of the Complainant, it will increase the risk of confusion as well.

2. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant states that the Respondent has no rights on the disputed domain name while there is also no evidence suggests that the Respondent has been commonly known within the consumers by the disputed domain name or by the

distinctive part “FILEHIPPO” included in the disputed domain name. Before the beginning of this dispute nor ownership of any identical or similar trademark nor use of any identical or similar brand by the Respondent before the registration of the disputed domain name have been proved.

Lastly, the Complainant states that there is no fair or bona fide use of the disputed domain name. Despite there is a disclaimer in the website offered under the disputed domain name, the mentioned disclaimer does not clarify the relationship between the Respondent and the Complainant and it also does not constitute a bona fide use since it only regards the liability of the web site holder. The Complainant highlights that it is only by unauthorised use of the trademark that the potential customer is brought to the website (containing the disclaimer) in the first place. Moreover, the use of the Complainant´s logo usually excludes any possibility of bona fide reference to Complainant’s services.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

The Complainant states that the disputed domain name was registered and is being used in bad faith. The Complainant alleges that the Respondent was clearly aware of the registration and use of the Complainant’s trademark „FILEHIPPO“ before the registration of the disputed domain name as follows from the use of the Complainant’s logo, mark and trade dress and links to the Complainant’s website by the Respondent.

Furthermore, the Complainant also states that the disputed domain name is being used by the Respondent to reach the Complainant´s customers and offer them the identical download service as is offered by the Complainant on its website. In addition to this, the Complainant also indicates that the Respondent uses the disputed domain name in bad faith by attempting to attract, for commercial gain, Internet users to the Respondent’s website and by creating a likelihood of confusion with the Complainant’s “FILEHIPPO“ mark as to the source, sponsorship, affiliation or endorsement of the Respondent’s website.

Finally, it is also mentioned by the Complainant that the use of a proxy service by the true owner hidden behind the Respondent is often by itself an indicator of bad faith.

RESPONDENT:

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

A. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
B. The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
C. The disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of the “FILEHIPPO” trademarks.

The Panel finds that this case undeniably represents a clear example of typosquatting, where the disputed domain name is one letter less than or different from the Complainant's mark. Such attempts have been disapproved of in various WIPO decisions (e.g. Telstra Corp. Ltd. v. Warren Bolton Consulting Pty. Ltd. D2000-1293; Playboy Enterprises International Inc. v. SAND Webnames-For Sale D2001-0094). These decisions were more recently confirmed by Société Nationale des Chemins de fer Français - SNCF v. Damian Miller / Miller Inc., Case No. D2009-0891), and by CAC decision No. 101715 on the domain name <arcelormittla.com>. The disputed domain name is nearly identical with the Complainant’s FILEHIPPO trademarks since the amendment of the letter “A” into the ending of the trademark is not sufficient to vanish the similarity.

The Panel is of the opinion that the internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademarks. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is open to a Respondent to establish its rights or legitimate interests in the disputed domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making 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; or
(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the Respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the Complainant will have failed to discharge its burden of proof and the Complaint will fail. The burden is on the Complainant to demonstrate a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. Once the Complainant has made out a prima facie case, then the

Respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has no relation in any legal or commercial way with the Complaint. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name. Finally, there is no bona fide uses of the disputed domain name found.

In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Panel concludes that the Complainant's "FILEHIPPO" trademarks have significant reputation and is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the FILEHIPPO trademarks and the associated domain name, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Using the identical logo and redirecting the users who want to download software which are not available to download from the website under the disputed domain name is also shown that the Respondent has clear knowledge about the Complainant and its trademark as well as the website the Complainant offers under its domain name. Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FILEHIPPOA.COM**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2019-02-11

Publish the Decision