Decision for dispute CAC-UDRP-102363

Case number	CAC-UDRP-102363
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Domain names	salesoneill.com

Case administrator

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

Complainant

Organization	O'Neill Brand S.à r.l

Respondent

Name	Pan Chen

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware of.

IDENTIFICATION OF RIGHTS

The Complainant has established registered trademark rights on which it may rely in this proceeding. The Complainant has submitted that it has rights in the following registered trademarks:

• International registration no. 572361, registered on May 31, 1991;
• US registration no. 1339268, registered on June 4, 1985;
• US registration no. 1069298, registered on July 12, 1977;
• US registration no. 1183040, registered on December 22, 1981;
• EUTM registration no. 008499782, registered on May 17, 2010.

(collectively " the O'NEILL trademark").

It has produced documentary evidence of such registration of trademarks for

• International registration no. 572361, registered on May 31, 1991; and
• EUTM registration no. 008499782, registered on May 17, 2010.

The Panel accepts the evidence submitted by the Complainant and its submission that it has trademark rights in all of the trademarks constituting "the O'NEILL trademark".

The Complainant has also registered the domain name <oneill.com> which it uses in its business.

FACTUAL BACKGROUND

Complainant is a United States company that is famous internationally for its brand of popular clothing. It has been in

business since 1952.

It conducts its business by means of a series of trademarks for O'NEILL which are owned by Sisco Textiles N.V. but licensed to the Complainant pursuant to an exclusive licence. Those trademarks are more particularly described above and referred to collectively as "the O'NEIL trademark."

Without any permission from the Complainant, the Respondent registered the disputed domain name <salesoneill.com> on July 12, 2018. The website to which the domain name resolves promotes products which have a very similar look and feel to genuine O'NEILL products.

To protect its rights, the Complainant has caused several infringement takedown notices to be sent to the different host providers of the disputed domain name but to no avail.

The Complainant has therefore filed this Complaint to obtain the transfer of the disputed domain name from the Respondent to itself.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant has made the following contentions.

The disputed domain name is confusingly similar to the O'NEILL trademark.

That is so because it wholly incorporates the entirety of the mark. The Respondent has added the word "sales" before the trademark, but this is a generic word covering the sales activities of the Complainant which does not reduce, but emphasizes the confusing similarity, a view that has been regularly endorsed in many prior domain name decisions when a generic word has been included with a trademark in a domain name.

Accordingly, consumers will assume that the domain name and the website, which openly displays goods described as "O'Neill", are the official domain name and website of the Complainant. It is also well established that gTLDs such as ".com" are disregarded for the purposes on this comparison.

Accordingly, the disputed domain name is confusingly similar to the O'NEILL Trademark.

The Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has never assigned, granted, licensed, sold, transferred or authorized the Respondent to register or use the O'NEILL trademark in a domain name or anywhere else. There is no relationship between the Complainant and the Respondent which might conceivably entitle the Respondent to use the O'NEILL trademark.

The Respondent has never used or made preparation to use the disputed domain name in connection with a bona fide offering of goods or services.

The Respondent uses the disputed domain name in relation to a website which falsely pretends to be associated to the O'NEILL Trademark.

The website resolving from the disputed domain name creates the false impression that it is an official website for the O'NEILL trademark. Such use of the disputed domain name is not bona fide because it attracts internet traffic by using a domain name which is confusingly similar to an established and well-known trademark, creating confusion amongst

consumers.

The Respondent is using the domain name and the website to sell unauthorized O'Neill products.

The generation of revenue from the utilization of the use of the O'NEILL Trademark in this manner does not constitute a legitimate non-commercial use of the disputed domain name.

The disputed domain name appears to be designated to mislead Internet users into believing that the website to which the domain names resolve is operated or authorized by the Complainant, which it is not.

The disputed domain name was registered and has been used in bad faith.

The Respondent has registered the disputed domain name intentionally to attempt to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's trademarks.

The Respondent must have known of the famous O'NEILL trademark at the time of registering the disputed domain name because it is well-known throughout the world and the subject of a large number of trademark registrations.

In addition, after several infringement takedown notices were sent to the Respondent from the host providers, the Respondent hosted the disputed domain name with another host provider, in order to continue its activities , which itself shows bad faith.

As a result, internet users are likely to believe that they have arrived at the official website of the Complainant as that is the clear impression given by the content of the website.

The Complainant therefore submits that the Respondent registered and has used the disputed domain name in bad faith.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for

Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated February 20, 2019 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that it had not correctly identified the Respondent. The CAC invited the Complainant to have regard to the Registrar’s verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. The notification also notified the Complainant that the Complaint had not specified at least one Mutual Jurisdiction and advised the Complainant that Mutual Jurisdiction was at least one court jurisdiction to which any Complainant has to submit himself in his Complaint with respect to any challenges to a decision in a UDRP proceeding; according to the UDRP Rules, the Complainant must submit to:

a.The principal office of the Registrar (provided the domain name holder has submitted to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name in its Registration Agreement); or

b.The domain name holder‘s address as provided in the registration of the domain name under Registrar’s WHOIS database at the time the complaint is submitted to the CAC.

On February 21, 2019 the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

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 that regard, the Panel also notes that the onus 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.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

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

(i) The 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 domain name; and
(iii) The 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 Complainant has adduced evidence that the Panel accepts that it has rights in several registered trademarks which are owned by Sisco Textiles N.V. but licensed to the Complainant pursuant to an exclusive licence. The trademarks are defined collectively as "the O'NEILL trademark" and the Panel finds that as such the Complainant has rights in those trademarks which are:

• International registration no. 572361, registered on May 31, 1991;
• US registration no. 1339268, registered on June 4, 1985;
• US registration no. 1069298, registered on July 12, 1977;
• US registration no. 1183040, registered on December 22, 1981;
• EUTM registration no. 008499782, registered on May 17, 2010.

The Panel next finds that the disputed domain name is confusingly similar to the O'NEILL trademark for the following reasons:

First, the disputed domain name includes the entirety of the O'NEILL trademark and that word is by far the dominant part of the disputed domain name. Accordingly, the attention of the internet user would naturally be drawn to that part of the disputed domain name and would inculcate in the mind of the user the idea that the disputed domain name was an official domain name of the Complainant.

Secondly, the disputed domain name includes the generic word "sales" preceding the trademark. This would inculcate in the mind of the internet user that the domain name was an official domain name of the Complainant dealing with the sale of the Complainant's famous goods sold under its trademark and that the domain name would lead to a website dealing with that subject. That is so because it is now well established that where a domain name includes a trademark and a generic word describing an activity in which the trademark owner engages, internet users will assume that the domain name deals with that activity. Thus, taken as a whole, the disputed domain name would convey to the objective bystander that it related to the activities of the Complainant when selling its goods.

It is also now well established that the addition of a generic top level domain, such as “.com” as in the present case, and the omission from a trademark of a comma from the trademark as in the present case cannot negate confusing similarity that is otherwise present, as it is in the present case.

Accordingly, the disputed domain name is confusingly similar to the Complainant’s O'NEILL trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. 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.

But by virtue of paragraph 4(c) of the Policy, it is open to the Respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [respondent] 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; or

(ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or

legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The Respondent has chosen to take the Comaplainant's famous O'NEILL trademark and to use it in its domain name without permission.

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the O'NEILL trademark and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that the Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).

The Respondent uses the disputed domain name in relation to a website which falsely pretends to be associated with the O'NEILL Trademark.

The Complainant has never assigned, granted, licensed, sold, transferred or authorized the Respondent to register or use the O'NEILL trademark in a domain name or anywhere else.

The website resolving from the disputed domain name creates the false impression that it is an official website for the O'NEILL trademark. Such use of the disputed domain name is not bona fide because it attracts internet traffic by using a domain name which is confusingly similar to an established and well-known trademark, creating confusion amongst consumers. It is now well established that such conduct cannot give rise to a right or legitimate interest in the disputed domain name and the Panel so holds in the present proceeding.

The Respondent has never used or made preparations to use the disputed domain name in connection with a bona fide offering of goods or services.

The Respondent is using the disputed domain name and the website to sell unauthorized O'Neill products.

The generation of revenue from the utilization of the use of the O'NEILL Trademark in this manner does not constitute a legitimate non-commercial use of the disputed domain name.

The disputed domain name appears to be designated to mislead Internet users into believing that the website to which the domain names resolve is operated or authorized by the Complainant, which it is not.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive.

The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's 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 site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b)(iv) of the Policy and probably within other provisions of paragraph 4(b).

That is so because the evidence leads to the conclusion that the Respondent has registered the disputed domain name intentionally to attempt to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's trademarks. That must be so because its website clearly promotes goods that purport to be the famous O'Neill goods, but which are unauthorised and which may well be counterfeit. In any event the Respondent is not authorised to sell goods under that name. The conduct is therefore particularly brazen and illegal and the Respondent must be taken to have registered and used the domain name in bad faith.

The Respondent must also be taken have had actual knowledge of the famous O'NEILL trademark at the time of registering the disputed domain name because it is well-known throughout the world and the subject of a large number of trademark registrations and is well-known in the public mind. It is well established that if it appears that a registrant had actual knowledge of a trademark when the registrant registered a confusingly similar domain name, that is evidence of bad faith registration and use.

In addition, the Complainant submits and the Panel accepts that after several infringement takedown notices were sent to the Respondent from the host providers, the Respondent hosted the disputed domain name with another host provider, in order to continue its activities, which itself shows bad faith.

As a result, internet users are likely to believe that they have arrived at the official website of the Complainant as that is the clear impression given by the contents of the website and no doubt the impression that the Respondent intended to give.

Moreover, the Respondent on the evidence clearly intended to deprive the Complainant of revenue the it, the Complainant, would have earned had it been able to sell products to potential purchasers who have been diverted by the existence of the domain name and the website to which it resolves.

The totality of the evidence shows that the Respondent acted in bad faith because it had no right to do what it did, it engaged in the proven conduct with a bad intention and the clear intention of confusing the buying public and the equally

clear intention of doing damage to the Complainant. There is therefore no other way of describing the registration and use of the disputed domain name than that it was in bad faith.

The Panel therefore finds that the Respondent registered and has used the disputed domain name in bad faith.

The Complainant has therefore made out the third of the three elements that it must establish.

The Complainant has therefore made out the while of the case that it must establish and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SALESONEILL.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2019-04-10

Publish the Decision