# Decision for dispute CAC-UDRP-102459

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| Case number | **CAC-UDRP-102459** |
| Time of filing | **2019-05-13 08:59:44** |
| Domain names | **vodafon.club** |

## Case administrator

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

## Complainant

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| Organization | **Vodafone Group Plc** |

## Complainant representative

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| Organization | **Boult Wade Tennant LLP** |

## Respondent

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| Name | **Kostya Kumeyko** |

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks, many of which are word trademarks and incorporate the term “Vodafone” (hereafter the "Vodafone trademark" or the "Vodafone trademarks"). Said trademarks are registered in several countries around the world, including in Ukraine (i.e., the country where the Respondent is located). The Panel refers for example to the Ukrainian Vodafone trademarks with number 84163, 107747 and 230403, valid for several classes including class 9, 35, and 38.

FACTUAL BACKGROUND

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

The Complainant ("Vodafone Group Plc") is a global communications company organised and existing under the laws of England and Wales, United Kingdom, located in Newbury, United Kingdom. The Complainant is one of the world’s largest mobile communications companies by revenue, operating across the globe through numerous subsidiaries and partnership agreements, providing a wide range of communications goods and services including the services of a mobile communications network operator. The global reach and reputation of the Complainant and its brand are significant. The Complainant points out that the Vodafone trademark holds a substantial amount of goodwill, and is an extremely valuable

asset to the Complainant’s business.

The Complainant also owns numerous domain names consisting of the Vodafone trademark, including the domain <vodafone.club> as well as many more domain names in which the term Vodafone is used in combination with other words and/or numbers. The Complainant also owns the domain name <vodafon.com> (i.e., the .com equivalent of the disputed domain name).

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

1. Confusing similarity

The disputed domain name consists of the Complainant's Vodafone trademark(s) with omission of the letter "e".

The Complainant contends that numerous previous panels have accepted that a domain name which is identical to another's mark but with a minor misspelling is sufficient to establish identity or confusingly similarity (see, Novartis AG v. Ancient Holdings, LLC, Wendy Webbe, WIPO Case No. D2014-1084 and Wachovia Corporation v. Peter Carrington, WIPO Case No. D2002-0775).

In this case, the Panel notes that the disputed domain name consists of the Complainant's Vodafone trademark(s) with omission of the letter "e". The Panel finds that this minor misspelling and the “.club” gTLD does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy.

First, a domain name that takes over the entirely of a well-known trademark and only omits the last letter may be considered to be confusingly similar to the well-known trademark. The Panel decides that this applies to the disputed domain name in the case at hand. The Panel also points out that the words “Vodafone” and “Vodafon” are phonetically very similar.

Moreover, previous UDRP panels have stated that the addition of a gTLD or a ccTLD to a domain name does not avoid confusing similarity (see, Missoni S.p.A v. Colin Zhao WIPO case No. DCC2010-0004, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. WIPO case no. D2006-0451 and Telstra Corporation Limited v. Nuclear Marshmallows WIPO case no. D2000 0003). Therefore, the ".club" suffix may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

The Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to a respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Domain Name. If the respondent fails to come forward with such appropriate allegations or evidence, the complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the complainant.

The Respondent did not file an administratively compliant (or any) response. In the circumstances, the Panel finds from the facts put forward that:

The Complainant contends that: (1) the Respondent has no connection with or affiliation to the Complainant, and has not received any licence or authorisation to use the Vodafone trademarks or any variation of them in a domain name, on its website or in any other manner; (2) the Respondent does not hold any trade mark registrations for trademarks incorporating VODAFON or VODAFONE, and is not known by the names “Vodafone” or “Vodafon”, while the Complainant’s trademark is well-known; (3) the Complainant's registered Vodafone trademarks are being used on the disputed domain name, relating and referring to Vodafone Ukraine; and (4) the Complainant’s activities under its Vodafone trademark(s), as well as its registered trademark rights, predate the date of registration of the disputed domain name.

The Complainant refers to previous UDRP decisions, in which it filed Complaints regarding the use of its Vodafone trademark(s) in a domain name. In Vodafone Group Plc v. Jad Corporation (WIPO case no. DPH 2010-0001, decision of 4 June 2010) the sole panellist found that “[i]n view of the notoriety enjoyed by the Complainant in its VODAFONE trademark, it is difficult to imagine what evidence the Respondent could produce to establish that it does have rights or legitimate interests in the disputed domain name.” In Vodafone Group Plc v. TurnCommerce, Inc. DBA NameBright.com / Zhenhua Bin, (WIPO case no. D2014-0504) it was noted that “it is difficult to imagine what legitimate use might be made of a domain name entailing such a very strong likelihood of confusion with a well-known brand”.

The contentions of the Complainant are not contested by the Respondent.

The Panel finds that the Complainant has at least made a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name, for the combination of the following reasons: (1) the Respondent seems not to be related to the Complainant, and seems not to have received any licence or authorisation to use the Vodafone trademarks or any variation of them; (2) the Complainant's registered Vodafone trademarks are being used on the website available via the disputed domain name, relating and referring to Vodafone Ukraine. This entails a risk that inaccurate or false information is provided to the public and that the Complainant and its customers are being harmed; and (3) the Respondent seems not commonly known by the disputed domain name.

On the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

The Complainant asserts that its registered Vodafone trademark is a well-known and famous mark. The Complainant contends that the Respondent, by using the disputed domain name, has intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant's Vodafone trademark(s) 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 also contends that the mere registration of a domain name that is identical or confusingly similar to a famous or well-known trademark such as the Vodafone trademark, by an unaffiliated entity, can by itself create a presumption of bad faith, in particular when the domain name comprises typos or incorporates the registered mark.

The Respondent has not submitted any response.

The Panel weighs these arguments as follows:

The Panel finds that there is sufficient evidence to conclude that the disputed domain name was registered and is being used in bad faith. In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the Vodafone trademark(s) of the Complainant in mind when registering and using the disputed domain name. The Panel refers to the fact that the Vodafone trademark of the Complainant is well-know, and that the Complainant also registered several Vodafone trademarks in Ukraine (i.e., the home country of the Complainant) prior to the date that the disputed domain name was created.

The content of the website associated with the disputed domain name shows that the Respondent was in fact aware of the Complainant and its Vodafone trademarks at the time that the Disputed Domain Name was registered and at the time of use of the disputed domain name. Indeed, the website available via the disputed domain name publishes the Complainant’s wordmark “Vodafone” and its registered logo, as well as certain commercial information regarding goods and services, similar to the Complainant’s commercial activities.

The Panel believes that this is a typical case of cybersquatting or typosquatting whereby the Respondent reflects a registered trademark in a domain name, while only omitting one letter (letter "e") and adding a suffix (“.club”).

In light of these facts, it is highly unlikely that the Respondent would not have been aware of the unlawful character of the disputed domain name at the time of its registration and use.

For the reasons set out above, the Panel determines that the disputed domain name was registered and is being used in bad faith within the meaning of 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. **VODAFON.CLUB**: Transferred

## PANELLISTS

| Name | **Bart Van Besien** |
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DATE OF PANEL DECISION 2019-06-24

Publish the Decision