Decision for dispute CAC-UDRP-102581

Case number	CAC-UDRP-102581
Time of filing	2019-07-23 10:00:18
Domain names	swisskron.com

Case administrator

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

Complainant

Organization	SWISS KRONO Tec AG

Complainant representative

Organization	Convey srl

Respondent

Name	William Carter

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous trademark registrations consisting of or including the wording "SWISS KRONO" and, in particular:

- Swiss Trademark Registration No. 696970 "SWISS KRONO" (device), filed on December 19, 2016 in classes 35, 36, 37, 40, 42 and 44.

- Swiss Trademark Registration No. 696971 "SWISS KRONO" (device), filed on December 19, 2016 in classes 35, 36, 37, 40, 42 and 44.

- Swiss Trademark Registration No. 696981 "SWISS KRONO", filed on December 19, 2016 in classes 35, 36, 37, 40, 42 and 44.

- International Trademark Registration No. 1332846 "SWISS KRONO" of June 7, 2016 in classes 1, 2, 16, 17, 19, 20, 27, 35, 36, 37, 40 and 42 (designating many countries including Ukraine - Respondent's country).

- International Trademark Registration No. 1332843 "SWISS KRONO" (device) of June 7, 2016 in classes 1, 2, 16, 17, 19, 20,

27, 35, 36, 37, 40 and 42 (designating many countries including Ukraine - Respondent's country).

FACTUAL BACKGROUND

The Complainant is SWISS KRONO Tec AG, a branch of SWISS KRONO Group a Swiss company founded in 1966 by Ernst Kaindl, an Austrian entrepreneur, and headquartered in Lucerne, Switzerland.

Since then, the company has been growing continuously and constantly expanding its portfolio. In the 80s, the production started expanding in France, Germany, Poland and the US. At the turn of the millennium the first plant in Ukraine was added, followed by two more in the following years. With the recent openings of the subsidiaries in Russia and in Hungary, SWISS KRONO Group has become one of the world's leading manufacturers of wood-based materials and in 2016 the Group celebrates its 50th anniversary with 10 plants worldwide in 8 countries and a turnover of 1.8 billion US dollars.

Nowadays, SWISS KRONO Group is the world's leading manufacturer of engineered wood products and the global market leader in the area of laminate flooring, products for timber construction as well as for decorative furniture and interior fittings.
The Complainant is the owner of the trademark "SWISS KRONO" protected in many countries.

In addition, in order to protect and promote its trademark in the Internet, Complainant registered various domain names consisting of the wording "SWISS KRONO". In particular, the official website www.swisskrono.com generates a significant number of visits by Internet users every day.

The Complainant informs that the disputed domain name was registered on October 1, 2018 and that it is redirected to a website dedicated to the Complainant's Ukrainian branch.

When the Complainant became aware of the Respondent's registration and use of the domain name in dispute, it instructed its representative to address to the owner of said domain name a cease and desist letter in order to notify it of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer of, the disputed domain name to the Complainant.

A cease and desist letter was therefore sent, on July 15, 2019 by e-mail to the Respondent's known e-mail addresses indicated in the Whois record; the Respondent did not deem to reply to the cease and desist letter.

In light of the absence of the reply, the Complainant instructed its representative to file the complaint in order to obtain the transfer of the disputed domain name under its ownership and control.

Actually, according to the Complainant, the disputed domain name <swisskron.com> is confusingly similar to the trademark "SWISS KRONO" in which the Complainant has rights since the disputed domain name <swisskron.com> fully incorporates the Complainant's trademark, except for the letter "o".

Additionally, the Complainant states that (i) it is not in possession of, nor aware of the existence of, any evidence demonstrating that the Respondent might be commonly known by the domain name in dispute or by a name corresponding to the disputed domain name as an individual, business, or other organization and (ii) the Respondent is not an authorized dealer of the Complainant nor has ever been authorized by the Complainant to use the trademark "SWISS KRONO" in the disputed domain name.

Rather, the Complainant contends that the Respondent has registered and is using the disputed domain name to pass off as the owner of the trademark "SWISS KRONO", since (i) the disputed domain name is connected to a website dedicated to the Ukrainian branch of the Complainant (ii) said website is presented as the official website of "SWISSKRONO UKRAINE" and (iii) in the above website both the word trademark and the figurative trademark of the Complainant are reproduced.

The Complainant also emphasizes that (i) it has a strong business in Ukraine and for this reason the same Complainant has registered the domain name <swisskrono.ua> on March 16, 2017 to redirect it to the active website www.swisskrono.ua fully dedicated to its three Ukrainian branches which employ almost 800 employees and (ii) in the website corresponding to the domain name in dispute the Respondent has indicated the true address of Complainant's plant of the Lviv Region associated to the Respondent e-mail contacts swisskronoo@gmail.com and help@swisskron.com in order to pass off as the Complainant and prima facie to obtain advantages by receiving e-mail and orders from Complainant clients.

The Complainant also notes that, with the aim of passing off its website as the Complainant's website, the Respondent has used, in the website corresponding to the domain name in dispute, the Complainant's trademarks and an imagine of the Complainant's headquarter together with the disclaimer "SWISS KRONO UKRAINE – OFFICIAL WEBSITE".

Therefore, according to the Complainant, the Respondent's purpose is to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking "SWISS KRONO" products to its own websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and/or the goods offered or promoted through said websites.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1) There are discrepancies between the information rendered by the Complainant and the trademark extracts attached to the

complaint:

A - The Complainant affirms that Swiss trademark registration No. 696971 was filed on May 12, 1999, while the relevant extract clearly shows December 19, 2016 as filing date and beginning of term of protection.

B - The Complainant affirms that Swiss trademark registration No. 696981 was filed on May 12, 1999, while the relevant extract clearly shows December 19, 2016 as filing date and beginning of term of protection.

C - The Complainant pretends to base this complaint also on EUTM registration No. 8120073 SWISS KRONO GROUP and affirms to be the owner of said registration, while the relevant extract clearly shows that the current owner is a company different from the Complainant (KRONOTEC AG and not SWISS KRONO Tec AG) with a registered address different from the Complainant's address.

D - The Complainant affirms that International trademark No. 1332846 was registered on March 27, 1987, while the relevant extract clearly shows June 7, 2016 as date of the registration; in addition also the class indicated by the Complainant (25) is wrong since the mark appears to be registered for classes 1, 2, 16, 17, 19, 20, 27, 35, 36, 37, 40, 42.

In addition the Panel notes that the Complainant pretends to base this complaint also on International trademark No. 1039438C KRONO (device). In the Panel's view the domain name in dispute <swisskron.com> is sufficiently different from KRONO to safely exclude the confusing similarity requested by the Policy.

Anyway, the Panel founds that the Complainant has established to have rights in the trademark "SWISS KRONO" at least since June 2016. The Complainant therefore enjoys rights on "SWISS KRONO" from a prior date with respect to the registration date of the disputed domain name (October 1, 2018).

The disputed domain name is <swisskron.com> and is almost identical to Complainant’s “SWISS KRONO” mark. The only difference between Complainant’s mark and the disputed domain name is the deletion of the last letter “O” in the domain name.

As stated in WIPO Overview 2.0 “the threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name”.

Here the mark is clearly recognizable within the domain name and the absence of the last letter does not change the overall impression and does not avoid the likelihood of confusion between the disputed domain name and the trademark. Making small changes such as adding or deleting a letter or a symbol does not usually change the perception of a mark within a domain name (see Shubin Aleksej vs. Schneider Electric SA, CAC Case No. 100911 and eunock eunock vs. Boursorama SA, CAC Case No. 101334).

In addition, the Panel notes that the consensus view in previous UDRP panel decisions is that in determining confusing similarity under paragraph 4(a) of the Policy, the generic Top-Level Domain (“gTLD”) suffix (“.com” in this particular instance) should be totally disregarded.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

2) Firstly, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any response to the cease and desist letter sent to it by the Complainant and in the absence of any response in this proceedings has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name.

In addition, the Complainant has demonstrated that the website connected to the disputed domain name is fully dedicated to the Complainant's Ukrainian branch and business. The Complainant has correctly considered that the Respondent has the hope and the expectation that Internet users looking for the brand "SWISS KRONO" will be directed to the website corresponding to the disputed domain name.

The Respondent has indeed used the disputed domain name in a manner to attempt to engage in business transactions with third parties creating a likelihood of confusion with the Complainant and attempting to unduly profit from the Complainant's reputation and goodwill. The Panel finds that such use does not constitute a bona fide offering of goods or services, or a legitimate noncommercial fair use of the disputed domain name" (see Groupe Lactalis v. John Kleedofer / Privacy Protection Service INC d/b/a Privacy Protect.org, WIPO Case No. D2014-0133).

The Panel finds that said activity, of course, does not provide a legitimate interest in the disputed domain name under the Policy and therefore the Complainant succeeds on the second element of the Policy.

3) It must be considered that the Complainant has a strong presence and business in Ukraine and that the same Complainant registered the domain name <swisskrono.ua> connected to a website dedicated to its three Ukrainian branches before the registration of the domain name in dispute.

The disputed domain name is connected to a website dedicated to an Ukrainian branch of the Complainant and clearly presented as the official website of "SWISSKRONO UKRAINE". In the above website the Complainant's trademarks are clearly reproduced. Furthermore, the Respondent has also indicated in said website the true address of one of the Complainant plants in Ukraine associated to Respondent's e-mail contacts (swisskronoo@gmail.com and help@swisskron.com).

The Panel believes that the Respondent's conduct clearly demonstrates bad faith registration and use of the disputed domain name within the meaning of paragraph 4(a)(iii) of the Policy.

Actually, in the Panel's view, the Respondent has introduced a slight deviation with respect to the "SWISS KRONO" trademark, by simply deleting the last letter "O" when registering the disputed domain name with the unique and clear intent to confuse "SWISS KRONO" customers. This is furtherly confirmed by the circumstance that the Respondent uses the disputed domain name with the aim of passing off its website as the Complainant's website and especially to create a fraudulent association between the address of the true Ukrainian branch of the Complainant and the Respondent e-mail contacts.

The Respondent has ignored Complainant's attempts to resolve this dispute outside of this administrative proceeding by refusing to answer the cease and desist letters. Past UDRP panels have held that failure to respond to a cease and desist letter may properly be considered a factor in finding bad faith (see, for instance, Encyclopedia Britannica v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330 and RRI Financial, Inc., v. Chen, WIPO Case No. D2001-1242).

The Panel believes that the intention behind the registration of the domain name in dispute is to create the false impression that the domain name in dispute is effectively owned by the Complainant and that the connected website is an official website of the same Complainant. In this manner the Respondent may obtain advantages by receiving e-mail from Internet users looking for "SWISS KRONO". Additionally it must be considered that in the website connected to the disputed domain name there are forms to be filled in order to request further information on the products promoted in the same website; it is clear therefore that by filling said forms personal data are obtained from the website's visitors looking for Complainant and for its products.

According to the Panel, the circumstance that the disputed domain name is used to dishonestly impersonate the Complainant is an obvious evidence of bad faith since it is a clear indication that the Respondent had the Complainant's trademark and company in mind at the time of registration of the disputed domain name (see, National Westminster Bank plc v. Royal Bank of Scotland, WIPO Case No. D2013-0123 and Teva Pharmaceutical Industries Ltd. v. Whois Privacy Protection Service, Inc., CAC Case No. 100921). The Panel sees no plausible explanation for Respondent's decision to

register the domain name <swisskron.com> other than to create a false association with Complainant's trademark (see Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com", WIPO Case No. D2000-0847). Therefore the Panel finds that the disputed domain name was registered by the Respondent in bad faith.

Finally, the Respondent has used the disputed domain name in order to potentially receive communications from Internet users interested in Complainant's business, including personal data from Internet users visiting the website through filling forms. In the Panel's opinion, such users would not provide such data, which represent a valuable commodity, unless they believe they are dealing with the Complainant or with a representative of the Complainant. In the opinion of the Panel, the result of said use of the disputed domain name is effectively a very high risk that Internet users would mistakenly associate the disputed domain name to the Complainant and therefore be deceived as to the source, affiliation, or authenticity of the website to which the disputed domain name resolves. In other words it is the Panel's view that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant's "SWISS KRONO" mark as to the source, sponsorship, affiliation, or endorsement of its website (see, for instance, Confederation Nationale du Credit Mutuel v. HMD HMDA, WIPO Case No. D2013-1262; SVB Financial Group v. WhoisGuard Protected, WhoisGuard, Inc. / Citizen Global Cargo, WIPO Case No. D2018-0398; Haas Food Equipment GmbH v. Usman ABD, Usmandel, WIPO Case No. D2015-0285).

Therefore the Panel finds that the disputed domain name was registered and used by the Respondent in bad faith and that the Complainant succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SWISSKRON.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2019-08-19

Publish the Decision