Decision for dispute CAC-UDRP-102626

Case number	CAC-UDRP-102626
Time of filing	2019-08-19 11:48:06
Domain names	oneillwetsuit.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	O'Neill Brand S.à r.l

Respondent

Organization	EDIT INDUSTRIES INC

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Sisco Textiles N.V is the owner of multiple registrations for the O'NEILL mark, including an international registration (IR Registration No. 572361 registered on May 31, 1991) and multiple registrations in the US (US Registration No. 1069298 registered on July 12, 1977; US Registration No. 1183040 registered on December 22, 1981; and US Registration No. 1339268 registered on June 4, 1985).

The Complainant claims to be a holder of several domain names, including the domain name <oneill.com>, registered on December 23, 1997.

FACTUAL BACKGROUND

O'Neill is a surf, ski and casual brand. Apparel, accessories, and performance wear goods have been designed, manufactured, marketed and sold under the O'Neill brand since 1952. The O'Neill brand is well known, and goods sold under the O'Neill brand are renowned for their sporty and trendy look and fit.

The disputed domain name, <oneillwetsuit.com>, was created on 9 September 2018 and presently resolves to a GoDaddy parking page containing Pay-Per-Click ("PPC") links relating to goods sold under the O'Neill brand, for example, "surf wetsuit", "lycra surf" and "scuba diving equipment".

On October 31, 2018, the Complainant sent a cease and desist email to the Respondent. On the same day, the Respondent replied to the Complainant, stating that he did not own the domain name <oneilwetsuits.com>. The Complainant replied to the Respondent on November 2, 2018, clarifying the domain name that they were referring to and that the disputed domain name resolved to a page displaying PPC links. The Respondent then replied on the same day stating that the domain name was not in use and was not parked for cash. The Respondent further stated that he would change the setting of the domain

name to “private”. On November 19, 2018, the Complainant sent an email stating that the disputed domain name continued to resolve to a parking page.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant informs that it is the exclusive licensee of Sisco Textiles N.V for the O’NEILL mark and O’Neill brand, that Sisco Textiles N.V. granted to the Complainant an exclusive worldwide license to license any intellectual property rights regarding the O’Neill brand, including but not limited to the trademarks, logos, copyright, and trade names. The Complainant further informs that it is the owner of several domain names, including the domain name <oneill.com>, registered on December 23, 1997.

The Complainant contends that the disputed domain name is confusingly similar to the O’NEILL mark on the basis that the disputed domain name reproduces the entirety of the O’NEILL mark, and the addition of the descriptive word “wetsuit” and the generic Top-Level Domain (“gTLD”) “.com” are insufficient to avoid the likelihood of confusion with the O’NEILL mark. The Complainant further argues that the addition of the descriptive word “wetsuit” increases the likelihood of confusion as it refers to one of the core products under the O’Neill brand.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the O’NEILL mark.

The Complainant further asserts that the disputed domain name has been registered and is being used in bad faith as the Respondent knew of the O’NEILL trademark given its reputation and the Respondent’s alleged awareness of the surfing industry. The disputed domain name also resolves to a GoDaddy parking page containing PPC links.

RESPONDENT:

The Respondent contends that he purchased the disputed domain name off the open market as a dropped domain. The Respondent further contends that although he purchased the disputed domain name, he never did anything in regard to the disputed domain name and that the parking page containing PPC links that the disputed domain name resolved to was created by the registrar, GoDaddy.com, LLC (the “Registrar”). Finally, the Respondent asserts that he has never made any profit off the parking page containing PPC links that the disputed domain name resolved to.

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

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the trademark belong to its respective owner. Sisco Textiles N.V. is the owner of trademark registrations for the O'NEILL mark.

Aside from the trademark owner, the trademark owner's affiliate such as an exclusive trademark licensee is considered to have rights in a trademark under the UDRP for the purposes of standing to file a complaint (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition "WIPO Overview 3.0", paragraph 1.4.1).

In the present case, the Complainant has informed the Panel that it is the exclusive worldwide licensee of the O'NEILL mark. The Complainant has not adduced any evidence to prove its relationship to Sisco Textiles N.V. However, as this point was not challenged by the Respondent, he is deemed to have accepted this and thus the Panel accepts that the Complainant is the exclusive licensee of the O'NEILL mark and thus has rights in the O'NEILL mark under the UDRP for purposes of standing to file a complaint.

The disputed domain name <oneillwetsuit.com> reproduces the O'NEILL mark in its entirety with the apostrophe omitted and the addition of the descriptive term "wetsuit" and the gTLD ".com".

The Panel notes that the apostrophe is not a valid character for domain name registration and domain names that correspond to a particular word containing an apostrophe typically omits the apostrophe. The omission of an apostrophe in a domain name does not normally change the identity of the original word containing the apostrophe (see McDonald's Corporation v. Lei Wang, WIPO Case No. D2012-0624). Thus, the Panel is of the view that the omitted apostrophe in the disputed domain name does not assist to distinguish the disputed domain name from the O'NEILL mark.

It is well established that where the disputed domain name wholly incorporates the complainant's trademark, the addition of other terms, like descriptive terms, would not prevent a finding of confusing similarity (See WIPO Overview 3.0, paragraph 1.8). Thus, the Panel finds that the addition of the descriptive term "wetsuit" in the disputed domain name does not assist in avoiding confusion. In fact, the Panel finds that the addition of the descriptive term "wetsuit" is likely to increase the likelihood of confusion as the term describes one of the products produced under the O'Neill brand bearing the O'NEILL mark.

It is also widely established that the addition of the gTLD ".com" to a disputed domain name does not avoid confusing similarity (see Accor v. Noldc Inc. WIPO Case No. D2005-0016; F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; L'Oréal v Tina Smith, WIPO Case No. 2013-0820; Titoni AG v Runxin Wang, WIPO Case No. D2008-0820; and Alstom v. Itete Peru S.A. WIPO Case No. D2009-0877). The addition of the gTLD ".com" in the disputed domain name is therefore without significance in the present case since the use of a TLD is technically required to operate a domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the O'NEILL mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see WIPO Overview 3.0, paragraph 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant has stated that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant also stated that it is not connected or affiliated with the Respondent and did not authorize or license the Respondent to use the O'NEILL mark (See OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, WIPO Case No. D2015-1149; Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). Further, the Respondent is not commonly known by the disputed domain name and the name of the Respondent's organization, Edit Industries Inc, does not bear any resemblance to the disputed domain name.

Although the Respondent has submitted a response, he did not provide any evidence to show any rights or legitimate interests in the disputed domain name to rebut the Complainant's prima facie case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the disputed domain name was created long after the O'NEILL mark was registered. The Complainant's evidence has shown that the O'NEILL mark has been registered since as early as 1977 whereas the disputed domain name was only created in September 2018. Thus, the prior registration of the O'NEILL mark is suggestive of the Respondent's bad faith when he acquired the disputed domain name (see Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).

The Complainant argued that the Respondent knew of the O'NEILL mark at the time when he registered the disputed domain name because the O'NEILL mark is well known throughout the world and has been registered multiple times. The Complainant further argued that the Respondent was aware of the surfing industry and the O'NEILL mark. The Complainant has submitted evidence showing that the Respondent was involved in the surfing industry. Although the Respondent asserted that he purchased the disputed domain name off the open market, the Respondent did not deny that he was not aware of the O'NEILL mark at the time of his purchase of the disputed domain name. Therefore, the Panel finds that the Respondent knew or should have known about the O'NEILL mark and finds it inconceivable that the Respondent could have acquired the disputed domain name without knowledge of the O'NEILL mark and intention of benefiting from confusion with the O'NEILL mark. (See Leite's Culinaria, Inc. v. Gary Cieara, WIPO Case No. D2014-0041; WIPO Overview 3.0, paragraph 3.2.2)

Finally, the Complainant has shown that the disputed domain name resolves to a parking page with PPC links relating to goods sold under the O'Neill brand, for example, "surf wetsuit", "lycra surf" and "scuba diving equipment". In the Panel's view, by using the disputed domain name, comprising the O'NEILL mark, in connection with a parking page with PPC links relating to goods sold under the O'Neill brand, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the O'NEILL mark.

The Respondent seeks to escape responsibility by asserting that the disputed domain name website was a default parking page created by the Registrar and submitted evidence in support of this. However, it has been established that the fact that the PPC links are generated by a third party such as a registrar, or the fact that the respondent itself may not have directly profited, would not by themselves prevent a finding of bad faith (see WIPO Overview 3.0, paragraph 3.5; Bobst Mex SA v. Steven Thompson, WIPO Case No. D2016-0949). Although positive efforts by a respondent to avoid links that target the complainant's mark may be a mitigating factor, the Respondent has not shown any evidence of such an attempt here. The evidence submitted by the Respondent only shows the Registrar providing information regarding the page that the disputed

domain name resolves to.

The Panel, therefore, finds that the disputed domain name was registered and is being used in bad faith and the Complainant has satisfied 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. **ONEILLWETSUIT.COM**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2019-10-08

Publish the Decision