Decision for dispute CAC-UDRP-102649

Case number	**CAC-UDRP-102649**
Time of filing	**2019-09-04 11:47:41**
Domain names	**ccleanerfreedownload.net**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Piriform Software Limited**

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**Igor Kreek**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of, inter alia, the following trademarks all of which are registered also for computer software programs:
- registered EU word mark “CCLEANER” no. 007562002 for goods and services in the class 9 (software) with priority from January 30, 2009;
- registered EU word mark “CCLEANER” no. 015100803 for goods and services in the class 9 (software) and 42 (cloud computing featuring software for use in analysis of computer systems, optimizing and maintaining the performance of computers and operating systems, adding and removing software, and removing unused files…) with priority from February 11, 2016;
- registered UK word mark “CCLEANER” no. 2486623 for goods and services in the class 9 (computers software) with priority from May 2, 2008;
- registered U.S. word mark “CCLEANER” no. 5099044 for goods and services in the class 9 (computer software) with priority from February 25, 2016;
- registered U.S. word mark “CCLEANER” no. 3820254 for goods and services in the class 9 (computer software) with priority from March 6, 2009.

FACTUAL BACKGROUND

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

Language of the proceeding

In accordance with the para. 11 of the Rules, the language of this proceeding shall be English. English is also the language of the Registration Agreement which is available at the registrar's website. Furthermore, the website under the domain name ccleanerfreedownload.net is only in English version what indicates that the Respondent targets global audience and prefers communication in English.

Evidence: Registration agreement available on <publicdomainregistry.com>

The Complainant and his rights

The Complainant provides to its customers one of the world most popular PC optimization software named "CCleaner" which protects their privacy and makes their computers faster and more secure. This award-winning optimization tool was released in 2004 and has been already downloaded more than two and a half billion times. The Complainant is well known on the market globally as a reliable company with long history which develops software tools, provides excellent technology and amazing service for customers and business.

Popularity of the Complainant as well as high quality of CCleaner software is admitted by the Respondent under disputed domain name (under tab named "About Piriform") by stating: "Piriform has created Ccleaner with a unique mission to ensure smooth operation of a laptop.", "…it would be extremely wise for you to learn as much as you can about Piriform and what they can offer you as one of their millions of customers around the world.", "CCleaner is the most unique piece of software." The Respondent is clearly aware of the Complainant, its trademark, products and good reputation.

Furthermore, the Complainant is the owner of, inter alia, the following trademarks all of which are registered also for computer software programs:

- registered EU word mark "CCLEANER" no. 007562002 for goods and services in the class 9 (software) with priority from January 30, 2009;
- registered EU word mark "CCLEANER" no. 015100803 for goods and services in the class 9 (software) and 42 (cloud computing featuring software for use in analysis of computer systems, optimizing and maintaining the performance of computers and operating systems, adding and removing software, and removing unused files…) with priority from February 11, 2016;
- registered UK word mark "CCLEANER" no. 2486623 for goods and services in the class 9 (computers software) with priority from May 2, 2008;
- registered U.S. word mark "CCLEANER" no. 5099044 for goods and services in the class 9 (computer software) with priority from February 25, 2016;
- registered U.S. word mark "CCLEANER" no. 3820254 for goods and services in the class 9 (computer software) with priority from March 6, 2009;

The Complainant distributes its optimization tool "CCleaner" i.a. via its website www.piriform.com and ccleaner.com where a customer can find product information and can directly and legally download CCleaner software. The authorization to use software downloaded from Complainant's website is regulated by End User License Agreement and is strictly limited to personal use. Through these websites, the Complainant also provide support to its customers in case they need any help regarding CCleaner and other software tools provided by the Complainant. The Complainant owns tents of domains including the words piriform or ccleaner, such as CCLEANERCLOUD.COM, ccleaner.cloud, CCLEANERFORMAC.COM, CCLEANERMAC.COM.

This dispute concerns the domain name ccleanerfreedownload.net created on October 29, 2012. It follows that the domain

name was registered with the knowledge of older above mentioned trademarks of the Complainant. The website under the disputed domain name is being used by the Respondent to offer CCleaner software for download in competition with the Complainant. Moreover, under disputed domain name Respondent distributes malware to Internet users while downloading CCleaner.

The disputed domain name <ccleanerfreedownload.net> is confusingly similar to the Complainant's family of CCLEANER trade and service marks (both statutory and common law) named above, the Respondent has no rights or legitimate interests in respect of the <ccleanerfreedownload.net> domain name which has been registered and is being used in bad faith.

A. The domain name is confusingly similar to the Complainant´s trademarks

Word CCLEANER is at the core of Complainant's family of marks. It consists of the capital letter "C" and a part "-CLEANER" which indicates something that serves for cleaning. The capital "C" is very characteristic for the Complainant as it is also used in his logo with the picture of a broom.

Due to high popularity of the Complainant and its software, considering the leadership position of the Complainant on the market with the optimization software, the word "CCLEANER" acquired a distinctive character. CCLEANER trademark is a globally known brand with good reputation. The complainant (presenting CCleaner) has more than half a million of followers on Facebook and about 15,000 followers on Twitter. Furthermore, the Complainant´s website <ccleaner.com> was in last 6 months visited by approximately 43 million of Internet users.

Based on a large number of the users of the Complainant´s optimization tool, it can be assumed that the word CCLEANER is automatically associated with the Complainant by an ordinary customer and Internet user.

The domain name registered by the Respondent www.ccleanerfreedownload.net is confusingly similar to the Complainant´s registered trademarks.

It is well established that the specific top level of a domain such as ".com", ".org", ".tv" or ".net" does not affect the domain name for the purpose of determining the identity or similarity of domain name and a trademark (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).

The Complainant´s mark "CCLEANER" is entirely reproduced in the disputed domain name. From the perspective of the average customer "CCLEANER" is the distinctive part in the disputed domain name. It is the first dominant part to which an attention of the public is concentrated. An additional part "-freedownload" is descriptive in nature meaning copying of program into computer´s memory without any payment being made. Therefore, this additional part is not able to change overall impression and does not eliminate the confusing similarity with the older trademarks of the Complainant and this is even more true in a situation where Complainant itself offer CCleaner software for download for free under its own website on which uses its trademarks. The dispute domain name is therefore confusing and diverting Internet users. Furthermore, the website to which the disputed domain name resolves displays the Complainant's CCleaner logo at its main page.
It is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity under the first element (see par. 1.8 of WIPO Overview 3.0). Similarly, numerous prior panels have held that the fact that a domain name wholly incorporates a complaint´s registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks. (e.g. EAuto, L.L.C. v. EAuto Parts, WIPO Case no. D2000-0096; Caterpillar Inc. v. Off Road Equipment Parts, WIPO Case no. FA0095497).
Well know character of the Complainant´s trademark was established in previous CAC case no. 101759 (regarding illegal offer of CCleaner for download) and CAC case no. 101760.

On balance, there is high presumption that ordinary consumers will believe that the domain name registered by the

Respondent is owned by the Complainant (or is connected with the Complainant) and will access the website only due to its misleading character assuming that the credible CCleaner tool could be provided directly by the Complainant or with its authorisation. However, instead of CCleaner tool, the Internet user is attacked by the Respondent´s malware what can damage good reputation of the Complainant.

Moreover, the Respondent contributes to the confusion of the public by placing the trademark “CCLEANER” of the Complainant on the websites available under the disputed domain name, by using Complainant´s logo and by referring to the Complainant in a way which gives an impression of connection or cooperation between the Complainant and the Respondent.

On the basis of the above mentioned there can be no question but that the disputed domain name is confusingly similar to the Complainant´s family of marks “CCLEANER” for purposes of the Policy.

B. The respondent has no right or legitimate interests in respect of the domain name

There does not exist any evidence that the Respondent has been commonly known within the consumers by the disputed domain name (by “CCLEANER”) before the beginning of this dispute nor owes any identical or similar trademark nor has ever used any identical or similar brand before the registration.

The Complainant did not grant any license or authorization to register or use the disputed domain name by the Respondent. The use of the Complainant’s trademark and logo as well as distribution of CCleaner in the absence of Complainant’s authorization represents illegal unauthorized conduct of the Respondent.

Before the dispute the Respondent did not use the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services because he has not provided the trademarked goods and service but has used the trademark to bait Internet users and then switch them to his competing software (Nikon, Inc. v Technilab, WIPO Case no. D2000-1774). Competing use is not considered a bona fide offering of goods and services, nor a legitimate noncommecial or fair use, see WIPO case no. D2017-0655-NUOVARIVER.COM.

Panel have found that use of complainant’s trademark and logo along with the offer for download the complainant’s software in the absence of complainant’s authorization and in violation of End User License Agreement negate any potential justification of the Respondent. The Panel also notes that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (Avast Software s.r.o. v Victor Chernyshov, CAC Case no. 101568). Trademark and copyright infringement as well as distribution of malware shall be considered as illegal.

The Respondent was seeking to create a false impression of association with the Complainant, which does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name (Carrefour v Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra, WIPO Case no. D2016-0608).

Under the Policy, a complainant may make out a prima facie case that the respondent lacks rights or legitimate interests in the domain name at issue. Once 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 fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. The domain name has been registered and is being used in bad faith

There is no indication that the disputed domain name was registered and is used in bona fide. The Respondent was clearly aware of the registration and the use of the Complainant´s trademarks before the registration of the domain name as follows from the Respondent´s explicit references on his website to the logo, trademark and CCleaner software of the Complainant and to trade name Piriform.

In the previous CAC cases as stated above the Panel held that the Complainant´s trademarks, company and reputation are well-known. Panels have consistently found that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see par. 3.1.3 of WIPO Overview 3.0).

Furthermore, the disputed domain name is used solely for the illicit distribution of the Complainant's CCleaner software. The Complainant did not provide an authorization for such distribution of its software protected by the copyright. With regard to the End User License Agreement (the EULA) art. 2, the user of the CCleaner software cannot resale or further distribute the CCleaner software. Unauthorized distribution of CCleaner software through the website www.ccleanerfreedownload.net therefore violates the EULA as well as applicable copyright laws.

To conclude, the disputed domain name is used by the Respondent to reach the Complainant´s customers and offer them the optimization tool of the Complainant for download as is offered by the Complainant on its website. This could suggest (incorrectly) that the Respondent operates as an affiliate or a partner of the Complainant or has Complainant´s authorization to offer the software. This is supported by placement of Complainant´s logo and detailed information about Piriform under disputed domain name. Moreover, the quality of the offered CCleaner tool provided by the Respondent is not under the Complainant´s control and therefore software offered by the Respondent can very easily harm good reputation built by the Complainant for years. The Complainant found out that the Respondent distributes malware under disputed domain name.

The Respondent does not disclose its identity and stays anonymous. The Respondent only indicates under "Terms and Conditions" tab that: "We might not really be associated with the companies straight. We might supply alternative choices to those products and services mentioned on this website." These sentences are really vague and do not exclude association with the Complainant. Therefore, as such cannot be considered as a disclaimer. Moreover, such statement will barely get into attention of Internet users given that it is depicted under the tab "Terms and Conditions". The average Internet user will not notice the statement as it usually not read and analyse every page before downloading software from the main page. With regard to these circumstances, the existence of such statement cannot by itself cure the lack of bona fide of the Respondent. It is worth pointing out that it is only by unauthorised use of the trademark that the potential customer is brought to the website in the first place.

The Policy indicates in para 4 (b) (iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent´s website or other online location, by creating a likelihood of confusion with a complainant´s mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

The disputed domain name has no other purpose than misleadingly diverting the potential Complainant´s consumers to illegal distribution of the CCleaner software and to tarnish the trademarks at issue by creating the likelihood of confusion with the Complainant´s marks.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant provides to its customers PC optimization software named "CCleaner" to protect the privacy of computers and make them more secure and faster. Released in 2004, it has been downloaded more than two and a half billion times.

First, Complainant considers that the disputed domain name is confusingly similar to its trademarks. Complainant argues

that, by using the capital letter “C” in the disputed domain name, Respondent is referring to cleaning and that it is very characteristic of the Complainant, who uses this letter in its logo. It also considers that the “CCLEANER” trademark is well-known.

Complainant then alleges that based on the large number of followers on Facebook and Twitter and of visitors on Complainant’s website <ccleaner.com>, the word CCLEANER is automatically associated with Complainant.

Furthermore, Complainant considers that the trademark “CCLEANER” is entirely reproduced in the disputed domain name and constitutes the distinctive part of it. The additional part “freedownload” is descriptive to the nature and meaning of copying a program into a computer’s memory without any payment being made. It considers that this addition does not eliminate the confusing similarity since Complainant itself offers CCleaner software for download for free under its own website. The disputed domain name diverts Internet users from that website.

Complainant then contends that there is a high presumption that ordinary consumers will believe that the domain name registered by Respondent is owned by or linked to Complainant. Internet users are intentionally misled and the good reputation of Complainant can be damaged.

Furthermore, the fact that Respondent places the trademark “CCLEANER” and the CCLEANER logo on the websites available under the disputed domain name contributes to confusion in the public’s mind and gives an impression of connection between Complainant and Respondent.

Second, Complainant alleges that Respondent has no rights or legitimate interests in respect of the domain name. Complainant argues that there is no evidence that Respondent has been commonly known among the consumers by the disputed domain name or owned any identical or similar trademarks before the registration.

Complainant did not grant any license or authorization to register or use the disputed domain name to the Respondent. The use of Complainant’s trademark and logo appears to be an illegal unauthorized use.

Complainant also argues that Respondent’s use is not considered a bona fide offering of goods and services, nor a legitimate noncommercial or fair use. Respondent was seeking to create a false impression of association with Complainant by selling its software illegally.

Third, Complainant considers that the disputed domain name has been registered and is used in bad faith. It contends that Respondent was aware of the registration and the use of the Complainant’s trademark before registering its domain name. Respondent makes explicit references on his website to the logo, trademark, trade name and CCleaner software of the Complainant.

Complainant then argues that the disputed domain name is only used for the illicit distribution of Complaint’s software. Respondent did not receive an authorization for such distribution, while the software is protected by copyright. Respondent violated Complainant’s copyright. It concludes that Respondent harms the good reputation of Piriform, the distributor of CCleaner, by distributing malware under the disputed domain name.

Finally, Complainant alleges that Respondent remains anonymous and only states some vague wording to try to show that it is independent from Complainant and is not to be associated with it under the terms and conditions of its website.

Complainant considers that the disputed domain name has no other purpose than misleadingly diverting potential Complainant’s consumers to an illegal distribution point for the software and to tarnish the reputation of the software.

RESPONDENT:

Respondent did not reply to the Complainant’s contentions.

FINDINGS:

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
(2) Respondent has no rights or legitimate interests in respect of the domain name; and
(3) the domain name has been registered and is being used in bad faith.

A. Rights – Identical or confusingly similar

Complainant has duly shown valid trademark rights for the sign “CCLEANER”.

First, the said sign is used for the distribution of a software, known and used by an important number of Internet users.

Second, the disputed domain name <ccleanerfreedownload.net> fully incorporates Complainant’s trademark associated to the generic and descriptive terms “free” and “download”. Those terms refer precisely to Complainant’s activity. The disputed domain name points to a website offering the possibility to download Complainant’s software for free. As such, those additional terms are purely descriptive and still leave a risk of confusion with Complainant’s trademark.

In most previous cases, Panel considers that “the addition of a common or generic term following a trademark does not create a new or different mark in which the Respondent has rights” (See Wal-Mart Stores, Inc v. Wallsucks & Walmarket Puerto Rico, WIPO case No. D2000-0477).

Third, Panel usually considers that the addition of a gTLD does not dispel the likelihood of confusion between a trademark and a disputed domain name. See eBay Inc. v. Du Hongxia/Liu Yujiao/WHOIS AGENT, DOMAIN WHOIS PROTECTION SERVICE, WIPO case No. D2014-2015: “Neither the addition of the numeral(s), nor the ".com" or ".net" suffixes detracts in any way from the distinctiveness of the Complainant's trade mark”.

Panel finds that the disputed domain name <ccleanerfreedownload.net> is confusingly similar to Complainant’s trademark.

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

B. No rights or legitimate interests

Complainant is required to make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name. If the prima facie case is successful, then the burden of proof shifts to Respondent.

First, Complainant contends that there is no link between it and Respondent and that it did not grant any authorization or license to Respondent. Also, there is no evidence that Respondent has been commonly known among the consumers by the disputed domain name.

Second, Respondent is selling the CCleaner software on its website even though it has been created by Complainant and is protected by copyright. A previous Panel has found that “Distribution of unauthorised, pirated software on the other hand would not constitute such a bona fide offering” (See Sharman License Holdings, Limited v. KazaaPlatinum.com, WIPO Case

No. D2004-0401).
Panel finds that Respondent lacks rights and legitimate interests in the disputed domain name. Respondent's use do not constitute a bona fide offering of goods and services nor a legitimate noncommercial or fair use.

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

C. Bad faith

Paragraph 4(a)(iii) of the Policy requires that Complainant show that the disputed domain name has been registered and is being used in bad faith.

First, and given the reputation of CCLEANER, Respondent could not have ignored its existence when registering the disputed domain name. Since Respondent registered the disputed domain name in such a way as to distribute the CCleaner software for free, it necessarily registered it in bad faith. Furthermore, a Panel has previously found that "the registration of a domain name that is similar to a distinctive trademark by the respondent, when the respondent has no relationship to that mark may suggest bad faith" (See The Net-A-Porter Group Limited v. Suh Hanjun, WIPO case No. D2014-2071).

Furthermore, on its website, Respondent refers to Complainant and to its rights and indicates under "terms and conditions" that it is not linked to Complainant. This shows that Respondent knows about Complainant's rights.

Panel finds that Respondent registered the disputed domain name in bad faith, since any authorization has been granted to Respondent while he necessarily was aware of Complainant's rights.

Second, Respondent is actually distributing CCleaner software through the disputed domain name, without having rights to it. It appears to be an illicit distribution of Complainant's software and as such, a violation of Complainant's copyright. Also, Respondent is using Complainant's logo on the website pointed to by the disputed domain name, without any authorization.

Panel thus finds that the disputed domain name is being used in 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

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be granted, without prejudice to a future judicial decision.

Accordingly, it is ordered that the disputed domain name <ccleanerfreedownload.net> be transferred from Respondent to Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CCLEANERFREEDOWNLOAD.NET**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2019-10-22

Publish the Decision