Decision for dispute CAC-UDRP-102537

Case number	CAC-UDRP-102537
Time of filing	2019-06-27 11:41:59
Domain names	affordablepapers4u.com

Case administrator

Name	Lenka Náhlovská (Case admin)

Complainant

Organization	One Freelance Limited

Complainant representative

Name	Valentyna Kopolovych

Respondent

Organization	TrafficTerminal

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is a registered owner of the following trademark containing a word element "AFFORDABLE PAPERS”:

(i) AFFORDABLE PAPERS (word), US Trademark, priority (filing) date 25 October 2018, registration date 14 May 2019, trademark registration no. 5751325, registered for services in the international class 41;

(referred to as "Complainant's trademark").

Also, the Complainant is the owner of the domain name <affordablepapers.com> registered on April 2, 2006, from which the Complainant derives its unregistered trademark rights to the "AFFORDABLE PAPERS" denomination prior to the registration of the Complainant's trademark.

FACTUAL BACKGROUND

The Complainant, One Freelance Limited, provides through its website available under the domain name <affordablepapers.com> services consisting primarily of on-line custom essay writing.

The disputed domain name <affordablepapers4u.com> was registered on 30 May 2017 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) is currently used by the Respondent for promoting and offering services similar to those of the Complainant, i.e. custom on-demand essay writing.

The Complainant seeks transfer of the disputed domain name to Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The "AFFORDABLE PAPERS" denomination has acquired distinctiveness and reputation through long public use since 2006 and it has acquired secondary meaning attributable to the Complainant as an unregistered trademark.

- Subsequently, Complainant's rights to the "AFFORDABLE PAPERS" denomination (as to an unregistered trademark) predates registration of the disputed domain name despite a fact that the Complainant's Trademark was applied for only thereafter.

- The disputed domain name contains “AFFORDABLE PAPERS” word elements, and it is thus almost identical (i.e. confusingly similar) to the Complainant’s trademark.

- Adding a suffix "4U" (having a meaning "for you") is not sufficient to escape confusing similarity between the disputed domain name and the Complainant’s trademark.

- The Complainant refers to previous domain name decisions in this regard.

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name.

- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.

- On the contrary, the disputed domain name was used for attracting internet users to services provided by the Respondent and this why it is free riding on reputation of the Complainant's trademark and its business.

- The Complainant refers to previous domain name decisions in this regard.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's rights to the "AFFORDABLE PAPERS" denomination (as unregistered trademark rights) predates the disputed domain name registration.

- The disputed domain name was used for attracting internet users to services provided by the Respondent, which are identical to those provided by Complainant, and therefore it is free riding on reputation of the Complainant's trademark and its business.

- The Complainant refers to previous domain name decisions in this regard.

The Complainant presents the following evidence which has been assessed by the Panel:

- Information about the Complainant and its business, its history and reviews concerning the services provided by the Complainant;
- Excerpt from a trademark database;
- Excerpt from a WHOIS database regarding disputed domain name;
- Screenshots of relevant websites;
- Copy of Complainant's correspondence to the Respondent concerning infringement of Complainant's trademark rights

RESPONDENT:
The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is neither 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.

As a result, the Panel rejects the complaint.

NO RIGHTS OR LEGITIMATE INTERESTS

This element was not envisaged by the Panel.

Since the three elements of paragraph 4(a) of the Policy are conjunctive and because the Complainant did not satisfy the requirement of paragraph 4(a)(i) and 4 (a) (iii) of the Policy, the Panel did not further investigate whether the remaining element is present or not.

BAD FAITH

The Panel concluded that the disputed domain name is not being used in bad faith within meaning of paragraph 4(a)(iii) of the Policy.

As a result, the Panel rejects the complaint.

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

RIGHTS

Since the domain name and the Complainant's trademark are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a rather generic terms "AFFORDABLEPAPERS4U" is confusingly similar to the Complainant's trademark "AFFORDABLE PAPERS".

Having in mind the complexity of this issue, the Panel below reveals in detail its considerations and findings:

(i) Existing Case Law

In decisions by various panels constituted under the UDRP process to resolve domain name disputes, there has been discussion of what constitutes confusion for the purposes of paragraph 4(a)(i) where registered trademarks and domain names already in use had been joined together with generic prefixes or suffixes to form a new domain name (sometimes referred to as a derivative).

Although the panel is well aware that the principle of stare decisis does not apply in these proceedings and that it is not bound by decisions reached by earlier panels, it is of the opinion that a review of some the cases provides some support for the conclusions of this decision.

(i) (a) Prefix or Suffix Case Law

There are a number of other decisions within the UDRP process which have addressed the issue of whether a domain name, which comprises the Complainant's mark together with a prefix or suffix, gives rise to confusing similarity.

The decisions fall mainly into two categories: 1) addition of a geographical suffix to a well-known domain name (see, for example, Wal-Mart Stores, Inc. v Walmarket Canada, WIPO D2000-0150; Wal-Mart Stores, Inc. v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477; AltaVista Company v S.M.A. Inc., WIPO D2000-0927), or 2) addition of "sucks" to a similarly well known name (see, for example, Dixons Group Plc v Purge I.T. and Purge I.T. Ltd., WIPO D2000-0584; Cabela's Inc. v Cupcake Patrol, NAF FA0006000095080; Wal-Mart Stores, Inc. v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477).

The Complainant has typically prevailed in both types of categories.

Decisions in the former category have been disposed of generally on the clearly correct basis that the addition of a place name is not likely to alter the underlying mark (Wal-Mart Stores, Inc v Walsucks and Walmarket Puerto Rico, WIPO D2000-0477) and not likely to change the fact that consumers will be confused.

Decisions in the second category have been decided for on the basis of similar reasoning, though this seems more open to dispute. There are a number of other decisions where there is neither a geographical, nor derogatory addition (see, for example, Yahoo!, Inc. and Geocities v Cupcakes et al., WIPO D2000-0777; Yahoo!, Inc. v Cupcake Patrol et al., WIPO D2000-0928). These too have followed similar reasoning, though the finding of confusing similarity is largely based in these cases on evidence of demonstrated confusion amongst consumers.

The disputed domain name which is the subject of this administrative decision does not fall into either the geographical or "sucks" category, but at first blush the same principle would appear to apply: the addition of a suffix "4U" does not alter the underlying mark and confusion may result.

However, it is here that the idea of 'genericness' comes into play. The other decisions dealt with either extremely well known marks, which had a high degree of inherent or acquired distinctiveness: for example, Walmart, Standard Chartered, Dixons, Altavista and Yahoo, or at least concerned trademarks which have no meaning in common language (i.e. they are fantasy or imaginary trademarks "invented" by their holders).
They did NOT deal, as here, with marks, which are the concatenation of two words that are fairly generic. This has been dealt in other case law.

(i) (b) Generic mark and generic word case law

On the other hand, decisions dealing with an issue of descriptiveness of the trademark or a trademark and a generic word, showing a more mixed decision, often resulted in rejection of the complaint (see, for example, Hotels unis de France vs. Christopher Dent / Exclusivehotel.com, WIPO D2005-1194, Pinnacle Intellectual Property vs. World Wide Exports. WIPO D2005-1211, City Utilities of Springfield vs. Ed Davidson, WIPO D2000-0407 and similar).

(ii) Legal Analysis

The effect of strictly and automatically adopting the principle from the prefix or suffix cases would be to stop any other registrations of domain names which add either a prefix or suffix to registered trademarks, even though such trademarks are quite generic.

In the Panel's view, the scope of the concept of "confusing similarity" (not a mere "similarity) must be taken into account. The Panel believes that it is necessary to apply a more case specific approach as established by "mark with generic word" and "generic / distinctive" case law.

As a result, the Panel believes that as a basic guideline, following test should be followed:

A domain name comprising from a trademark and a suffix should not be in general held confusingly similar to such trademark:

(1) Where that trademark is essentially generic within the online world and has not acquired such distinctiveness as to merit broader protection (i.e. in particular, where such originally generic trademark has not yet - through its use, advertising good name, etc. - acquired such distinctiveness that it is exclusively attributable to its trademark holder – Complainant); and

(2) Where the suffix (or the domain name as a whole) does not relate specifically and exclusively to the business of the Complainant.

Ad 1) Generic Nature of the Trademarks

In the Panel's view, the Complainant's trademark consisting of the "AFFORDABLE PAPERS" denomination is rather non-distinctive. It is apparent that the words "AFFORDABLE" and "PAPERS" are both descriptive or laudatory of the services in respect of which the trademark and the domain names are used. i.e. providing on-line writing services at an affordable price.

In addition, results of the internet search show that the words "AFFORDABLE" and "PAPERS" are commonly used by other service providers, by some of them directly in a domain name, but mostly for description of their services. Consequently, words "AFFORDABLE" and "PAPERS" are not, by far, attributable or connected solely to the business of the Complainant.

As a result, despite all the long term use and promotion spent by the Complainant, its trademark has not become so well known as to acquire the requisite degree of distinctiveness taking them out of their original generic nature.

This implies that Internet user's are aware of the fact that the term "AFFORDABLE PAPERS" is legitimately and commonly used by various subjects on the Internet, both as a part of domain names or within Internet content (e.g. on websites, etc.) and, therefore, that they do not associate this term solely with the Complainant or its business. In the Panel's view, the Internet public understands and anticipates that various modifications of such generic and common terms will exist, that they will be used by different subjects, and that they do not reasonably expect that all of them will be associated with the Complainant.

Ad 2) Generic Nature of the Suffix

It is apparent that the suffix “4U” cannot alone or by inclusion to the disputed domain name change the generic nature thereof or make the domain name specially attributable to the Complainant, or be exclusively connected with its services or business.

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In addition to the test above, the Panel believes that for a domain name to be regarded as confusingly similar to the Complainant's trademark, there must be a risk that Internet users may actually believe there to be a real connection between the domain name and the Complainant and/or its services. As it follows from the above, this is not the case.

Thus, by failing the above test, the Panel concludes that even though the disputed domain name is similar to the Complainant's trademark, it is not CONFUSINGLY similar to the same.

Since the Panel has decided that there is no confusing similarity in this case, it also concludes that the Complainant has not satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

This element was not envisaged by the Panel.

Since the three elements of paragraph 4(a) of the Policy are conjunctive and because the Complainant did not satisfy the requirement of paragraphs 4(a)(i) and 4 (a)(iii) of the Policy, the Panel did not further investigate whether the remaining element is present or not.

BAD FAITH

Moreover, in the opinion of the Panel, the Complainant has not managed to prove bad faith on the part of the Respondent in registering and using the disputed domain name.

It is clear from the terms of paragraph 4(a)(iii) of the Policy as well as confirmed by numerous decisions under it that the two elements of this third requirement are cumulative; both registration and use in bad faith must be proved for a complaint to succeed. See, for example, World Wrestling Federation Entertainment, Inc. v. Michael Bosman, WIPO D1999-0001, Telstra Computers Ltd v. Nuclear Marshmallows, WIPO D2000-0003 and A. Nattermann & Cie. GmbH and Sanofi-aventis v. Watson Pharmaceuticals, Inc., WIPO D2010-0800.

The Panel contends that the bad faith element in this particular case is closely connected with the “confusing similarity” and “false association” concepts as described above. Since the Panel has asserted that the terms “AFFORDABLE PAPERS” are still generic and commonly used, it has concluded that there is no likelihood of confusion or false association between the disputed domain name and the Complainant’s trademark and its business, unless the Complainant proves otherwise in this specific case.

It is possible that the Respondent has been aware of Complainant’s trademarks, domain names and business in general; however, this does not automatically mean that it has registered the disputed domain name in bad faith in order to “free ride” on the Complainant’s or its trademarks’ reputation, since the domain name is descriptive of the services that the Complainant has been offering.

In addition, the Complainant claims that the Respondent has attempted to create a likelihood of confusion also because a design of the disputed domain name website was identical or very similar to the design of Complainant's website. However, at the time being, the disputed domain name website has rather different design and style than Complainant's websites and in Panel's view, no likelihood of confusion in this regard is present.

The Panel also contends that the disputed domain name was registered before priority date of the Complainant's trademark. Before such priority date the Complainant might have relied only on unregistered (trademark) rights to the "AFFORDABLE PAPERS" name. However, the Panel did not find evidence supporting Complainant's assertions of acquired distinctiveness and secondary meaning of such name to be satisfactory. In this case involving unregistered (common law) trademark that comprise solely of descriptive terms which are not inherently distinctive, there is a greater onus on the Complainant to present evidence of acquired distinctiveness and secondary meaning of the term "AFFORDABLE PAPERS" which he failed to do. Alleged quality of services provided by the Complainant does not automatically mean that the consumers associate the term "AFFORDABLE PAPERS" solely with the Complainant and its business.

To conclude, Complainant has chosen a generic term “AFFORDABLE PAPERS” to be used for promotion of his services. This provides him certain advantage over his competitors as such domain name is intuitive and likely returns better results in case of search engine optimization compared to fantasy names. However, at the same time, the Complainant cannot "monopolize" this term only for himself and restrict uses of derivative terms thereof for bona fide offering of services by his competitors, e.g. by the Respondent.

As a result, the Panel concludes that the Complainant has failed to prove that the disputed domain name is being used in bad faith within meaning of paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **AFFORDABLEPAPERS4U.COM**: Remaining with the Respondent

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2019-11-28

Publish the Decision