Decision for dispute CAC-UDRP-102553

Case number	**CAC-UDRP-102553**
Time of filing	**2019-07-12 11:34:12**
Domain names	**ccleaner-new.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Piriform Software Limited**

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**Nikolai Koulisidis**

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any pending or decided proceedings related to the disputed domain name.

IDENTIFICATION OF 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.

Furthermore, it 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 www.ccleaner.com where a customer can find product information and can directly download CCleaner software. 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 website www.ccleaner.com is almost identical to the disputed domain name. The Complainant owns tens of domains including the words piriform or ccleaner, such as CCLEANERCLOUD.COM, ccleaner.cloud, CCLEANERFORMAC.COM, CCLEANERMAC.COM.

FACTUAL BACKGROUND

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

Language of the proceeding/request for English to be the language of the administrative proceedings.

In accordance with the para. 11 of the Rules, the language of this proceeding shall be English.

Out of caution, the Complainant requests the panel to proceed in the English language with regard to the circumstances of this case. It is acknowledged that the registrar informed that the language of the registration agreement was Russian. This was however not evidenced in any way and the Complainant contends that the terms and conditions of the registrar are in English. When registering the domain name, the Respondent most likely agreed with the English terms.

Furthermore, the website under the disputed domain name <ccleaner-new.com> is only in English language. Moreover, the disputed domain name <ccleaner-new.com> is in Latin alphabet and is derived from the English words “cleaner” meaning something that serves for cleaning and “new”. This shows Respondent's good knowledge of the language which is a strong factor favouring the proceeding to be in English (cf. case No. 101403 "Perspirex", case no. 101568 Avast Software s.r.o. vs. Victor Chernyshov).

Furthermore, it has been established that where the merits of the case strongly favour the complainant and translating the complaint would cause unnecessary delay, English is an acceptable language for the proceedings (cf. WIPO case No. D2016-1567 "Remy Martin"). The Complainant contends that this is the case of this proceeding showing prima facie trademark infringement in which the Respondent is engaged. Further, the disputed domain name is not active and there is not any justifiable reason why the Respondent should be allowed to use the Complainant´s trademark. There is high presumption that in the future the disputed domain name will be used for the illicit distribution of the Complainant´s optimization software named “CCleaner” what will cause substantial damage to the Complainant and to its reputation built for years.

With regard to the above mentioned, the Complainant hereby request for English to be the language of the administrative proceedings.

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.

Furthermore, it 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;
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The Complainant distributes its optimization tool “CCleaner” i.a. via its website www.piriform.com and www.ccleaner.com where a customer can find product information and can directly download CCleaner software. 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 website www.ccleaner.com is almost identical to the disputed domain name. The Complainant owns tens of domains including the words piriform or ccleaner, such as CCLEANERCLOUD.COM, ccleaner.cloud, CCLEANERFORMAC.COM, CCLEANERMAC.COM.

This dispute concerns the domain name www.ccleaner-new.com created on April 4, 2019. It follows that the domain name was registered with the full knowledge of older above mentioned trademarks of the Complainant. The website under the disputed domain name was used by the Respondent for distribution of malware pretending to be CCleaner software. Nowadays, the disputed domain name is not active because hosting service is inactive due to expiration of web hosting plan or due to violation of Term of Web hosting service (as stated on the website).

The domain name ccleaner-new.com 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 disputed 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 www.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 disputed domain name 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. The only distinction between the dispute domain name and the Complainant´s mark is added word "-new". This additional part is descriptive in nature meaning something that did not exist before, i.e. recently created (could be associated with new version of CCleaner software and creates misleading impression that it is updated version of Complainant´s website). This additional part is not able to change overall impression and does not eliminate the confusing similarity with the older trademarks of the Complainant. The dispute domain name is therefore confusing and diverting internet users.

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 company name and trademark was established in previous CAC case no. 101759 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 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.

Moreover, the Respondent contributes to the confusion of the public by placing the trademark "CCLEANER" of the Claimant on the websites available under disputed domain name presumably in order to abuse this very famous trademark in his favour.

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 disputed 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 in the absence of Complainant's authorization represents illegal unauthorized conduct of the Respondent.

Panel have found 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).

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/her websites under which distributed malware (Nikon, Inc. v Technilab, WIPO Case no. D2000-1774).

The disputed domain name is currently inactive (in passive holding of the Respondent). In the case no D2018-1111 (FXCM Global Services LLC v. WhoisGuard Protected, Whoisguard Inc. / Jenny Sohia) it was held that mere passive holding does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use.

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 disputed 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 to the trademarks of the Complainant (before the content of the disputed domain name was blocked, the disputed domain name served for distribution of malware presented as CCleaner tool).

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).

Bad faith of the Respondent is further supported by the fact that the Respondent concealed his/her identity. There is not any reasonable justification why the disputed domain name should include the Complainant´s trademark. A situation as this one, where there has been an adoption of a well-known mark in a domain name which the Respondent has no apparent connection to nor any plausible reason why it should have chosen the disputed domain name, leads to an inference of bad faith. (see WIPO Case No. D2015-0843, <missoni.)

To conclude, the disputed domain name is used by the Respondent to reach the Complainant´s customers. This could suggest (incorrectly) that the Respondent operates as an affiliate or a partner of the Complainant or has Complainant´s authorization to use its trademark. This is even more true when the disputed domain name contains the additional word - new which misleadingly indicates new version of CCleaner software or upgrade version of the Complainant´s website.

There is no plausible explanation why the Respondent selected the disputed domain name other than for the purpose of “intentionally [attempting] to attract, for commercial gain, Internet users to [its] web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [its] web site or location or of a product or service on [its] web site or location” (para. 4(b)(iv) of the Policy) and in order to tarnish the trademarks at issue by creating the likelihood of confusion with the Complainant´s marks.

Furthermore, the use of a proxy server by the true owner hidden behind the Respondent is markedly corroborate a finding of bad faith (Carrefour v Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra, WIPO Case no. D2016-0608).

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. Identical or confusingly similar
The Complainant contended that the disputed domain name <ccleaner-new.com> is identical to its registered trademark "CCLEANER". The Complainant also stated addition of the descriptive term “-new” is not sufficient to escape the finding that the disputed domain names is identical to the Complainant's trademark and does not change the overall impression of the designations as being connected to its trademark.
The Complainant’s registered mark “CCLEANER” has no common meaning in the English language. As indicated by the Complainant, the mark is created to represent its product served for cleaning purposes, and has used a distinctive capital letter “C” that is distinctive as it is used also used in its logo image with the picture of a broom. it is well established that the addition of a top level domain would not change the determination that the dispute domain name is identical to the Complainant’s trademark. According to WIPO Overview 3.0 §1.11.1, “the applicable Top Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusion similarity test”. In addition, the added term “-new” does not differentiate itself well enough from the Complainant’s brand. New is a common English word and it means something recently created, which could also be used by the brand owner to indicate a new version of its product. According to WIPO Overview 3.0 paragraph 1.8, “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.” Here, the addition of the term “-new” does not impair the natural association consumers might have with the Complainant’s brand, and therefore should not impact the assessment of the identicality or confusing similarity within the meaning of paragraph 4(a)(i) of the Policy
The Panel therefore 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. No rights or legitimate interests
Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such 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 is deemed to have satisfied paragraph 4(a)(ii) of the Policy.
The Respondent has offered two arguments to support its contention that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Firstly, the Respondent is not known as the disputed domain name; secondly, neither license or authorization has been granted to the Respondent.
According to the information of the Respondent as provided by the Registrar, the name of the Respondent’s organization is protected by privacy. Therefore, there is no evidence suggests that the Respondent is in anyway associated with the name “CCLEANER”. The Complainant also contended that it does not carry out any activity for, nor has any business with the Respondent. It has never licensed nor authorized the Respondent to make any use of the Complainant’s trademark CCLEANER.
On the basis of preponderance of evidence, 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 rights or

legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

As contended by the Complainant, it is true that UDRP Panels have consistently held 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. It could be inferred from the circumstance that the Respondent was aware of the Complainant's brand name at the time of registering the disputed domain name. The Complainant has also contended that by creating a website using a domain name similar to its own while keeping the website inactive, the Respondent could easily reach to the Complainant's costumers, and gives the wrong impression that the Respondent operates as an affiliate or a partner of the Complainant. This is a "passive holding" scenario, where the panel is allowed to examine a totality of circumstances including the degree of distinctiveness or reputation of the complainant's mark, the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, the respondent's concealing its identity or use of false contact details, and so on (WIPO Overview 3.0 §3.4). Here not only the Respondent maintains the website in its inactive state, it is also trying to conceal its true identity in registering the domain name. Not being able to fathom any other plausible reason that the Respondent registered the disputed domain name, these evidence collectively give a strong inference that the domain name has been registered and used in bad faith.

In view of the above, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, 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. **CCLEANER-NEW.COM**: Transferred

PANELLISTS

Name	**Carrie Shang**

DATE OF PANEL DECISION 2019-12-24

Publish the Decision