Decision for dispute CAC-UDRP-102737

Case number	**CAC-UDRP-102737**
Time of filing	**2019-11-04 16:41:02**
Domain names	**cleanpcsoftwareccleanerfree.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Piriform Software Limited**

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**Juan li**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of, inter alia, the following registered regional and national trade marks all of which are registered for computer software programs. A registered EUTM being the word mark “CCLEANER,” no. 007562002 in class 9 (software) with priority from 30 January 2009 and the registered EUTM word mark “CCLEANER,” no. 015100803, in class 9 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 11 February 2016. A registered UK word mark “CCLEANER” no. 2486623 in class 9 with priority from 1 May 2008, a registered U.S. word mark “CCLEANER” no. 5099044 in class 9 with priority from 25 February 2016 and a registered U.S. word mark “CCLEANER,” no. 3820254 in class 9 with priority from 6 March 2009. Finally, the registered national mark in China, the word mark “CCLEANER,” no. 18167490 in class 9 with priority from 27 October 2015 and the registered national mark in China, word mark “CCLEANER,” no. 18169134 in class 42 with priority from 27 October 2015. None of the marks appear to disclaim any terms. The Complainant also asserts and relies on its common law rights arising from use in trade where recognised in local law.

FACTUAL BACKGROUND

The Complainant supplies a popular PC optimization software tool named “CCleaner” which protects users’ privacy and

makes computers faster and more secure. This award-winning tool was launched in 2004 and has been 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. The Complainant distributes its optimization tool “CCleaner” via its websites at www.piriform.com and ccleaner.com --where a customer can find product information and download the tool. Through these websites, the Complainant also provides customer support.

Due to the popularity of the Complainant’s market leading software, the word “CCLEANER” has acquired a distinctive character. CCLEANER trademark is a well-known brand with a good reputation. The Complainant has more than half a million of followers on Facebook and about 15,000 followers on Twitter. Furthermore, the Complainant´s website, ccleaner.com, from November 2018 to April 2019 was visited by approximately 43 million Internet users. The Complainant owns a large portfolio of domains including the words “piriform” or “ccleaner”, such as ccleanercloud.com, ccleaner.cloud, ccleanerformac.com, ccleanermac.com.

The disputed domain name, <www.cleanpcsoftwareccleanerfree.com>, was created on 20 July 2019. The disputed domain name was then used to illegally offer competitive software similar to CCleaner. The disputed domain name more recently has resolved to a site that is a lottery platform, www.mycp.com, which may have been unlawful but is in any event, no longer active.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:
The disputed domain name is confusingly similar to the Complainant’s family of CCLEANER trade and service marks (both statutory and common law) and 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 trade marks
The word “CCLEANER” is the core of the Complainant’s family of marks. It consists of the capital letter “C” and in the second part, the word “CLEANER” which indicates something that serves for cleaning. This capital “C” is emblematic of the Complainant and is also used in its logo with the picture of a broom.

Due to the popularity of the Complainant’s market leading software, the word “CCLEANER” has acquired a distinctive character. CCLEANER trademark is a globally known brand with good reputation. The Complainant has more than half a million of followers on Facebook and about 15,000 followers on Twitter. Furthermore, the Complainant´s website, ccleaner.com, from November 2018 to April 2019 was visited by approximately 43 million 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 trade marks. It is now 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 of the disputed domain name which is surrounded by descriptive terms “clean”, “pc”, “software” and “free”. The first terms “clean”, “pc”, “software” simply describe the main function of the Complainant´s software. The term “free” added at the end of the disputed domain name gives the impression that the software can be downloaded at the websites under the disputed domain name without charge. These additional descriptive terms do not alter the overall impression or eliminate the confusing similarity with the trade marks of the Complainant. It is well accepted that where the relevant trade mark is recognizable within the disputed domain name, the addition of descriptive terms will 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 complainant´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 and significant reputation of the Complainant´s company name and trade mark was established in previous CAC case no. 101759 and CAC case no. 101760, as well as in WIPO case No. DCC2019-0002

There is a presumption that ordinary consumers will believe that the disputed domain name is, or is owned by, the Complainant and will access the website only due to its misleading character assuming that the genuine CCleaner tool with professional support would be provided by the Complainant or with its authorisation. Instead of this, malware may be installed to their PC and/or advertisement promoting unlawful or unregulated lotteries.
It is highly probable that the Respondent uses Complainant´s trade mark in order to abuse this famous trade mark to attract the attention of Internet users to the lottery platform mycp.com which has no connection with the Complainant. The Complainant does not wish to be connected in any way with such lottery platform based on completely different values. For these reasons, the disputed domain name is confusingly similar to the Complainant´s family of marks “CCLEANER” for purposes of the Policy.

B. There is no evidence that the Respondent has been commonly known by consumers by the disputed domain name (or by the name “CCLEANER”) before this dispute nor that it owns any identical or similar trademark or has ever used any identical or similar mark or name before. The Complainant did not grant any license or authorization to register or use the disputed domain name to the Respondent. The use of the Complainant’s trade mark in the absence of Complainant’s authorization represents unlawful and unauthorized use by the Respondent.
The Panel has 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 trade marked goods and service but has used the trademark to bait Internet users and then switch them to websites which promote an illegal lottery platform, mycp.com (Nikon, Inc. v Technilab, WIPO Case no. D2000-1774). 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). After the complaint was filled the Complainant found out that the disputed domain name is probably not active. 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.

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 bona fide. The Respondent was clearly aware of the registration and the use of the Complainant´s trade marks before the registration of the domain name due to well-known character of the Complainant´s trademarks. In the previous CAC cases as stated above, the panels held that the Complainant´s trade marks are well-known. Panels have consistently found that the mere registration of a domain name that is confusingly similar to a famous or well-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).

The Complainant´s marks have a considerable reputation in software sector. The Complainant and its trademark CCLEANER also have considerable exposure and presence in the Internet through its many domains including the words piriform or ccleaner, such as ccleanercloud.com, ccleaner.cloud, ccleanerformac.com, ccleanermac.com.
On the Internet, the reach and reputation of brands and trade marks can transcend national borders. A simple search on the

Internet would reveal the presence of the Complainant's trade mark and domain names. Therefore, it is inconceivable that the Respondent would not have known of the Complainant's trade mark rights at the time of the registration of the disputed domain name (similarly in WIPO case no. D2012-0583).

When entering the term "ccleaner" into the Google search engine, the results point to Complainant and its business activities and Respondent could easily have performed a similar search before registering the disputed domain name. He would then quickly have learned that Complainants own the CCLEANER trademark, and that Complainant has been using it globally. The registration of the disputed domain names seeks to take advantage of an association with the businesses of Complainant and its trade mark. (similarly, in WIPO case no. D2017-0182). The respondent as an entrepreneur is expected to have a degree of professionalism, including prudence (reasonable level of due care).
There is no reasonable justification for why the disputed domain name should include the Complainant´s trade mark. Where there is an adoption of a well-known mark in a domain name which the Respondent has no apparent connection to nor any plausible reason for, leads to an inference of bad faith. (see WIPO Case No. D2015-0843, <missoni.)
Furthermore, bad faith is evident as the Respondent uses the Complainant´s trademark to promote his business- the lottery platform --in order to make profit to the detriment of the Complainant and its trade marks. The Respondent abuses the well know character of the Complainant's trademark and popularity of CCleaner software in his favour. Using of Complainant´s trademark for the promotion of such a platform damages the good reputation of the Complainant and its trade mark.

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 trade mark for the promotion of lottery platform.

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).

The fact, that the disputed domain name became inactive after the submission of the complaint (is currently not actively used but merely passively held) does not prevent a finding of bad faith use under the Policy as, in the present case, such a passive holding of the domain name is equal to active use. There is consensus view among Panellists that the element of use in bad faith is satisfied not only if a domain name is actively being used on the Internet, but also if in the light of the overall circumstances of the domain registration, the passive holding of a domain name equates with an active use of a domain name (ADR case no. 07458).

RESPONDENT:

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.

The language of the registration agreement was Chinese language, and this would usually govern under the Policy. The disputed domain name is in the Latin alphabet and is comprised of English words. This shows Respondent's has some knowledge of the English language and targets global audience, 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).

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 trade mark infringement in which the Respondent is engaged.

The UDRP Rules at 11a provide a discretion to the Panel and in this case the Complainant’s submission is accepted.

PRINCIPAL REASONS FOR THE DECISION

While the Complainant has registered its word mark, CCleaner, for computer software in various jurisdictions, in English, it is a highly descriptive mark. It is made up or an ordinary letter from the Latin Alphabet and a common English dictionary word.

The law of registered trade marks deals with this issue of descriptiveness as an Absolute Ground and when applying for such a mark, proof of “acquired distinctiveness” or “secondary meaning” is usually required. The Complainant must have either met this standard or disclaimed exclusivity in order to register its trade marks.

Highly descriptive marks comprised of common dictionary words do not make good trade marks as they do not signal the badge of origin of one trader and must be free for use by all for their informational value. Not only is it relevant as an Absolute Ground, it is also highly relevant to Relative Grounds and to enforcement.

Highly descriptive marks do not grant any exclusivity and traders selecting such marks must be prepared to suffer confusion from others wishing to use the same common dictionary words for their informational value.

The Policy deals with this internationalised trade mark norm by its protection in the second limb for fair and legitimate use and informational or descriptive use is fair and legitimate use under 4(c) (iii) of the Policy. The cases and decisions under this limb look very closely at the manner and reason for use.

Some look very hard at whether the disputed domain name is using the term in question in its “primary” or “dictionary” sense or in its “secondary” or “acquired” meaning to designate a complainant’s goods or services. And this is useful here.

On the one hand, the Complainant’s mark is barely recognisable in the disputed domain name – which looks like a selection of common dictionary words. The C before cleaner is only perceptible if you are looking for it.

However, that begs the question –why is it there? It must be deliberate, and it must be to free-ride on the trade mark.

We note also that the disputed domain name originally resolved to offers of competing software. The wayback machine evidence shows this very clearly. This removes any doubt that the purpose was free-riding.

That is the determinative point under the Policy at para 4(b)(iv) and this is paradigm bad faith.

The disputed domain name was registered and used in bad faith and the Complainant has made out its case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CLEANPCSOFTWARECCLEANERFREE.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2020-01-30

Publish the Decision