Decision for dispute CAC-UDRP-102830

Case number	**CAC-UDRP-102830**
Time of filing	**2019-12-23 09:26:12**
Domain names	**davidoffcoolwaterman.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Zino Davidoff SA**

Complainant representative

Organization	**BRANDIT GmbH**

Respondent

Organization	**Super Privacy Service LTD c/o Dynadot**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings related to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following Trademarks, among many others:

- International Registration No. 467510 DAVIDOFF, registered on January 27, 1982 for goods in classes 3, 14, 15, 16, 18, 20, 21, 25, 33 and 34;

- US Registration No. 5332230 (79207836) DAVIDOFF COOL WATER WAVE, filed on February 27, 2017 and registered on November 14, 2017 for goods in class 3.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

Since the language of the Registration Agreement of the Disputed Domain Name <davidoffcoolwaterman.com> is English according to the applicable Registrar, the language of the proceeding should be English.

II. ABOUT COMPLAINANT AND THE BRAND

Zino Davidoff SA (hereinafter referred to as the Complainant) is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation. The Complainant has been using and marketing its brands for over 30 years. In 1984 the Complainant launched perfumery and cosmetics. Since then, the Complainant has been developing various products such as watches, clothing, cognac, leather goods, glasses, writing instruments, coffee etc. The business has been continuously expanding and the scope of the goods bearing the mark DAVIDOFF gets wider over time.

The Complainant and its trademarks enjoy a high reputation around the world due to Complainant's long-term use and publicity. Complainant has continually and heavily invested in publicizing and advertising its trademarks around the world including the United States where the Respondent is domiciled.

The Complainant has a strong presence in the United States where the Respondent is located. The below link connects customers to the official local sales and service locator and to the official websites of the Complainant:

www.zinodavidoff.com/store-locator?selectedFilters=afab5032-4a5a-4d43-8b58-c2133b8507b2--en%2C3e76072b-fe2f-4d06-8e0f-3aace161e1c5--en%2Cd26a3e15-be09-48ce-8b5d-1c7a45eda5ea--en%2Cb93413e5-dc66-457c-8974-eca75e123e8c--en%2Ca20aae14-a1d9-4e72-b002-d5715a4cc5f4--en%2Cda1135ff-d49a-4bb1-bc33-95756f3186e1--en%2C13b42136-5e5a-4307-881d-c8ea565c1fdf--en

The Complainant is the owner of the widely known, distinctive trademarks DAVIDOFF/ DAVIDOFF/ DAVIDOFF COOL WATER/ DAVIDOFF COOL WATER WAVE as word and/or figure marks in several classes in numerous of countries all over the world including in the United States. These trademarks registration predates the registration of the Disputed Domain Name.

Trademark registration in the United States

Trademark: DAVIDOFF (IR)
Registration no: 467510
Date of registration: 27 Jan 1982

Trademark: DAVIDOFF COOL WATER WAVE (US)
Registration no: 5332230
Date of registration: 14 November 2017

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "Davidoff" and "DAVIDOFF COOL WATER", see for example, <zinodavidoff.com> (created on 2002-12-16) and <davidoffcoolwater.com> (created on 2016-07-19). The Complainant is using the domain names to connect to a website through which it informs potential customers about its trademarks and its products and services.

Furthermore, the Complainant has previously successfully challenged several DAVIDOFF domain names through UDRP proceedings, e.g. WIPO Case no: D2013-0410 Zino Davidoff SA vs. Yang Yong concerning the domain <davidoffperfumes.com>; WIPO Case no: D2015-2318 Zino Davidoff SA vs. Tang Bin concerning the domain <davidofftea.com>; WIPO Case no: D2016-1027 Zino Davidoff SA vs. Guan Rang Guang concerning the domain <davidoshore.date>.

LEGAL GROUNDS:

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <davidoffcoolwaterman.com> (hereinafter referred to as the “Disputed Domain Name”), which was registered on 1 August 2019 according to the WHOIS, entirely or partially incorporates the Complainant’s widely known, distinctive trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE combined with a generic term “man”, which closely relates to the Complainant’s business activities as the Complainant has a perfumery product with the name COOL WATER MAN under the housemark DAVIDOFF. The addition of the gTLD “.com” does not add any distinctiveness to the Disputed Domain Name. Referring to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), as the term “DAVIDOFF/DAVIDOFF COOL WATER” is distinctively recognizable in the Disputed Domain Name, the Disputed Domain Name should be considered as confusingly similar to the trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant has never granted the Respondent any right to use the DAVIDOFF/DAVIDOFF COOL WATER WAVE trademarks within the Disputed Domain Name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that it has legitimate interest over the Disputed Domain Name or the major part of it. When entering the terms “DAVIDOFF” “cool” “water” and “man” in the Google search engine, the returned results all point to the Complainant and its business activities.

The Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in the United States and many other countries of the world. However, the Respondent still chose to register the Disputed Domain Name as such.

By the time the Complainant prepared this Complaint on 16 December 2019, the Dispute Domain Name resolved to a pay-per-click website with terms relevant to the Complainant and its business activities. For example, “Davidoff Parfum”, “Parfums Homme”, “Zino Davidoff”, etc.

From the Complainant’s perspective, the Respondent deliberately chose to incorporate its widely known, distinctive trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE in the Disputed Domain Name combined with the term “man” in order to confuse internet users as to the source or sponsorship, and/or to attract internet traffic to its own website by benefiting from the Complainant’s renown of its trademarks.

The Respondent therefore has not been using the Disputed Domain Name for any bona fide offering of goods or services.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted that the registration of the Complainant’s trademarks predates the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name.

As noted in previous paragraphs, the Complainant has a strong presence in the United States. It is inconceivable that the combination of the widely known trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE and the generic term “man” in the Disputed Domain Name is not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights.

Considering the fact that:

• The Respondent very likely knows about the Complainant and its trademarks;
• The Complainant's trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE is a widely known, distinctive trademark worldwide and in the United States where the Respondent resides;
• The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name,

the Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.:

"If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, … (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name…"

and para.3.1.4:

"Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Name resolved to a pay-per-click website with related and/or unrelated term(s). From the Complainant's perspective, the Respondent has selected the widely known, distinctive trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE for its domain name to attract business to its pay-per-click website, in the belief that the widely known trademarks would attract visitors looking for DAVIDOFF/DAVIDOFF COOL WATER WAVE and give potential for pay-per-click revenue from people who would not otherwise have visited the website.

In a similar case Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364 where pay-per-click website is involved, the panel states in the decision that:

"it is use in bad faith within the scope of paragraph 4(b)(iv) of the Policy where the registrant is using the domain name in this manner because of its similarity to a mark or name of another person in the hope and expectation that that similarity would lead to confusion on the part of Internet users and result in an increased number of Internet users being drawn to that domain name parking page (see, for example, Express Scripts, Inc. v. Windgather Investments Ltd, supra). The confusion that is usually relevant here is the confusion that draws the Internet user to the respondent's website in the first place (for example, confusion that leads an Internet user to type the domain name into his Internet browser). It does not matter that when the Internet user arrives at the pay–per-click site that it then becomes clear that the website is unconnected with the trade mark holder."

Therefore, the Complainant concludes that by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or website of others, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

Secondly, the Complainant has tried to reach the Respondent by a cease-and-desist letter on 11 September 2019. Since the Respondent was using privacy shield, the Complainant sent the letter via the email davidoffcoolwaterman.com@superprivacyservice.com as provided In the WHOIS records, with copy to the Registrar via email abuse@dynadot.com. In the cease-and-desist letter, the Respondent notified the Respondent about its prior trademark rights and requested a voluntary transfer.

Without receiving reply from the Respondent, subsequently, the Complainant followed up the cease-and-desist letter by two reminders sent on 20 September 2019 and 27 September 2019. However, until the time the Complainant prepared this

Complaint, it has not received any response from the Respondent. Since the amicable approach has been unsuccessful, the Complainant chose to file a UDRP.

The Respondent's non-response to cease-and-desist letter under these circumstances infers bad faith use of the Disputed Domain Name, see Arla Foods Amba v. Mlanie Guerin, CAC case No. 101640; Medela AG v. Donna Lucius, CAC case No. 101808.

SUMMARY

• DAVIDOFF/DAVIDOFF COOL WATER WAVE are widely known, distinctive trademarks worldwide including in the United States;
• The Complainant's trademarks registration predates the registration of the Disputed Domain Name;
• The Respondent has no legitimate rights in the trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name;
• It is highly unlikely that the Respondent was not aware of the Complainant's prior rights in the trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE at the time of registering the Disputed Domain Name, given the Complainant's worldwide renown and its active presence in the United States;
• The Respondent has been using the Disputed Domain Name to associate to a pay-per-click website;
• The Respondent has not responded to the Complainant's cease-and-desist letter and reminders;
• The Respondent has been under privacy shield to conceal its identity.

Consequently, the Respondent should be considered to have registered the Disputed Domain Name confusingly similar to the Complainant's widely known, distinctive trademarks DAVIDOFF/DAVIDOFF COOL WATER WAVE. The Complainant has not found that the Respondent is of any legitimate right or interest in using the Disputed Domain Name, but rather registered and has been using the Disputed Domain Name in bad faith.

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

I. RIGHTS

The Disputed Domain Name is confusingly similar to the Complainant's registered trademarks DAVIDOFF and DAVIDOFF

COOL WATER WAVE. Actually, the applicant uses its mark in the form DAVIDOFF COOL WATER MAN to identify its well-known products.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the domain name in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D20020856:

“As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the Disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists.“ WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, apparently the Respondent did not reply to the C&D letters sent by the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant´s allegations and evidence with regard to the Respondent´s registration and use of the Disputed Domain Name in bad faith.

Paragraph 4(b) (iiii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the Disputed Domain Name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of a product or service on its website or location.

The Complainant's DAVIDOFF trademark is well-known in the luxury perfume industry and the DAVIDOFF COOL WATER MAN is one of its most successful products, well before the registration of the Disputed Domain Name. The Respondent's registration of the Disputed Domain Name wholly incorporating a well-known third-party mark is, in the Panel´s view, indicative of bad faith.

As mentioned in Andrey Ternovskiy dba Chatroulette v. Alexander Ochki, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the Disputed Domain Names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see AT&T Corp. v. Amjad Kausar, WIPO Case No. D2003-0327)."

The other party, in a case such as the one at hand, reproducing a well-known trademark, the use of a privacy service may also be interpreted as an indication of bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DAVIDOFFCOOLWATERMAN.COM**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2020-01-27

Publish the Decision