Decision for dispute CAC-UDRP-102983

Case number	**CAC-UDRP-102983**
Time of filing	**2020-03-23 09:52:50**
Domain names	**piriformdownloads.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Piriform Software Limited**

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**iqbal fajrian**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is owner of the followings trademarks:

- UK word mark “PIRIFORM” no. UK00002486624 filed on 2 May 2008 and registered on 24 October 2008 for goods and services in the Classes 9 (software, online electronic publications (downloadable) from the Internet), 35 (support services), 41 (providing online electronic publications (not downloaded) by means of the Internet); and 42 (computer programming; design, maintenance and updating of computer software; computer systems analysis, advice and consultancy services in relation to the use of computer software; business software consultancy services);

- EU word mark “PIRIFORM” no. 007562085 filed on 30 January 2009 and registered on 21 January 2009 for goods and services in the classes 9 (software, online electronic publications (downloadable) from the Internet), 35 (support services), 41 (providing online electronic publications (not downloaded) by means of the Internet); and 42 (computer programming; design, maintenance and updating of computer software; computer systems analysis, advice and consultancy services in relation to the use of computer software; business software consultancy services);

- US word mark “PIRIFORM” no. 77684996 filed on 6 March 2009 and registered on 15 June 2019 for goods and services in the classes 9 (computer software for optimising and maintaining the performance of computers and operating systems), 41 (providing online electronic publications (not downloaded) by means of the Internet); and 42 (computer programming; design, maintenance and updating of computer software; computer systems analysis, advice and consultancy services in relation to the use of computer software; business software consultancy services).

The Complainant has been carrying out business under the trade name Piriform Software Limited and is also owner of numerous domain name containing the wording "PIRIFORM", such as piriform.com (used as its main website), piriform.it, piriform.hu, piriform.org.uk.

FACTUAL BACKGROUND

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

The Complainant is a global leader in PC optimisation softwares. The Complainant is a PC maintenance and software company dedicated to creating the best applications for speeding-up and optimising the customer's computer. Under the trademark "PIRIFORM" the Complainant sells and promotes the following well-known softwares:
- CCleaner - Optimisation and Cleaning
- Defraggler - File Defragmentation
- Recuva - File Recovery
- Speccy - System Information
- CCleaner Cloud - Powerful PC cleaning and management in one place
- CCleaner Business Edition - Professional System Optimisation and Cleaning
- CCleaner Network Professional - Network Cleaning and Optimisation with Remote Deployment.

The Complainant distributes its softwares though its website www.piriform.com and www.ccleaner.com, containing product information and enabling the direct download of the CCleaner, Defraggler, Recuva and Speccy softwares. The authorisation to use the software downloaded from the Complainant’s website is regulated by a license agreement. Use is strictly limited to personal use. Through the afore-mentioned websites, the Complainant also provides support to its customers.

The disputed domain name was created on 22 July 2019, well after the Complainant's trademarks.

The website associated with the disputed domain name has been used by the Respondent for illegal distribution of the Complainant's softwares. The Respondent explicitly states that the primary purpose of its website is to share its knowledge about Piriform. Therefore, the Respondent is well aware of the Complainant, its trademark, products and services and good reputation.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

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

The wording "PIRIFORM" is the core of the Complainant’s trademarks and trade name, meaning in common English pear-shaped. The Complaint uses the image of a pear in its well-known logo. The Complainant's logo is also used by the Respondent as the favicon of the disputed domain name, thus proving the Respondent's knowledge of the Complainant and its business. Based on the large number of the users of the Complainant's softwares (CCleaner software has been downloaded by more than 2,5 billion times), the Internet users automatically associate the wording "PIRIFORM" with the Complainant.

The Complainant's trademark is entirely reproduced in the disputed domain name. From the perspective of the average

customer “PIRIFORM” is the distinctive part of the disputed domain name. It is the first dominant part on which the attention of the public is concentrated. The additional term “downloads” is descriptive, meaning copying of program into the computer's memory. This additional term is not able to change the overall impression and does not eliminate the confusing similarity with the Complainant's prior trademarks. This is even more true in a situation where the Complainant itself offers its softwares for download under its own official website. Therefore, disputed domain name is confusing and diverting the Internet users.

It is likely that ordinary consumers will believe that the disputed domain name is owned by the Complainant and will access the website only due to its misleading character assuming that the softwares could be provided directly by the Complainant or with its authorisation. Instead, the Internet user might be attacked by the Respondent's malware or low quality (old versions) of softwares which would damage the Complainant's good reputation.

Moreover, the Respondent contributes to the confusion of the public by using the Complainant's trademark on the website associated with the disputed domain name and explicit references to the Complainant's official websites. The Respondent also uses the Complainant's logo as a favicon, presumably in order to abuse such well-known mark and the Complainant's reputation in his favour.

Therefore, the disputed domain name is confusingly similar to the Complainant's trademarks.

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

No evidence exists showing that the Respondent has been commonly known by the disputed domain name before the introduction of the present dispute. The Respondent neither owns any identical or similar trademark, nor has ever used any identical or similar mark before the registration of the disputed domain name.

The Complainant did not grant any license or authorisation to the Respondent to register or use the disputed domain name. The use of the Complainant’s trademark in the absence of the Complainant’s authorisation represents an illegal unauthorised conduct of the Respondent (copyright and trademark infringement). The Respondent uses the disputed domain name for illegal distribution of the Complainant's softwares.

Before any notice of the dispute, the Respondent did not use the disputed domain name or a corresponding name in connection with a bona fide offering of goods or services. He has used the trademark to bait Internet users and then switch them to his competing distribution of softwares. Competing use is neither considered a bona fide offering of goods and services, nor a legitimate non-commercial or fair use (see CAC case no. 102640).

The Respondent is 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.

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 being used in bona fide. The Respondent was clearly aware of the Complainant's trademarks before the registration of the disputed domain name, as evidenced by the Respondent's explicit references to the Complainant's official websites, to its trademarks and softwares sold and promoted under the PIRIFORM trademark. Furthermore, the Respondent has used the Complainant's logo as a favicon of the disputed domain name and has misleadingly stated that the author of the articles published on the website is the Complainant.

Considering the great number of users of Complainant's softwares, the PIRIFORM trademark is well-known with good reputation on the relevant market.

The disputed domain name has been used solely for the illicit distribution of the Complainant’s CCleaner and Recuva softwares. The Complainant did not provide any authorisation for the distribution of its softwares protected by copyright. According to the End User License Agreement (as well as the software license and support agreement), the user of the

Complainant's softwares cannot resale or further distribute such softwares. Therefore, the unauthorised distribution of CCleaner and Recuva softwares through the disputed domain name violates the EULA, as well as the applicable copyright laws.

Finally, the disputed domain name is used by the Respondent to reach the Complainant's customers and offer them the Complainant's softwares for download. This could suggest (incorrectly) that the Respondent operates as an affiliate or a partner of the Complainant or has Complainant's authorisation to offer the softwares. This is supported by the fact that the Respondent refers directly to the Complainant, its trademarks, official websites and uses the Complainant's logo as a favicon of the disputed domain name. The quality of the CCleaner and Recuva softwares provided by the Respondent is not under the Complainant's control and, therefore, the softwares offered by the Respondent might very easily harm the Complainant's good reputation built for years. Furthermore, these facts directly prove that the Respondent was aware of Complainant's website, its trademarks, logo, as well as of its popularity and good reputation when creating the disputed domain name. The Respondent is trading on the Complainant’s name and brand and intentionally tarnish its trademarks at issue.

Bad faith of the Respondent is further supported by the fact that the Respondent concealed his/her identity. The website associated with the disputed domain name does not contain any information about the provider of the service. The statement placed under the “Disclaimer” tab does not include any relevant information and in no way excludes association with the Complainant. Therefore, as such it cannot be considered as a disclaimer. The existence of such irrelevant statement cannot by itself cure the lack of bona fide of the Respondent.

The disputed domain name has no other purpose than misleadingly diverting the Complainant's potential consumers to illegal distribution of the CCleaner and Recuva softwares and to tarnish the Complainant's trademarks by creating the likelihood of confusion with the Complainant's trademarks.

Furthermore, the use of a proxy service by the Respondent is also indicator of bad faith.

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.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:
(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant

has rights; and
(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used by the Respondent in bad faith.

I. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in the PIRIFORM trademark since 2008.

In assessing identity or confusing similarity the Panel finds that the disputed domain name incorporates the entirety of the Complainant's trademark and differs from such mark by merely adding the generic and descriptive term "downloads", as well as the TLD ".com". The addition of such generic and descriptive term (clearly related to the business of the Complainant) to the Complainant's mark neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain name from the Complainant's mark.

In UDRP cases where the relevant trademark is recognisable within the disputed domain name, Panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) and letters does not prevent a finding of confusing similarity under the first element (see 1.8 WIPO Overview 3.0).

UDRP Panels also agree that the top-level domain is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of registration (see 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP Panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see 2.1 WIPO Overview 3.0: "[...] where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.")

The Respondent is iqbal fajrian, an individual residing in Indonesia.

The Complainant has no relationship with the Respondent whatsoever.

The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register the disputed domain name.

There is no evidence that the Respondent has been commonly known by the disputed domain name or has acquired any rights in a trademark corresponding to the disputed domain name.

The disputed domain name resolves to a website with clear references to the Complainant, its trademarks, products and services. Therefore, the disputed domain name was registered and has been used with the intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Complainant, well-known for its business, has sufficiently demonstrated to be owner of the PIRIFORM trademark, registered prior to the registration of the disputed domain name.

The Respondent registered the disputed domain name confusingly similar to Complainant's mark, since it wholly incorporates the PIRIFORM trademark. The addition of the generic and descriptive term “downloads” and the TLD “.com” (technical requirement of the registration) is not sufficient to escape the finding of confusing similarity between the disputed domain name and the Complainant’s mark.

Furthermore, the Respondent used a privacy service when registering the disputed domain name. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact a panel’s assessment of bad faith (see 3.6 WIPO Overview 3.0).

Given the good-will and reputation of the Complainant acquired over the years, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant’s website. Such intention is indeed confirmed by the use of the disputed domain name, which resolves to a website containing clear references to the Complainant, its trademarks, products and services.

By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, the Internet users to his website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of his website or of the products or services on his website.

Considered all circumstances of the dispute, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

Therefore, the disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRIFORMDOWNLOADS.COM**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2020-05-08

Publish the Decision