Decision for dispute CAC-UDRP-102433

Case number	CAC-UDRP-102433
Time of filing	2020-06-15 09:52:45
Domain names	ikea90.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Inter IKEA Systems B.V.

Complainant representative

Organization	Convey srl

Respondent

Organization	New Ventures Services, Corp

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the trademark IKEA, with several international and national trademark registrations worldwide, including the following:

- German Trademark Registration n. DE867152 of March 12, 1970 in class 20;

- U.S.A. Trademark Registration n. 1118706 of May 22, 1979 in classes 11, 20, 21, 24, 27;

- U.S.A. Trademark Registration n. 1661360 of October 22, 1991 in classes 2, 18, 25, 29, 30, 31, 35, 36, 39, 41;

- European Union Trademark Registration n. 000109652 of October 1, 1998 in classes 2, 8, 11, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 35, 36, 39, 41, 42;

- European Union Trademark Registration n. 000109637 of October 8, 1998 in classes 2, 8, 11, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 35, 26, 39, 41, 42;

- International Trademark Registration n. 926155 of April 24, 2007 in class 16, 20, 35, 43 designating also China;

- Italian Trademark Registration n. 0001257211 of March 12, 2010 in class 20; and

- Italian Trademark Registration n. 0001300174 of June 3, 2010 in class 21.

FACTUAL BACKGROUND

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

The disputed domain name was registered by the Respondent on October 16, 2013, without authorization of Complainant, and has been pointed to a parking page displaying pay-per-click links. The disputed domain name is also offered for sale via both Afternic and Network Solutions platforms.

When the Complainant became aware of the registration and use of the disputed domain name by the Respondent, it instructed the Legal Representative to serve the Respondent and the corresponding Internet Service Providers with cease and desist letters in order to formally notify them of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer of the disputed domain name to the Complainant.

On September 26, 2019 a cease and desist letter was sent by the Legal Representative to the Respondent's e-mail dedicated to the trademark complaint but the Respondent did not deem appropriate to reply. On March 20, 2020, the Legal Representative drafted and sent via e-mail a new cease and desist letter to the Respondent requesting to refrain using the disputed domain name and to transfer it to the Complainant.

In absence of a reply and the failure to comply with the request for transfer of the disputed domain name, the Complainant has decided to file the present Complaint in order to obtain the transfer of the disputed domain name under its ownership and control.

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).

The disputed domain name <ikea90.com> reproduces the Complainant's IKEA trademark in its entirety with the addition of the number "90" after word "ikea", thus the disputed domain name is undoubtedly confusingly similar to the trademark IKEA in which the Complainant has rights.

Such addition of the number "90" after word "ikea" does not reduce the high degree of similarity between the disputed domain name and the Complainant's trademark. As indicated in the decision for Fendi S.r.l. v. Federico Porcedda Case No. D2018-1265: "This Panel agrees with the Complainant's opinion and previous UDRP decisions, affirming that confusing similarity is generally established when the domain name incorporates the complainant's trademark in its entirety, and the addition of descriptive prefixes and suffixes does not avoid confusing similarity. […] The further addition of the letter "s" is also insufficient to avoid confusing similarity.".

The top level ".com" is merely instrumental to the use in Internet - as found in The Forward Association, Inc., v. Enterprises Unlimited (Forum case FA0008000095491, October 3, 2000) and numerous others - and not able to affect the confusing similarity of the disputed domain name to the Complainant's trademark.

Therefore, the disputed domain name fully incorporates the word element of the Complainant's trademark. As indicated in the decision for No Zebra Network Ltda v. Baixaki.com, Inc. Case No. D2009-1071: "having determined, on the limited record

presented in this proceeding, that BAIXAKI appears to be a mark in which the Complainant has rights, the Panel must next assess whether the disputed domain name is identical or confusingly similar to that trademark. The disputed domain name fully incorporates the word element of the Complainant's BAIXAKI Mark".

Furthermore, the trademark is a distinctive, invented word and there is no plausible reason that Respondent would register it by chance. At the time of the registration, the Respondent received also a trademark claims notice about the Complainants rights in the IKEA trademark, in view of the registration of the trademark IKEA in the ICANN's Trademark Clearinghouse.

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).

As a preliminary note, along the lines set forth in Pharmacia & Upjohn Company v. Moreonline, WIPO Case No. D2000-0134 and National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net, WIPO Case No. D2000-0118, the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Respondent is not an authorized dealer of the Complainant nor has ever been authorized by the Complainant to use the trademark IKEA in the disputed domain name.

The Complainant is not in possession of, nor aware of the existence of, any evidence demonstrating that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name as an individual, business, or other organization.

In the case at hand, IKEA is neither a generic term, nor descriptive, and it is not a dictionary word, rather it is an inherently distinctive trademark which solely refers to - and should belong to the Complainant. As anticipated, the word IKEA is an acronym without meaning and completely original and creative; it was coined in 1943 from the initials of Complainant's founder, i.e. Ingvar Kamprad, the farm on which he grew up, i.e. Elmtaryd, and the nearby village, i.e. Agunnaryd.

There has been no evidence showing that Respondent has any registered trademark rights with respect to the disputed domain name. Respondent registered the disputed domain name on October 16, 2013, years after the IKEA trademark became widely known. Thus, the disputed domain name is almost identical to Complainant's IKEA trademarks.

The Respondent has not provided the Complainant with any evidence of its use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute.

Considered that prima facie no relationship has ever been established between the parties and no lawful connection to the denomination IKEA appears from the records either, the Complainant could not find any evidence on which to ground the assumption that the Respondent is making a bona fide offering of goods or services related to the denomination IKEA.

Rather, the Complainant contends that the Respondent has registered the disputed domain name – which is confusingly similar to the Complainant's trademark – to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, since the disputed domain name – at present - is connected to a parking page hosting pay-per-click links to third party websites dedicated to the furniture sector and to Complainant's website. As indicated at section 2.9 of the WIPO Overview 3.0 "Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users".

Furthermore, the disputed domain name is offered for sale via a couple of platforms.

The above-described uses of the disputed domain name suggest that the Respondent intends to trade upon the reputation of Complainant's trademark obtaining profits from the PPC links and by intentionally offering for sale the disputed domain

name without the Complainant's authorization. Consequently, there has been no evidence showing that Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. Respondent has not provided evidence of a legitimate noncommercial use of the disputed domain name or reasons to justify the choice of the term IKEA in the disputed domain name and in its business operation. Likewise, in the WIPO decision Klarna Bank AB v. Yaoliming This Domain is for Sale at Sedo.com Case No. D2019-0864: "there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name or that before any notice of the dispute the Respondent has made use of, or demonstrable preparations to 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. Instead, there is evidence in the complaint that the disputed domain name was registered with the intention of profit, since it is being offered for sale".

For all of the foregoing reasons, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name pursuant to 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).

The registered trademark IKEA has been indeed used extensively and exclusively by the Complainant since 1943 and, through long established and widespread use in several countries of the world, the aforesaid trademark of the Complainant enjoys worldwide reputation in the sector of furniture. The disputed domain name was registered in October 2013, years after the Complainant obtained its trademark registrations, including in Italy where the Respondent is located.

Therefore, by virtue of its extensive worldwide use, the Complainant's trademark IKEA has become a well-known trademark as indicated also in several UDRP decisions. For instance, in the WIPO decision No. D2016-0067: "The Panel is satisfied that the disputed domain name was registered and is being used in bad faith for the following reasons: (a) The Panel finds that at the time of registration the Respondent must have been aware of the Complainant's well-known trademark and registered the disputed domain name incorporating that well-known trademark in bad faith for the following reasons: (i) The Complainant's IKEA trademark is distinctive. At the time of registration of the disputed domain name on February 25, 2015 it was one of the world's most well-known global brands. IKEA is not a term that anyone would likely use descriptively. It is inconceivable to the Panel that the Respondent could have coincidentally chosen the disputed domain name without knowledge of the Complainant's marks as it encapsulates the distinctive mark IKEA.". Moreover, in the WIPO Case No. D2016-0432 "the element of bad faith is clearly established by the fact that the trademark IKEA is one of the most well-known trademarks in the world in connection with furniture and household items. In the WIPO decision No. D2017-2211 related to the domain name <ıkea.com> in Punycode: "at the time of the registration of the disputed domain name the Complainant's trademark and business had both been very well-known for many years; it is not plausible that the Respondent stumbled on the name in the disputed domain name, much less its relevant Punycode, by chance or serendipity. This alone strongly suggests a bad faith registration, with the motive of making use of the disputed domain name to deceive Internet users into believing that the website linked to the disputed domain name was linked to the Complainant and its brand."

As indicated in many decisions, registering a well-known trademark is deemed bad faith registration considering indeed that the Respondent knew or should have known that its registration would be identical to the Complainant's mark. Along these lines, WIPO Case No. D2002-0033 Ferrari S.p.A. v. Allen Ginsberg, the registration of a domain name related to a well-known trademark is a: "Respondent has registered the domain name <maserati.org> corresponding to the well-known or even famous trademark MASERATI which he must have been aware of". In view of the trademark's distinctiveness and well-known character of IKEA trademark, it is inconceivable that the Respondent was unaware of the existence of the Complainant's registered trademark at the time of the registration of the disputed domain name, with which it is almost identical.

Furthermore, the Respondent has not replied to the cease and desist letter sent on March 20, 2020, consequently he has avoided to provide evidence of contemplated good-faith use. The fact that the disputed domain name is offered for sale via both Afternic and Network Solutions platforms is a further proof of bad-faith registration. The Respondent has indeed

registered the disputed domain name having in mind the value of the Complainant's trademark and with the aim to offer it for sale obtaining, therefore, profits from it. This aspect reveals the implausibility of any good faith use of the disputed domain name by the Respondent.

Currently, the disputed domain name is redirected to a parking page hosting pay-per-click links to the Complainant and to third party websites, this circumstance could not be deemed a good faith use because the Respondent receives profits by the pay-per-clink link as indicated in the WIPO decision: SAP SE v. Domains by Proxy, LLC / Kamal Karmakar, WIPO Case No. D2016-2497: "It is well established that where a domain name is used to generate revenue in respect of 'click through' traffic, and that traffic has been attracted because of the name's association with the Complainant, such use amounts to use in bad faith, see for example Shangri-La International Hotel Management Limited v. NetIncome Ventures Inc., WIPO Case No. D2006-1315; Owens Corning v. NA, WIPO Case No. D2007-1143; McDonald's Corporation v. ZusCom, WIPO Case No. D2007-1353; Villeroy & Boch AG v. Mario Pingerna, WIPO Case No. D2007-1912; Rolex Watch U.S.A., Inc. v. Vadim Krivitsky, WIPO Case No. D2008-0396. Revenue will be generated by such visitors clicking on the provided links and it does not matter whether that revenue accrues to the Respondents or the operator of the parking site."

Among the sponsored links displayed in the page, the first one is related to the Complainant, so the Respondent is aware of the existence of the trademark IKEA and targeted the parking page to include the Complainant's trademark.

As displayed in the decision Owens Corning v. NA WIPO Case No. D2007-1143: "Even if the Respondent did not have any direct influence over what sponsored links were chosen, in this case it does not matter. The Respondent must have known that by using a parking service, some sponsored links would be generated. Since the Respondent knew that the term "Pink Batts" was one which could only be sensibly associated with the Complainant's insulation products, she must also have known that any sponsored links generated by GoDaddy were likely to relate to insulation connected goods and services. Finally, even if the sponsored links had been to businesses unconnected with insulation, again in this case it would not matter. What is important is that the Respondent must have known that internet users seeking information about the Complainant's products would then find themselves at a website upon which goods and services unrelated to the Complainant were advertised. In the circumstances, the Panel finds the use of GoDaddy's domain name parking service was a bad faith use of the Domain Name".

Therefore, the Respondent wants to capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users. Therefore, considering the high reputation of the trademark IKEA, we can claim such use amounts to bad faith.

The offer for sale of the disputed domain name for USD 300 exceeds the Respondent's out-of-pocket costs, the fees for the registration and maintenance of a domain name .com is usually around USD 10 per year. Along the same lines, WIPO Case No. D2013-1152 Inter IKEA Systems B.V. v. Above.com Domain Privacy / Host Master, Transure Enterprise Ltd: "the "Mr. Smith" who communicated with the Complainant's representative demanded USD 500 for the Domain Name and reported that he had listed the Domain Name on an auction website for any party to bid on. The stated amount substantially exceeds the Respondent's likely out-of-pocket costs, given that the Domain Name had only recently been registered and the Registrar typically charges less than USD 10 for registration of a ".com" domain name (as indicated on the Registrar's website). Thus, the Respondent's conduct is consistent with the example of bad faith described in the Policy, paragraph 4(b)(i)."

The Respondent has been involved in other UDRP procedures as indicated also in the recent WIPO decision No. D2019-2982 Nicolas Ghesquiere v. THIS DOMAIN MAY BE FOR SALE AT HTTPS://WWW.NETWORKSOLUTIONS.COM, New Ventures Services, Corp, where the Respondent was New Ventures Services, Corp, "- The Respondent has been involved in numerous proceedings under the Policy, where the UDRP panels have found bad faith on the part of the Respondent, and the outcome of the proceeding was a transfer to the complainant (see, for example, Dr. Rebecca Parsons, ThoughtWorks, Inc. v. Perfect Privacy, LLC / This Domain May be for Sale at https://www.networksolutions.com, New Ventures Services, Corp, WIPO Case No. D2019-0866; SGII, Inc. v. New Ventures Services, Corp, WIPO Case No. D2019-2748; and Ashok Leyland Limited v. New Ventures Services Corp, WIPO Case No. D2015-0762).". As indicated in such recent proceeding, similarly to the case at issue, the disputed domain name was redirected to a parking page containing sponsored links for clothes and accessories, including links to clothing and bags from "Balenciaga" to capitalize on the reputation and goodwill of the complainant's

mark.

In light of the above, the Panel concludes that the disputed domain name was registered and is being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) 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

The manner in which the disputed domain name is confusingly similar to the protected mark. The Respondent does not have any rights or legitimate interest in the disputed domain name. The disputed domain name has been registered and is being used in bad faith in a case where the registration of a well-known trade mark is involved, while the Respondent does not answer to various cease and desist letters and attracts internet users for commercial gain by creating a likelihood of confusion with the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IKEA90.COM**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2020-07-07

Publish the Decision