Decision for dispute CAC-UDRP-103077

Case number	CAC-UDRP-103077
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Domain names	philipspulseoximeters.com

Case administrator

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

Complainant

Organization	KONINKLIJKE PHILIPS N.V.

Complainant representative

Organization	REACT B.V. SUCURSAL REACT SPAIN

Respondent

Name	feng ze qu di xing fu shi wang dian

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant (KONINKLIJKE PHILIPS N.V.) is the owner of several registered trademarks for the term “PHILIPS” including the international trademark word registration No. 310459 “PHILIPS” registered on March 16, 1966, international trademark figurative registration No. 991346 “PHILIPS” registered on June 13, 2008 and the European Union trademark word registration No. 000205971 “PHILIPS” registered on October 22, 1999.

The disputed domain name <philipspulseoximeters.com> was registered on April 3, 2020.

FACTUAL BACKGROUND

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

The Complainant is the owner of the International trademark word registration No. 310459 for PHILIPS registered on March 16, 1966, for goods and services of classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 14, 15, 16, 17, 19, 20, 21, 28, 31 and 34, the International trademark figurative registration No. 991346 for PHILIPS registered on June 13, 2008, for goods and services of classes 3, 5, 7, 8, 9, 10, 11, 14, 16, 18, 20, 21, 25, 28, 35, 36, 37, 38, 41, 42, 44, 45 and the European Union trademark word registration No. 000205971 for PHILIPS filed on April 1, 1996 and registered on October 22, 1999 for goods and services of

classes 3, 6, 7, 8, 9, 10, 11, 14, 16, 18, 20, 21, 25, 28, 35, 37, 38, 40, 41 and 42. The Complainant's main website is available at "www.philips.com". The Complainant's trademarks PHILIPS are well-known worldwide.

The disputed domain name was created on April 3, 2020, and it is used to promote the manufacture and sale of specialist range of personal medical equipment, including Pulse Oximeters. The website concerned to the disputed domain, aims to present as a professional domain both operationally and aesthetically, with clearly accessible terms and conditions, a 30 day returns policy and a guarantee that all customer and payment information is transmitted using the Internet-standard SSL (Secure Sockets Layer) protocol. Furthermore, on the website corresponding to the disputed domain name, PHILIPS trademark was displayed together with the colors, font type and feel of the Complainant's main website.

The Complainant contends that the disputed domain name is confusingly similar to its trademark PHILIPS plus an additional generic term. The Respondent has no rights or legitimate interests in the disputed domain name. The registration and use of the disputed domain name performed by the Respondent has been carried out in bad faith, providing products which are not produced or sold by the Complainant. It seems that the Respondent is using the trademarks of the Complainant in order to gain the trust of consumers and more easily cause them confusion about the origin of the products/services offered by the Respondent.

The Complainant owns PHILIPS´ trademark rights since, at least, 1966, and the disputed domain name was registered by the Respondent on April 3, 2020, after the Complainant began using its trademark. The disputed domain name incorporates the Complainant's trademarks PHILIPS in its entirety, followed by the term "pulseoximeters". However, such addition does not prevent a finding of confusing similarity, as the Complainant's trademarks are clearly recognizable within the disputed domain name. Numerous UDRP panels have considered that the addition of other terms (whether descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name is not sufficient to escape a finding of confusing similarity under the first element.

Confusion is only heightened since the generic word added by Respondent is descriptive or suggest being so of the Complainant's goods or services marketed in relation to the trademark. It effectively ensures that the domain name will convey the same idea, or impression, as the mark.

Furthermore, the Respondent is not only using the Complainant's trademarks in the disputed domain name, but also in other clearly visible elements of the website, such as the logo, the content or the contact e-mail address provided.

Complainant has no relationship whatsoever with Respondent and has never authorized Respondent to use the disputed domain name or any other domain name. Moreover, the Respondent has not acquired trademark or service mark rights and the Respondent's use and registration of the disputed domain name was not authorized by the Complainant. In the absence of any license or permission from the Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed.

The current state of UDRP panel consensus in relation to this issue is helpfully summarized in the section 2.8 of the WIPO Overview 3.0, based on panel decisions such as Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001 0903. According to the "Oki Data test", several cumulative requirements will be applied in the specific conditions of a UDRP case, including the fact that the site must accurately and prominently disclose the registrant's relationship with the trademark holder (the Complainant) and that the Respondent must not try to "corner the market" in domain names that reflect the trademark. In this case there was no indication regarding the relationship between the Parties on the website corresponding to the disputed domain name.

Complainant's trademarks have been held to be famous in numerous occasions, highlighting the WIPO Case No. D2011-2274 and WIPO Case No. D2010-1494. It can be assumed that Complainant's trade and service mark are known by the Respondent, as Complainant has been in the business for a considerable number of years.

Use of a domain name that is identical or confusingly similar to a trademark that applies to goods sold by a respondent is not a bona fide use if the domain name serves as a "bait" to attract customers to respondent's website, rather than merely as

a descriptor of the respondent's products.

Complainant emphasizes that a finding of bad faith (as set out below) also means that the Respondent's use of the disputed domain name cannot be regarded as "fair", or "legitimate", nor as a use in connection with a bona fide offering of goods or services under paragraph 4(c)(i).

It is incumbent upon the Respondent to come forward with concrete evidence rebutting the assertion that the Respondent has no rights or legitimate interests connected to the disputed domain name.

The Respondent is not commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests. Use of the expression "PHILIPS", in a trade mark sense, on the Respondent's website, does not itself prove that the Respondent, or any business or organization represented by him or it, is "commonly known" by that expression. To come within the safe harbor of that provision, a respondent (or his/her organization or business) must have been commonly known by the at-issue domain at the time of registration. There is no evidence of that in this case.

The Respondent's domain name registration, and the continuous use of this, appears to be an attempt to exploit the fame and goodwill of Complainant's trademarks by diverting Internet traffic intended for Complainant's website to its own website. The corresponding website content does not prima facie support a referential use, commentary, criticism, praise, or parody, is misleading as to source or sponsorship, or a pretext for tarnishment or commercial gain. Notably in this regard, commercial gain may include the Respondent gaining or seeking reputational and/or bargaining advantage, even where such advantage may not be readily quantified.

The Respondent has used the disputed domain name in connection with a website selling goods that are not produced or sold by the Complainant, and this is something that evidence the bad faith in the registration of the disputed domain name. By using the trademark on both, website and domain name, visitors may think that they are visiting a website which is affiliated with the trademark holder. If visitors actually buy something on the website, it is most likely that they do not receive anything.

Bearing in mind the Respondent's failure to respond the notice of take down and to heed the warnings of infringement contained, there is evidence of bad faith in the registration of the disputed domain name. Something that also is confirmed by the clear occult aptitude of the Respondent, that in a first moment registered the disputed domain name across the Internet Services Provider Shopify, for later and after this warning of taking down, changing it to Alicloud (on April 27, 2020), for again changing it to the first and the one that is now, Shopify.net (on May 5, 2020).

The Complainant holds trademark rights for PHILIPS since at least 1966, and it is well known in its field of activity. The disputed domain name was registered in bad faith, knowing the Complainant and targeting its trademarks. A simple trademark search at the time of the registration of the disputed domain name would have revealed the Complainant's trademark registrations. Also a simple search on the Internet would have revealed the Complainant's presence and trademarks. As a result, considering also the use of the website, the Respondent could not reasonably have been unaware of the Complainant's trademark at the time of registration. The Respondent should have undertaken a clearance search in order to check whether the domain name was free of use and would not violate third parties' interests. He would thus have detected the earlier rights of the Complainant. Having neglected to do so, the Respondent has demonstrated evident carelessness.

The Respondent was using without permission the Complainant's well known trademarks in order to get traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential affiliation or connection with the Complainant. This false impression was increased by the incorporation of the Complainant's trademark PHILIPS in the disputed domain name, the goods offered and related to the Complainant's area of commercial activity, the unauthorized featuring of the Complainant's marks, including the attempt to reproduce of the feel of the Complainant's official website on such website. Proof of that are the multiple consumer's report available on the Internet, posted between April 22 and 23, 2020, along with several websites believed to be part of the same business

operations as “Philipspulseoximeters”. Also the Complainant has received several direct complaints from confused customers who purchased items from the site.

Furthermore, the Respondent is selling goods that, although related to the Complainant’s area of commercial activity, are not sold or produced by the Complainant, and such use carries a risk of implied affiliation with the Complainant in two ways: the first one, because the goods themselves, taking advantage of the reputation of the Complainant's trademarks, are not even marketed by the Complainant; and the second reason, because the disputed domain name creates confusion that the Complainant is selling these products, which is not the case.

The Complainant neither manufactures nor markets the products offered in the disputed domain name website. The Respondent is not only selling their products through its website, but it is also possible that consumers purchase them through other websites on the Internet, some of which are even couponing and offer pages.

The Complainant’s trademark furthermore has a strong reputation and is widely known, as evidenced by its substantial use in multiple countries. According to paragraph 3.1.4. of the WIPO Jurisprudential Overview 3.0: 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.

In cases such as this, where the reputation of Complainant in a given mark is significant and the mark bears strong similarities to the disputed domain name, the likelihood of confusion is such that bad faith on the part of the respondent may be inferred.

Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark:

(i) actual confusion;

(ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent’s commercial benefit, even if unsuccessful;

(iii) the lack of a respondent’s own rights to or legitimate interests in a domain name;

(iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer;

(v) redirecting the domain name to the complainant’s (or a competitor’s) website; and

(vi) absence of any conceivable good faith use.

Taking into account the significant reputation associated with the Complainant’s trademarks, there is no conceivable legitimate use of the disputed domain name by the Respondent. Any use of the disputed domain name by the Respondent is likely to constitute passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s trade mark rights.

And as set out in paragraph 3.1 of the WIPO Jurisprudential Overview 3.0: the Complainant’s burden can also be satisfied with “evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant’s trademark”.

Therefore, the Respondent is using the disputed domain name to intentionally attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship,

affiliation or endorsement of the website. Indeed, this conduct additionally confirms that the Respondent has used the disputed domain name in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

The Complainant has established the fact that it has valid rights for the international trademark No. 310459 for PHILIPS registered on March 16, 1966 and other trademarks. The disputed domain name has been registered on April 3, 2020, i.e. more than 50 years after the trademark registration.

There are no doubts that the Complainant's trademarks "PHILIPS" are well-known worldwide as confirmed by the previous panels (e.g. WIPO Case No. D2010-1494).

The first part of the disputed domain name (PHILIPS) fully corresponds to the Complainant's trademark.

The second part of the disputed domain name (PULSEOXIMETERS) is a descriptive term referring to the personal medical equipment (a pulse oximeter is a medical device that indirectly monitors the oxygen saturation of a patient's blood and changes in blood volume in the skin). The addition of this descriptive term "PULSEOXIMETERS" does not change the overall impression of the designation as being connected to the Complainant and its trademark and more likely strengthens the likelihood of confusion between the disputed domain name and Complainant's trademark as the pulse oximeters (or similar products) are part of the Complainant's products portfolio.

Furthermore, the addition of the generic top level domain ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark.

Moreover, it has been proved, that the Respondent used term PHILIPS on the website associated to the disputed domain name and thus explicitly connected the disputed domain name to the Complainant.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant's trademark "PHILIPS" in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not filed any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term "PHILIPS" or "PHILIPSPULSEOXIMETERS" or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. There is also no evidence, that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Moreover, the disputed domain name resolved to a web page with the commercial offering of medical equipment that could be connected with the Complainant but that is not produced nor marketed by the Complainant. Even if the products offered on the Respondent's website are connected to the Respondent, there is no disclosure of the Respondent's relationship with

the trademark holder as required according the Oki Data test (Section 2.8 of the WIPO Overview 3.0) and the Complainant's trademark "PHILIPS" is used on the website.

The Panel therefore considers that 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The Respondent has registered the disputed domain name which consists the full content of the Complainant's trademark "PHILIPS" and generic term "PULSEOXIMETERS" that refers to the type of the medical equipment produced by the Complainant. There are no doubts that the Complainant's trademark is distinctive, famous and is well-known worldwide for tens of years as proved by the Complainant. It could be therefore concluded that the Respondent had or should have the Complainant and its trademark in mind when registering the disputed domain name.

Furthermore, the disputed domain name redirects to a website with the commercial offer of the medical equipment including the "pulse oximeters", i.e. the equipment that could be connected with the Complainant by the internet users. Besides that, the Complainant's trademark "PHILIPS" is used on the website without any disclosure of the Respondent's relationships with the Complainant. Therefore, the disputed domain name has been used to attract the internet users to such website for commercial gain by creating a likelihood of confusion with the Complainant's trademark (paragraph 4(b)(iv) of the Policy).

Considering the (i) similarity between the Complainant's trademark and the disputed domain name, (ii) use of the disputed domain name for the commercial gain, (iii) distinctiveness of the Complainant's trademark and (iv) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Thus 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

Paragraph 11 of the Rules provides that: "(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case. (WIPO Case No. DCC2006-0004).

The Panel found in CAC Case no. 102911 that the following should be taken into consideration upon deciding on the language of the proceeding: (i) domain name consists of Latin letters, rather than Chinese letters; (ii) when the Panel accessed the disputed domain names, the pages that the disputed domain names resolved to offer their respective domain names for sale in the English language; (iii) the Complainant may be unduly disadvantaged by having to conduct the proceeding in the Chinese language; and (iv) the Respondent did not object to the Complainant's request that English be the language of the proceeding. Upon considering the above, the Panel determined that English be the language of the proceeding.

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.5.1, states: "panels have found that certain scenarios may warrant proceeding in a language other than that of the registration

agreement. Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant's mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement."

The language of the Registration Agreement for disputed domain name is Chinese. The Complainant requested that the language of the proceeding be English. The Respondent did not respond to the Complainant's language request. The content of the website accessible through the disputed domain name was completely in English language prior the commencement of the dispute. It is evident, that the disputed domain name (through the associated website) was targeted to the English speaking visitors as the products offered on the website were described in English. It is therefore evident, that the Respondent is capable to communicate in English and it would be inappropriate to order the Complainant to translate the Complaint to Chinese. Upon considering the above mentioned, the Panel determines English to be the language of the proceeding.

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 Panel considers that the Complainant has shown that the disputed domain name <philipspulseoximeters.com> is confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PHILIPSPULSEOXIMETERS.COM**: Transferred

PANELLISTS

Name	**JUDr. Petr Hostaš**

DATE OF PANEL DECISION 2020-07-14

Publish the Decision