

Decision for dispute CAC-UDRP-103085

Case number	CAC-UDRP-103085
-------------	-----------------

Time of filing	2020-08-14 08:55:21
----------------	---------------------

Domain names	pandora-braslet.com
--------------	---------------------

Case administrator

Name	Olga Dvořáková (Case admin)
------	-----------------------------

Complainant

Organization	Pandora A/S
--------------	-------------

Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.
--------------	--

Respondent

Organization	Protection of Private Person
--------------	------------------------------

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on the following trademarks:

- "PANDORA" (word) EU trademark No.003397858, registered on April 18, 2007;
- "PANDORA" (word) EU trademark No.000653519, registered on April 17, 2000;
- "PANDORA" (word) international trademark No.1004640, registered on May 14, 2009 and
- "PANDORA" (word and device) international trademark No. 979859, registered on September 17, 2008.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is a company incorporated in Denmark. It designs, manufactures and markets hand-finished and

contemporary jewellery. The Complainant states that its products have been marketed and sold under the “Pandora” name in more than 100 countries and through more than 7,700 points of sale, total revenue in the 2019 annual report was approximately 2.9 billion Euros and as a result its PANDORA mark enjoys a high degree of global recognition for jewellery, and can be considered a famous mark.

The Complaint refers to its “PANDORA” trademarks listed above and mentions that it registered various domain names incorporating the “PANDORA” mark such as <pandora.net>.

The Complainant contends that the disputed domain name incorporates the PANDORA mark in its entirety. The addition of the word ‘braslet’ (“bracelet” in Russian) does not change the perception of the disputed domain name as this additional word is a generic / descriptive term for one of the kinds of jewellery sold by the Complainant.

The Complainant’s mark is recognizable within the disputed domain name and the .com suffix shall be disregarded.

Therefore, the disputed domain name is confusingly similar with the trademark of the Complainant.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant highlights that it had not authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the PANDORA trademark.

The Complainant has prior rights in the PANDORA trademark which precede the Respondent’s registration of the disputed domain name.

The Complainant contends that the Respondent’s use of the disputed domain name in these circumstances does not amount to legitimate use of the Complainant’s trademark for the resale of the Complainant’s goods, nor does it give rise to any other rights or legitimate interests on the part of the Respondent in respect of the disputed domain name.

The Respondent has registered and used the disputed domain name for the purpose passing itself off as being (connected with) the Complainant by prominently featuring the Complainant’s PANDORA mark and the logo at the top of every page in connection with the sale of jewellery.

The Respondent also placed copyright logo on the website by the disputed domain name as follows: “2020 © Pandora-Braslet.com” (in the footer).

The Complainant alleges that the Respondent attempts to imitate/pass-off itself as the Complainant to mislead customers.

The Complainant had also done a test purchase of products sold via the website by the disputed domain name and provided a respective report indicating that the goods sold via the website under the “PANDORA” mark are fake and imitation of Complainant’s original products.

The Complainant refers to some earlier UDRP cases and WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) and states that use of the disputed domain name for illegal activity can never confer rights or legitimate interests.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant claims that the disputed domain name is registered and used for the purpose of disruption of Complainant’s business and by using disputed the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to their website 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 Respondent’s website or location or of a product or service on their website or location.

The Complainant emphasizes the following:

- The Complainant’s PANDORA trademark and brand are known internationally and it has marketed its goods and services under the PANDORA visual mark (with the crown above the letter “O”) since 2008, several years before the Respondent’s

registration of the disputed domain name.

- Respondent's purpose in registering the disputed domain name which incorporates Complainant's PANDORA mark in its entirety is to capitalize on the reputation of Complainant's mark by diverting Internet users seeking jewellery products of the Complainant to Respondent's own website where consumers may purchase counterfeit goods offered and sold under the PANDORA mark.

- The Respondent has used the disputed domain name for a website which uses the Complainant's trademark to sell counterfeit versions of the Complainant's products. It would defy common sense to believe that the Respondent coincidentally selected the disputed domain name without knowledge of the Complainant's trademark. The Respondent must have registered the disputed domain name with the knowledge about the Complainant's trademark PANDORA and with the intention of taking unfair advantage of the Complainant's goodwill in that mark.

The Complainant refers to UDRP cases confirming that the use of a domain name for illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith.

The Complainant also supports its claims by relying on WIPO Overview 3.0 and lists the following factors demonstrating bad faith:

- The nature of the disputed domain name;
- The content of the website;
- A clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name and the use of privacy services to register the disputed domain name.

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.

The registrar of the disputed domain name is Reg.ru from Russia and it is not clear which is the language of the registration agreement (it can be either Russian or English as Reg.ru has an English language website – www.reg.com and also has an English language version of the registration agreement). The registrar in its communication to the Czech Arbitration Court (CAC) stated that the language of the registration agreement is Russian.

The Complainant requests that English be adopted as the language of the proceeding.

The Panel agrees with the Complainant, taking into account that the disputed domain name is in the .com zone, the registrar has a registration agreement in both Russian and English languages and the English language version of its website, the fact that Respondent has been given a fair chance to object but has not done so and considering previous UDRP decisions (e.g. CAC Case No.103140 and Orlane S.A. v. Yu Zhou He / He Yu Zhou, WIPO Case No. D2016-1763) and Goodwill Industries International, Inc. v. Protection of Private Person REG.RU Protection Service / Denis Denisov, WIPO Case No. D2017-1085).

It is the Panel's obligation to ensure that the administrative proceeding takes place with due expedition under paragraph 10 (a) of the UDRP Rules and in the Panel's opinion it would be fair to have English as the language of this proceeding.

The Panel also needs to address the issue of Respondent's identity and who shall be the Respondent in this dispute. The registrar in its communication to CAC stated that the registrant of the disputed domain name is: Mykola Rybchenko; address: 69000, Ukraine, Zaporozhye, Belinskogo 92.

The Complainant claims that these contact details are fictitious and, therefore, "Protection of Private Person (REG.RU Protection Service)" should still be considered as the Respondent.

The Complainant claims that it was the WHOIS listed registrant when the Complaint was filed and the Complainant can amend the complaint after the Registrar Verification mechanism to include a Registrant who should be listed as the Respondent in case the WHOIS data was either incorrect, incomplete, or redacted for GDPR purposes, but it is certainly not obligated to do so when the WHOIS data is complete and correct but points to a Privacy Service (even a service offered by the registrar themselves).

The Panel notes that "Protection of Private Person (REG.RU Protection Service)" is still indicated as the registrant of the disputed domain name in the publicly available whois database on the date of this decision.

The Panel believes that for the purpose of this particular dispute and for the reasons described below it is not material whether the Respondent is "Protection of Private Person (REG.RU Protection Service)" or Mykola Rybchenko as claimed by the registrar. There was no reaction from the alleged "real" registrant of the disputed domain name to all the notices and communication sent to him and it is indeed unclear whether his contact details are genuine or false.

The Panel also notes previous panels' position in similar cases and that in the past Complainant's request was often supported (see e.g. CAC Case No. 100985; RapidShare AG, Christian Schmid v. PrivacyAnywhere Software, LLC, Mikhail Berdnikov, WIPO Case No D2010-0894 and CAC case No. 100221).

The Panel also takes into account the fact that "Protection of Private Person (REG.RU Protection Service)" was already named as a respondent in a number of UDRP proceedings, see Facebook Inc. v. Protection of Private Person, REG.RU Protection Service / Nikita Sakhnenko, WIPO Case No. D2019-0870 and A Medium Corporation v. Protection of Private Person, REG.RU Protection Service/Ivan Ivanov, WIPO Case No. D2018-2382.

The Panel agrees with the Complainant that "Protection of Private Person (REG.RU Protection Service)" shall be the Respondent in this dispute however the Panel also decides to add Mykola Rybchenko as the second Respondent to this dispute for the sake of completeness, see CAC Case No. 100998.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar with Complainant's trademark

The Complainant is the owner of numerous "PANDORA" trademark registrations.

As confirmed by WIPO Overview 3.0, paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name fully incorporates the "PANDORA" mark of the Complainant coupled with the word "braslet"

("bracelet" in Russian). This word can be considered descriptive of Complainant's goods.

It is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity under the first element (see par. 1.8 of WIPO Overview 3.0).

The Panel notes that the addition of the word "braslet" does not change overall impression and does not eliminate the confusing similarity between the disputed domain name and the Complainant's "PANDORA" trademarks.

The trademark is clearly recognizable in the disputed domain name.

The gTLD suffix ".com" is to be disregarded under the confusing similarity test.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

- (i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
- (ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see *Julian Barnes v. Old Barn Studios*, WIPO Case No. D2001-0121; *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110 and *CAC Case No. 101284*.

The Complainant states that the Respondent had not been authorised, licensed, or permitted to register or use the disputed domain name or to use the PANDORA trademark.

The Complainant also claims and provides proof that the disputed domain name is used to sell fake goods under the Complainant's "PANDORA" mark.

The disputed domain name was registered on December 8, 2015. According to the registrar's communication the second Respondent has been the registrant of the disputed domain name since 2018-04-05.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and *Vertical Solutions Management, Inc. v. webnet-marketing, inc.*, FA 95095, National Arbitration Forum).

To reach the right decision, a panel is allowed to undertake limited factual research into matters of public record if it deems this necessary.

Under paragraph 10(a) of the Rules the Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and the Rules and the Panel shall be able to independently visit the Internet in order to obtain additional light in a default proceeding (see *Société des Produits Nestlé SA v. Telmex Management Services*, WIPO Case No. D2002-0070; *InfoSpace.com, Inc. v. Hari Prakash*, WIPO Case No. D2000-0076).

The Panel notes that the website by the disputed domain name on the date of the decision appears to be an on-line shop selling "PANDORA" jewellery in Ukraine. Moreover, the website claims to be "Official Pandora Braslet" site and indeed contains a copyright notice as follows: 2020 © PBraslet.com.

The website has some contact information such as address in Kyiv, phone numbers in Ukraine and email address.

Complainant's logo (part of one of its "PANDORA" marks) is used on the website and this increases possible confusion between the website and the Complainant.

UDRP panels allowed under certain circumstances nominative fair use of a trademark in a domain name by resellers or distributors (even extending it to unauthorized resellers/distributors) – "the Oki data test" (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO case No. D2001-0903), however the Panel finds that this is not the case here.

Use of Complainant's logo, claims that the website is "official" in the absence of Complainant's authorization, an attempt of false impersonation of the Complainant by the Respondent and evidence provided by the Complainant that the goods sold via the website are not genuine, negate any potential justification (especially in the absence of any response and explanations of the Respondent).

The Panel also notes that the use of a domain name for illegal activity (e.g. the sale of counterfeit goods) can never confer rights or legitimate interests on a respondent (see par. 2.13.1 of the WIPO Overview 3.0 and see also *Pandora A/S v. Linda White*, WIPO Case No. D2019-0130 – "there is no right or legitimate interest in holding a domain name for such a purpose"). The Complainant has made out a prima facie case.

The Panel, therefore, finds that the Complainant satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith. These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

A range of considerations apply in assessing Respondent's bad faith, i.e. the nature of the domain name, the content of any website to which the domain name directs, a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or other indicia generally suggesting that the respondent had somehow targeted the Complainant (see par. 3.2.1 of the WIPO Overview 3.0).

The Panel finds that at least one element described in paragraph 4(b) of the Policy is present here, namely 4(b) (iv) and by using the domain name the Respondent is attempting to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the affiliation or endorsement of the Respondent's website.

Factors finding in favor of this conclusion are inter alia similarity between the Complainant's official website and the website by the disputed domain name (in particular, use of Complainant's logo by the Respondent) as well as the content of the website and activities conducted by the Respondent via the website, namely sale of goods similar with the goods for which the Complainant's "PANDORA" mark is protected, provided proof of sale of fake goods under the "PANDORA" marks and a clear attempt to imitate and copy Complainant's business.

The use of the word "Official" on the Respondent's website is also misleading and confuses consumers. The disputed domain name is used to sell goods that are supposedly goods of the Complainant but appear to be fake as proved by the Complainant and not rebutted by the Respondent.

As confirmed by WIPO Overview 3.0 "given that the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith".

The Panel also notes that there are previous UDRP decisions regarding Complainant's "PANDORA" marks with similar facts and circumstances, namely use of the mark in domain names for sale of fake/non-original goods, i.e. *Pandora A/S v. Yan Li*, WIPO Case No. D2019-1273; *Pandora A/S v. Linda White*, WIPO Case No. D2019-0130 – "the Panel is prepared to infer from

the use made of the domain name, and in the absence of any argument or evidence to the contrary, that the domain name was either registered or acquired by the Respondent for the purpose of impersonating the Complainant with a view to the sale of counterfeit products. That is sufficient for a finding of bad faith registration” and Pandora A/S v. Domain Admin, Privacy Protect LLC (PrivacyProtect.org) / Robin Puckett, WIPO Case No. D2018-0586 – “the Respondent must have deliberately chosen and used the confusingly similar disputed domain name primarily to ride upon and take unfair advantage of the Complainant's reputation and goodwill by intentionally attempting to attract for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademark. As such, this would constitute bad faith registration and use.”

The Panel holds that the third element of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **PANDORA-BRASLET.COM:** Transferred

PANELLISTS

Name	Igor Motsnyi
------	--------------

DATE OF PANEL DECISION 2020-09-20

Publish the Decision