Decision for dispute CAC-UDRP-103278

Case number	CAC-UDRP-103278
Time of filing	2020-09-17 15:52:32
Domain names	pepsicog.com, pepsicogd.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	PepsiCo, Inc.

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Name	Terry Khan

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 names.

IDENTIFICATION OF RIGHTS

The Complainant claims ownership of over 900 active trademark registrations for PEPSI-variant marks including the following:

- PEPSI, United States of America Trademark Registration No. 824,150, dated February 14, 1967, in Class 32;

- PEPSICO (& DESIGN), United States of America Trademark Registration No. 3026568, dated December 13, 2005, Classes 16, 18, and 25;

- PEPSICO, Mexico Trademark Registration No. 950496, dated August 29, 2006, in Class 32;

- PEPSICO (& Design), European Union Trademark Registration No. 013357637, dated March 13, 2015, Classes 16, 29, 30, 32, 35, 36, and 41;

FACTUAL BACKGROUND

COMPLAINANT:

The Complainant is one of the world's most iconic and recognized consumer brands globally. It was founded in 1898 and has become a leading supplier of food and beverage products, including its flagship PEPSI soft drinks which were created in 1911. Products produced by the Complainant are enjoyed by consumers more than one billion times a day in more than 200 countries and territories around the world. The Complainant also owns numerous registrations for its PEPSI and PEPSICO trademarks, both in standard characters as well as with design elements covering a variety of food and beverage products as well as related goods. Widespread recognition and numerous awards and honors have been enjoyed and bestowed upon the Complainant.

The disputed domain name <pepsicogd.com> was created on October 30, 2019 and the domain name <pepsicog.com> was created on August 10, 2020. Neither of these domain names resolve to any website content. However, a phishing email was sent to one of the Complainant's suppliers using an address that incorporates the <pepsicog.com> domain name.

RESPONDENT:

The Respondent has not filed a response or made any other submission in this case.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of the disputed domain names 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 names (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 names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

Multiple Respondents

The Whois records for the two disputed domain names identify different registrant names. However, the Complainant names these two registrants as the Respondents in this proceeding and requests that the domain names and the named Respondents be consolidated in a single UDRP proceeding.

Paragraph 4(f) of the Policy provides that "[i]n the event of multiple disputes between [a respondent] and a complainant, either [the respondent] or the complainant may petition to consolidate the disputes before a single Administrative Panel…." This is allowed where it "promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, reduces the potential for conflicting or inconsistent results arising from multiple proceedings, and generally furthers the fundamental objectives of the Policy." See, e.g., MLB Advanced Media, The Phillies, Padres LP v. OreNet, Inc., D2009-0985 (WIPO Sep. 28, 2009). Further, paragraph 3(c) of the Rules provides that "[t]he complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder." UDRP Panels have looked to a variety of factors in determining whether multiple domain names are, in fact, of common ownership. WIPO Overview 3.0 at par. 4.11.2. Such factors as similarities in the Whois information and similar naming conventions in the disputed domain names, etc. may lead to the conclusion that domain names with some differing registrant names are,

nevertheless, owned by a single entity. See, e.g., Delta Dental Plans Association v. ICS INC., et al., D2014-0474 (WIPO June 16, 2014) (Consolidation of 31 domains allowed where "[t]he Panel notes that each of the disputed domain names follows an identical naming convention, namely (DELTA DENTAL marks+ of + state name or two-letter state abbreviation); ("while the names of the registrants of the Domain Names are different", consolidation allowed where "[t]he Domain Names have a 'quasi identical structure'" and "[b]oth registrants email addresses include the term 'gamester' before the '@' symbol.").

In the present case, the Registrant of the <pepsicogd.com> domain name is listed as Terry Khan, and the registrant of the <pepsicog.com> domain name is listed as Rene Lammers. However, the Whois records for both of the disputed domain names identify nearly identical email addresses for their Registrants and list the Complainant's own corporate name and business address in the relevant fields. Further, both of the disputed domain names use a similar naming pattern of adding one or two letters to the Complainant's PEPSICO trademark. In view of these similarities between the disputed domain names the Panel finds it highly likely that both of them are owned by the same person. Thus, by a preponderance of the evidence presented, the Panel finds sufficient grounds to conclude that it would be equitable and procedurally efficient to permit the consolidation of the two disputed domain names into this single case.

The Panel is satisfied that all other 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

A. Each of the disputed domain names is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrates its ownership of trademark rights and that the disputed domain names are confusingly similar to such trademark. Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant, 103255 (CAC Sep. 30, 2020) ("it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).").

The Complainant has submitted screenshots from the websites of various national trademark authorities as evidence that it owns rights to its asserted trademarks. The disputed domain names, which were each registered long subsequent to the existence of the Complainant's trademark rights, reproduce Complainant's trademarks in their entirety and merely add the letters "g" or "gd" as a suffix, as well as the ".com" TLD. Thus, the Complainant asserts that the second level of each of the disputed domain names is confusingly similar to the asserted trademarks and will lead internet users to wrongly believe that the disputed domain names are endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. Boursorama SA v. Rosaura Sagese, 103186 (CAC Sep. 2, 2020) ("The disputed domain name is almost identical to the trademark BOURSORAMA of the Complainant since the only difference are the additional two letters 'fr' at the end being an indication for 'France' and accordingly not distinctive.").

Also, the extension ".com" typically adds no meaning to the second level of a disputed domain name and may be disregarded in the paragraph 4(a)(i) analysis. Accor v. Whois Agent, Domain Protection Services, Inc. / Nguyen Trong Hoa, Home, D2020-1969 (WIPO Oct. 4, 2020) ("the Panel finds, similarly to other UDRP panels, that the addition of the TLD '.com' to the Disputed Domain Name does not constitute an element as to avoid confusing similarity for the Policy purposes.").

Accordingly, the Panel finds that the Complainant has rights to its claimed trademarks and that the additions made thereto in the disputed domain names are insufficient to avoid a finding that they are identical or confusingly similar to the Complainant's trademarks. Thus, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain names

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in a domain name. Cephalon, Inc. v. RiskIQ, Inc., 100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests

in the domain name.

Paragraph 4(c) of the Policy offers respondents several examples of how to demonstrate their rights or legitimate interests to a domain name.

With reference to Paragraph 4(c)(ii) of the Policy the Complaint states that the Respondent has not received any license or authorization to use the Complainant´s trademarks. The Respondent has not participated in this case and so it does not contest this. As such, the Panel concludes that the Respondent is not affiliated with the Complainant, nor is it authorized or licensed to use the Complainant's trademark or to seek registration of any domain name incorporating the aforementioned trademarks. Furthermore, the Whois records for the disputed domain names identify the Registrant as either Terry Khan or Rene Lammers. There is no evidence that the Respondent is known otherwise (any mention of the Complainant's company name in the Whois records may be disregarded as fraudulent). Based upon the available evidence in this case, the Panel cannot conclude that the Respondent is commonly known by the disputed domain name or that it has any rights to the Complainant's trademark.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain names. Attempting to pass oneself off as a Complainant in emails to phish for confidential information is not considered a bona fide offering of goods or services under paragraph 4(c)(i) or (iii) of the Policy. See Emerson Electric Co. v. Adilcon Rocha, FA 1735949 (FORUM July 11, 2017) (finding that the Respondent's attempt to pass itself off as the Complainant through emails does not constitute a bona fide offering of goods or services and, as such, the Respondent lacked rights or legitimate interests in the disputed domain name). The disputed domain names do not resolve to any website content. However, the Complainant has provided a copy of an email sent from the address procurement@pepsicog.com that seeks "bulk pricing for these Raw Materials below" from one of the Complainant's suppliers. This was sufficiently suspicious as to cause the supplier to bring the email to the Complainant's attention and inquire if it is a legitimate inquiry. The Complainant also notes the use of false alias names and the listing of the Complainant's own corporate name and business address in the Whois records for the disputed domain names. For its part, Respondent has filed no Reply or made any other submission in this case to explain its actions or otherwise refute Complainant's claims. Therefore, based upon a preponderance of the available evidence, the Panel finds that the Respondent does not use the <pepsicog.com> domain name for any bona fide offering of goods or services under Policy paragraphs 4(c)(i) or (iii).

As for the <pepsicogd.com> domain name, the Complainant points out that this domain name was suspended by the concerned Registrar. Apparently, the Complainant was not able to gather evidence showing misuse of this domain name for phishing emails. Nevertheless, it is noted that this domain name does not resolve to any website content. Resolving a disputed domain name to an error page or to no content at all is not a bona fide use thereof. See Kohler Co. v xi long chen, FA 1737910 (FORUM Aug. 4, 2017) (where the disputed domain name resolves to an inactive webpage displaying the message "website coming soon!" the Panel held that the "Respondent has not made a bona fide offering of goods or services, or a legitimate non-commercial or fair use of the domain.") In light of the non-resolution of the confusingly similar <pepsicogd.com> domain name for nearly one year the Panel finds that the Respondent has not demonstrated any rights or legitimate interests therein under Policy paragraphs 4(c)(i) or (iii).

For all of the above-stated reasons, this Panel finds, by a preponderance of the evidence, that the Complainant has made a prima facie showing under Paragraph 4(a)(ii) of the Policy and that the Respondent has not refuted this to show that it has any rights or legitimate interests in the disputed domain names.

C. The disputed domain names were registered and are being used in bad faith

The Complainant argues that the Respondent registered the disputed domain names in bad faith, as it had actual knowledge of the Complainant's rights in its asserted trademarks when it registered the disputed domain names. Actual knowledge of rights in a trademark at the time of registering a disputed domain name is generally sufficient as a foundation upon which to build a case for bad faith under Policy paragraph 4(a)(iii), and can be demonstrated through such actions as a respondent's

use of a well-known mark in its disputed domain names to send phishing emails to business partners of a Complainant. See AutoZone Parts, Inc. v. Ken Belden, FA 1815011 (FORUM Dec. 24, 2018) (the "Complainant contends that Respondent's knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii).") See also Spectrum Brands, Inc. v. Guo Li Bo, FA 1760233 (FORUM January 5, 2018) ("[T]he fact Respondent registered a domain name that looked identical to the SPECTRUM BRANDS mark and used that as an email address to pass itself off as Complainant shows that Respondent knew of Complainant and its trademark rights at the time of registration.") The Complainant argues that in light of the notoriety and global fame of its trademarks, along with the Respondent's use of one of the disputed domain names to send a fraudulent email to the Complainant's own supplier, the Respondent must have registered the disputed domain names with actual knowledge of the Complainant's trademark rights. The Complainant submits into evidence documents showing that its flagship trademark is ranked at No. 22 on the Interbrand Best Global Brands 2019 and 2017 and that it is ranked at No. 30 on Forbes magazine's list of the World's Most Valuable Brands for 2017. It also submits a copy of the Respondent's phishing email which uses the address procurement@pepsicog.com. In light of this evidence, the Panel finds that the Respondent registered the disputed domain names with actual knowledge of the Complainant's trademarks.

Next, the Complainant argues that the Respondent registered and uses the disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy. Although it does not specify any of the examples set out in paragraph 4(b), its claims seem to fit best within paragraphs 4(b)(iii) and (iv) involving disruption of the Complainant's business and the pursuit of commercial gain based upon a likelihood of confusion with its trademarks. Using disputed domain names to pass oneself off as a Complainant in emails attempting to further a phishing scheme is generally considered bad faith disruption as well as the seeking of commercial gain based on trademark confusion under paragraphs 4(b)(iii) and (iv) of the Policy. See Chevron Intellectual Property, LLC v. Jack Brooks, FA 1635967 (FORUM Oct. 6, 2015) (finding that Respondent's use of <chevron-corps.com> to impersonate an executive of the Complainant in emails is in opposition to the Complainant and is therefore in bad faith under Policy ¶ 4(b)(iii)); See also Qatalyst Partners LP v. Devimore, FA 1393436 (FORUM July 13, 2011) (finding that using the disputed domain name as an e-mail address to pass itself off as the Complainant in a phishing scheme is evidence of bad faith registration and use). As noted above, the Complainant provides a copy of an email sent from an address that impersonates the Complainant and attempts to establish a relationship with one of the Complainant's suppliers by requesting a price quote for certain items. Therefore, the Panel finds, with respect to the <pepsicogd.com> domain name, that the Respondent has sought to disrupt the business of the Complainant and has sought commercial gain by creating a likelihood of confusion with the Complainant's trademarks as to the source of its phishing email under paragraphs 4(b)(iii) and (iv) of the Policy.

As for the <pepsicogd.com> domain name, the failure to actively use a disputed domain name can be evidence of bad faith registration and use pursuant to paragraph 4(a)(iii) of the Policy. See Dermtek Pharmaceuticals Ltd. v. Sang Im / Private Registration, FA 1522801 (FORUM Nov. 19, 2013) (holding that because the respondent's website contained no content related to the domain name and instead generated the error message "Error 400- Bad Request," the respondent had registered and used the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy). As there is no evidence that the <pepsicogd.com> domain name has resolved to any website content since its registration nearly one year ago, the Panel finds that the Respondent registered and uses this disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Next, the Complainant argues that the "the mere registration of a domain name incorporating a typo of a famous or widely-known trademark by an unaffiliated entity creates a presumption of bad faith…" Section 3.1.4 of the WIPO Overview 3.0 states that "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". Also see Vivendi v. Stott.Inc, 103286 (CAC Oct. 20, 2020) (disputed domain name vivendiusa.com presumed to have been registered in bad faith based upon the fame of the Complainant's VIVENDI trademark). Of course, presumptions may be rebutted but the Respondent has not filed a Response or made any other submission in the present case. As such, this presumption stands and further supports the conclusion that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy.

Finally, the Complainant asserts that, despite the lack of any websites that resolve from the disputed domain names, "in this case, merely configuring mail servers on a domain name evidences that the domain name is being used for the generation of custom email accounts, and that bad faith regarding the use of a domain name can be found in relation to uses other than websites, such as where a Respondent uses a domain name to send deceptive emails…" Prior decisions have inferred an intent to use disputed domain names for the sending of email based upon the creation of associated MX records. In The Standard Bank of South Africa Limited v. N/A / mark gersper, FA 1467014 (FORUM Dec. 5, 2012), the Panel noted that the "Complainant contends this phishing could be carried out via email and not just through a website. Complainant has examined the domain name's MX records and they apparently allow the transmission of email, which would not be necessary if the domain name was merely parked. The Panel finds Complainant's allegations about the possibility of Respondent using the disputed domain name for phishing sufficient…" This inference has been adopted in other decisions. See, e.g., Pepsico, Inc. v. Allen Othman, 102380 (CAC Apr. 25, 2019) ("The Complainant submits, fairly, that the preparatory steps in relation to email addresses could enable the inappropriate sending or receipt of email communications purporting to emanate from, or intending to be received by, the Complainant. These preparatory steps (configuring 'MX' or mail exchange records) have considered in relation to 'use' for the purposes of the Policy by other Panels, which the present Panel has considered of its own motion.") In the present case, the Complainant submits screenshots showing that MX records have been created for both of the disputed domain names thus indicating that they may be used for the sending and receiving of email. While, in the abstract, the creation of such records does not indicate any ill intent, in the circumstances of the present case where a phishing email has been sent by the Respondent these MX records do require some further explanation which the Respondent has not provided. As such, the Panel finds that the existence of MX records for the disputed domain names further supports the conclusion that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PEPSICOG.COM**: Transferred
2. **PEPSICOGD.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2020-10-20

Publish the Decision