Decision for dispute CAC-UDRP-103276

Case number	CAC-UDRP-103276
Time of filing	2020-09-11 10:16:36
Domain names	IKEACASA.COM

Case administrator

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

Complainant

Organization	Inter IKEA Systems B.V.

Complainant representative

Organization	Convey srl

Respondent

Name	Lorenzo Scalzone

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

The Complainant has proven to be the owner of the IKEA trademark, which enjoys protection through numerous registrations worldwide.

The Complainant is, inter alia, the owner of:

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

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

- European Union Trademark Registration n. 000109652 registered on 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 registered on 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 registered on April 24, 2007 in class 16, 20, 35, 43 designating also China;

- Italian Trademark Registration no. 0001257211 registered on March 12, 2010, renewal of registration no. 0000877315 filed on March 4, 1999 in class 20;

- Italian Trademark Registration no. 0001300174 registered on June 3, 2010, renewal of registration no. 546978 filed on June 14, 1991 in class 21.

The Complainant is also the owner of hundreds of domain names, including the following domain names bearing the signs <IKEA": <ikea.com>, <ikea.net>, <ikea.us>, <ikea.cn>, <ikea.de>, <ikea.it> and <ikea.co.uk>.

FACTUAL BACKGROUND

The Complainant is the worldwide IKEA franchisor and responsible for developing and supplying the global IKEA range.

IKEA is one of the most well-known home furnishing brands in the world.

According to Best Global Brands of Interbrand, in 2019 the brand IKEA was ranked in the twenty-sixth position.

The IKEA web site www.ikea.com was launched in 1997.

The disputed domain name <ikeacasa.com> was registered on April 25, 2009.

The corresponding website "www.ikeacasa.com", is currently used to offer a vast range of products and services from antiques, art and automotive parts to toys, travel and bicycle. Amongst them many competing with the Complainant's goods.

The Complainant's trademark registrations predate the registration of the disputed domain name.

The Respondent is of Italian origin and resides in Switzerland.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims that the disputed domain name is confusingly similar to the Complainant's registered trademark; that the Respondent has no rights or legitimate interests whatsoever with respect to the disputed domain name; and that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant's claims for each point are here below reported:

(1) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The disputed domain name <ikeacasa.com> reproduces the Complainant's IKEA trademark in its entirety with the addition of the Italian word "casa", thus the disputed domain name is undoubtedly confusingly similar to the trademark IKEA in which the Complainant has rights. The addition of the Italian word "casa" (meaning "house" or "home") following the IKEA trademark does not reduce the high degree of similarity between the disputed domain name and the Complainant's trademark. The Complainant's IKEA trademark is inherently distinctive and the addition of the generic term "casa" does not negate the confusing similarity between the mark and the disputed domain name, as that term is closely linked to and associated with the Complainant's trademark. In fact, it only serves to underscore and increase the confusing similarity,

because the word “casa” aptly describes the business carried on by the Complainant.

The Complainant concludes that the disputed domain name is confusingly similar to the prior registered trademark in which the Complainant has rights in satisfaction of paragraph 4(a)(i) of the Policy.

(2) The Respondent has no rights or legitimate interests in respect of the disputed domain name

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’s nor has it ever been authorized by the Complainant to use the IKEA trademark in the disputed domain name. The Complainant is not in possession of, or 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, a business, or another organization. IKEA is neither a generic term, nor descriptive, and it is not a dictionary word; rather, it is an inherently distinctive trademark which refers solely to the Complainant. There has been no evidence to show that the Respondent has any registered trademark rights with respect to the disputed domain name.

The Respondent registered the disputed domain name on April 25, 2009, many years after the IKEA trademark became widely known.

The fact that the disputed domain name comprises a combination of the Complainant’s famed and distinctive trademark and the description of its business activity leads to the compelling conclusion that the Respondent was well aware of the Complainant and its rights in the IKEA trademark when adopting the disputed domain name. Subsequent use of the disputed domain name to direct to an online site offering goods and services in direct competition with those of the Complainant cannot constitute a use of the disputed domain name in the bona fide offering of goods or services.

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 was served.

Considering that prima facie no relationship has ever been established between the parties and no lawful connection to the IKEA name appears from the records, 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 IKEA name.

For all of the foregoing reasons, the Complainant 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.

(3) The Respondent registered and uses the disputed domain name in bad faith

The disputed domain name was registered in April 2009, many years after the Complainant obtained its trademark registrations.

Owing to its extensive worldwide use, the Complainant’s IKEA trademark has become a well-known trademark, as also indicated in several UDRP decisions. Quoting previous UDRP decisions, the Complainant asserts that it is inconceivable that the Respondent could have chosen the disputed domain name by coincidence, without knowledge of the Complainant’s marks, as it encapsulates the distinctive IKEA mark.

Moreover, as indicated in many decisions, registering a well-known trademark is deemed bad faith registration considering that the Respondent knew or should have known that its registration would be identical to the Complainant’s mark.

Currently, the disputed domain name redirects to a website displaying an e-store selling third-party trademarked products. This circumstance cannot be deemed a good faith use because the Respondent receives profits by offering for sale items bearing third-party trademarks while exploiting a domain name incorporating the well-known IKEA trademark in the domain name itself.

The Respondent’s use of the disputed domain name creates a likelihood of confusion as to the affiliation of its website for the purposes of confusing consumers and diverting customers to its own website where it offers for sale household products, home furnishing products and accessories in direct competition with the Complainant.

The Respondent is aware of the existence of the trademark IKEA and also of the INTER IKEA SYSTEMS B.V. company, and created its website to include the Complainant’s trademark in order to capitalize on the reputation and goodwill associated with the Complainant’s mark or otherwise mislead Internet users. Therefore, considering the high reputation of the IKEA trademark, the Complainant claims that such use amounts to bad faith.

Finally, since the IKEA trademark is an invented word, it is also unlikely that the disputed domain name, including that word, was chosen by the Respondent without having the Complainant’s trademark in mind. Rather, such trademark distinctiveness, together with the generic term "casa" (the Italian term for “house” or “home”) creates a domain name confusingly similar to the Complainant’s trademarks and it is the Complainant’s contention that the Respondent has exploited this similarity for its own commercial gain, in so doing inducing even more confusion among Internet users searching for the Complainant’s products for the home.

Therefore, the Respondent's purpose is clearly to capitalize on the reputation of the Complainant's trademark for financial gain by diverting Internet users seeking IKEA products to its own website, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites, according to paragraph 4(b)(iv) of the Policy.

In light of the above, the Complainant respectfully submits 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.

RESPONDENT:

Respondent contends that:

The Domain name is neither identical nor confusingly similar to the protected mark (i.e. IKEA) for the following reasons:

(Note: errors are in the original)

“Ike a casa” is a product name for building modules in wooden structure.

The name Ikeacasa is composed by 3 words, IKE A CASA and it is referred to the Hurricane "Ike". It means: Ike at home.

The name is: Ike a casa. Its reading pronunciation is consequent and it has nothing in common with the famous Ikea.

The logo ikeacasa, in order to avoid eventual confusion with the most famous ikea, is subdivided in 3 different colors, one color for each word making up the domain name

The homepage of ikeacasa.com clearly reports the reference to the hurricane

The products sold on the ikeacasa.com site are completely different in nature from those sold by ikea.com”.

The Respondent has rights and/or legitimate interest in the domain name because:

Ikeacasa is a name initially created for prefabricated wood-frame house modules.

The Respondent claims that the choice of this name came from a “crazy idea” that came to its staff while watching the effects of the hurricane Ike that left only one house standing. "That house, which looks like a wooden structure, remained intact, must have been the house of Hurricane IKE, where he returned after the disaster. As a result, Ike had returned home, so the name reads: Ike A Casa and not otherwise”.

The Respondent, who was in Italy and at the time of the events dealt in prefabricated wood-frame houses, created the name Ikeacasa simply by using the name of a hurricane and two words of its native language.

The Respondent further points out that “not coincidentally, to make a clear distinction between ikeacasa and ikea, and above all to show this difference to site visitors, thus avoiding possible confusion, the logo was created with 3 different colors, one color for each word making up the domain name”.

With regard to this section, the Panel notes that the Respondent has provided the Center with several documents and information regarding the IKE hurricane and the “Ike a casa” products, i.e. prefabricated wooden walls.

The Respondent contends that the disputed domain name has not been registered and used in bad faith for the following reasons:

Ikeacasa is a name initially created for prefabricated wood-frame house modules.

The Respondent, who was in Italy and at the time of the events dealt in prefabricated wood-frame houses, created the name Ikeacasa simply by using the name of a hurricane and two words of its native language.

The products sold on the ikeacasa.com site are completely different in nature from those sold by ikea.com.

The Respondent documents that it received its first communication regarding the disputed domain name on December 19, 2013, from CSC Digital Brand Services in the person of the lawyer Christian Elftorp, who sent the Respondent a "Notification of violation of Trademark rights", and asserts (without documenting same) that on January 8, 2014, with an email, Mr Elftorp concluded as follows: "We agree to reimburse your out of pocket expenses, but we will not buy the domain."

The Respondent thus affirms that: “The logical conclusion was that the IKEA company was not interested in the ikeacasa.com name”.

Finally, the Respondent claims that since 2012 it has been a reseller of domain names and all related services. In virtue of its capacity as a reseller, the Respondent requests that all the rules of sale of domain names of Godaddy.com be applicable.

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

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy lists three elements that Complainant must prove to merit a finding that the domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark (“mark”) in which the Complainant has rights; and

2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

3) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established that it has rights in the renowned IKEA registered trademark.

The disputed domain name <ikeacasa.com> reproduces the Complainant's IKEA trademark in its entirety with the addition of the word “casa”.

It is the Panel’s opinion that the Respondent’s claim that the disputed domain name, owing to the addition of the descriptive word “casa” (“house” or “home” in Italian) and the use of different colors for the logo ikeacasa, is neither identical nor similar to the IKEA registered trademark, has no substance. In fact, domain names are technically not allowed to be reproduced in colors, whereas the addition of the word “casa”, i.e. a generic and descriptive term referring to the main activity of the Complainant (furniture and goods for the home) is not sufficient to avoid confusing similarity.

Indeed, the Panel agrees with the Complainant’s assertion that the IKEA trademark is inherently distinctive and that the addition of the generic term “casa”, which is closely linked to and associated with the Complainant’s business activity, underscores and increases the confusing similarity.

The Complainant has, to the satisfaction of the Panel, shown that 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).

B. Rights or Legitimate Interests

Complainant must show that Respondent has no rights or legitimate interests in respect of the disputed domain name.

Respondent in a UDRP proceeding does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:

a) that before any notice to the respondent of the dispute, he or she used or made preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;

b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or

c) that the respondent is making a legitimate, non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Respondent has no connection or affiliation with the Complainant, which has not licensed or otherwise authorized the Respondent to use or apply for any domain name incorporating the Complainant's trademark. The Respondent does not appear to make any legitimate use of the disputed domain name for non-commercial activities. On the contrary, it appears that the Respondent has used and is using the disputed domain name to redirect to an online site offering a vast range of products and services ranging from antiques, art and automotive parts to toys, travel and bicycles. Amongst these are many products competing with the Complainant's goods.

The Respondent claims that Ikeacasa is a name initially created for prefabricated wood-frame house modules, and that the choice of this name is due to "a crazy idea" that links the chosen name to Hurricane Ike.

The Panel, without entering into the merits of the credibility of the Respondent's assertion regarding the creation of the ikeacasa name, notes however that the Respondent admitted that when choosing and then registering the disputed domain name he was already aware of the renowned IKEA trademark. In fact, the Respondent claims that "not coincidentally, he made a clear distinction between ikeacasa and ikea, and above all to show this difference to site visitors, thus avoiding possible confusion".

The Panel further notes that the documents provided by the Respondent regarding the use of the name Ike a casa mostly relate to printouts of files (brochures, cost estimates and product technical details), and that these documents by their specific nature (i.e. computer files) can at best constitute only an inference (and not evidence) of the existence of a product named Ike a casa and of the disputed domain name. In any case, these documents are far from proof that the disputed domain name has been used in connection with a bona fide offering of goods or services as required by paragraph 4(b)(i) of the Policy.

In addition, most of these documents show that the company that was producing and selling the prefabricated wood-frame house modules had a different name, i.e. Boiswiss, S.A.. Indeed, even where there is a mention of the "Ike a casa" product and/or of the disputed domain name, it appears that in order to promote and/or publicizes this content a different domain name and related website was used, i.e. casa-dolcesasa.com and/or boiswiss.com.

The Respondent provided only two printouts of the website corresponding to the disputed domain name (apparently printed on October 23, 2020), which show their use to redirect to an online site offering a vast range of products and services ranging from antiques, art and automotive parts to toys, travel and bicycles, and which contain no reference to the "Ike a casa" product (i.e. prefabricated wooden walls).

Therefore, the Panel finds that although the Respondent may possibly have used the "Ike a casa" for a certain time in relation to a product related to prefabricated house modules, it has however failed to show any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name in accordance with the UDRP Policy. The Respondent did not provide any elements to demonstrate, as required by the Policy, that he used or made preparations to use the disputed domain name or a name corresponding to it in connection with a bona fide offering of goods or services.

Accordingly, the Panel finds that Complainant has satisfied the burden of proof with respect to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith.

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found

by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or

ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or

iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's web site or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's web site or location or of a product or service on the holder's web site or location.

Accordingly, for a Complainant to succeed, the Panel must be satisfied that the disputed domain name has been registered and is being used in bad faith.

Having considered:

a) that the Respondent offered to sell the disputed domain name to the Complainant for an amount exceeding out-of-pocket expenses;

b) that the Respondent sees the Complainant's refusal to buy the disputed domain name as legitimizing the holding and use of a domain name comprising the renowned IKEA trademark for a website offering for sale competing goods;

c) that the Respondent affirmed that it was aware of the Complainant's renowned trademark at the time he registered the disputed domain name and nevertheless went ahead and registered it;

d) that the Respondent is using the disputed domain name for a website where he offers for sale household products, home furnishing products and accessories in direct competition with the Complainant's goods; and

e) that the Respondent has continued to do so (i.e. to use the disputed domain name for a website where home furnishing products and accessories in direct competition with those of the Complainant are displayed) even after receiving a cease and desist letter from the Complainant's representatives.

It is the Panel's opinion that all of the above has shown the Respondent's bad faith registration and use of the disputed domain name, which clearly falls within the example given in paragraph 4 of the Policy.

Considering the foregoing, the Complainant has, to the satisfaction of the Panel, shown that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraphs 4(a)(i) and 4(a)(iv) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IKEACASA.COM**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2020-11-04

Publish the Decision