Decision for dispute CAC-UDRP-103332

Case number	CAC-UDRP-103332
Time of filing	2020-10-06 11:52:23
Domain names	achem-block.com

Case administrator

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

Complainant

Organization	Advanced ChemBlocks Inc

Complainant representative

Organization	Dimov Internet Law Consulting

Respondent

Name	liangliang wang

OTHER LEGAL PROCEEDINGS

The Panel is not aware of pending or decided legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant claims to have acquired unregistered trademark rights on "ACHEMBLOCK" through use in United States.

The Complainant contends to be the owner of the domain name <achemblock.com>.

FACTUAL BACKGROUND

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

The Complainant is a worldwide supplier of advanced building blocks and research chemicals for drug discovery. The Complainant has been active in the pharmaceutical industry since 2009. The Complainant is active in the United States, Canada, Europe, Japan, India, South Korea, and China, among other countries.

The Complainant uses the trademark <achemblock> in the course of trade since 2009 and has registered the domain name <achemblock.com> in 2009.

The disputed domain name was registered on April 28, 2019 and it currently hosts a website active in the supply of chemical materials.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

As regards the First element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to its prior trademark "ACHEMBLOK". The addition of the "-" between the elements "ACHEM" and "BLOCK" does not exclude the finding of confusing similarity for the purposes of the Policy.

As regards the Second element of the Policy, the Complainant denies that the Respondent has rights or legitimate interests in registering the disputed domain name. According to the Complainant the disputed domain name is not used in connection with a bona fide offering of goods or services as the disputed domain name is allegedly used to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's Trademark.

As regards the Third element of the Policy, supports that the disputed domain name is used in bad faith because the purpose of the registration was to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's Trademark.

RESPONDENT:

No administrative response has been submitted.

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

1. The disputed domain name is confusingly similar to a trademark in which the Complainant has rights

As regards the First element, it is undisputed and accepted practice, that paragraph 4(a)(i) of the Policy refers merely to a "trademark or service mark" in which the Complainant has rights, and does not expressly limit its application to registered trademark or service mark. Therefore, according to the policy, the Complainant could rely both on registered and unregistered trademarks.

The Complainant does not own registered trademarks covering the sign <ACHEMBLOCK>. Therefore the Panel must assess whether the evidence submitted by the Complainant is sufficient to successfully assert unregistered or common law trademark rights on the sign <ACHEMBLOCK>.

The evidence submitted is summarized as follows:

i) documents attesting to the creation of the company "Advanced Chemblocks Inc" dating back to 1999;

ii) corporate and tax documents regarding the Complainant;

iii) screenshot of the <achemblock.com> dating back to 2011;

iv) more than 40 invoices and orders covering the years 2015, 2016, 2017 and 2018;

v) advertising material attesting to the presence of the Complainant at an exhibition in 2017.

The Panel will not assess whether such evidence is sufficient to establish unregistered trademark rights according to US law. The Panel will only examine such documents in the light of the rules set forth by the Policy. Under this regard, case law shows that the following elements are taken into consideration in proving unregistered trademark rights: (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

Given this background the Panel states the following. The corporate documents combined with historic screenshot show that the Company was effectively established in 2009 and that the <ACHEMBLOCK> trademark was in use since 2011. Invoices show that goods distinguished by the ACHEMBLOCK trademark were sold in the market. The sales cover mainly United States but also some European countries. Moreover the goods are intended for a specialized public and not for the public at large; therefore the assessment of the evidence must take into consideration also the limited public the relevant goods are intended for.

All above considered and taken into consideration the lack of response by the Respondent, the Panel takes the view that the evidence submitted by the Complainant is sufficient to establish unregistered trademark rights on the sign <achemblock>.

The Panel also observes that the disputed domain name is substantially identical to the Complainant's trademark. The addition of the "-" does not exclude the risk of confusion.

The Panel accordingly concludes that paragraph 4(a)(i) of the Policy is satisfied.

2. The Respondent lacks rights or legitimate interests in the disputed domain name

The Respondent has not submitted a response to the Complaint. Therefore, it has filed no information nor evidence regarding possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which, according to the Panel, are sufficient to conclude that the Respondent has no rights or legitimate interest in the disputed domain name.

The Panel agrees with the Complainant that the current use of the disputed domain name could mislead internet users creating a likelihood of confusion between the services offered by the different undertakings. As a matter of fact, the trademark and domain name are substantially identical and they are used for identical/similar goods and services. The Respondent’s registration and use of the domain name could suggest an affiliation with the Complainant which is not the case. To the Panel's view, such use cannot be qualified as a non-commercial or fair use for the purposes of the Policy neither a bona fide offering of goods and services.

As previously stated, the Respondent did not inform the Panel about any possible rights or legitimate interests that could justify the registration and use of the disputed domain name. As a consequence, the Panel has no reason to not believe to the Complainant's allegations.

For these reasons, the Panel takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name for the purposes of the Second Element of the Policy.

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

As regards third and last element of the Policy, the Panel finds reasonable the Complainant's arguments about the bad faith registration and use of the disputed domain name. The disputed domain name is practically identical to the Complainant's trademark. Previous panels found that the identity between the domain name and the trademark could be interpreted as an index of bad faith. Moreover, the disputed domain name redirects to a website which is active in the same field of the Complainant. These circumstances, in the absence of any reasonable explanation by the Respondent, are sufficient for the Panel to conclude that the purpose of the registration and use of <achem-block.com> was to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's Trademark.

The concrete and effective likelihood of confusion is also confirmed by the evidence submitted by the Complainant. Under this regard, previous panels found that actual confusion could be useful in proving registration and use in bad faith.

Indeed, the Complainant does not own registered trademarks. Moreover, the Complainant did not prove that its trademark was used in China where the Respondent is allegedly based. Notwithstanding the above, the fact that the disputed domain name is identical to the Complainant's trademark combined with the very specific nature of the Parties' businesses, makes it improbable that the Respondent was not aware of the Complainant's use of the ACHEMBLOCK trademark at the time of registration.

A quick search on google could have immediately disclosed the Complainant's company and the use of the ACHEMBLOCK trademark. Moreover, checking the website www.achem-block.com, it appears that the Respondent is also active in the US market. Of course, this fact increases the possibilities that the Respondent knew about the Complainant's ACHEMBLOCK trademark.

All these circumstances, in the absence of any explanation which the Respondent had the chance to provide by participating to this proceeding, are sufficient to conclude that the disputed domain name was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ACHEM-BLOCK.COM**: Transferred

PANELLISTS

Name	**Andrea Mascetti**

DATE OF PANEL DECISION 2020-11-15

Publish the Decision