Decision for dispute CAC-UDRP-103312

Case number	CAC-UDRP-103312
Time of filing	2020-10-19 16:04:27
Domain names	xxx-lutz.net

Case administrator

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

Complainant

Organization	XXXLutz Marken GmbH

Complainant representative

Organization	Grünecker Patent und Rechtsanwälte PartG mbB

Respondent

Name	Majup Hoffberg

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is XXXLutz Marken GmbH, the intellectual property holding company of the XXXLutz Group (the Complainant). The XXXLutz Group is one of Europe's largest retailers of furniture and related home accessories, with more than 25,700 employees and an annual turnover of over EUR 5.1 billion. It operates more than 320 furniture stores, most of them in Germany, Austria, Switzerland, the Czech Republic, Slovakia and Sweden under its highly well-known XXXLutz brand.

The Complainant states that it owns an important domain name portfolio, including the same distinctive wording "XXXLUTZ" such as <xxxlutz.de>. Further online stores are operated by the XXXLutz Group under the domains <xxxlutz.at>, <xxxlutz.cz>, <xxxlutz.sk>, <xxxlutz.ch>, and <xxxlutz.se>. Under the domain <xxxlutz.com> the user finds a website containing links to the respective nationalized online shops under the aforementioned domains as well as to the website under the domain <xxxlutz.hu>, which is currently announcing the above-mentioned upcoming opening of Hungarian stores. Another domain <xxxlutz.net> currently forwards users to the central <xxxlutz.com> domain.

The Complainant states and provides evidence to support, that it is the owner of a large portfolio of trademarks including the word "XXXLutz", such as:

- German Trademark Registration No. 30551204 “XXXLutz” (Word-Figurative mark for the XXXLutz logo), registered on November 17, 2005, in International classes 12, 14, 35, 37, 43;

- German Trademark Registration No. 30551205 “XXXLutz” (Word mark), registered on November 17, 2005, in International classes 12, 14, 35, 37, 43;

- European Trademark Registration No. 001553999 “XXX Lutz” (Figurative mark for the XXXLutz logo), registered on April 16, 2003, in International classes 16, 20, 21, 27;

- European Trademark Registration No. 003765658 “XXXLutz” (Figurative mark for the XXXLutz logo), registered on June 29, 2005, in International classes 06, 11, 18, 19, 24, 25, 26, 28, 35.

The disputed domain name <xxx-lutz.net> was registered on September 28, 2019.

FACTUAL BACKGROUND

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

The Complainant draws Panel attention to previous UDRP decisions:

- WIPO Case No. D2017-0381 Andrey Ternovskiy dba Chatroulette v. Protection of Private Person / Aleksandr Katkov, finding the respondent’s use of the domain name <chatroulettelolz.com> to redirect Internet users to pornographic websites “should and could not be considered a bona fide offering of goods or services”;

- WIPO Case No. D2015-1200 L’Oréal v. Robert Caceres, Dollarviews, finding that use of a domain name for a website displaying pornographic videos “does not constitute an example of rights and legitimate interests as per paragraph 4(c) of the Policy”;

- WIPO Case No. D2014-0883 Neste Oil Oyj v. Nesin Dmitry / Privacy Protection Service INC, noting that “pornographic content of the Respondent’s website ought to be regarded as a proof of lacking right or legitimate interest”.

PARTIES' CONTENTIONS:

COMPLAINANT:

I. The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the disputed domain name <xxx-lutz.net> is confusingly similar to the XXXLutz mark as the domain name fully incorporates the XXXLutz mark, adding the purely generic top-level domain (“gTLD”) “net”. Even though there is a hyphen in the domain name between its elements “XXX” and “LUTZ”, the XXXLutz mark is clearly recognizable within the disputed domain name, as the relevant public perceives and pronounces the term “XXXLutz” as consisting of two elements, namely “XXX” and “Lutz”.

II. The Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant states that it has not authorized the Respondent to use the distinctive and famous XXXLutz mark and name.

There is also no use nor any demonstrable preparations thereof concerning any use of the disputed domain name with respect to a bona fide and legitimate offering of goods or services, according to Policy 4(c)(i).

According to the Complainant, the Respondent does not clearly draw the line between itself and the Complainant (respectively the XXXLutz Group). Rather to the contrary, by prominently using the XXXLutz logo on its website, the Respondent is actively creating the impression that it might be at least affiliated with the Complainant in some manner.

Finally, the Complainant provides that the intention of the Respondent is obviously to aim at redirecting customers, thereby tarnishing the reputation of the XXXLutz trademarks at issue (Policy 4(c)(iii)), as the Respondent tries to create the impression that there may even be a connection between its services and the Complainant by prominently using the Complainant`s trademarks and referring to its services, without any clarification that in reality, no such affiliation exists.

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

According to the Complainant, the Respondent has registered and is using the disputed domain name in bad faith. The Respondent is actively using the Complainant's marks within the disputed domain name and the well-known XXXLutz logo on the website. Further, the Respondent refers to the XXXLutz Group’s furniture retail services in the website description. Therefore, it is evident that the Respondent was and is aware of the Complainant and its trademark rights.

The Complainant further states that it is also evident that, by registering and using the disputed domain name the Respondent has intentionally attempted to attract Internet users by creating a deliberate likelihood of confusion with the Complainant's XXXLutz mark for the sole purpose of generating traffic on the Respondent's website.

PARTIES CONTENTIONS

RESPONDENT:

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.

PRINCIPAL REASONS FOR THE DECISION

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

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

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

The Complainant has provided evidence and proved to be the owner of a large portfolio of trademarks including the word "XXXLutz". Essentially, the Respondent has appropriated the trademark "XXXLutz" by adding a hyphen between the words "XXX" and "Lutz" to presumably lead consumers to believe that it is affiliated with the Complainant. The disputed domain name thus fully incorporates the XXXLutz mark, adding the purely generic top-level domain (“gTLD”) “net”.

The disputed domain name is confusingly similar to the Complainant's trademarks "XXXLutz" since it fully incorporates the Complainant’s trademark "XXXLutz" despite the addition of the hyphen and a generic top-level domain "net" which the Panel finds does not eliminate any confusing similarity. This is especially true where, as here, the trademark is “the dominant portion of the domain name,” LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents “the most prominent part of the disputed domain name[] which will attract consumers’ attention.” Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768., and since the term "XXXLutz" is fully distinguishable with respect to the additional component of the domain name, either because it is placed at the beginning of the domain name, which is where consumers mainly focus their attention, or because the additional element of the domain name is deprived of a distinctive character.

Moreover, the addition of a generic term and gTLD is insufficient in distinguishing a domain name from a mark under Policy 4(a)(i). See e.g., Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (Forum Jan. 22, 2016). Also, the “use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark.".

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark "XXXLutz".

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

Under the Policy, a complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term “XXXLutz” as part of its domain name. The Respondent actively uses the term "XXXLutz" on its website, thus creating an impression that it might be at least affiliated with the Complainant.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

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

The Panel finds that the disputed domain name <xxx-lutz.net> is confusingly similar to the Complainant's distinctive trademark "XXXLutz", which is widely known and well-established.

Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. Since the Respondent not only actively uses the Complainant's marks within the disputed domain name and the well-known XXXLutz logo on the website, but also refers to the XXXLutz Group’s furniture retail services in the website description, it worsens the likelihood of confusion between the disputed domain name and the Complainant’s trademark.

The Panel finds that such actions constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy, which provides: "by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site 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 web site or location or of a product or service on respondent's web site or location."

In the present case, the Panel is of the opinion that the Complainant’s "XXXLutz" trademark is distinctive and widely used, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy, that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **XXX-LUTZ.NET**: Transferred

PANELLISTS

Name	**Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION 2020-11-20

Publish the Decision