Decision for dispute CAC-UDRP-103417

Case number	CAC-UDRP-103417
Time of filing	2020-11-23 11:47:35
Domain names	gefrans.com

Case administrator

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

Complainant

Organization	Gefran SpA

Complainant representative

Organization	Convey srl

Respondent

Name	Yang Chang

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 is the owner, among others, of trademarks:

International Trademark no. 852323 ‘GEFRAN’ registered on January 11, 2005;

Italian Trademark no. 0000796756 ‘GEFRAN’ registered on November 29, 1999; and

European Trademark no. 004435152 ‘GEFRAN’ registered on May 18, 2006.

FACTUAL BACKGROUND

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

The Complainant was founded in the 1960s in Italy producing electric panels for machines used in manufacturing plastics. It has 900 employees in its production facilities worldwide and 17 sales offices located around the world with revenues of

about € 135,000,000 in 2018 spread mainly in Europe (60%), America (17%) and Asia (22%). The Complainant has spent considerable effort in promoting its mark “GEFRAN”, thereby acquiring the trademark’s goodwill.

The disputed domain name was registered on May 14, 2016. The disputed domain name has been redirected to a website where both the Complainant’s products and the competitors’ products are offered for sale.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

i) The Complainant has rights in the mark “GEFRAN” based on International, Italian and EUIPO trademark registrations. The disputed domain name is confusingly similar to its trademark “GEFRAN” with the mere addition of the letter “S.”

ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant’s trademarks. The Respondent is not commonly known by the disputed domain name as individuals, business or other organization and their family names do not correspond to ‘GEFRAN’ or the disputed domain name. The Respondent's use can be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name.

iii) The Respondent has registered and is using the disputed domain name in bad faith. The disputed domain name has been redirected to a website where both the Complainant’s products and the competitors’ products are offered for sale. There is no disclaimer informing the users as to the Respondent’s lack of relationship with the Complainant, and thus the website creates the impression that the Respondent is an official dealer in China. The Respondent did not respond to a cease and desist letter.

RESPONDENT:

The Respondent did not submit a Response.

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

Preliminary Issue: Language of the Proceedings

The Panel notes that the Registration Agreement is written in Chinese, thereby making the language of the proceedings in Chinese. Complainant has alleged that because Respondent has knowledge of the English language and understands English, the proceeding should be conducted in English. The Panel has the discretion under UDRP Rule 11(a) to determine

the appropriate language of the proceedings taking into consideration the particular circumstances of the administrative proceeding. See FilmNet Inc. v Onetz, FA 96196 (Forum February 12, 2001) (finding it appropriate to conduct the proceeding in English under Rule 11, despite Korean being designated as the required language in the registration agreement because the respondent submitted a response in English after receiving the complaint in Korean and English).

In accordance with the Rules, paragraphs 11(a), 10(b) and 10(c), Complainant requests that the Panel determine English to be the language of the proceeding for the following reasons: (a) some parts of the website corresponding to the disputed domain name are in English; (b) the disputed domain name is registered in Latin characters, rather than Chinese script; (c) English is the primary language for business and international relations; and (d) in order to avoid additional expense and delay that would be incurred if the Complaint must be translated into Chinese.

Pursuant to UDRP Rule 11(a), the Panel finds that persuasive evidence has been adduced by the Complainant to suggest the likely possibility that the Respondent is conversant in the English language. After considering the circumstance of the present case, in the absence of a Response and no objection to the Complainant's request for the language of proceeding, the Panel decides that the proceeding should be in English.

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 for the UDRP ('the Policy') instructs this Panel to "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 requires that a complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

(2) 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.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (Forum July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO February 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Rights

The Complainant contends that it has rights in the mark ‘GEFRAN’ based on, among others, International Trademark no. 852323 registered on January 11, 2005; Italian Trademark no. 0000796756 registered on November 29, 1999; and European Trademark no. 004435152 registered on May 18, 2006.

The Complainant has provided the Panel with a copy of each of the trademark registrations at issue. Registration of a mark

with national and regional trademark authorities sufficiently establishes the required rights in the mark for purposes of the Policy. As such, the Panel finds that the Complainant has established its rights in the mark 'GEFRAN.'

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's trademark 'GEFRAN.' The Complainant asserts that the disputed domain name includes non-distinctive elements such as the letter "S", a top-level domain .com, which does not affect the confusing similarity. The Panel agrees with the Complainant and notes that the addition of a letter or a gTLD is generally disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing disputed domain name and trademarks. Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark 'GEFRAN.'

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

The Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (Forum November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. The Respondent is not commonly known by the disputed domain name as individuals, business or other organization and their family names do not correspond to 'GEFRAN' or the disputed domain name. The disputed domain name has been redirected to a website where both the Complainant's products and the competitors' products are offered for sale. The Respondent's use can be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name. The Complainant has provided the Panel with a screenshot of the disputed domain name's website supporting its assertions.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 respondent's website or location or of a product or service on the respondent's website or location.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant specifically contends that the disputed domain name has been redirected to a website where both the Complainant's products and the competitors' products are offered for sale. A search on www.archive.org has highlighted that on June 6, 2017, the disputed domain name was redirected to a website, similar to the current website, offering for sale Complainant's and his competitors' products and showing a picture of the Complainant's headquarter copied by the Complainant's website in an attempt to pass off as the Complainant. The use of the disputed domain name in connection with commercial websites where the Complainant's trademark is misappropriated and prima facie replicas of GEFRAN products are offered for sale clearly indicates that the Respondents' purpose in registering and use of the disputed domain name was to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking GEFRAN products to their websites for financial gain.

The Panel recalls that the Complainant has provided the Panel with a screenshot of the disputed domain name's resolving websites supporting its arguments. The Panel observes that the use of a disputed domain name to pass off as a complainant is evidence of bad faith registration and use under Paragraph 4(b)(iv) of the Policy. See Indeed, Inc. v. Zhiteng Sun, FA 1751940 (FORUM November 1, 2017) (finding that the respondent's use of <Indeed.net> to misrepresent itself as the complainant by imitating the complainant's website design supported a finding of bad faith); see also Toyota Motor Sales U.S.A. Inc. v. Clelland, FA 198018 (FORUM November 10, 2003) ("Respondent used <land-cruiser.com> to advertise its business, which sold goods in competition with Complainant. This establishes bad faith as defined in Policy paragraph 4(b)(iv)."). Therefore, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith paragraph 4(b)(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. **GEFRANS.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2021-01-13

Publish the Decision