Decision for dispute CAC-UDRP-101794

Case number	CAC-UDRP-101794
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Domain names	officecom-setupp.com, goofficecomsetup.com, goofficecom-setup.com, office365-download.com, office-365-download.com, officecomsetupl.com, officecomsetupp.com, officecom-setupz.com, officeecomsetup.com, officesetupp.com, help1office.com, help2office.com, help3office.com, help5office.com, help6office.com, help7office.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Microsoft Corporation

Complainant representative

Organization	Convey srl

Respondent

Name	Sourabh Chhabra

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 is the registrant of the following trademarks:

OFFICE 365, International trademark No.1175022, registered on August 20, 2013;
OFFICE MOD, International trademark No. 1190337, registered on December 10, 2013;
MICROSOFT OFFICE MOD, International trademark No. 1190539, registered on December 10, 2013;
OFFICE, European trademark No. 011413556, registered on May 9, 2013;
MICROSOFT OFFICE, European trademark No. 007138225, registered on May 12, 2013; and
OFFICE 365, European trademark No. 010171403, registered on January 8, 2012.

FACTUAL BACKGROUND

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

Founded in 1975, the Complainant, Microsoft Corporation, develops, manufactures, licenses, supports and sells computer software, consumer electronics, personal computers and related services. Microsoft Office, introduced in 1990, bundled separate applications such as Microsoft Word and Microsoft Excel. Today, Microsoft is amongst the leading players in the world of hi-tech, with about 120 subsidiaries and 160,000 employees worldwide.

The Complainant is the owner of trademark registrations for OFFICE, OFFICE 365, OFFICE MOD, MICROSOFT OFFICE MOD and MICROSOFT OFFICE. The trademark “OFFICE”, registered and used since many years, is distinctive and well known all around the world. Office 365 is used by over a million companies worldwide. The Complainant has been extensively using the “OFFICE” denomination on all internet environments including its official websites www.office.com and www.microsoft.com.

The disputed domain names were registered, without authorization of the Complainant, by the Respondent between December 2019 and July 2020 and have been pointed to websites confusingly similar to the Complainant’s website offering assistance services to internet users for the Complainant’s software programs and for products of Complainant’s competitors.

The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Respondent has no rights or legitimate interests in respect of the disputed domain names, which were registered and are being used in bad faith.

As to legitimacy, upon information and belief, the Respondent is not commonly known by the disputed domain names as an individual, business or other organization and the family name does not correspond to OFFICE nor to the disputed domain names. The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before any notice of this dispute.

The disputed domain names are redirected by the Respondent to websites reproducing the Complainant’s trademarks with layouts similar to the Complainant’s website and with favicons identical to the Complainant’s favicon in order to pass itself off as the Complainant, and providing assistance services to Internet users for the Complainant’s software programs, information on how to download the Complainant’s software programs and assistance for products of the Complainant’s competitors.

The Respondent is not an authorized seller or service agent of the Complainant. Despite this, the Respondent is offering a service connected to the Complainant’s software programs without authorization and without accurately disclosing its relationship with the Complainant. It is cornering the market in registering 16 domain names.

Therefore, it is apparent that 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 names.

In order to provide assistance services to Internet users for the Complainant’s software programs and information to download the Complainant’s software programs, the Respondent could register and use domain names avoiding use of the Complainant’s trademark OFFICE in the domain names and the Complainant’s favicon in the websites. These elements suggest affiliation with the Complainant or sponsorship and endorsement by the Complainant to Internet users.

The Respondent offers technical assistance for many hi-tech products, not limited to those of the Complainant, as indicated in the Social Media profiles or in the blog pages in each website corresponding to the disputed domain names.

As an example, the domain name <officecom-setupp.com> resolves to a website where links to the following Social Media are inserted: Facebook, Pinterest, Tumblr, Google Site and Twitter. Clicking on the Twitter and Tumblr icons, Internet users are redirected to accounts of “khushi sharma” where Mcafee and Webroot Antivirus are promoted and, by clicking on the posts dedicated to those software programs, customers are redirected to websites "https://mcafeeloginz.com/ and

"http://webrootcomsafer.com/ similar to the websites at issue, including the links to the official websites of Webroot and Mcafee. Investigations on the Whois database have highlighted that the registration data for <mcafeeloginz.com> and <webrootcomsafer.com> are similar to the ones utilized for the disputed domain names: Eranet International Limited as registrar, India as the domain name's owner country, similar lay-out of the websites, the use of the trademarks also as favicons.

The Complaint contains further examples of how the Respondent uses the disputed domain names for illegitimate purposes, saying the Respondent uses the disputed domain names and the fame of the Complainant's trademarks as a bait to attract customers to the Respondent's websites and social media accounts prima facie in order to promote its services utilizing various names. Further, the Respondent informs the customers about the Complainant's products and promotes products of Complainant's competitors without a clear and prominent disclaimer disclosing the lack of relationships with the Complainant. The absence of clear and prominent disclaimers could induce the users to believe that the registration of the disputed domain names and their redirection to the corresponding websites have been authorized by the Complainant. But the Internet users redirecting to the websites at issue can easily discover social media profiles, posts and websites dedicated to the Complainant's competitors.

Therefore, the registration and use of the disputed domain names are only pretexts for commercial gain or for other purposes for the Respondent's benefit. The Respondent, knowing the value of the Complainant' trademark, has targeted the Complainant in order falsely to suggest a correlation among the disputed domain names, the corresponding websites and the Complainant's mark.

The registration of sixteen domain names confusingly similar to the Complainant's trademark and of several domain names including well-known trademarks of the hi-tech sector as McAfee, Norton, Garmin, AOL and PayPal is not bona fide registration and use nor legitimate non-commercial or fair use of the disputed domain names, without intent for commercial gain misleadingly to divert consumers or to tarnish the trademark or service mark at issue.

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

As to bad faith, the Respondent has targeted the Complainant and various companies of the hi-tech sector, as McAfee, Webroot, Garmin, Norton, Linksys, Netgear, Magellan Navigation, registering 16 domain names confusingly similar to the trademark OFFICE and several domain names of the Complainant's competitors.

The registrations of the 16 disputed domain names prevent the Complainant from reflecting the OFFICE mark in corresponding domain names and constitute a pattern of conduct for the purposes of Paragraph 4(b)(ii).

Furthermore, in light of the registration and intensive use of the trademark OFFICE since many years, the aforesaid trademark of the Complainant enjoys worldwide reputation in the sector of hi-tech. The disputed domain names were registered between December 2019 and July 2020, years after the Complainant obtained its trademark registrations and, in view of the advertising and sales of the Complainant's products worldwide, the Respondent could not have possibly ignored the existence of the Complainant.

It is clear indeed that the Respondent was well aware of the Complainant's trademark and registered the disputed domain names with the intention to refer to the Complainant and its trademarks. Considering the trademark's distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant's registered trademark at the time of the registration of the disputed domain names.

As to use in bad faith, as mentioned above, the disputed domain names are redirected to websites where the Respondent informs the customers about the Complainant's products and, via the social media accounts indicated in the websites corresponding to the disputed domain names, promotes products of the Complainant's competitors without a clear and prominent disclaimer disclosing the lack of relationships with the Complainant.

Therefore, the uses of the disputed domain names are only pretexts for commercial gain or for other purposes inhering to the Respondent's benefit. The Respondent, knowing the fame and notoriety of the Complainant's trademark, has targeted the Complainant in order to speculate and obtain profits for his or her business activity.

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

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.

The Complainant respectfully requests that the disputed domain names be consolidated in a single UDRP proceeding because, despite being registered in different names, they are all under the control of a single individual or entity or, at least, reflective of a group of individuals acting in concert.

PRINCIPAL REASONS FOR THE DECISION

Preliminary issue: multiple Respondents.

Paragraph 3(c) of the Rules provides that a "complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder".

The Complainant contends that the disputed domain names are effectively controlled by the same person. They are all registered with the same Registrar and share the following similarities:
- same country of the registrant: India;
- same extension of the domain names: .com;
- same registrar, i.e. Eranet International Limited;
- similar lay-out of the websites corresponding to the domain names. For instance, in all the websites there are the links "Office.com/setup", except for <office365-download.com> and <office-365-download.com>.
- the favicon of the websites corresponding to the domain names is identical to the Complainant's figurative trademark.

In the absence of any response and having regard to the extensive evidence provided by the Complainant regarding the Registrar's verification information, the content of the websites to which the disputed domain names resolve and the links to be found on those websites, the Panel is satisfied that the disputed domain names are effectively controlled by the same person, despite being registered in different names. Accordingly, the Panel accepts that this proceeding may address all 16 of the disputed domain names and will refer to all the registrants as "the Respondent".

Substantive issues.

Paragraph 15(a) of the Rules 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 the 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 the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
(2) the 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.

Identical and/or Confusingly Similar

The Panel finds each of the disputed domain names to be confusingly similar to the Complainant’s OFFICE mark as each contains the mark in its entirety and merely adds one or more generic terms, letters and numbers, such as "go", " com", "setup", "help", "download", none of which suffice to distinguish any of the disputed domain names from the OFFICE mark, and the inconsequential “.com” generic top-level domain (gTLD), which may be ignored.

The Complainant has established this element.

Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if established by the Respondent, shall demonstrate rights to or legitimate interests in a disputed domain name for the purposes of paragraph 4(a)(ii) of the Policy, i.e.

(i) before any notice to the Respondent of the dispute, the use by the Respondent of, or demonstrable 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; or

(ii) the Respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

The Complainant's OFFICE mark was registered and had become very well-known many years before the disputed domain names were registered, as follows:

Domain name Registration date Registrant
OFFICECOMSETUPL.COM 2019-12-17 Avast Software s.r.o.
OFFICECOM-SETUPZ.COM 2019-12-20 Avast Software s.r.o.
OFFICESETUPP.COM 2019-12-20 Avast Software s.r.o.
OFFICESETUPP.COM 2019-12-20 Avast Software s.r.o.

OFFICEECOMSETUP.COM 2020-03-04 Avast Software s.r.o.
OFFICECOM-SETUPP.COM 2020-05-02 Sourabh Chhabra
OFFICE365-DOWNLOAD.COM 2020-05-09 Sourabh Chhabra
OFFICE-365-DOWNLOAD.COM 2020-05-09 Sourabh Chhabra
GOOFFICECOMSETUP.COM 2020-05-26 Sourabh Chhabra
GOOFFICECOM-SETUP.COM 2020-05-26 Sourabh Chhabra
OFFICECOMSETUPP.COM 2020-05-26 Sourabh Chhabra
HELP1OFFICE.COM 2020-07-28 Dixit Deepti
HELP2OFFICE.COM 2020-07-28 Dixit Deepti
HELP3OFFICE.COm 2020-07-28 Dixit Deepti
HELP5OFFICE.COM 2020-07-28 Dixit Deepti
HELP6OFFICE.COM 2020-07-28 Hari Om
HELP7OFFICE.COM 2020-07-28 Hari Om

Each of the disputed domain names resolves to a website purporting to be that of the Complainant.

These circumstances, coupled with the Complainant's assertions, are sufficient to constitute a prima facie showing of absence of rights or legitimate interests in respect of the domain names on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show that it does have rights or legitimate interests in the disputed domain names. See Neal & Massey Holdings Limited v. Gregory Ricks, FA 1549327 (FORUM Apr. 12, 2014). The Respondent has made no attempt to do so.

In the circumstances of this case, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant has established this element.

Registration and Use in Bad Faith

This element requires the Complainant to establish, on the balance of probability, that the Respondent both registered the disputed domain names in bad faith and is using them in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which, though not exclusive, shall be evidence of the registration and use of a domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy, including:

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

In light of the circumstances set out above in relation to the second element, the Panel finds that the Respondent clearly knew of Complainant's very well-known OFFICE mark when registering the disputed domain names and that, by using them for websites virtually identical to Complainant's website that purport to offer similar services, the Respondent is masquerading as the Complainant so as intentionally to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites.

Accordingly, the Panel finds that the Respondent registered and is using the disputed domain names in bad faith.

The Complainant has established this element.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **OFFICECOM-SETUPP.COM**: Transferred
2. **GOOFFICECOMSETUP.COM**: Transferred
3. **GOOFFICECOM-SETUP.COM**: Transferred
4. **OFFICE365-DOWNLOAD.COM**: Transferred
5. **OFFICE-365-DOWNLOAD.COM**: Transferred
6. **OFFICECOMSETUPL.COM**: Transferred
7. **OFFICECOMSETUPP.COM**: Transferred
8. **OFFICECOM-SETUPZ.COM**: Transferred
9. **OFFICEECOMSETUP.COM**: Transferred
10. **OFFICESETUPP.COM**: Transferred
11. **HELP1OFFICE.COM**: Transferred
12. **HELP2OFFICE.COM**: Transferred
13. **HELP3OFFICE.COM**: Transferred
14. **HELP5OFFICE.COM**: Transferred
15. **HELP6OFFICE.COM**: Transferred
16. **HELP7OFFICE.COM**: Transferred

PANELLISTS

Name	**Mr. Alan Lawrence Limbury**

DATE OF PANEL DECISION 2021-03-08

Publish the Decision