Decision for dispute CAC-UDRP-103563

Case number	CAC-UDRP-103563
Time of filing	2021-02-17 09:39:28
Domain names	PEPSICO-US.COM

Case administrator

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

Complainant

Organization	PepsiCo, Inc.

Complainant representative

Organization	RiskIQ, Inc. - Incident, Investigation and Intelligence (i3), Jonathan Matkowsky

Respondent

Organization	Pepsico

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.

The Panel recommends that, in order to avoid any confusion, the name of the Respondent (currently "Pepsico") is replaced by its contact e-mail "thermofishesci@gmail.com" or, at least, by the name appearing in the WhoIs search presented by the Complainant: "Jim Manzi" (if the latter is not a real person working for the Complainant).

IDENTIFICATION OF RIGHTS

In these proceedings, the Complainant relies on the following trademarks:

- PEPSICO (& device), US Registration No. 3026568, registered as of December 13, 2005, in the name of PepsiCo, Inc. (the Complainant);

- PEPSICO (& device), UK Registration No. UK00000992395, registered as of May 19, 1972, in the name of PepsiCo, Inc. (the Complainant);

- PEPSICO (& device), EU Trade Mark Registration No. 013357637, registered as of March 13, 2015, in the name of PepsiCo, Inc. (the Complainant);

- PEPSI, US Registration No. 824,150, registered as of February 14, 1967, in the name of PepsiCo, Inc. (the Complainant);

- PEPSI, UK Registration No. UK00000978461, registered as of July 29, 1971, in the name of PepsiCo, Inc. (the Complainant); and

- PEPSI, EU Trade Mark Registration No. 000105247, registered as of April 1, 1996, in the name of PepsiCo, Inc. (the Complainant),

among many others. The Complainant owns hundreds of similar well-known trademarks in various countries, all around the world.

FACTUAL BACKGROUND

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

The Complainant is a famous, giant multinational corporation, based in the USA but commercially present all around the world, in as many as 200 countries. Its annual net revenue amounts to several billion US Dollars and its trademarks are well-known among consumers.

The Complainant owns a large-sized portfolio of trademarks including the wordings "PEPSICO" and “PEPSI”, among which numerous US, UK and EU registrations dating back to the 1970’s. It also owns a multitude of related domain names, like <pepsi.com>, <pepsico.net>, <mypepsico.com>, and many others. It is the registrant of <pepsico.com> since October 19, 1993.

The disputed domain name <pepsico-us.com> was registered on January 8, 2021 by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its “PEPSICO” trademark, as it wholly incorporates this trademark (to which it merely adds a hyphen and the geographic designation “us”). This last element is sufficient to support the finding that the disputed domain name is confusingly similar to the Complainant's trademark. Indeed, the mere adding of a geographic designation to the Complainant’s trademark does not change the overall impression of a most likely connection with the well-known trademark “PEPSICO” of the Complainant. As to the gTLD “.com”, the Complainant suggests that it should be disregarded, as per the usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name because the Respondent is not known by the disputed domain name, the Complainant is not affiliated with nor has it ever authorised the Respondent to register its trademark as a domain name and the Complainant has no business with the Respondent.

According to the Complainant, given the distinctiveness and reputation of the PEPSICO trademark, the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed way with the aim to create a likelihood of confusion with the Complainant’s trademarks and domain names, and this is evidence of the fact that the disputed domain name was registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has used the disputed domain name in order to impersonate the Complainant, a fact that by itself obviously proves use in bad faith. The latter is also substantiated, according to the Complainant, by the fact that the Respondent has a pattern of registering look-alike (toe the Complainant)

domain names.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

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).

The disputed domain name consists of the Complainant's whole trademark (PEPSICO), followed by a hyphen and the geographic designation “us”. Neither the hyphen, nor the geographic designation added to the disputed domain name is sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark of the Complainant. Actually, the geographic designation adds to the confusion, as the headquarters of the Complainant are situated in the US.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, Panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the PEPSICO trademark in a domain name, and that it had never licensed its trademark to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name. On the contrary, the Respondent has impersonated the Complainant, in a fraudulent way.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark and the fact that the disputed domain name fully incorporates this trademark, it is evident that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name has been used to impersonate the Complainant, for large amounts of money. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain name. For this Panel, such fraudulent behaviour clearly amounts to use in bad faith. Therefore, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate.

An additional bad faith element in this case is the pattern of look-alike domain name registrations that the Respondent has demonstrated.

Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain name wholly incorporates the Complainant's trademark, accompanied by the geographic designation “us” (which corresponds to the Complainant’s headquarters’ location). The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's reputable trademark. His use of the disputed domain name is in bad faith, as the Respondent has fraudulently impersonated the Complainant and as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

The Panel recommends that, in order to avoid any confusion, the name of the Respondent (currently "Pepsico") is replaced by its contact e-mail "thermofishesci@gmail.com".

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PEPSICO-US.COM**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2021-03-19

Publish the Decision