Decision for dispute CAC-UDRP-103449

Case number	CAC-UDRP-103449
Time of filing	2021-02-03 09:32:57
Domain names	BrushSync.com

Case administrator

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

Complainant

Organization	KONINKLIJKE PHILIPS N.V.

Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.

Respondent

Organization	Zhongshan Warmth Intelligent Co., Ltd. ( )

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 of International Registration No. 1418893 for BRUSHSYNC registered on July 30, 2018 designating, amongst other jurisdictions, the European Union, China, Japan, Korea, and Singapore. In particular, the designation of China was notified on August 23, 2018, with the statement of grant of protection pronounced on January 21, 2019.

FACTUAL BACKGROUND

The Complainant is a large and well-known manufacturer active in the area of healthcare products. The BRUSHSYNC registered trademark is used by the Complainant to refer to its goods that support the Complainant's technology that links between the Complainant's electric toothbrush handle and brush heads. Such technology uses an RFID chip included in the brush head.

The Respondent is a Chinese company that is in the oral care industry that markets its products under the brand name "Phoenix Smart".

The disputed domain name, <brushsync.com>, was created on June 27, 2020, and is presently inactive.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the BRUSHSYNC mark on the basis that the disputed domain name reproduces the entirety of the BRUSHSYNC mark and addition of the generic top-level domain name suffix (“gTLD”) “.com” does not change the overall impression of being connected to the BRUSHSYNC mark.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the BRUSHSYNC mark. The Complainant further argues that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services. In addition, the Respondent is not commonly known by the disputed domain name. The Complainant also argues that the Respondent is using the disputed domain name for commercial gain to misleadingly divert consumers. The Complainant further asserts that although the disputed domain name is not active, the Respondent has used e-mails hosted on the disputed domain name to create a store on Alibaba, a Chinese e-commerce website, and that the disputed domain name and an e-mail hosted on the disputed domain name are listed on products that are sold on the store on Alibaba.

The Complainant further asserts that the disputed domain name has been registered and is being used in bad faith as the Respondent should have known of the Complainant’s BRUSHSYNC mark at the time of registration of the disputed domain name. The Complainant also asserts that the Respondent has registered the domain name primarily for the purpose of disrupting the business of the Complainant, which is a competitor of the Respondent. In addition, the Complainant asserts that the Respondent is attempting to attract, for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with the Complainant’s mark as to the source, affiliation, or endorsement of the Respondent’s website or location or of a product.

RESPONDENT:

The Respondent asserts that it did not know of the BRUSHSYNC mark until it received the present UDRP dispute notification in respect of the disputed domain name, and that it had been using the disputed domain name in good faith.

The Respondent also argues that the disputed domain name had not been registered and used in bad faith. The Respondent asserts that the Complainant had failed to meet the standard of proof required. The Respondent further asserted that their use of the disputed domain name did not mislead consumers, and that the Respondent did not disrupt the Complainant’s business or created the possibility of confusion with the Complainant 's mark to attract internet users to its website or other online locations.

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.

Preliminary Issue: Language of Proceedings

Paragraph 11 of the Rules provides that:

„(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

The language of the Registration Agreement for the disputed domain name <brushsync.com> is Chinese. Although the Complainant argues that the English language agreement of the Administrator applies, it is clear from the Administrator's response and the Registration Agreement provided in the Respondent's evidence that the language of the Registration Agreement is Chinese.

The Complainant requested that, if the Registration Agreement were in any language other than English, the language of the proceeding be English for the following reasons:

(i) the Respondent is familiar with English;

(ii) the disputed domain name is in English; and

(iii) that there would be unnecessary delay of the proceedings in ordering the Complainant to translate the complaint into Chinese.

The Respondent asserts that the language of the proceeding should be Chinese and that the proceeding should be terminated for the following reasons:

(i) the language of the Registration Agreement is Chinese; and

(ii) it is neither reasonable nor fair for the Complainant to request that the Respondent reply in English because the Respondent is only familiar with basic English and not English legal language.

The Panel observes that in this proceeding, the Complainant and the Amended Complain were filed in English, and the Response was also filed in English.

The Panel cites the following with approval: "Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time, and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case." (See Groupe Auchan v. xmxzl, WIPO Case No. DCC2006 0004).

Having considered the above factors, the Panel determines that English be the language of the proceeding. The Panel finds that Respondent appears to be familiar with the English language, taking into account their selection of the English-language trademark and the domain name in dispute, the usage of English in the Respondent's online store on Alibaba, as well as the usage of English on the Respondent's products. Although the Respondent argues that they are only familiar with basic English and not legal language, the Response filed by the Respondent shows that Respondent is able to full communicate and argue his position using the English language. Under these circumstances, ordering the Complainant to translate the Complaint into Chinese would unnecessarily delay the proceedings, especially in view of the fact that the Respondent has already filed its Response articulating its arguments well in the English language.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns a registered trademark for the BRUSHSYNC mark.

The only difference between the disputed domain name and the Complainant's BRUSHSYNC trademark is the addition of a gTLD ".com".

It is established that the addition of a descriptive term would not prevent a finding of confusing similarity under the first element (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.8).

It is also established that gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11). The addition of a gTLD to a disputed domain name does not avoid confusing similarity as the use of a TLD is technically required to operate a domain name (see Accor v. Noldc Inc. WIPO Case No. D2005-0016; F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; L'Oréal v Tina Smith, WIPO Case No. 2013-0820; Titoni AG v Runxin Wang, WIPO Case No. D2008-0820; and Alstom v. Itete Peru S.A. WIPO Case No. D2009-0877).

The Respondent submitted arguments that the Complainant did not use the BRUSHSYNC mark as a trademark, that the words "BRUSH" and "SYNC" are common words, and that the combination of the words "BRUSH" and "SYNC" is not special. This is irrelevant to the first element. The Complainant holds a registration for the BRUSHSYNC mark, and Respondent has not rebutted the Complainant's assertion that it holds such rights. Therefore, the Panel finds no reason to doubt that Complainant is, in fact, the holder of the rights it claims (see WIPO Overview 3.0, Section 1.2; Actavis Group PTC ehf v. Personal Email WIPO Case No. DAE2020-0005).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the BRUSHSYNC mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, paragraph 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name.

The Complainant has stated that it is not connected or affiliated with the Respondent and did not authorise or license the Respondent to use the BRUSHSYNC mark (See OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, WIPO Case No. D2015-1149; Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).

In addition, the evidence submitted by the Complainant shows that the Respondent is not commonly known by the disputed domain name. The name of the Respondent, Zhongshan Warmth Intelligent Co., Ltd., does not bear any resemblance to the disputed domain name. In fact, the Respondent argues that the term "BRUSHSYNC" is descriptive, which strengthens the Complainant's assertion that the Respondent is not commonly known by the disputed domain name.

Conversely, the Respondent asserts that it has rights and legitimate interests in the disputed domain name based on two arguments. First, the Respondent argues that the mark "BRUSHSYNC" is generic/descriptive, arguing that "BRUSH" is commonly used in the oral care industry, "sync" is a common descriptive word, and that there is nothing special about the combination of the two words in the oral care industry. The Panel disagrees and is of the opinion that although the words "BRUSH" and "SYNC" are common words, the combination of the two words for the products sold by the Complainant under the mark is not descriptive.

Second, the Respondent also stated that it has legitimate rights because it has been using the disputed domain name since June 27, 2020, prior to receipt of notice of the dispute and in connection with its own company name and in connection with the brand name "Phoenix Smart". As indicated below in connection with the discussion of the third element, the Panel is of the view that the Respondent was aware of the Complainant's mark, was offering goods in competition with the Complainant or infringing on other rights of the Complainant using the disputed domain name on the packaging. Under the particular circumstances of this case, the use of the Respondent's name or other marks in connection with the Complainant registered trademark cannot amount to evidence of rights or legitimate interests when such use is intended for commercial gain in view of the Complainant's registered rights.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Respondent asserts that the BRUSHSYNC mark was not registered in China and that it did not know of the BRUSHSYNC mark at the time of the registration of the disputed domain name.

The Complainant provide clear evidence that the BRUSHSYNC mark was indeed registered in China at the time the disputed domain name was registered and that it had, since 2008, before the registration of the disputed domain name sold some 20 over million sets of brush-heads under the BRUSHSYNC mark in the Chinese market alone. The Respondent did not deny that it knew of the term "BRUSHSYNC" at the time of registration. Instead, the Respondent argued that the term "BRUSHSYNC" was descriptive. Taking the evidence in total, the Panel is of the opinion that, it is likely that the Respondent knew of the Complainant's BRUSHSYNC mark at the time of registration, and that the registration of the disputed domain name was targeting the Complainant.

The Complainant submitted evidence showing that the disputed domain name is confusingly similar to the Complainant's BRUSHSYNC registered trademark which the Panel finds is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. Previous UDRP panels ruled that in such circumstances "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's

site to the Respondent's site" (see Edmunds.com, Inc v. Triple E Holdings Limited, WIPO Case No. D2006 1095). To this end, prior UDRP panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the Policy.

This and more, the Complainant provided evidence showing that the Respondent has used e-mail addresses hosted on the disputed domain name in order to open an online store on Alibaba and that the disputed domain name and an e-mail address hosted on the disputed domain name are printed on products sold by the Respondent on their online store. The Complainant has further shown several similarities between the Respondent's products and the Complainant's products. The Respondent's argument that such use was for service of the Respondent's products was not supported by evidence and the Respondent did not deny that the store on Alibaba and the products sold on such store are the Respondent's. The Panel finds that such evidence also serves to indicate the bad faith registration and use of the disputed domain name by the Respondent.

The Complainant has submitted evidence that although the disputed domain name is currently inactive, the disputed domain name is used in relation to e-mail addresses used by the Respondent in relation to an online store on Alibaba and also printed on the packaging of the Respondent's products. The Complainant has also shown the packaging of the Respondent's products uses the mark "DIAMOND CLEAN", which is another trademark owned by the Complainant. The Respondent has not denied or provided any explanation of the above. The Complainant has further submitted evidence of cases in which the Respondent's products were found to infringe upon design rights owned by the Complainant. This is not denied by the Respondent, who simply stated that these cases have nothing to do with the disputed domain name as they involve design rights. However, taking a total view of all the circumstances, the Panel finds that the Respondent had the Complainant's business in mind when it registered and used the disputed domain name.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain name and the Complainant's mark, the usage of e-mail addresses hosted on the disputed domain name, and the similarities between the Respondent's products and the Complainant's products, including the use of the Complainant's additional mark, the Panel draws the inference that the disputed domain name was registered and is being 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. **BRUSHSYNC.COM**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2021-03-19

Publish the Decision