Decision for dispute CAC-UDRP-103344

Case number	CAC-UDRP-103344
Time of filing	2020-12-07 13:48:53
Domain names	coolwatercologne.com

Case administrator

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

Complainant

Organization	Zino Davidoff SA

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	guizhen Chen

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 the reputable brand COOL WATER registered as word and figure trademarks in several classes in numerous countries all over the world including in China. Trademark registrations in China:

Trademark: COOL WATER (figurative)
Registration no: 615313
Date of registration: February 4, 1994

Trademark: COOL WATER (word)
Registration no: 812386
Date of registration: October 28, 2003

FACTUAL BACKGROUND

The Complainant is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy

a high reputation. The Complainant has been using and marketing its brands for over 30 years. In 1984 the Complainant launched perfumery and cosmetics. Since then, the Complainant has been developing various products such as watches, clothing, cognac, leather goods, glasses, writing instruments, coffee etc. The business has been continuously expanding and the scope of the goods bearing the mark DAVIDOFF gets wider over time. “Cool Water” is a men's fragrance introduced in 1988 by the Complainant.

The disputed domain name <coolwatercologne.com> was registered on June 21, 2020.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

i) The Complainant has rights in the COOL WATER mark (i.e. Reg. No. 812386 registered on October 28, 2003); and the COOL WATER (figurative) mark (i.e., Reg. No. 615313 registered on February 4, 1994) through its registration of the marks with the China Trademark Office. The disputed domain name is confusingly similar to the Complainant’s trademarks.

ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name: a) the Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the COOL WATER trademark in any forms, including the disputed domain name; b) the Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name. When searched for “COOL WATER” and “cologne” in the Google and Baidu search engines, the returned results pointed to the Complainant and its business activities; and c) by the time the Complainant prepared this Complaint on 1 December 2020, the disputed domain name resolved to a website of a Chinese university, which is a copy of the genuine website of the Shao Guan University. The Respondent has not been using the disputed domain name to offer any bona fide goods or services.

iii) The Respondent has registered and is using the disputed domain name in bad faith: a) firstly, as noted in the previous paragraphs, the disputed domain name resolved to a website under construction, which falls into the category of passive holding; b) the Complainant tried to reach the Respondent by a cease-and-desist letter sent on November 6, 2020 to the Respondent’s e-mail as provided in the WHOIS and to the online form https://gdpr-masked.com. However, until the time the Complainant prepared this Complaint, it had not received response from the Respondent; and c) in terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent’s use of the disputed domain name in bad faith.

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. The Complainant has alleged that because the 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: (i) reverse WHOIS search for the Respondent's e-mail showed that the Respondent has registered at least 530 domain names, many of which are composed by English terms, which demonstrates clearly that the Respondent understands well English; (ii) by the time the Complainant sent a cease-and-desist letter to the Respondent on September 22, 2020, the disputed domain name resolved to active website displaying information of a university. The English term "university" was displayed in the upper-left corner; the English terms "copyright" and "All rights reserved" were displayed in the lower-right corner. It again demonstrates clearly that the Respondent understands well English; (iii) the disputed domain name is composed of the trademark COOL WATER in combination with English term "cologne" which are correctly spelt and therefore proves that the Respondent can understand English well. Moreover, the choice of registering and using a domain name with English terms shows that the Respondent's intention is to target Internet users who understand English; (iv) by the time the Complainant prepared the amended Complaint on 25 March 2021, the disputed domain name resolved to active website displaying gambling information. Although such information was in Chinese, in the lower-right corner the icon redirected to another domain 68497.com, where it displayed a sentence in English: "Service is not available in your region due to district restrictions. We really appreciate your support and understanding." It again confirmed the Respondent's knowledge of English; and (v) if the Complainant had to translate the Complaint's subsequent communications in Chinese, such translation would entail significant additional costs for the Complainant and delay in the proceedings.

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 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 Feb. 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 COOL WATER mark (Reg. No. 812386 registered on October 28, 2003); and the COOL WATER (figurative) mark (Reg. No. 615313 registered on February 4, 1994) through its registration of the marks with the China Trademark Office. Registration of a mark with a national trademark agency 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 marks ' COOL WATER (word)' and ' COOL WATER (figurative).'

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's trademarks on the grounds that the disputed domain name incorporates the Complainant's well-known trademark COOL WATER in combination with a term "cologne", which is closely related to the Complainant and its business activities. The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name.

The Panel agrees with the Complainant, and thus it finds that the disputed domain name is confusingly similar to the Complainant's trademark COOL WATER.

No rights or legitimate interests

The Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy, then the burden shifts to the 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 paragraph 4(a)(ii) of the Policy).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name:

i) the Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the COOL WATER trademark in any forms, including the disputed domain name;

ii) the Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name. When searched for "COOL WATER" and "cologne" in the Google and Baidu search engines, the returned results pointed to the Complainant and its business activities; and

iii) by the time the Complainant prepared this Complaint on December 1, 2020, the disputed domain name resolved to a website of a Chinese university, which is a copy of the genuine website of the Shao Guan University. The Respondent has not been using the disputed domain name to offer any bona fide goods or services.

The Panel notes that the Respondent has been identified as 'Redacted Privacy' and no information suggests that the Complainant has authorized the Respondent to use the "COOL WATER" mark in any way. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

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:

i) the disputed domain name resolved to a website under construction, which falls into the category of passive holding;

ii) the Complainant tried to reach the Respondent by a cease-and-desist letter sent on November 6, 2020 to the Respondent's e-mail as provided in the WHOIS and to the online form https://gdpr-masked.com. However, until the time the Complainant prepared this Complaint, it had not received a response from the Respondent; and

iii) in terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent's use of the disputed domain name in bad faith.

The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited

v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith).

The particular circumstances of this case that the Panel has considered are:

i) the Complainant is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation. The Complainant has been using and marketing its brands for over 30 years. In 1984 the Complainant launched perfumery and cosmetics. Since then, the Complainant has been developing various products such as watches, clothing, cognac, leather goods, glasses, writing instruments, coffee etc. The business has been continuously expanding and the scope of the goods bearing the mark DAVIDOFF gets wider over time. The Complainant's mark "Cool Water" is a men's fragrance introduced in 1988 by the Complainant. The Complainant and its trademarks enjoy a high reputation around the world due to Complainant's long-term use and publicity. Complainant has continually and heavily invested in publicizing and advertising its trademarks around the world including China where the Respondent is domiciled. As such, the Complainant's mark 'Cool Water' is considered as being a well-known and reputable trademark; and

ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith under Policy, paragraph 4(a)(iii) and that the Respondent is using 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. **COOLWATERCOLOGNE.COM**: Transferred

PANELLISTS

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

DATE OF PANEL DECISION 2021-04-28

Publish the Decision