

Decision for dispute CAC-UDRP-103671

Case number	CAC-UDRP-103671
Time of filing	2021-04-01 00:00:00
Domain names	somavedic-official.com

Case administrator

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

Organization	Somavedic Technologies s.r.o.
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Complainant representative

Organization	Linkers, advokátní kancelář, s.r.o.
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Respondent

Name	Jan Starcevic
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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

Complainant holds the following trademark registrations on the SOMADEVIC sign:

- European Union Trademark for SOMADEVIC, registration n° 015091961, dated May 25, 2016, in classes 10, 42 and 44;
- Czech Trademark for SOMADEVIC, registration n° . 350700, dated January 6, 2016, in classes 10, 42 and 44.

Complainant also specifies that it has operated the domain name <somavedic.cz> reflecting its trademark, since October 24, 2014.

FACTUAL BACKGROUND

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

The Complainant, Somavedic Technologies s.r.o., is a Czech company, incorporated on May 31, 2010, under the name Last Temptation s.r.o. The Complainant has been operating under the business name Somavedic Technologies s.r.o. since

November 7, 2014.

Since its establishment, the Complainant has been specializing in production and sale of products and devices based on the principle of controlled positive energy release into its surroundings.

In order to protect its intellectual property rights, the Complainant has registered and owns various trademark registrations for the word SOMAVEDIC including European Union Intellectual Property Office Trade Mark No. 015091961, registration date May 25, 2016, in classes (10) Medical and veterinary apparatus and instruments; Diagnostic, examination, and monitoring equipment; (42) Medical research; Medical and pharmacological research services; and (44) Professional consultancy relating to health care; Professional consultancy relating to health; Health care consultancy services [medical]; Consultation relating to bio-rhythms; Consulting services relating to health care; Health counselling; Providing health information; Providing information about dietary supplements and nutrition; Health care relating to naturopathy; Health screening. Apart from the European trademark, the Complainant has registered at Industrial Property Office of the Czech Republic and owns the Czech trademark for the word SOMAVEDIC No. 350700, registration date January 6, 2016 (with the right of priority from August 12, 2015), in classes 10, 42, 44. The Complainant has operated the domain name <somavedic.cz>, among others, reflecting its trademark, since October 24, 2014.

Alongside with the disputed domain name, the Respondent is also a registered holder of domain names <somavedic.co.uk> and <somavedic.eu>, which are subject matter of parallel proceedings. Given that the subject matter and details of these parallel proceedings are very similar to this case, it is probable that the Respondent is Jan Starcevic, born on September 22, 1980, residing at Radlická 112/22, Praha, 15000, Czech Republic. The Respondent is therefore neither affiliated with the Complainant in any way nor has he been authorized by the Complainant to use and register its trademarks, or to seek registration of any domain name incorporating said trademarks.

The disputed domain name resolves to a website on which products of the Complainant are promoted and sold. The affected website <https://www.somavedic-official.com/> is operated by Mercury Project s.r.o., a Czech company most likely wholly owned and run by the Respondent.

The Respondent's violation of law

The Domain Name <somavedic-official.com> incorporates entirely Complainant's trademark SOMAVEDIC, associated with the generic term "official", along with the ccTLD ".com" which does not prevent any likelihood of confusion. On the contrary, the use of this term increases the likelihood of confusion since they simulate the "official" domain of the Complainant. The use of these terms therefore obviously increases the likelihood of confusion with the Complainant's domain names, such as <somavedic.cz>.

Consumers searching for the Complainant's products would be likely to stumble across the disputed domain names owing to (i) the Complainant's own website and the disputed domain name <somavedic-official.com> both being very similar, differing only by added word -official and by the suffix (.cz vs .com), and (ii) the disputed domain name <somavedic-official.com> being almost identical to the registered mark SOMAVEDIC. That is a recipe for initial interest confusion.

As mentioned above, the disputed domain name resolves to a website on which products of the Complainant are promoted and sold.

The Respondent (or his subsidiary operating the affected website) did not add any note, information or disclaimer pointing out that he actually has no relationship with the Complainant.

Thus, internet users may be led into believing that the disputed domain name directs to the official website offering Complainant's products.

Since this use is clearly commercial, it cannot be considered a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Furthermore, such use cannot be qualified a bona fide offering of goods or services as it is misleading and diverting consumers, making them erroneously believe that the Respondent is authorized dealer, retailer, or re-seller of Somavedic products, and is authorized to promote sales of Somavedic products. By using the disputed domain name with intent for commercial gain without being in any way being authorized to do so, the Respondent engaged in unfair competition activities under articles 2976 et seq. of Czech Act no. 89/2012 Coll., Civil Code, in particular misleading advertising, recall a likelihood of confusion or riding on the reputation of the Complainant. At the same time, the Respondent violates the rights of the Complainant arising out of a registered trademark under Czech Act no. 441/2003 Coll, Trademarks Act.

Above all, the Complainant can document that the Complainant's customers from the United Kingdom approach the Complainant complaining that the goods ordered by them via Respondent's webpage have not been delivered. Therefore, the confusion of the internet users is evident and could be supported with actual evidence. As mentioned above, the addition of generic term "official" and the ccTLD <.com> is clearly insufficient to distinguish the disputed domain name from Complainant's trademarks.

This indicates an intention to use the disputed domain name to make a profit, or as a blocking registration or to take advantage of the Complainant's goodwill. All of these would disrupt the Complainant's business and take unfair advantage and cause detriment to it and this finding alone may be sufficient to decide that the disputed domain name in the hands of Respondent is an abusive registration.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

First, Complainant asserts that the disputed domain name to be confusingly similar to its SOMADEVIC trademarks.

Complainant holds the trademark rights on the SOMADEVIC sign:

- European Union Trademark for SOMADEVIC, registration n° 015091961, dated May 25, 2016;
- Czech Trademark for SOMADEVIC, registration n°. 350700, dated January 6, 2016.

Complainant also specifies that he has operated the domain name <somavedic.cz> reflecting its trademark, since October 24, 2014.

Complainant underlines that the disputed domain name reproduces entirely its SOMADEVIC trademark. Complainant notes that the addition of the generic term 'official' or the ccTLD '.com' may not neutralize the risk of confusion between the disputed domain names and trademarks. Complainants further argues that the term 'official' may on the contrary increase the likelihood of confusion as it implies that it is this official domain of Complainant. As a result, Complainant considers that consumers looking for its products will be confused.

Complainant claims that Respondent was neither affiliated with or authorized by Complainant to use and register its trademarks or to register any domain name reproducing its trademarks.

Despite this lack of authorization, Complainant claims that Respondent has been operating the disputed domain name to promote and sell products of Complainant.

Moreover, Complainant underlines that Respondent did not add any note, information or disclaimer clarifying that he is not related with Complainant in any way. As a result, consumers might think that the disputed domain name resolves to

Complainant's website.

Besides, Complainant considers that Respondent is not making a fair or non-commercial use of the disputed domain name as its use is commercial. Also, Complainant asserts that Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services either because it is engaging in unfair competition activities. According to Complainant, Respondent is using the disputed domain name to mislead and divert consumers, to its website, by implying that believe it is affiliated with or authorized by Complainant to promote its products.

Finally, Complainants comes down to the conclusion that Respondent uses the disputed domain name merely to make a profit, as a blocking registration, or to take advantage of its goodwill.

RESPONDENT:

Respondent is Jan Starcevic. Respondent did not provide any response to this complaint and is therefore in default.

RIGHTS

Paragraph 4(a) of the Policy requires the Complainant to prove three elements in order to the transfer of the disputed domain name:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Complainant has shown that he has trademarks rights on the SOMADEVIC sign in the European Union and in Czech Republic. This is sufficient to establish rights in a mark in accordance with Policy 4(a)(i). A well-established case law states that trademark registration in a single jurisdiction is generally sufficient to show Complainant's rights. For recent case law, see ACINDAR INDUSTRIA ARGENTINA DE ACEROS S.A. v. Sandeep Rangu, Case n° 102400 (CAC March 19, 2019), " To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001)); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark ACINDAR".

Complainant claims that the disputed domain name is confusingly similar to its SOMADEVIC trademark as it reproduces the latter mark entirely. Complainant further notes that the addition of the generic term "official" and of the gTLD <.com> do not prevent any likelihood of confusion between a disputed domain name and Complainant's trademark. Under Policy 4(a)(i), generic terms as well as top-level domains are indeed generally insufficient to neutralize the risk of confusion between a disputed domain name reproducing a mark in its entirety and Complainant's marks. For recent case law, see Avast Software s.r.o. v. Pham Dinh Nhut, Case n° 102373 (CAC April 29, 2019) « The disputed domain name <avastsupport.com>, as it reproduces the trademark in its entirety, with the mere addition of the discribing suffix "support" and the generic Top-Level Domain ".com", which is usually disregarded in the assessment of confusing similarity is considered to be confusingly similar to the relevant mark for purposes of the first element. »

The Panel estimates that the disputed domain name is causing confusion with Complainant's trademark, since it reproduces entirely its trademark with the mere addition of the generic term "official" and the top-level domain <.com>. As asserted by Complainant, the addition of the term "official" actually enhances the risk of confusion as it implies that Respondent is related to

Complainant.

Therefore, the Panel finds that Complainant has satisfied Policy 4(a)(i).

NO RIGHTS OR LEGITIMATE INTERESTS

Consistently with a long-standing case law, Complainant must make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), the burden then shifts to Respondent. For recent case law, see *Intesa Sanpaolo S.p.A. v. Abayomi Ajileye*, Case n° 102396 (CAC March 19, 2019), « It is a consensus view of UDRP panels that the Complainant shall 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 (see paragraph 2.1 of the WIPO Overview 3.0: "where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element"). »

Complainant alleges that Respondent was neither affiliated with nor authorized by Complainant to use and register its trademarks or to register any domain name reproducing its trademarks. Complainant further claims that Respondent has been operating the disputed domain name to promote and sell products of Complainant without clarifying that he was not related with Complainant in any way. This is generally considered as evidence that Respondent does not have rights nor legitimate interests in the disputed domain name, see *ARCELOMITTAL (SA) v. Milton Liquors ILC*, Case n° 102360, (CAC April 11, 2019) « In the absence of any Response, or any other information from the Respondent indicating the contrary, the Panel further holds that the Complainant successfully presented its prima facie case and that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, the Respondent is not affiliated with nor authorized by the Complainant in any way, and it is not related in any way to the Complainant's business. » The Panel agrees and considers that Respondent is not related in any way to Complainant and that it should have disclaimed on its website that it was not linked to Complainant's business. As a result, the Panel finds that Respondent has no rights nor legitimate interests in the disputed domain name within the meaning of Policy 4(a)(ii).

Besides, Complainant considers that, by misleading and diverting consumers to its website for commercial gain, Respondent did not make any fair or non-commercial use of the disputed domain name and did not use the disputed domain name in connection to a bona fide offering of goods and services. Such activities on a disputed domain name are indeed generally considered by previous panels as evidence that Respondent is not making a fair or non-commercial use of the disputed domain name and that the disputed domain name is not used in connection to any bona fide offering of goods or services, see *SANDRO ANDY v. Lucy Barton*, Case n° 102311 (CAC March 6, 2019) « 2. The Complainant stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent might have been commonly known by the disputed domain name or by a name corresponding to the disputed domain name. According to the evidence on records, the Respondent has pointed the disputed domain name to a website featuring the Complainant's trademark SANDRO and offering for sale purported SANDRO products along with competitors' goods, without providing any accurate disclaimer as to the lack of affiliation with the Complainant and generating the impression that the website is operated by, or affiliated with, the Complainant. Therefore, the Panel finds that the Respondent's use does not meet the conditions set forth in the decision *Oki Data Americas, Inc. v. ASD, Inc.* WIPO Case No. D2001-0903 (the so-called "Oki data test") for a reseller to succeed in claiming to be making a bona fide offering of goods or services under a disputed domain name. Moreover, the use of the disputed domain name described above clearly does not amount to a legitimate non-commercial or fair use. Therefore, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name and that, by not submitting a Response, the Respondent has failed to rebut the Complainant's prima facie case. » Consequently, the Panel finds that Respondent does not use the disputed domain name in connection to a bona fide offering of goods and services nor make a fair or non-commercial use of the disputed domain name.

The Panel therefore conclude that Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name and has therefore satisfied Policy 4(a)(ii).

BAD FAITH

Complainants comes down to the conclusion that Respondent uses the disputed domain name in bad faith to make a profit, as blocking registration, or to take advantage of the its goodwill. In similar circumstances, previous panels have considered the registration of the disputed domain name to be done in bad faith, see O'Neill Brand S.à r.l v. Pan Chen, Case n° 102363 (CAC April 15, 2019) « The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b)(iv) of the Policy and probably within other provisions of paragraph 4(b).

That is so because the evidence leads to the conclusion that the Respondent has registered the disputed domain name intentionally to attempt to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's trademarks. That must be so because its website clearly promotes goods that purport to be the famous O'Neill goods, but which are unauthorised and which may well be counterfeit. In any event the Respondent is not authorised to sell goods under that name. The conduct is therefore particularly brazen and illegal and the Respondent must be taken to have registered and used the domain name in bad faith. » Consistently, the Panel finds that Respondent uses the disputed domain name in bad faith.

The Panel finds that Complainant has satisfied Policy (4)(a)(iii).

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 Panel ultimately considers that:

Complainant holds valid registrations for the SOMADEVIC trademarks. The disputed domain name is reproducing Complainant's trademark in its entirety. Complainant made a prima facie case that Respondent lacks legitimate rights or legitimate interests in the disputed domain name. Complainant has established that Respondent registered and uses 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. **SOMAVEDIC-OFFICIAL.COM**: Transferred

PANELLISTS

Name	Nathalie Dreyfus
DATE OF PANEL DECISION	2021-05-14
Publish the Decision	