

Decision for dispute CAC-UDRP-103722

Case number CAC-UDRP-103722

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Domain names ikeadubaionline.com

Case administrator

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

Complainant

Organization Inter IKEA Systems B.V.

Complainant representative

Organization Convey srl

Respondent

Name mahran bahi

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 claims rights on several trademark registrations, such as:

- The registered German word mark IKEA No DE867152 of March 12, 1970 for goods and services in the class 20;
- The registered US figurative mark IKEA No 1118706 of May 22, 1979 for goods and services in the classes 11, 20, 21, 24, 27;
- The registered US word mark IKEA No 1661360 of October 22, 1991 for goods and services in the classes 2, 18, 25, 29, 30, 31, 35, 36, 39, 41;
- The registered EU word mark IKEA No 000109652 of October 1, 1998 for goods and services in the classes 2, 8, 11, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 35, 36, 39, 41, 42;
- The registered EU figurative mark IKEA No 000109637 of October 8, 1998 for goods and services in the classes 2, 8, 11, 16,

18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 35, 26, 39, 41, 42;

- The registered international mark figurative No 926155 of April 24, 2007 for goods and services in the class 16, 20, 35, 43 designating also China;
- The registered Italian word mark IKEA No 0001257211 of March 12, 2010 for goods and services in the class 20;
- The registered Italian word mark IKEA No 0001300174 of June 3, 2010 for goods and services in the class 21.

The Complainant does not provide any evidence regarding the registered US word trademark IKEA No 1661360.

It does not prove either the renewal of the two Italian word trademarks IKEA No 0001257211 and No7. 0001300174.

The provided exhibits are dated March 2020 and the Panel had to check the current status of the other cited trademarks, which are indeed valid.

The disputed Domain Name is:

- <ikeadubaionline> created on March 9, 2020.

FACTUAL BACKGROUND

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

The Complainant is the worldwide IKEA franchisor and responsible for developing and supplying the global IKEA range. IKEA is one of the most well-known home furnishing brands in the world with more than four hundred stores, whilst all the IKEA Group has roughly 220,000 employees worldwide reaching more than fifty markets and almost a billion of visitors per year.

IKEA was founded in 1943 and is named after the initials of its founder Ingvar Kamprad, Elmtaryd, the farm on which he grew up, and Agunnaryd, the nearby village. In 1980s, IKEA became popular in new markets such as USA, France and the UK.

The IKEA website www.ikea.com was launched in 1997.

Nowadays, the Complainant holds trademark registrations in more than 80 countries around the world and the IKEA trademark has been extensively promoted, without limitation, in print advertisements, promotional materials, Internet forums acquiring a high international recognition.

The Complainant has also registered more than 441 Domain Names under generic Top-Level Domains ("gTLDs") and 294 Domain Names under country code Top-Level Domains ("ccTLDs") – among which are <ikea.com>, <ikea.net>, <ikea.us>, <ikea.cn>, <ikea.de>, <ikea.it>, <ikea.co.uk>.

The disputed domain name <ikeadubaionline.com> was registered by the Respondent on March 9, 2020.

The Registrant provided in the Whois contact details the e-mail address "ikeadubai786@gmail.com".

The disputed domain name pointed to a website hosting IKEA related content, passing off as the official website of INTER IKEA SYTEMS B.V.'s franchisee in the United Arab Emirates (UAE). It reproduced a picture of the IKEA shop, reproducing the IKEA trademark and imitating the landing page of the official IKEA website related to Dubai.

On July, 6, 2020, the Complainant sent a cease and desist letter to the Respondent's e-mail address indicated on the Whois. The Respondent did not answer either to this first e-mail or to the second e-mail sent on November, 24, 2020, asking the

Respondent to refrain using the disputed domain name and to transfer it to the Complainant.

As of December 2020, the disputed domain name was redirected to a website that was no longer showing such scam IKEA related content, but it was still active and used for commercial purposes hosting Google Ads linked to third party websites/content.

Later, the disputed domain name resolved to a website presenting videos.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Confusing similarity

The Complainant submits that the disputed domain name <ikeadubaionline.com> is confusingly similar to its IKEA trademarks.

The Complainant contends that the addition of both the geographical term "dubai" and descriptive term "online" after the word "ikea" does not reduce the high degree of similarity with the Complainant's trademarks IKEA and is therefore undoubtedly confusingly similar. Plus, the disputed domain name reproduces the Complainant's IKEA trademark.

Right or legitimate interest

The Complainant contends that no evidence suggests that the Respondent has been commonly known by the disputed domain name or a name corresponding to the disputed domain name or by any IKEA trademark as an individual, business, or other organization.

It asserts that it did not grant any license or authorization to the Respondent.

The use of the word IKEA in the disputed domain name which is an acronym without meaning and completely original excludes any possibility of bona fide reference to Complainant's services or legitimate non-commercial or fair use of the disputed domain name.

The Complainant contends that the Respondent has registered the disputed domain name, which is confusingly similar to the Complainant's IKEA trademark, to trade upon IKEA trademark reputation, since the disputed domain name was at first connected to a page that was hosting IKEA related content.

The Complainant claims that the Respondent has nothing to do with INTER IKEA SYTEMS B.V.'s franchisee "Al-Futtaim" in United Arab Emirates, nor with the 5 official stores in UAE. Furthermore, the IKEA trademark is widely used in both UAE and in Pakistan as well, i.e. in the country where the Respondent is domiciled, according to the disclosed Whois data.

Bad faith

The Respondent uses the disputed domain name in bad faith by attempting to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's IKEA trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website or location or of a product or service on such web site or location.

The Respondent's registration and use of the disputed domain name indicates that such registration and use was done for the specific purpose of trading on the name and worldwide reputation of the Complainant and its IKEA trademark.

RIGHTS

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

The Complainant has submitted evidence of its prior registered IKEA trademarks which are protected in several countries worldwide.

The disputed domain name entirely incorporates the Complainant's IKEA trademark.

The addition to the IKEA trademark of the denomination "dubaionline", composed with the geographical term "dubai" and the descriptive term "online" does not exclude any likelihood of confusing similarity.

The Complainant has, to the satisfaction of the Panel, shown that 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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed Domain Name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the Respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial 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.

The Respondent did not respond to the Complaint. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain name.

The Respondent is not related in any way with the Complainant nor has ever been authorized by the Complainant to use the IKEA trademark to register the disputed domain name. There is no indication that the Respondent is commonly known by the term "IKEA", or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent's lack of rights or legitimate interests in relation to the disputed domain name, which the Respondent has not rebutted.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad

faith registration and use of the disputed domain name.

It provides that:

“For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

- (i) circumstances indicating that the Respondent has registered or the respondent has 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 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 your website or other on-line 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 Respondent uses the Complainant’s trademarks years after the Complainant obtained its trademark registrations, including in UAE and Pakistan where the Respondent is domiciled.

Given the Complainant’s long established and widespread use of its IKEA trademark in several countries of the world, its worldwide reputation in the sector of furniture, as indicated in several UDRP decisions and its presence on the Internet through its own websites such as <ikea.com>, the Panel finds that the Respondent was well aware of the Complainant’s rights on the IKEA trademarks when it registered the disputed domain name.

The Registrant mentioned in the Whois contact details the e-mail address ikeadubai786@gmail.com, which shows that it wanted to appear as a local IKEA agent in Dubai.

The Respondent was of course well aware of the worldwide well-known IKEA trademark when it registered the disputed domain name.

The Respondent didn’t either answer any of both cease and desist letters sent by the Complainant, nor answered to the complaint.

It first used the disputed domain name to give access to a website dedicated to IKEA in Dubai, reproducing the IKEA trademark and imitating the IKEA landing page

The produced evidence of this first use does not mention the address of the website.

After it received the cease and desist letters sent by e-mail, the Respondent took down the website dedicated to IKEA in Dubai and the disputed domain name resolved to a website presenting videos and then to a website presenting software.

This use cannot be regarded as a good faith use.

The Panel finds that, according to Par. 4(b) (iv) of the Policy “by using the Domain Name, the Respondent has intentionally

attempted to attract, for commercial gain, Internet users to your website or other on-line 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 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.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name incorporates the worldwide well-known IKEA trademark.

The addition of the geographical and generic terms "Dubai" and "online" do not avoid any likelihood of confusion.

It has been used to point to a website presented as the IKEA website in Dubai.

The Complainant has established a prima facie case of the Respondent's lack of rights or legitimate interests in relation to the disputed domain name, which the Respondent has not rebutted.

The Respondent was well aware of the IKEA trademark when it registered the disputed domain name.

He wanted to target the IKEA trademark.

Its use of the disputed domain name to give access to a page imitating the official IKEA website in Dubai is a bad faith use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IKEADUBAIONLINE.COM**: Transferred

PANELLISTS

| | |
|------|--------------------------------------|
| Name | Marie-Emmanuelle Haas, Avocat |
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DATE OF PANEL DECISION **2021-05-17**

Publish the Decision
