

Decision for dispute CAC-UDRP-103785

Case number	CAC-UDRP-103785
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Time of filing	2021-05-12 10:41:21
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Domain names	mypepsico-usa.com
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Case administrator

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

Organization	PepsiCo, Inc.
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Complainant representative

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

Organization	Pepsico inc
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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

The Complainant is the owner of the following trademark registrations for the sign “PEPSI” (the “PEPSI trademark”):

- the United States trademark PEPSI with registration No. 824150, registered on 14 February 1967 for goods in International Class 32, with first use in commerce on 21 November 1911;
- the United Kingdom trademark PEPSI with registration No. UK00000978461, registered on 29 July 1971 for goods in International Class 32; and
- the European Union trademark PEPSI with registration No. 000105247, registered on 28 October 1998 for goods in International Classes 25 and 32.

The Complainant is the owner of the following trademark registrations for the sign “PEPSICO” (the “PEPSICO trademark”):

- the United States trademark PEPSICO with registration No. 3026568, registered on 13 December 2005 for goods in International Classes 14, 16, 18, 20 and 25;
 - the United Kingdom trademark PEPSICO with registration No. UK00000992395, registered on 19 May 1972 for goods in International Class 30; and
 - the European Union trademark PEPSICO with registration No. EU013357637, registered on 13 March 2015 for goods and services in International Classes 16, 29, 30, 32, 35, 36 and 41.
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FACTUAL BACKGROUND

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

The Complainant's product portfolio includes a wide range of foods and beverages, including 23 brands, such as the flagship PEPSI brand, that generate more than USD 1 billion each in estimated annual retail sales. The products of the Complainant and its consolidated subsidiaries are enjoyed by consumers more than one billion times a day in more than 200 countries and territories around the world. In 2019, the Complainant generated more than USD 67 billion in net revenue.

The Complainant is also the owner of the domain names <pepsi.com>, <pepsico.com>, <mypepsico.com>, and many others.

The Respondent registered the disputed domain name on 28 April 2021. It is currently inactive.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that PEPSI, PEPSICO, and PEPSI-COLA are famous and well-known marks, and PEPSI is one of the world's most recognized consumer brands globally. It has been used for soft drinks since 1911 as a shortened version of the PEPSI-COLA mark that first denoted the Complainant's soft drinks in 1898.

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's PEPSICO mark, because it incorporates it together with the weak possessive pronoun "my", a hyphen, and the abbreviation for the United States of America, where the Complainant is headquartered.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant submits that it has never authorized the Respondent to use the PEPSICO trademark and the Respondent is not commonly known by the disputed domain name. The Respondent had knowledge of the Complainant's fame, name, and activities, because it masqueraded as the Complainant, using its corporate address, to register the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The structure of the disputed domain name and the use by the Respondent of the Complainant's corporate address and identity to register it show that the Respondent had the Complainant's business in mind when it registered the disputed domain name, and that the Respondent tried to benefit from reputation of the Complainant in an attempt to intentionally attract, for commercial gain, Internet users to its website or other on-line location by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Respondent's website or on-line location.

According to the Complainant, the fact the website does not resolve currently to an active website is immaterial as even a respondent's failure to make an active use of a domain name may satisfy the requirements of paragraph 4(a)(iii) of the Policy. In this case, the Registrar suspended the disputed domain name due to violation of its terms of service because the Respondent

used the Complainant's identity and corporate address to identify itself as part of the registration of the disputed domain name. The submission of false and misleading contact details supports bad-faith registration and use of the disputed domain name, particularly where the identity of the Complainant is abused.

The Complainant further submits that it may fairly be presumed that the disputed domain name is part of a pattern by the same threat actors of registering look-alike domains with the Registrar to send fraudulent emails targeting the Complainant's vendors in an attempt to attack its supply chain for ill-gotten gain. The disputed domain name is almost identical to the domain name <pepsico-usa.com> that was subject to CAC Case No. 103670. That domain name was also registered with the Registrar and its registrant was masquerading as the Complainant to register it using the Complainant's corporate address.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

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.

PRINCIPAL REASONS FOR THE DECISION

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ...”

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the PEPSI and PEPSICO trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence “mypepsico-usa”, which reproduces the well-known PEPSI and PEPSICO trademarks with the addition of the word “my”, a hyphen, and the abbreviation for the United States of America, which addition has a low effect on the overall impression made by the disputed domain name, in which the PEPSI and PEPSICO trademarks are easily distinguishable and dominating. As discussed in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “WIPO Overview 3.0”), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element of the Policy.

Taking the above into account, the Panel finds that the disputed domain name is confusingly similar to the PEPSI and PEPSICO trademarks in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent was not authorized to use the PEPSI and PEPSICO trademarks and is not commonly known under the disputed domain name. The Complainant also points out that the Respondent has masqueraded as the Complainant when registering the disputed domain name by using its name and address. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not disputed the Complainant’s contentions.

The Panel finds that the evidence in the case file supports the prima facie case made by the Complainant. The disputed domain name incorporates the well-known PEPSI and PEPSICO trademarks, and the contact details provided by the Respondent to the Registrar are identical to those of the Complainant. In the lack of any arguments or evidence to the contrary, this leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant’s PEPSI and PEPSICO trademarks, has registered the disputed domain name targeting these trademarks in an attempt to exploit their goodwill by confusing and attracting Internet users who may believe that the disputed domain name is affiliated to the Complainant. In the Panel’s view, such conduct may not give rise to rights and legitimate interests of the Respondent in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

- “(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

As discussed in the section on rights and legitimate interests, the disputed domain name incorporates the well-known PEPSI and PEPSICO trademarks, and the contact details provided by the Respondent to the Registrar are identical to those of the Complainant. In the lack of any arguments or evidence to the contrary, this leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant’s PEPSI and PEPSICO trademarks, has registered the disputed domain name targeting these trademarks in an attempt to exploit their goodwill by confusing and attracting Internet users who may believe that the disputed domain name is affiliated to the Complainant.

The disputed domain name is inactive, but in the absence of an authorization by the Complainant, and in view of the fact that the Respondent has not provided any plausible explanation of its choice of domain name and why it has provided to the Registrar the Complainant’s contact details as its own, the Panel is not aware of any good faith use to which the disputed domain name may be put, and there is risk that it may be used for fraudulent activities. Therefore, the non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the WIPO Overview 3.0.

This satisfies the Panel that the disputed domain name has been registered and 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. **MYPEPSICO-USA.COM**: Transferred

PANELLISTS

Name	Assen Alexiev
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DATE OF PANEL DECISION	2021-06-15
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Publish the Decision
