

Decision for dispute CAC-UDRP-103826

Case number	CAC-UDRP-103826
Time of filing	2021-05-25 09:36:11
Domain names	magicscotch-new.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	3M Company
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Complainant representative

Name	JUDr. Jiří Čermák advokát
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Respondent

Organization	AB Cloud Group Ltd
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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 registered scotch trademarks, e.g US verbal trademark SCOTCH, Reg. No. 0805065, registered for goods in class 9, registration date August 3, 1966;

The EU verbal trademark SCOTCH, Reg. No. 2900884, registered for goods in classes 16 and 17, registration date June 14, 2002;

The EU verbal trademark SCOTCH, Reg. No. 3201671, registered for goods in classes 8, 16 and 17, registration date December 23, 2002;

Further he registered verbal trademarks „magic“. The EU verbal trademark MAGIC, Reg. No. 5175849, registered for goods in class 16, registration date April 1, 2008.

Both are active and were registered before the Respondent registered the disputed domain name.

The Complainant also provided evidence that it owns a domain name containing the names “scotch“ and “magic“, registered well before the Respondent registered the disputed domain name.

FACTUAL BACKGROUND

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

The Complainant is an industrial and consumer product company based in St. Paul, MINNESOTA, USA. The Complainant has been manufacturing adhesive tapes under the brand "Scotch" and "Magic Scotch" since 1930s when the Complainant's engineer developed the first sample of the transparent sticky tape and Scotch masking tape that later evolved into their current forms. Universality of the "Scotch tape" was recognized very early and earned confidence among the consumers turning it into an indispensable item for every household, firstly in the USA, later around the world.

The Respondent is a Company on the Seychelles, using a hidden domain holder name, who is represented by his Registry which is based in Cyprus. The disputed domain name was registered on August 29, 2019 and contains a website that offers for sale and sells "Magic scotch tape" with double sided adherence. This product is not an original Complainant's product and bears the Complainant's trademarks without authorization from the Complainant as the Trademarks owner.

The Complainant, represented by JUDr. Jiří Čermák, filed the Complaint against the Respondent claiming that the Respondent registered the disputed domain name without rights or legitimate interest and in bad faith. Therefore, the registration should be declared abusive and the disputed domain name transferred to the Complainant.

The Respondent didn't react to the Complainant's contentions.

For legal reasoning, please see Principal Reasons for the Decision.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

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

The Panel finds that the disputed domain name magicscotch-new.com is confusingly similar, partially identical to the trademarks of the Complainant.

The Complainant asserted and proved that the Respondent tried to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademarks, see eg. CAC Case No. 102913 Bollloreusa.com. The Complainant rightfully contended that the first word of magicscotch-new.com is identical to the prior trademark „MAGIC“ of the Complainant. Further he rightfully contended that the second word of magicscotch-new.com is identical to the prior trademark „SCOTCH“ of the Complainant. The Complainant also referred to the distinctiveness and reputation of its SCOTCH trademarks. Further the term „new“ in the disputed domain name is descriptive and not distinctive. The addition of the gTLD „.com“ do not add any distinctiveness to the disputed domain names.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Further it argues that the Respondent is not related to the Complainant.

Moreover, the Complainant contends and provides evidence that the disputed domain name resolves to a website that offers adhesive tapes in competition with the Complainant. The Complainant further rightfully contends that the Respondent has not developed a legitimate use in respect of the disputed domain name. Competing use is not considered a bona fide offering of goods or services, nor a legitimate non-commercial or fair use. The Complainant contends that the Respondent was seeking to use the disputed domain name only to divert consumers to its own website with buttons links named "buy", "sale" and "order" and that the Respondent has no legitimate interests in respect of the disputed domain name. Reference is made to: CAC case N° 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - <dulcolax.xyz> and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

This makes it highly unlikely that the Respondent had no knowledge of the Complainant's prior trademark rights at the time of registration of the disputed domain name. The Complainant rightfully contended that the Respondent has used the disputed domain name intentionally to attract visitors for commercial gain by creating confusion with the Complainant's trademarks, and that the Respondent has used the disputed domain name with that intention, namely in bad faith. Had the Respondent wanted to present a bona fide criticism site then it would have been well advised to have included some negative modifier in its domain name and to have restricted itself to objective and reasoned criticism on its website. This is a clear evidence of registration of the domain names in bad faith, see in this concern, Halifax Plc. v. Sontaja Sanduci, WIPO Case No. D2004-0237 and also CarrerBuilder LLC v. Stephen Baker, WIPO Case No. D2005-0251. Furthermore, the Respondent is using a hidden identity. But this argument is not to be discussed further because bad faith is evident, whatsoever.

Accordingly, the Panel finds that the disputed domain name was both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MAGICSCOTCH-NEW.COM**: Transferred

PANELLISTS

Name	Dr. jur. Harald von Herget
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DATE OF PANEL DECISION	2021-06-28
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Publish the Decision
