

Decision for dispute CAC-UDRP-103855

Case number CAC-UDRP-103855

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Domain names filehippo.com

Case administrator

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

Complainant

Organization FileHippo s.r.o.

Complainant representative

Name Rudolf Leška

Respondent

Name Nicole W. Hawkins

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 relies on the following registered trademarks:

- EU registered trademark no. 8893745 for the word mark "FILEHIPPO" registered for various goods and services in classes 9, 35 and 42 with a priority date of 18 February 2010;
- UK registered trademark no. 2514818 for the word mark "FILEHIPPO" registered for various goods and services in classes 9, 35 and 42 with a priority date of 28 April 2009;
- US registered trademark no. 6024355 for the word mark "FILEHIPPO" registered for various goods in class 9 with a priority date of 18 December, 2018.

The Complainant also refers to use of the mark "FILEHIPPO" since 2004 by its predecessor and itself for a website at www.filehippo.com providing legitimate downloadable copies of the latest versions of the best free software, as well as information and news about software.

FACTUAL BACKGROUND

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

Jurisdictional Basis for the Administrative Proceeding

This dispute is properly within the scope of the Policy and the Rules. Therefore, the Administrative Panel (Panellist) has jurisdiction to decide this dispute.

Factual and Legal Grounds

Language of the proceeding

In accordance with the para. 11 of the Rules, the language of this proceeding shall be English. English is also the language of the Registration Agreement which is available at the Registrar's website. Moreover, the website under the disputed domain name <filehippo.com> is only in English version which indicates that the Respondent targets global audience and prefers communication in English.

The Complainant and its rights

The Complainant is holder of the domain name <filehippo.com> created on November 1, 2004 which is curated software download site focused on highest quality freeware. It has a section that contains a list of most recently updated computer programs, and another section which lists the most popular downloads. The computer programs are organized into categories and the Complainant's website contains information about computer programs as well as articles containing recent technology news. The aim of the website is to provide users with the simplest legal method of downloading the newest versions of the best software. The customers can also download Complainant's software "FileHippo App Manager" which is a great application that keeps computer system up-to-date. It scans a computer for installed applications, checks the versions and then sends this data to FileHippo.com to ascertain if there are any newer releases available. If there are any new releases, these are then neatly displayed in browser window for download. Its popularity on the market and high quality is supported by the fact that it acquired many awards on websites that compare and evaluate software and applications.

Furthermore, the Complainant is the owner of, inter alia, the following trademarks all of which are registered also for software, freeware, installation, maintenance of software:

- registered EU word mark "FILEHIPPO" no. 008893745 for goods and services in the class 9 (software, freeware and shareware programs), 35 (retail services connected with the sale of computer software and upgraded software) and 42 (design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software) with priority from February 18, 2010;
- registered UK word mark "FILEHIPPO" no. UK00002514818 for goods and services in the class 9 (software, freeware and shareware programs), 35 (retail services connected with the sale of computer software and upgraded software) and 42 (design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software) with priority from April 28, 2009;
- registered US word mark "FILEHIPPO" no. 6024355 for goods and services in the class 9 (computer software for use in browsing the internet, messaging and chat, anti-malware, and networking; computer software for use in browsing the internet, messaging and chat, anti-malware, and networking that may be downloaded from a global computer network; computer freeware and shareware programs for browsing the internet, messaging and chat, anti-malware, and networking, computer software for filtering and removing viruses from a computer; computer servers for web hosting; all of the aforesaid software is in downloadable form), with priority from December 18, 2018.

Domain <filehippo.com> as well as FileHippo software was firstly operated by the company Media Limited which transferred its right to the company Avast Software s.r.o. which transferred FileHippo business to the Complainant on the basis of Intellectual Property Assignment Agreement concluded on December 10, 2017.

This dispute concerns the domain name <filehippo.com> registered by the Respondent on August 19, 2017. It follows that the domain name was registered with the knowledge of older above-mentioned trademarks of the Complainant. The website under the disputed domain name is used by the Respondent as a website providing evaluations about various software, games, applications and programs as well as offering those for download. It follows that the purpose of the website operated under the disputed domain is similar to the purpose of the Complainant's official website filehippo.com, however unlike the Complainant, the Respondent does not have any license for the distribution of the offered software, applications, programs and games for download. Most importantly, the Respondent provides these download services under the Complainant's trademark without the Complainant's authorization.

The Respondent places Complainant's mark prominently on every page of the disputed domain name and in the same way as the Complainant does on his official website. The Respondent uses colour combination of light blue and white on the top of his website, particularly for the tab menu, which is the same colour combination as the one used by the Complainant for his trademark and logo. Moreover, the Respondent uses the Complainant's logo as the favicon for the disputed domain name. The Respondent's knowledge of Complainant's mark and website is therefore evident. As the Respondent offers many different software and program applications for download under disputed domain name, there is no reason why the disputed domain name should include the Complainant's trademarks and logo, except of clear Respondent's intention to parasitize on the Complainant's good reputation.

The domain name <filehippo.com> is confusingly similar to the Complainant's trade and service marks "FILEHIPPO" (both statutory and common law) named above, the Respondent has no rights or legitimate interests in respect of the <filehippo.com> domain name which has been registered and is being used in bad faith.

A. The disputed domain name is confusingly similar to the Complainant's trademarks

The Complainant's trademarks "FILEHIPPO" has no generic meaning in common English or in any other language. It consists of two words "FILE-" (meaning suite) and "HIPPO" (meaning abbreviation for hippopotamus which is depicted in Complainant's logo). The Complainant's trademarks are thus not descriptive and highly distinctive. The Complainant, its trademarks, logo and domain have been well known amongst Internet users since 2004. The marks and associated domain have been continuously used for over 17 years. They have therefore acquired goodwill and gained a reputation amongst consumers in relation to the products and services for which the marks are registered. This has been previously established by the panel in WIPO Case No. D2015-1327, Media Limited v. TechShaper Domains (the complaint was filed by predecessor of the Complainant) and confirmed in the recent UDRP case no. 102279 (regarding the domain <filehippoa.com>) in which panel concluded that the Complainant's "FILEHIPPO" trademarks have significant reputation and is of distinctive character. The well known and good reputation was confirmed by the Panel in a recent decision from 2021 UDRP case no. 103553 (regarding the domain name <filehippo.digital>).

Based on a large number of the users of the Complainant's services, it can be assumed that the Complainant's name and trademark FILEHIPPO is automatically connected with the Complainant by an ordinary customer. The Complainant has almost 165,000 followers on Facebook. According to the records of SimilarWeb, which tracks the traffic of internet websites, the Complainant's domain filehippo.com is monthly visited by more than 3.8 million visitors. Such large number of the visitors supports the distinctive character of the Complainant's marks and popularity of the services provided by the Complainant.

The domain name registered by the Respondent <filehippo.com> is confusingly similar to the Complainant's registered trademarks for the following reasons.

The Complainant's mark "FILEHIPPO" is reproduced in the disputed domain name almost without any modification. The only difference is the barely noticeable addition of the letter "i" between the two words that make up the Complainant's trademark FILEHIPPO, namely between the letter "e" and "h" in the following manner: "FILEIHIPPO". This misspelling is hardly noticeable and results in a very minor modification of the Complainant's trademark, being a common mistake that any Internet user can make when searching for Complainant's website, particularly where this added letter "i" is in very close proximity on majority of keyboards to letter "h" which follows it within the disputed domain name. Respondent's use of the disputed domain name is a blatant example of typo squatting within the meaning of section 1.9. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") which states which states that "a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element." Typo squatting is a form of piracy aimed at capitalizing on spelling mistakes. The practice of typo-squatting intentionally takes advantage of Internet users that inadvertently type an incorrect address when seeking to access the Complainant's website. It has been previously established by a panel in *Government Employees Insurance Company v. Domain Administrator, Fundacion Privacy Services Ltd.*, Case No. D2018-2527, that from the perspective of the average customer, the addition of one letter, in this case "i", would constitute common, obvious misspelling, which is not capable of changing the overall impression and does not eliminate the confusing similarity with the older trademarks of the Complainant. This is even more so in a situation where the Respondent offers software, applications and other programmes for download under the disputed domain name and where the disputed domain name imitates certain characteristics of the Complainant's official website (such as the colour combination of light blue and white in the main tab menu, the favicon as well as the same font and style of the trademark name).

Similarly, numerous prior panels have held that the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other letters to such marks. (e.g. *EAuto, L.L.C. v. EAuto Parts*, WIPO Case no. D2000-0096; *Caterpillar Inc. v. Off Road Equipment Parts*, WIPO Case no. FA0095497).

It is well established that the specific top level of a domain such as ".com", ".tv", ".digital" or ".org" does not affect the domain name for the purpose of determining the identity or similarity of domain name and a trademark (*Magnum Piercing, Inc. v D. Mudjackers and Garwood S. Wilson, Sr.* WIPO Case No. D-2000-1525; *Hugo Boss A.G. v. Abilio Castro*, WIPO case No. DTV2000-0001; *Radale Inc. v. Cass Foster*, WIPO case No. DBIZ2002-00148. *Carlsberg A/S v. Brand Live television*, WIPO case NO. DTV-2008-0003).

On balance, there is thus high presumption that an ordinary consumer will believe that the domain name registered by the Respondent is owned by the Complainant or its partner and will access the website only due to its misleading character assuming that the download and evaluation services are provided directly by the Complainant or alternatively by its partners and therefore will expect high quality software without any malwares.

Moreover, the Respondent's website under the disputed domain name places Complainant's trademark name FILEHIPPO prominently on the top left corner on each website of the domain name in the same way as the Complainant's trademark is placed and displayed on his official website, i.e. also on the top left corner of the site and in the identical font and style to that of the Complainant's trademark. It is also important to note, that the Respondent displays the Complainant's trademark name without the typo mistake that is made within the domain name, i.e. the Respondent uses the name FILEHIPPO (corresponding to the trademark of the Complainant) and not FILEIHIPPO (as he uses within the domain name). Moreover, the Respondent uses the same colour combination for the main tab menu of the disputed domain name and the Complainant's logo (of a blue hippopotamus face) is being illicitly used as the favicon for the disputed domain name. The above clearly demonstrates the Respondent's awareness and knowledge of the Complainant's trademark and his illicit and purposeful intention to create connection to the Complainant that contributes to the confusion of the public accessing the website under the disputed domain name.

Thus, there can be no question but that the disputed domain name is confusingly similar to the Complainant's family of marks "FILEHIPPO" for purposes of the Policy.

B. The Respondent has no right or legitimate interests in respect of the disputed domain name

No evidence suggests that the Respondent has been commonly known amongst consumers by the disputed domain name or by the trademark "FILEHIPPO" included in the disputed domain name before the beginning of this dispute nor ownership of any identical or similar trademark nor use of any identical or similar brand by the Respondent before the registration of the disputed domain name. The Complainant did not grant any license or authorization to the Respondent to register or use the disputed domain name.

Prior to the dispute, the Respondent did not 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 because he has not provided the trademarked service but has used the trademark to bait Internet users and then switch them to his competing service (Nikon, Inc. v Technilab, WIPO Case no. D2000-1774).

Moreover, the Respondent does not accurately disclose its relationship with the Complainant (Oki Data Americans, Inc. v. ASD, Inc., WIPO case no. D2001-0903). The placement of the Complainant's trademark on every page of the website, use of the same font and style of the trademark name, use of the same colour combination for the trademark name and the main menu tab, which is characteristic for the Complainant's business provided under its trademark, as well as use of the Complainant's logo as the favicon for the disputed domain name give rise to a false and misleading existence of presumed and direct affiliation with the Complainant. This confusion as to any potential bona fide reference to the Complainant is further underlined by the copyright notice referring to FileHippo Copyright (C) 2020 on the bottom of the disputed domain name website.

The use of the Complainant's trademark and logo as well as reference to copyright in this manner usually excludes any possibility of bona fide reference to Complainant's services. The Panel has previously found that use of complainant's trademark and logo in the absence of complainant's authorization negates any potential justification of the respondent. The Panel also notes that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (Avast Software s.r.o. v Victor Chernyshov, CAC Case no. 101568). Trademark and copyright infringement shall be considered illegal.

The Respondent was seeking to create a false impression of association with the Complainant, which does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name (Carrefour v Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra, WIPO Case no. D2016-0608).

Under the Policy, a complainant may make out a prima facie case that the respondent lacks rights or legitimate interests in the domain name at issue. Once such a 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 may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions Second Edition ("WIPO Overview 2.0"), paragraph 2.1.

C. The disputed domain name has been registered and is being used in bad faith

There is no indication that the disputed domain name was registered and is used in bona fide. The Respondent was clearly aware of the registration and the use of the Complainant's trademarks and logo before the registration of the domain name as follows from the use of the Complainant's mark in identical font and style, use of the identical colour combination for the main tab menu as well as use of the Complainant's logo as the favicon. As explained above, the disputed domain name is being used by the Respondent for the similar purpose as that of the Complainant, i.e. to provide download and evaluation services on various software, applications, programs and games. However the Respondent offers these services illegally, under the Complainant's trademark name and with the use of Complainant's logo in the favicon, without the Complainant's authorization and without the Complainant's ability to control the quality of such services.

Panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names comprising typos) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see par. 3.1.3 of WIPO Overview 3.0, see WIPO Case No. D2015-0843, Missoni S.p.A. v. /Missoni Limited). Significant reputation of the trademark "FILEHIPPO" was confirmed in UDRP case no. 102279 and most recently in 2021 in UDRP case No. 103553 as mentioned above.

The Policy indicates in para 4 (b) (iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website...or of a product or service on the website. The disputed domain name is used by the Respondent to reach the Complainant's customers and offer them highly similar download and evaluation services as are being offered by the Complainant on his official website. This could suggest (incorrectly) that the Respondent operates as an affiliate or a partner of the Complainant. This is supported by the placement of the Complainant's trademark under the disputed domain name as well as the use of identical font and style of the trademark name, colour combination for the main menu tab, use of the Complainant's logo as the favicon for the disputed domain name as well as the reference to the Complainant's FileHippo Copyright (C) 2020 on the bottom of the disputed domain name website. The Respondent is not related in any way to the Complainant's business. The quality of the service provided by the Respondent is not under the Complainant's control and therefore the competing service can very easily harm good reputation built by the Complainant for over 17 years. Furthermore, the use of Complainant's trademark without its consent constitutes infringement of Complainant's copyright and trademark which supports the evidence of Respondent's bad faith.

Bad faith of the Respondent is also supported by the fact that the Respondent placed on every page of the disputed domain name Complainant's trademark in identical font and style, that the main menu tab uses the same colour combination (white and blue) as is used on the Complainant's website which likewise evokes the Complainant's official website and the Respondent's affiliation to the Complainant. This illicit connection to the Complainant is further supported by the use of the Complainant's official logo as the favicon for the disputed domain name which adds to the confusion as to the affiliation and connection with the Complainant. Also on the bottom of the disputed domain name there is explicit and direct reference to FileHippo Copyright (C) 2020 without any disclaimer. It thus follows, that when registering the disputed domain name, as well as during the use of the disputed domain name, the Respondent had and has a clear intention to create the impression of belonging to the Complainant as is further supported by the fact that the Respondent used the Complainant's trademark name on the website without the typo mistake in contrast to the domain name in which Respondent "intentionally" makes a typo mistake.

The Respondent's action of registering the disputed domain name and using it to direct Internet traffic to its website (in order to increase the popularity and value of its website), evidences a clear intent to disrupt the Complainant's business, deceive customers and trade off the Complainant's goodwill by creating an unauthorized association between the Respondent and the Complainant's "FILEHIPPO" mark (See Banco Bradesco S.A. v. Fernando Camacho Bohm, WIPO Case No. D2010-1552).

To conclude, 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 "FILEHIPPO" mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. 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 reputation of the Complainant and its "FILEHIPPO" mark. See Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com", WIPO Case No. D2000-0847.

Furthermore, the use of a proxy server by the true owner hidden behind the Respondent is markedly corroborate a finding of bad faith (Carrefour v Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra, WIPO Case no. D2016-0608). Moreover, the identity of the Respondent is not even disclosed under the disputed domain name. Therefore, it is not possible to contact the Respondent directly. It can be assumed that in case of any problems, the internet users would contact the complainant due to misleading character of the disputed domain name.

The Complainant operates a website at www.filehippo.com providing legitimate downloadable copies of the latest versions of what it considers to be the best free software, as well as information and news about software. The website has been operated by the Complainant or its predecessor since 2004. The Respondent registered the disputed domain name in 2017 and has used it for a website which also provides downloadable copies of software as well as evaluations of software, games and applications. The Complainant states that the software provided by the Respondent is not licensed and draws attention to the use on the Respondent's website of the Complainant's mark, logo and livery.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Panel finds that the Complainant has registered and unregistered rights in the mark "FILEHIPPO".

The Panel is satisfied that the disputed domain name is confusingly similar to this mark, from which it differs only in the insertion of the letter "i" between "file" and "hippo" and the addition of the generic top level domain suffix. As the Complainant observes, the disputed domain name could easily be typed by mistake instead of the Complainant's domain name containing the Complainant's mark.

In these circumstances, 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 disputed domain name was registered by the Respondent on 19 August 2017. The Panel finds on the undisputed evidence of the Complainant that the Respondent has used the disputed domain name for a website which offers unlicensed copies of software for downloading, as well as providing evaluations of software, games and applications. The Respondent's website displays the Complainant's mark in the top left corner of each page in the same font and style as that use by the Complainant on its website. It also uses a similar livery to the Complainant's website and a favicon which is similar to the Complainant's logo of a blue shaded depiction of the face of a hippopotamus.

In these circumstances, the Panel finds that the use made by the Respondent of the disputed domain name has not been a bona fide offering of goods or services. On the contrary, it has been a use in bad faith to pass off the Respondent's website as that of the Complainant.

The Panel further finds that the Respondent has not been commonly known by the disputed domain name and that it is not making legitimate noncommercial or fair use of this domain name. On the contrary, the Respondent has been using the disputed domain name for commercial gain by misleadingly diverting consumers to its website.

Accordingly, 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 Panel finds on the undisputed evidence that the Respondent has used the disputed domain name intentionally to attract Internet users to the Respondent's website for commercial gain from advertising revenue by creating a likelihood of confusion with the Complainant's mark as to the source of its website.

In accordance with paragraph 4(b)(iv) of the Policy this constitutes evidence of registration and use of the disputed domain name in bad faith. There is no evidence rebutting this presumption. Indeed, as the Complainant submits, this appears to be a clear case of typosquatting.

In these circumstances, 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

Clear case of typosquatting. The disputed domain name is identical to Complainant's mark apart from insertion of letter "i". No bona fide use. Use in bad faith to pass off Respondent's website as that of the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FILEIHIPPO.COM**: Transferred
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PANELLISTS

Name	Jonathan Turner
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DATE OF PANEL DECISION 2021-07-21

Publish the Decision
