

Decision for dispute CAC-UDRP-103930

Case number CAC-UDRP-103930

Time of filing 2021-08-02 09:34:44

Domain names sony-profi.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Sony Group Corporation

Complainant representative

Organization Coöperatieve Vereniging SNB-REACT U.A.

Respondent

Name Alexander Kleshchin

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 trademark "SONY", registered worldwide (including the EU and the USA) since 1964 for denoting many goods and services.

FACTUAL BACKGROUND

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

The Complainant is a well-known Japanese company engaged in several fields related to electronics, games and entertainment, as well as operating in the financial sector.

The Complainant owns several trademark registrations (since 1964) and domain names (since 1989) including/consisting in "SONY", which is one of the most known trademarks in the world.

The Respondent has registered the disputed domain name <sony-profi.com> only last October 16, 2020. According to the Complainant, the disputed domain name would be a variation of the Complainant's registered trademark SONY, with the

addition of the word "profi".

The Complainant affirms that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Neither license nor authorization has been granted to the Respondent to make any use, or apply for registration of the disputed domain name by the Complainant.

The Complainant contends that the disputed domain name has been registered and is being used in bad faith, as it redirects to a website which would exploit the renown of the trademark SONY.

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.

The language of the Registration agreement regarding this disputed domain name is in English. The Panel believes that English language is equally fair to both parties in this proceedings.

PRINCIPAL REASONS FOR THE DECISION

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO THE COMPLAINANT'S TRADEMARK

The Panel finds that the disputed domain name is confusingly similar to the trademark SONY and to the relative domain names registered by the Complainant, which has proven to have prior rights since 1964.

In particular, the Panel agrees that the mere addition of the word "profi" (likely an abbreviation for "professional") is not sufficient at all to escape the finding that the domain name is confusingly similar to the trademark SONY.

Many WIPO and CAC decisions – also involving the present Complainant – confirmed that domain names are identical or confusingly similar to a trademark for purposes of the Policy, “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale, WIPO Case No. D2000-0662).” For the same reasons, the addition of generic words after a trademark does not remove the confusing similarity between a mark and the domain name.

There is no doubt that the same case lies before us in this matter.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

According to the information provided by the Complainant, the Respondent is not authorized by the Complainant in any way to use the trademark SONY. Likewise, the Complainant neither licensed nor authorized the Respondent to make any use of its SONY trademark, or to apply for registration of the disputed domain name on behalf of the Complainant.

On the other side, it is true that the Respondent seems to carry out a business activity which includes repair services of SONY-branded products.

Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name, but only in some specific circumstances which have been summarized in the so-called "Oki Data test":

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

As for the clear disclosure, the Respondent did NOT comply with such condition, since the website connected to the disputed domain name does not bear any disclaimer which could let internet users understand the Complainant is not directly connected to the activity carried out through <https://www.sony-profi.com/>.

The Respondent describes itself as a "SONY service center, 2021" and even its data privacy policy makes reference to an undefined "SONY website": this conduct appears to be an attempt to exploit the renown of the Complainant's trademark by diverting Internet traffic intended for Complainant's web page to its own web page.

It is undeniable that Complainant is only required to make out a prima facie case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. Once such prima facie case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

Given all the above and taken into account the fact that the Respondent did not provide any response within the present proceeding, nor to the C&D letter which the Complainant previously sent, the Panel accepts the contentions of the Complainant that the Respondent has no such rights or legitimate interests in <sony-profi.com>.

THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH

The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name. This prima facie evidence was not challenged by the Respondent.

The disputed domain name redirects to a website which clearly bears the trademark SONY in order to promote its business, without any authorization from the Complainant. Given the reputation of the Complainant and its trademark (see the many decisions cited in the complaint), the Panel infers that the Respondent had the Complainant's trademarks SONY in mind when registering the disputed domain name.

In particular, it is quite clear the Respondent is using the disputed domain name to intentionally attract, for commercial gain,

Internet users to the website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the website. Indeed, this conduct additionally confirms that the Respondent has used the domain name in bad faith.

In the absence of a response from Alexander Kleshchin (who did not even reply to the Complainant's takedown requests to cease and desist), the Panel believes that the disputed domain name same was registered and is being 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. **SONY-PROFI.COM**: Transferred

PANELLISTS

Name	Tommaso La Scala
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DATE OF PANEL DECISION 2021-09-01

Publish the Decision