

Decision for dispute CAC-UDRP-104016

Case number CAC-UDRP-104016

Time of filing 2021-09-10 11:28:08

Domain names drpen.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization eShopping Group Pty Ltd

Complainant representative

Organization Dimov Internet Law Consulting

Respondent

Name Eric Tan Jun Zi

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

In this proceeding, the Complainant relies on U.S. trademark "DR.PEN" No.4991515, registered on July 5, 2016.

FACTUAL BACKGROUND

The Complainant is a licensee of the owner of the U.S. trademark "DR.PEN" No.4991515, registered on July 5, 2016. The trademark owner is the Chinese company Guangzhou Ekai Electronic Technology Co., Ltd.

According to the Complainant, the disputed domain name <drpen.com> is very similar to the trademark "DR.PEN" since the mere presence of a dot after the abbreviation "DR" in the trademark does not render the trademark dissimilar from the disputed domain name.

The Complainant informs that no evidence suggests that the Respondent has been commonly known within the consumers by the disputed domain name or by the name "DR.PEN", almost entirely reproduced in the disputed domain name, before the beginning of the present dispute. The Complainant also states that Guangzhou Ekai Electronic Technology Co., Ltd. did never grant any license or authorization to register or use the disputed domain name to the Respondent.

The Complainant informs that the present dispute concerns the domain name <drpen.com> which was registered in 2000 but acquired by the current owner on July 20, 2018 or later. According to the Complainant this circumstance indicates that the Respondent was well aware of the Complainant prior trademark rights at the moment of the acquisition of the domain name in dispute.

Finally, the Complainant points out that the domain name in dispute is used in connection with a website in which are shown and sold micro-needling skincare devices which aim to tighten, lift and rejuvenate skin bearing the mark "DR.PEN" owned by Guangzhou Ekai Electronic Technology Co., Ltd. and licenced to the Complainant.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the domain name, the Complainant must prove that each of the following elements is present:

- (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 domain name has been registered and is being used in bad faith.

A) Confusing similarity.

In this procedure, the Complainant relies on a trademark registered after the creation date of the disputed domain name. The Panel's view is that in order to assess the first requirement under the Policy, as UDRP panels have constantly held, it is sufficient to establish that trademark right is in existence at the time the complaint is filed (see FrogProg Limited vs. Pavlo Kucheruk, CAC Case no. 103413). As at the time of the filing of the complaint the Complainant is the licensee of a trademark registration for "DR.PEN", the Panel is satisfied that the Respondent has standing to file this dispute, and the Panel is entitled to evaluate whether the first requirement under the Policy has been met. In this perspective, it must be considered that many UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (e.g., F. Hoffmann-La Roche AG v. Jason

Barnes, ecnopt, WIPO Case No. D2015-1305; Compagnie Générale des Etablissements Michelin v. Christian Viola, WIPO Case No. D2012-2102; Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070; The Chancellor, Masters and Scholars of the University of Oxford v. Oxford College for PhD Studies, WIPO Case No. D2015-0812; Rhino Entertainment Company v. DomainSource.com, WIPO Case No. D2006-0968; SurePayroll, Inc. v. Texas International Property Associates, WIPO Case No. D2007-0464). The Panel's view is that, in the case at hand, the trademark can be considered as being fully included in the disputed domain name since the minor variation between the trademark – containing a dot "." between the two word elements "DR" and "PEN" – and the disputed domain name – in which the two word elements are written one after the other without punctuations marks – is absolutely insufficient to call into question the above finding of full inclusion (see "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Elliot Elliot, WIPO Case No. D2018-0213). Furthermore, it is well-established that the top-level domain name ".com" should be disregarded for the purpose of comparing the trademark with the domain name in dispute in order to evaluate possible confusing similarity or identity (see Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561; Burberry Limited v. Carlos Lim, WIPO Case No. D2011-0344; Magnum Piercing, Inc. v. The Mudjacks and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525). Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) The Respondent's rights or legitimate interests in the disputed domain name.

The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it does not own trademark identical or similar to the domain name in dispute, as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences submitted and in the absence of a response, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The fact that the domain name in dispute was registered in 2000, and therefore before the registration of the Complainant's mark, is totally irrelevant in assessing possible legitimate interests of the Respondent in the terms "DRPEN" and/or "DR.PEN". This especially because the domain name in dispute was never used for an independent business activity of the Respondent. Actually, the Complainant demonstrated that the website to which the disputed domain name is linked allegedly offers for sale authentic merchandise bearing the "DR.PEN" mark owned by Guangzhou Ekai Electronic Technology Co., Ltd. and licenced to the Complainant. In the Panel's view this is of course not a bona fide offering of goods and services. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C) Registration and use in bad faith.

The Panel has duly considered that, according to the current Whois records and to the domain report made available by Complainant, the disputed domain name was registered in 2000, but the ownership of the disputed domain name has changed on July 20, 2018. The Panel also knows that according to section 3.9 of the WIPO Overview 3.0, "the transfer of a domain name registration from a third party to the respondent is not a renewal and the date on which the current registrant acquired the domain name is the date a panel will consider in assessing bad faith". Now, after having analyzed the domain report, the Complainant notes that (i) from January 4, 2012 until April 10, 2018 the owner of the domain name in dispute was HTTP://CALIBERDOMAINNAMES.COM - DOMAIN IS FOR SALE (ii) that during that period the domain name was for sale and (iii) that on July 20, 2018 the Domain Names was acquired by an unknow person who uses domain name privacy services. Therefore, the Panel agrees that the latest owner of the disputed domain name acquired it on or after (for the effect of possible other transfers) July 20, 2018 and therefore after the registration of the U.S. trademark "DR.PEN" No.4991515, registered on July 5, 2016. According to the domain report, it results that the domain in dispute has been used to show and sell products bearing the trademark "DR.PEN" since October 18, 2020. According to the above it is clear to the Panel that the Respondent has acquired the disputed domain name after the use and registration of the "DR.PEN" mark and it is quite clear from the circumstances of the present case that the Respondent was surely aware of the "DR.PEN" trademark when he acquired <drpen.com>. Moreover, the Respondent appears to have attempted to benefit commercially from the appropriation of the "DR.PEN" mark in the disputed domain name. The use by the Respondent of the mark "DR.PEN", which is known for selling skincare devices, clearly indicates that the disputed domain name was chosen by the Respondent to take

advantage of the Complainant's mark reputation. This finding leads to the obvious conclusion that the disputed domain name has been registered in bad faith (Research In Motion Limited v. Privacy Locked LLC/Nat Collicot - WIPO Case No. D2009-0320; The Gap, Inc. v. Deng Youqian - WIPO Case No. D2009-0113; AXA S.A. v. P.A. van der Wees - WIPO Case No. D2009-0206; BHP Billiton Innovation v. Ravindra Bala - WIPO Case No. D2008-1059). The Panel also finds that, by linking the disputed domain name to a website offering for sale alleged "DR.PEN" items, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the trademark "DR.PEN" as to the source, sponsorship, affiliation or endorsement of its website and the products promoted therein. As the conduct described above falls within paragraph 4(b)(iv) of the Policy (see Triumph International Vietnam Ltd v. Tran Quoc Huy - WIPO Case No. D2017-0340), the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. Furthermore, the Panel draws an adverse inference from the Respondent's use of a privacy protection service to conceal its identity. Whilst privacy shields may be legitimate in certain cases, it is difficult to see why the Respondent in this case needs to protect its identity "except to frustrate the purposes of the Policy or make it difficult for a brand owner to protect its trade marks against infringement, dilution and cybersquatting" (see Ustream.TV, Inc. v. Vertical Axis, Inc, WIPO Case No. D2008-0598). Finally, the Panel also finds that the Respondent's failure to take part in the present proceedings constitutes an additional indication of its bad faith. Accordingly, the Panel finds that the Complainant has satisfied also paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on 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. DRPEN.COM: Transferred

PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION 2021-10-11

Publish the Decision
