

Decision for dispute CAC-UDRP-104034

Case number CAC-UDRP-104034

Time of filing 2021-09-24 09:22:49

Domain names davidoffcafe.com

Case administrator

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

Complainant

Organization Zino Davidoff SA

Complainant representative

Organization BRANDIT GmbH

Respondent

Name Hong Wen Pu

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

Zino Davidoff SA (hereinafter referred to as the Complainant) is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation. The Complainant's brands have been continuously used and marketed for over 30 years and in 1984 the Complainant launched perfumery and cosmetics and since then the Complainant has launched watches, clothing, cognac, leather goods, glasses, writing instruments, coffee etc. and the business has been continuously expanded and the scope of the goods bearing the DAVIDOFF becomes wider and wider.

Trademarks owned by Complainant

- Registration number: G467510 for DAVIDOFF registered in the following classes: 14, 15, 16, 18, 20, 21, 25, 33, registered: January 27, 2012.

DAVIDOFF - INTERNATIONAL TRADEMARK REGISTRATION:

Registration number: 467510 for DAVIDOFF registered in the following classes: 3, 14, 15, 16, 18, 20, 21, 25, 33, 34, registered: January 27, 1982.

The Complainant's above referenced trademark registrations (hereinafter referred to as the "trademarks") predates the Disputed Domain Name registration by several years. The Complainant also owns various registrations for domain names that include its trademarks, including but not limited to <zinodavidoff.com>, <zinodavidoff.asia>.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

In accordance with Paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the language of the proceedings is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its "discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs" (see Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

According to the Registrar Verification, the language of the registration agreement is Chinese. The Complainant requests the language of the proceedings to be English so it is fair to both parties. Should the Respondent request the language of the proceedings be different from English, the Complainant requests that the language of the present administrative proceedings be English based on the following reasons:

- The Disputed Domain Name is composed by the Complainant's trademark DAVIDOFF and the English term "cafe", both are correctly spelt; according to the Registrar Verification, the Respondent's e-mail is buydomain@xmkk.com, composed by the English terms "buy" and "domain", both are correctly spelt;
- The Respondent chose to register the Disputed Domain Name with the generic top level TLDs .com. This proves that by registering the Disputed Domain Name the Respondent is trying to target a broad audience, not limited to Chinese speaking visitors;
- The Disputed Domain Name is listed for sale on Sedo.com, the display language of which is English;
- Reverse WHOIS search showed that the Respondent has registered numerous domain names composed by English terms, e.g. <3dmedicines.cn>, <77thstreet.cn>, <acmbiotech.com.cn>;
- Moreover, a translation of the Complaint to Chinese would entail significant additional costs for the Complainant and delay in the proceedings.

The above facts show that the Respondent clearly understands English. The Complainant therefore requests the Panel to exercise its discretion and allow the language of the proceedings to be English.

II. ABOUT COMPLAINANT AND THE BRAND

Zino Davidoff SA (hereinafter referred to as the Complainant) is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation. The Complainant's brands have been continuously used and

marketed for over 30 years and in 1984 the Complainant launched perfumery and cosmetics and since then the Complainant has launched watches, clothing, cognac, leather goods, glasses, writing instruments, coffee etc. and the business has been continuously expanded and the scope of the goods bearing the DAVIDOFF becomes wider and wider.

The Complainant and its trademarks enjoy a high reputation around the world due to the Complainant's long-term use and publicity. The Complainant has continually and heavily invested in publicizing and advertising its trademarks around the world including China where the Respondent is domiciled. The Complainant's goods are also often sold on the flights to and from China and appear among others in in-flight catalogues and magazines. Therefore numerous passengers (including a number of Chinese passengers) have a very convenient way to directly access the Complainant's goods.

The Complainant also publicizes and promotes its brands by sponsoring and organizing a variety of activities and events. China is one of the Complainant's fastest-growing and major markets. In 2021, the Complainant had around 80 stores throughout China's major cities; the Complainant's coffee products were sold quantitatively on popular online malls such as JD.com. The Complainant also owns various registrations for domain names that include its trademarks, including but not limited to <zinodavidoff.com>, <zinodavidoff.asia>. The Complainant uses these domain names to connect to a website through which it informs potential customers about its trademarks and its products. The Complainant also operates its website in the Chinese language, which further supports that China is an important market. Complainant has previously successfully challenged other domain names through the UDRP process see among others the following cases: D2013-0410 (domain name transferred), D2011-0538 (case terminated) D2011-0104 (domain name transferred) D2010-1722 (domain name transferred) D2010-1681 (domain name transferred) D2009-1013 (case terminated) Forum Case 99381 (domain name transferred) CN1000413 (domain name transferred).

LEGAL GROUNDS:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <davidoffcafe.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 12 November 2020 according to the WHOIS, incorporates the Complainant's well-known trademark DAVIDOFF in combination with a term "cafe", which is closely related to the Complainant and its business activities. The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following:

"In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ".com") is to be disregarded under the confusing similarity test".

The same reasoning should apply in the current case and the Disputed Domain Name should be considered as confusingly similar to the trademark DAVIDOFF.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the DAVIDOFF trademark in any forms, including the Disputed Domain Name.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that it has interest over the Disputed Domain Name. When searched for "DAVIDOFF" and "cafe" in the Google and Baidu (leading search engine in China) search engines, the returned results pointed to the Complainant and its business activities.

The Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have

quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in China and many other countries worldwide. However, the Respondent still chose to register the Disputed Domain Name as such.

In addition, according to the Registrar Verification, the Respondent is an individual named “Hong Wen Pu”, which is not related to the Complainant nor to the term “Davidoff” in any form.

By the time the Complainant prepared this amended Complaint on 28 September 2021, the Disputed Domain Name resolved to Sedo.com where it was listed for sale for 2,000 USD, however it used to be sold at the price of 7,874 USD on 23 September 2021). The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services.

When Internet users, who search for information about the Complainant and/or about the brand “DAVIDOFF”, see the Disputed Domain Name and the Sedo website where the Disputed Domain Name is listed for sale, would very likely be confused and be led to believe that the Disputed Domain Name is somehow related to the Complainant and be disappointed as they would not find the information as expected – which will lead to trademark tarnishment for the Complainant.

From the Complainant’s perspective, the Respondent deliberately chose to incorporate the well-known trademark DAVIDOFF in the Disputed Domain Name, very likely with the intention to attract Internet traffic by benefiting from the Complainant’s worldwide renown.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name and has not been using the Disputed Domain Name for any bona fide offering of goods or services.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted that most of Complainant’s trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark DAVIDOFF, and the overall composition of the Disputed Domain Name, i.e. using the term “DAVIDOFF” in combination with a term “cafe”, which is closely related to the Complainant and its business activities, it follows that the use of the well-known trademark DAVIDOFF in the Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant’s rights and reputation.

Considering the facts that:

- The Respondent very likely knew about the Complainant and its trademark;
- The Complainant’s trademark DAVIDOFF is a well-known trademark worldwide and in China where the Respondent resides;
- The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name,

the Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.:

“If on the other hand circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent’s likely knowledge of the complainant’s rights, (ii) the distinctiveness of the complainant’s mark, ...

(vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name,....”

and para.3.1.4:

“Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

ii. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, being confusingly similar to the Complainant’s Trademark DAVIDOFF, the Disputed Domain Name resolved to Sedo website where it has been listed for sale. Obviously, the Registrant is not making any active use of the Disputed Domain Name, but only has “intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location.”

Secondly, the Complainant tried to reach the Respondent by a cease-and-desist letter sent on 4 June 2021 to the Respondent’s e-mail: buydomain@xmkk.com as provided in the WHOIS and to the registrar’s e-mail: domainabuse@service.aliyun.com. However, until the time the Complainant prepared this Complaint, it has not received response from the Respondent.

Lastly, the Respondent has been using privacy shield to conceal its identity.

In terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent’s use of the Disputed Domain Name in bad faith. See “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246:

“The Domain Name was not resolving to an active website at the time of filing. However, the consensus view amongst WIPO panellists is that ‘the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trade mark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trade mark, no response to the complaint having been filed, and the registrant’s concealment of its identity’.”

SUMMARY

- DAVIDOFF is a well-known trademark worldwide.
- Complainant’s trademarks registration predates the registration of the Disputed Domain Name.
- Respondent has no right in the mark DAVIDOFF, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name – accordingly it has no legitimate interest in the Disputed Domain Name.
- It is highly unlikely that Respondent was not aware of Complainant’s prior rights in the trademark DAVIDOFF at the time of registering the Disputed Domain Name, given the Complainant’s worldwide renown.
- Respondent has been passively holding the Disputed Domain Name.

- Respondent has been offering the Disputed Domain Name for sale to the public at a considerable price.
- Respondent failed in responding to cease-and-desist letter sent by the Complainant.
- Respondent has been using privacy shield.

Consequently, the Respondent should be considered to have registered the Disputed Domain Name confusingly similar to the Complainant's well-known trademark DAVIDOFF. The Complainant has not found that the Respondent is of any legitimate right or interest in using the Disputed Domain Name, but rather registered and has been using the Disputed Domain Name in bad faith.

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

Request for Change of Languages:

The Complainant requests that the language of this administrative proceeding be English pursuant to UDRP Rule 11(a): Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. Complainant makes this request in light of the potential Chinese language Registration Agreement of the Disputed Domain Name involved at this Complaint.

Paragraph 10 of the UDRP Rules vests a Panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios were summarized into WIPO Jurisprudential Overview 3.0, 4.5.1. In this particular instance, the Complainant tried to request change of languages of proceedings in light of Chinese language Registration Agreement by showing that 1) Disputed Domain Name <davidoffcafe.com> are formed in English characters; 2) the Respondent's e-mail address buydomain@xmkk.com is composed by correctly spelt English terms; 3) the Disputed Domain Name is listed for sale and in the English language; 4) conducting the proceeding in languages other than Chinese would entail significant additional costs for the Complainant and unnecessarily burden the Complainant. Relevant decisions have been cited to support the Complainant's positions.

In light of the scenarios and equity, the Panel is of the view that conducting the proceeding in English is unlikely to heavily burden the Respondent, and it is likely that the Respondent can understand the English language based on a preponderance of evidence test. Without further objection from the Respondent on the issue, the Panel will proceed to issue the decision in

English.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or confusingly similar

The Complainant contend that the Disputed Domain Name <www.davidoffcafe.com> is confusingly similar to the Complainant's trademark and the identifiable part of its company name "Zino Davidoff".

"Zino Davidoff". The Complainant, Zino Davidoff SA is a company incorporated in Fribourg, Switzerland and is a leading producer of prestige fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation. The Complainant's brands have been continuously used and marketed for over 30 years. The Complainant has registered various international trademark and Chinese trademark, assuming that the Respondent resides in China. The Complainant also owns various registrations for domain names that include its trademarks, including but not limited to <zinodavidoff.com>, <zinodavidoff.asia>. The Complainant's business operation extends to the coffee industry.

In this case, the Disputed Domain Name incorporates in its entirety the identifiable portion of the Complainant's trademark "Davidoff" and the generic top level domain ".com" does not affect the confusing similarity. It should be also noted that the added term "Café" implied that the disputed domain name is associated with the coffee/café business, a line of business that the Complainant already operates in, and is more apt to induce confusion among Internet users or to attract internet users based on the Complainant's trademark and for commercial gains. The Panel therefore concludes that the Disputed Domain Name is confusingly similar to a trademark in which the Complainants have rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such 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 is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in the present case has not licensed or authorized the Respondent to register or use the disputed domain name. There is no evidence that the Respondent is known by the Disputed Domain Name or owns any corresponding registered trademarks including the terms "Davidoff" and/or "Davidoff Café".

In this case, because the Respondent has used a proxy service in registering the Disputed Domain Name, additional information of the Respondent needs to be discovered. The uncovered identity of the Respondent, an individual/entity named "Hong Wen Pu" seems to have no connection with the Complainants' brand. The Complainant contends that no evidence suggests that the Respondent has been known in any way by the Disputed Domain Name. The Complainants did not grant any license or authorization to the Respondent to register or use the Disputed Domain Name, nor the use of the Complainants' trademark on every page of the disputed website.

In addition, before the dispute, the Disputed Domain Name has been listed for sale on sedo.com and the offered price has been reduced. The Respondent has not used the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the Disputed Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

Registration of the disputed domain name in bad faith – As far as registration goes, UDRP panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Complainant’s trademark registrations predate the registration of the Disputed Domain Name. The fact that the Complainant’s trademark is a well-known one and that The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name implied that the Respondent may have had knowledge of the Complainant’s trademark at the time of registration of the Disputed Domain Name. In addition, the added term “Cafe” seems to indicate that the Respondent is aware of the Complainant’s presence in the coffee industry. Given that the Respondent’s address and the request of the use of Chinese language implies that the Resident resides in China, the Complainant has a long business history in China and bee publicizing and promoting its brands by sponsoring and organizing a variety of activities and events. According to evidence provided by the Complainant, in 2021, the Complainant had around 80 stores throughout China's major cities; the Complainant’s coffee products were sold quantitively on popular online malls such as JD.com. Therefore, it is reasonable to conclude that the registrant registered the disputed domain name with the knowledge of the complainant’s trademark and/or brand influence. In addition, the Respondent choose to register the Disputed Domain Name to create a confusion with the Davidoff brand and products.

Use of the Disputed Domain Name in Bad Faith – Currently, the Disputed Domain Name resolves to sedo.com website where it has been listed for sale. The Respondent is not making any active use of the Disputed Domain Name. According to paragraph 4(b)(iv) of the Policy, “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”, if found by the Panel, shall be considered evidence of registration and use of the domain name in bad faith. The offer of the Disputed Domain Name for sale accompanied by the fact that the Disputed Domain Name has not been in active use indicates that the likely confusion caused by such offer could lead to illegitimate commercial gain to the Respondent.

Moreover, a cease and desist letter was sent to the Respondent on June 4, 2021 and the Respondent never responded. Prior panels have also held that a failure to respond to a cease and desist letter can be evidence of bad faith (see e.g., HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062).

Therefore, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the Complainants have failed to provide that Disputed Domain Name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. DAVIDOFFCAFE.COM: Transferred

PANELLISTS

Name	Carrie Shang
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DATE OF PANEL DECISION 2021-10-31

Publish the Decision
