

Decision for dispute CAC-UDRP-103853

Case number CAC-UDRP-103853

Time of filing 2021-09-03 09:10:24

Domain names licoreskahlua.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization The Absolut Company Aktiebolag

Complainant representative

Organization Palmer Biggs IP Solicitors

Respondent

Name Richard Francisco Rendon

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 an extensive number of trademarks for "KAHLUA", including the following:

- European Union trademark registration No. 9176661 for KAHLUA (word mark), filed on June 15, 2010 and registered on February 25, 2011, in classes 29, 30, 32 and 33;

- European Union trademark registration No. 9176728 for KAHLUA (word mark), filed on June 15, 2010 and registered on October 4, 2010, in classes 16, 35, 42 and 43;

- United Kingdom trademark registration No. UK00002259073 for KAHLUA (word mark), filed on January 25, 2001 and registered on July 6, 2001, in classes 35 and 42;

- United Kingdom trademark registration No. UK00909176661 for KAHLUA (word mark), filed on June 15, 2010 and registered on February 25, 2011, in classes 29, 30, 32 and 33;

- United Kingdom trademark registration No. UK00909176728 for KAHLUA (word mark), filed on June 15, 2010 and registered on October 4, 2010, in classes 16, 35, 42, and 43;

- United Kingdom trademark registration No. UK00001467186 for KAHLUA (word mark), filed on June 13, 1991 and registered November 20, 1992, in class 33; and

- United States trademark registration No. 2988022 for KAHLUA (word mark), filed on March 6, 2003 and registered on August 23, 2005, in international class 30.

FACTUAL BACKGROUND

The Complainant is a Swedish company specialized in the production and distribution of spirits. The Complainant is part of the Pernod Ricard Group, which is the second largest wine and spirits group in the world.

The Complainant is the owner of a number of well-known international drinks brands including KAHLUA, a coffee liqueur made from arabica beans from Veracruz in Mexico since its inception in 1936.

The Complainant is also the owner of the domain name <kahlua.com>, which was registered on July 27, 1997 and is used by the Complainant to promote its products under the trademark KAHLUA.

The disputed domain name <licoreskahlua.com> was registered on March 22, 2021 and, prior to the commencement of the present proceedings, was pointed to a website offering for sale alcoholic beverages unrelated to the Complainant.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that disputed domain name <licoreskahlua.com> is confusingly similar to the trademark KAHLUA in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive term "licores" (Spanish term for "spirits") and the generic Top-Level Domain ".com".

The Complainant underlines that its trademarks are registered in international classes which include alcoholic beverages and that the Complainant is also a well-known producer of the coffee liqueur called KAHLUA.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent was in no way authorized or licensed by the Complainant to use the trademark KAHLUA or apply for registration of the disputed domain name.

The Complainant further states that the Respondent is also not commonly known by the disputed domain name and that the Complainant in any case acquired rights to the KAHLUA mark long before the Respondent registered the disputed domain name.

Moreover, the Complainant submits that there is no evidence to demonstrate a bona fide offering of goods or service, nor is there any evidence of fair non-commercial use by the Respondent of the disputed domain name, since the website to which the disputed domain name resolved, offered for sale alcoholic beverages which were in direct competition to those of the Complainant.

With reference to the circumstances evidencing bad faith, the Complainant highlights that the Respondent registered the disputed domain name concealing its true identity through the use of a proxy shield service.

The Complainant emphasizes that, considering: i) the trademarks were registered by the Complainant long before the Respondent registered the disputed domain name, ii) the KAHLUA trademarks are distinctive and well-known worldwide iii) that prior to the commencement of the proceedings, the original location of the IP address associated to the original website

was Sweden, which is the country of incorporation of the Complainant, iv) the Respondent not only used the trademark KAHLUA in the disputed domain name, but also chose to include the word "licores" as a prefix, providing a clear and unavoidable reference to the Complainant and its trademark KAHULA, and that v) the Respondent originally sold alcoholic beverages in direct competition to those of the Complainant, the Respondent was undoubtedly aware of the Complainant when registering the disputed domain name and was thus acting in bad faith at the time of registration of the same.

The Complainant also asserts that the Respondent registered the domain name in order to prevent the Complainant from reflecting its trademark in a corresponding domain name and suspects that the Respondent may have engaged in a pattern of such conduct.

Furthermore, the Complainant highlights that the contact details and the legal sections of the disputed domain name redirect to the top of the home page of the website and suspects that the owner registered the disputed domain name with the intent of using it for phishing purposes in order to induce and/or divert the Complainant's legitimate customers to its website, intentionally attempting at the same time, to attract for commercial gain internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its website.

The Complainant also contends that the Respondent probably registered the disputed domain name for the purpose of selling, renting or otherwise transferring it to the Complainant or to one of its competitors, for valuable consideration in excess of its out-of-pocket costs directly associated with the disputed domain name and that this too, would constitute bad faith registration.

RESPONDENT:

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.

Language of the proceeding

In accordance with paragraph 11 (a) of the Rules of the Policy the proceedings should be conducted in the language of the Registration Agreement. However, the Complainant contends that the language of the proceedings should be changed to English.

The Panel finds that English be the appropriate language for the following reasons:

- to require the Complaint and all supporting documents to be translated and re-filed in Spanish would cause an unnecessary burden of additional costs to the Complainant;
- the translations would cause unnecessary delays to the proceedings;
- the CAC sent correspondence to the Respondent in both Spanish and English asking whether the Respondent is prepared to accept the change of language to English. The Respondent did not answer to such invitation;

- from provided evidence it is reasonable to infer that the Respondent understands English language, so it is fair to hold the present proceedings in English.

In accordance with paragraph 11 (a) of the UDRP Rules, the Panel determines that it would be appropriate for English to be the language of the proceedings.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is confusingly similar the Complainant's trademark KAHLUA, as it reproduces the trademark in its entirety, with the mere addition of the descriptive term "licores" (which is the Spanish term for "spirits"), and the generic Top-Level Domain ".com". As stated in a number of prior decisions rendered under the UDRP, these minor changes are not sufficient to exclude the likelihood of confusion.

2. The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademark.

Moreover, according to the evidence on records, the Respondent has redirected the disputed domain name to a website offering for sale alcoholic beverages in direct competition with those of the Complainant, thus showing it did not make use, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or that it has made a legitimate non-commercial or fair use of the disputed domain name.

The Panel also notes that the Respondent, whose name is Richard Francisco Rendon according to the Whois records, is not commonly known by the disputed domain name and the Complainant's rights long predate the Respondent's registration of the disputed domain name.

3. As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant's trademark, with which the disputed domain name is confusingly similar, of the prior registration and use of the trademark KAHLUA by the Complainant, of the composition of the disputed domain name (combining the Complainant's trademark with a descriptive term in Spanish meaning "spirits") and the content of the website to which the disputed domain name resolved, the Respondent was very likely aware of the Complainant's trademark at the time of the registration of the disputed domain name.

Moreover, that the Respondent's registration of the disputed domain name, corresponding to the Complainant's well-known trademark, suggests that the Respondent also acted in opportunistic bad faith, with a deliberate intent to create an impression of an association with the Complainant.

In view of the prior use of the disputed domain name, the Panel finds that the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the Complainant's trademark KAHLUA as to the source, sponsorship, affiliation or endorsement of its web site and the products offered therein, according to paragraph 4(b)(iv) of the Policy.

The disputed domain name is currently not resolving to an active web site, i.e. is passively held. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding, especially in cases of domain name registrations corresponding to distinctive and well-known trademarks; see i.a. the landmark case Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Therefore, the Panel finds that the disputed domain name 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. LICORESKAHLUA.COM: Transferred

PANELLISTS

Name	Luca Barbero
------	--------------

DATE OF PANEL DECISION 2021-11-04

Publish the Decision
