

Decision for dispute CAC-UDRP-104129

Case number CAC-UDRP-104129

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Domain names grand-duke.com

Case administrator

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

Complainant

Name Mindaugas Vaitkunas

Complainant representative

Organization Dimov Internet Law Consulting

Respondent

Name Bill Seakind

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 owns the following registered GRAND DUKE trademarks:

- the UK00003505735 word trademark GRAND DUKE filed on June 29, 2020 and registered on October 9, 2020;
- the Swiss word trademark No. 759215 GRAND DUKE filed on June 29, 2020 and registered on February 11, 2021;
- the EU figurative trademark No. 018179583 GRAND DUKE filed on January 13, 2020 and registered on June 6, 2020, in classes 3, 5, 30, 32 and 34 and citing in class 32 the following goods: "water; energy drinks; sport drinks".

In addition, the Complainant has filed the following trademark applications:

- US word trademark application No. 88834290 GRAND DUKE filed on March 13, 2020 and designating various non-alcoholic beverages in class 32;

- US word trademark application No. 88736700 GRAND DUKE filed on December 22, 2019;
 - US figurative trademark application No. 88766513 GD GRAND DUKE filed on January 20, 2020;
 - EU TM application No. 018500786 GRAND DUKE filed on June 25, 2021.
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FACTUAL BACKGROUND

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

The Disputed Domain Name <grand-duke.com> was registered by the Respondent on January 31, 2020, using a Privacy service. The Disputed Domain Name hosts a parked page comprising pay-per-click links that refer to goods and services related to the Complainant's registered trademarks.

The UK trademark No. UK00003505735 is registered by the Complainant for various non-alcoholic drinks in class 32: "Water; Energy drinks; Sports drinks; Aerated water; Bottled water; Non-alcoholic beverages flavored with coffee; CBD (cannabinoids) infused beverages." The Swiss trademark No. 759215 GRAND DUKE, the EU trademark No. 018179583 GRAND DUKE, the US trademark App. No. 88834290 GRAND DUKE are also registered for non-alcoholic drinks.

The website associated with the Disputed Domain Name includes paid links related to "Buckingham Palace Gin", referring to different gin-selling websites, knowing that "gin" can be a non-alcoholic or an alcoholic product.

Moreover, the pay-per-click links shown on the Website refer to websites selling a non-alcoholic drink similar to gin coffee liquors and coffee Digestif.

The terms GRAND DUKE composing the Disputed Domain Name refer to "a European hereditary title, used either by certain monarchs or by members of certain monarchs' families". The website associated with the Disputed Domain Name does not comprise pay-per-click links genuinely related to the dictionary meaning of the terms GRAND DUKE.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Confusing similarity

The Complainant submits that the Disputed Domain Name <grand-duke.com> is confusingly similar to its GRAND DUKE trademarks.

It contends that the Disputed Domain Name consists of the following four elements: (i) "grand"; (ii) "-"; (iii) "duke"; and (iv) ".com", and that only the first and the third elements are relevant for the purpose of assessing the confusing similarity between the Disputed Domain Name and the registered trademarks and the pending applications. It relies on the WIPO case No. D2003-0214 to justify that the addition of a hyphen to a Disputed Domain Name reflecting a trademark does not render it dissimilar from the trademark. It added that the generic Top Level Domain ("gTLD") ".com" is inconsequential in determining whether the Domain Name is confusingly similar to the Complainant's trademark according to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11.

Right or legitimate interest

The Complainant submits that the Respondent does not have any rights or legitimate interest in the Disputed Domain Name.

It contends that the Disputed Domain Name has not been used in connection with a bona fide offering of goods and services, but is parked and includes pay-per-click links that refer to goods and services related to the registered trademarks and pending applications.

It mentioned section 2.9 of the WIPO Overview 3.0, whereas panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users.

To justify that the pay-per-click links compete with or capitalize on the reputation and goodwill of the registered trademarks and Pending Applications or otherwise mislead Internet users, the Complainant asserts that the UK trademark No. UK00003505735 is registered by the Complainant for various non-alcoholic drinks in class 32: "Water; Energy drinks; Sports drinks; Aerated water; Bottled water; Non-alcoholic beverages flavored with coffee; CBD (cannabinoids) infused beverages." The Swiss trademark GRAND DUKE No. 759215 and the EU trademark GRAND DUKE No. 018179583 are also registered for similar goods.

It contends that the website associated with the Disputed Domain Name refers to paid links related to "Buckingham Palace Gin", whereas if someone clicks, it will be redirected to a website redirecting to gin-selling websites, noting that the term "gin" may refer to alcoholic and non-alcoholic products. It contends that people who use search engines to find products bearing the registered trademarks may be misled into believing that the Complainant has expanded its selection of non-alcoholic products to non-alcoholic or even alcoholic gins. Moreover, the pay-per-click links shown on the website refer to websites selling a non-alcoholic drink similar to gin, coffee liquors knowing that some of the abovementioned trademarks are registered in relation to "non-alcoholic beverages flavored with coffee" and with relation to "coffee", and coffee Digestif.

Therefore, the website will compete with or capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users and is not used in connection with a bona fide offering of goods or services.

It also adds that the conditions mentioned in Section 2.9 of the WIPO Overview 3.0 are not met: "Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark."

It asserts that the website does not comprise pay-per-click links genuinely related to the dictionary meaning of the word(s) or phrase comprising the Disputed Domain Name.

It also adds that the Respondent does not have any trademarks corresponding to the Disputed Domain Name and that the Disputed Domain Name merely refers to a parked page and there is no indication that the Respondent is engaged in any commercial or non-commercial activities that can make the Respondent commonly known by the Disputed Domain Name. Moreover, the Respondent cannot become commonly known by using a parked website that does not contain any indication of the name, the address, the brand(s), the products, the services, or other details of the Respondent.

Therefore, the Respondent is not commonly known by the Disputed Domain Name.

Moreover, it asserts that the Disputed Domain Name merely refers to a parked page without any evidence indicating that it was ever used for noncommercial or fair use purposes, and that therefore, the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Bad faith

The Complainant submits that the Disputed Domain Name <grand-duke.com> has been registered and is being used in bad faith.

It asserts that the Respondent intentionally attempts to attract, for commercial gain, Internet users to a parked webpage by creating a likelihood of confusion with the registered trademarks as to the source, sponsorship, affiliation, or endorsement of the parked page and or the products to which the parked page refers.

It adds that the respondent uses a privacy service, and that according to Section 3.6 of the WIPO Overview 3.0, “the circumstances in which such services are used, including whether the respondent is operating a commercial and trademark-abusive website, can however impact a panel’s assessment of bad faith.”

Consequently, it considers that the Disputed Domain Name using a privacy service to intentionally delay the disclosure of the identity of the actual underlying registrant. It relies on section 3.6 of the WIPO Overview 3.0 that states the following: “Panels have also viewed a respondent’s use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual underlying registrant as an indication of bad faith.”

It adds that the Disputed Domain Name was registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name. It contends that the Disputed Domain Name was registered on the January 31, 2020, which means following the Complainant’s filing of three trademark applications, namely, the EU TM No. 018179583 for “GRAND DUKE” filed on January 13, 2020, the US TM App. No. 88736700 for “GRAND DUKE” filed on December 22, 2019, and the US TM App. No. 88766513 for “GD GRAND DUKE” filed on January 20, 2020.

It asserts that the Respondent could identify these trademarks on the respective trademarks official databases.

It relies on section 3.8.2 of the WIPO Overview 3.0 that states as follows: “As an exception to the general proposition described above in 3.8.1, in certain limited circumstances where the facts of the case establish that the respondent’s intent in registering the domain name was to unfairly capitalize on the complainant’s nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent’s insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant’s filing of a trademark application.” Therefore, it considers that the fact that the Disputed Domain Name was registered shortly after the Complainant filed trademark applications in the US and the EU is a clear indication that the Respondent knew about the Complainant’s trademark applications.

It adds that the Respondent may be a competitor of the Complainant wanting to disrupt the business of the Complainant or a person acting for a competitor of the Complainant with the aim to disrupt the business of the Complainant, taking into account the fact that the Disputed Domain Name was registered shortly after the Complainant filed three trademark applications.

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has submitted evidence of its prior registered GRAND DUKE trademarks.

The EU figurative trademark No. 018179583 GRAND DUKE filed on January 13, 2021 and registered on June 6, 2020 is the only registered trademark in the name of the Complainant at the same address as the address mentioned on the Complaint.

Therefore, the Panel shall refer on this registered trademark.

The Disputed Domain Name <grand-duke.com> entirely incorporates the Complainant's GRAND DUKE trademark.

The addition of the hyphen between the two words GRAND and DUKE in the Disputed Domain Name does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's GRAND DUKE trademark.

The extension ".com" is a standard registration requirement, and is disregarded when determining identity or confusing similarity under the first element.

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

(i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to 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; or

(ii) the Respondent has been commonly known by the Disputed Domain Name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Respondent did not respond to the Complaint to rebut Complainant's prima facie case. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the Disputed Domain Name.

Respondent is not commonly known by the Disputed Domain Name and has never been authorized by the Complainant to use its GRAND DUKE trademark to register the Disputed Domain Name.

Respondent is using the Disputed Domain Name to host a parked page comprising pay-per-click links. It is found that the pay-per-click links refer to goods and services related to the registered trademarks.

For example, while the EU trademark No. 018179583 is registered by the Complainant for various non-alcoholic drinks in class 32 or for similar goods, the website associated with the Disputed Domain Name includes paid links to websites dedicated to non-alcoholic drinks or even to a website promoting "Buckingham Palace Gin". The pay-per-click links ranked on the website give access to websites selling non-alcoholic drinks for which the prior GRAND DUKE trademarks are registered in class 32.

Consequently, the Disputed Domain Name is not used in connection with a bona fide offering of goods or services.

Resolving to such a website and webpages aims at confusing the Internet users and is made for the sole purpose of commercial gain.

This is a commercial unfair use of the Disputed Domain Name.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the Disputed Domain Name.

It provides that:

“For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

(i) circumstances indicating that the Respondent has registered or the respondent has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the Domain Name; or

(ii) the Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your 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.”

The Respondent did not respond to the Complaint to rebut Complainant’s prima facie case. Consequently, it did not provide any evidence or allege any circumstance to establish that it behaved in good faith.

The Respondent registered the Disputed Domain Name on January 31, 2020, which means short after the filing dates of the registered EU trademark GRAND DUKE No. 018179583 (January 13, 2020), the US application GRAND DUKE No. 88736700 (December 22, 2019) and the US semi-figurative trademark GD GRAND DUKE No. 88766513 (January 20, 2020). Consequently, the Respondent must have been fully aware of the Complainant’s trademarks applications when it registered the Disputed Domain Name. At that time, he had without any doubt the possibility to check the main databases to identify prior identical trademarks designating non-alcoholic beverages.

The Disputed Domain Name hosts a parked page comprising pay-per-click links that refer to goods and services related to the registered GRAND DUKE trademarks, namely non-alcoholic beverages, as explained above.

The Respondent is attempting to attract, for commercial gain, Internet users to Respondent’s own website 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” in the meaning of Par. 4(b) (iv) of the Policy.

The Complainant has, to the satisfaction of the Panel, shown that 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

The Disputed Domain Name <grand-duke.com> is confusingly similar to the Complainant's GRAND DUKE trademark.

It entirely incorporates the Complainant's GRAND DUKE trademark.

The addition of the hyphen between the two words GRAND and DUKE in the Disputed Domain Name does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's GRAND DUKE trademark.

It has been used to host a parked page comprising pay-per-click links that refer to goods and services related to the registered trademarks.

The Respondent does not have any right or legitimate interest in the Disputed Domain Name.

The Disputed Domain Name resolves to a parking website targeting goods designated by the Complainant's trademark, it aims at confusing the Internet users and is made for the sole purpose of commercial gain.

The Respondent is not commonly known by the Disputed Domain Name and is not related in any way with the Complainant nor has ever been authorized by the Complainant to use the GRAND DUKE trademark to register the Disputed Domain Name. It made a commercial unfair use of the Disputed Domain Name.

The Respondent registered and is using the Disputed Domain Name in bad faith.

It did not respond to the Complaint to rebut Complainant's prima facie case. It was well aware of the GRAND DUKE trademark when it registered the Disputed Domain name. It is attempting to attract, for commercial gain, Internet users to Respondent's own website by creating a likelihood of confusion with the Complainant's trademark.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. GRAND-DUKE.COM: Transferred

PANELLISTS

Name	Marie-Emmanuelle Haas, Avocat
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DATE OF PANEL DECISION 2021-12-07

Publish the Decision