Decision for dispute CAC-UDRP-100180

Case number	CAC-UDRP-100180
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Domain names	corob.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	CPS Color Group Oy

Complainant representative

Organization	Berggren Oy Ab

Respondent

Organization	HERO Products Group

OTHER LEGAL PROCEEDINGS

No other legal proceedings are known to the Panel.

IDENTIFICATION OF RIGHTS

1. Japan – registered trademark 2550712 – COROB & Device
Application date: 02.03.1990
Registration date: 30.06.1993

2. Japan – registered trademark, 2587413 – COROB & Device
Application date: 02.03.1990
Registration date: 29.10.1993

3. Finland – registered trademark, 234371 – word: COROB
Application date: 01.11.2004
Registration date: 14.10.2005

4. Registered Community Trademark, 4102661 – word: COROB
Application date: 01.11.2004
Registration date: 02.02.2006

5. India – registered trademark, 1321465 – word: COROB
Application date: 22.11.2004
Registration date: 28.06.2007

6. International Registration, 852856 – word COROB

Countries: Australia, China, Japan, South Korea, Russia, Singapore

7. India – registered trademark, 1413621 – COROB & Device
Application date: 13.01.2006
Registration date: 01.08.2008

FACTUAL BACKGROUND

The Complainant is CPS Color Group Oy, a Finnish company providing tinting solutions. It offers colorant system for the production of decorative paints, industrial coatings, leather finishes, and coated fabrics. The company also provides color marketing support, which includes a color design service and a range of color communication tools, such as fan decks and displays. It serves architectural paints, industrial coatings, plastics, and leather markets. The company was founded in 1990 and is based in Vantaa, Finland. It has operating sites and production units in Finland, Sweden, the Netherlands, Italy, the Russian Federation, India, China, Australia, the United States, Brazil, and Uruguay.

CPS Color Group Oy has a global organization which employs 850 color professionals with operations all over the world. The Complainant affirms that the Group's 2008 turnover amounted to EUR 204 milion.

CPS Color Group Oy is the owner of trademark registrations for the mark COROB in many countries. See for example:

- COROB Community nominative trademark no. 4102661 filed on November 1, 2004 and registered on February 2, 2006;
- COROB International nominative trademark no. 852856 registered on November 25, 2004;
- COROB & device Japanese trademark no. 2550712 filed on March 2, 1990, registered on June 30, 1993 and duly renewed;
- COROB & device Japanese trademark no. 2587413 filed on March 2, 1990, registered on October 29, 1993 and duly renewed.

The Complainant held that thanks to long-term and wide use, the trademark COROB acquired a great fame and is well and widely known throughout the world.

Whois records provided by Complainant show that the domain name <corob.com> was created on October 11, 1998. However, the Complainant states that the Respondent is not the original registrant of the domain name.

The Respondent is Hero Products Group, a Canadian Group that manufacturers a complete range of manual paint colorant dispensers, airless paint sprayers, paint mixers and water pressure washers.

According to the response submitted by the Respondent, Hero Products Group purchased the domain name <corob.com> by a third party with the intention to have it remaining dormant and simply indicating, in the corresponding web site, the ownership of the asset.

The Respondent showed its availability to sell the domain name to the Complainant for the amount of EUR 25.000

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits sufficient evidence in order to prove its trademark rights on the word COROB.

Furthermore, the Complainant contends, in relevant part, as follows:

- The domain name <corob.com> is identical or confusingly similar to the COROB trademark.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name <corob.com> because (i) prior to notice from the Complainant, the Respondent had not used or made demonstrable preparation to use the disputed domain name in connection with a bona fide offering of good or services (ii) the Respondent is not commonly known as COROB and it does not hold any trademark, company name or any other relevant rights to the name which corresponds to the disputed domain name (iii) the Respondent is gaining unjustified benefit for the use of <corob.com> as it is used in connection to a web site including a link to the Respondent's "official" web site www.hero.ca. This represent a serious prejudice for the COROB trademark especially in consideration of the fact that the Respondent is one of the Complainant's main competitors.

- The disputed domain name has been registered and used in bad faith because (i) the Respondent has created a link between the web site corresponding to the domain name in dispute, identical to a competitor's well known trademark, and its own "official" web site www.hero.ca; by acting in this way it is clear that the Respondent is intentionally attempting to attract, for commercial gain, internet users to its "official" web site relying upon the goodwill of the Complainant's trademark COROB (ii) the use of the domain name by the Respondent may be considered as "passive holding" (iii) the Respondent has shown its availability to transfer to the Complainant the disputed domain name for the unreasonable amount of EUR 25.000 which clearly demonstrates that the Respondent obtained the domain name <corob.com> for the purpose of selling it to the holder of COROB trademark.

RESPONDENT:
The Respondent contends, in relevant part, as follows:

- The Respondent is not using the domain name for any monetary benefit as there are clearly no commercial products being promoted and offered for sale.

- The web site under the domain name in dispute makes no reference to the business carried out by the Complainant.

- The trademark COROB and the domain name <corob.com> present some similarities but they are not clearly identical.

- The Respondent acquired the disputed domain name only to protect the business of ICTC HOLDINGS and CPS COLOR GROUP OY from predators who may wish to register the domain name <corob.com>.

- The Respondent believes that the amount of EUR 25.000 may be considered appropriate for an intangible asset such as the disputed domain name.

RIGHTS

The Panel finds that Complainant possesses established legal rights in the term COROB by reason of its long use and in consideration of the trademark registrations for COROB obtained by Complainant in many countries of the world.

The Panel finds that <corob.com> is identical to the Complainant's COROB trademark. The addition of the ".com" suffix does not impact on the analysis of whether a disputed domain name is identical or confusingly similar to the Complainant's trademark (see Priority One Financial Services Inc. v. Michael Cronin, WIPO Case No. D2006-1499 and Laramar Group, L.L.C. v. XC2, WIPO Case No. D2006-0617).

Therefore, the Panel finds that the Complainant has satisfied the first requirement of paragraph 4(a) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant is required under paragraph 4(a) (ii) of the Policy to prove that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

According to paragraph 4(c) of the Policy, a Respondent may establish its rights or legitimate interests in a disputed domain name, among other circumstances, by showing any of the following elements:

"(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services; or

(ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or

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

The Complainant affirms that the Respondent is not commonly known as COROB and that it does not hold any trademark, company name or other relevant right on the word COROB. The Respondent does not submit any evidence showing the ownership of rights on the word COROB.
Furthermore, the Complainant notes that the web site associated with the disputed domain name is a sort of "parking page" explaining that the domain name <corob.com> is owned by the Respondent and including a link to a different web site owned by the Respondent and reachable through the domain name <hero.ca>.

The Panel has verified that when an internet user reaches www.corob.com he or she may read as follows: "The domain name www.corob.com is owned by HERO Products Group a division of I.C.T.C. Holdings Corporation, a manufacturer of colorant dispensers and paint mixers for point of sale, in plant and automotive applications. For more information on HERO please visit us at www.hero.ca Or contact us at Hero Products Group (.....)".

Therefore internet users when reaching the web address corresponding to the domain name in dispute, searching for information related to the company CPS COLOR GROUP OY, are invited to a different web site owned by the Respondent. In addition, it must be clarified that the promoted Respondent's activity, as illustrated in the web site under <hero.ca>, seems quite similar to the Complainant's business.

The Complainant asserts that the invitation on the Respondent's web site may cause a likelihood of confusion and deceive the public into believing that the Respondent is authorized by the Complainant to create a link between the two entities.

The Complainant contends that such use cannot confer rights or legitimate interests upon the Respondent and notes that the Respondent is making an illegitimate, commercial and non-fair use of the disputed domain name.

In the Panel's view, the Complainant's submissions constitute a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Once such a case has been shown, it is for the Respondent to present evidence that it does have such rights or interests, given that these may be matters exclusively within the knowledge of the Respondent.

However, the Respondent does not take a clear position on this specific issue and merely affirms that it acquired the domain name in dispute from a third party in order to avoid the registration from predators who may wish to register the domain name <corob.com>

It is clear that (a) the Respondent does not enjoy any right on the word COROB and (b) the actual use of the disputed domain name does not correspond to a bona fide offering of goods or services. The above finding is confirmed also by the Respondent in its response where it is stated that "Respondent is not using the domain name for any monetary benefit as there are clearly no commercial products being promoted or offered for sale".

In these circumstances, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that the Complainant has met its requirements under paragraph 4(a)(ii) of the Policy.

BAD FAITH

For the purpose of paragraph 4(a)(iii) of the Policy, 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 Respondent has registered or has acquired the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

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

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

(iv) by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on the holder's web site or location.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the domain name in dispute has been registered and is being used in bad faith.

Although the Respondent is not the original registrant of the disputed domain name, the Panel accepts its acquisition as constituting registration for the purposes of the Policy (see MC Enterprises v. Mark Segal(Namegiant.com), WIPO Case No. D2005-1270).

The Respondent affirms that the disputed domain name was not acquired in bad faith and in order to create a detriment to the Complainant's mark but only to protect the business of ICTC HOLDINGS and CPS COLOR GROUP OY from predators who may wish to register the domain name <corob.com>.

In consideration of the above statement it is important to determine whether the Policy's requirement of registration and use in bad faith can be satisfied where the disputed domain name may have been registered (acquired) in good faith but subsequently has been used in bad faith.

According to the recent decision in Ville de Paris v. Jeff Walter WIPO Case No. D2009-1278 which includes also a close reading of the decision in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. 2000-0003 "bad faith registration can be deemed to have occurred even without regard to the state of mind of the registrant at the time of registration, if the domain name is subsequently used to trade on the goodwill of the mark holder".

The above mentioned Panel's view, finds guidance in answering to the question from the analysis and reasoning adopted in the Telstra decision. In Telstra it was noted that, of the four (non-exclusive) scenarios deemed by Paragraph 4(b) of the Policy to be "evidence of registration and use of the domain name in bad faith", only one of these scenarios – the one described in Paragraph 4(b)(iv) – describes an actual use of the domain name. The other three scenarios describe purposes for which the domain name was registered. As the panelist noted, this fact is relevant not only to the issue under consideration in Telstra – which was whether a passive holding of the domain name following a bad faith registration could satisfy the Paragraph 4(a)(iii) requirement – but also whether a bad faith use of a domain name following a non-bad faith acquisition could satisfy the Paragraph 4(a)(iii) requirement. It is relevant to the latter issue because it shows that the Policy expressly deems one particular scenario to be "registration and use of the domain name in bad faith" even though that

scenario makes no mention of the mental state of the registrant at the time of acquisition of the domain name. The Policy expressly states that the Paragraph 4(b) scenarios are “without limitation” – that is, the Policy makes clear that there can be other scenarios that are also evidence of registration and use in bad faith. It follows, therefore, that the Policy expressly recognizes that the Paragraph 4(a)(iii) requirement of bad faith can, in certain circumstances, be satisfied where the Respondent has used the domain name in bad faith, even though the Respondent may not have been acting in bad faith at the time of acquisition of the domain name.

In the present case the Panel finds that Respondent has been using the domain name <corob.com> in bad faith to intentionally attract for commercial gain internet users to its products and services. Actually, the disputed domain name corresponds to a web page containing a link to the Respondent’s “official” web site www.hero.ca where the Respondent’s products and services are obviously illustrated.

In doing so the Respondent is clearly trading on the goodwill associated with the COROB trademark. Such conduct where the Respondent is realizing commercial gain exploiting the reputation of Complainant’s mark was considered as an utilization of the disputed domain name in bad faith in numerous previous WIPO decisions, as for example: Deutsche Telekom AG v. Gary Seto, WIPO Case No. D2006-0690 Zinsser Co. Inc., Zinsser Brands, Co. v. Henry Tsung, WIPO Case No, D2006-0413; Volvo Trademark Holding AB v. Unasi, Inc. WIPO Case No. D2005-0556; Cox Radio, Inc. v. Domain Administrator, WIPO Case No. D2006-0387; Gianfranco Ferré S.p.A. v. Unasi Inc., WIPO Case No. D2005-0622; L’Oreal, Biotherm, Lancome Parfums et Beauté & Cie v. Unasi, Inc., WIPO Case No. D2005-0623; Scania CV AB (Publ) v. Unaci, Inc., WIPO Case No. D2005-0585; Volvo Trademark Holding AB v. Michele Dinoia, WIPO Case No. D2004-0911; Claire’s Stores, Inc., Claire’s Boutiques, Inc., CBI Distributing Corp. v. La Porte Holdings, WIPO Case No. D2005-0589; Members Equity PTY Limited v. Unasi Management Inc., WIPO Case No. D2005-0383.

Furthermore it must be stressed that the Respondent is a competitor of the Complainant and such a consideration is particularly relevant in order to conclude that the domain name in dispute is used in bad faith.

The Panel has duly taken into consideration the argument introduced by the Respondent on this specific issue.

According to the Respondent’s view, the web site corresponding to the contested domain name makes simply reference to the ownership of the domain name <corob.com> and it may be useful for consumers that wish further information with respect to the <corob.com> domain name.

The above statement does not convince the Panel since the Respondent’s web site consists of a clear invitation to visit a web site under a domain name totally different from COROB and easily available for the consumer who initially wished to have information regarding the Complainant products and services and for this reason was looking for a domain name corresponding to the Complainant’s trademark.

In consideration of the fact that the Respondent is a competitor of the Complainant, since they operate in the same sector, the Panel believes that the above mentioned behavior of the Respondent constitutes a sort of unfair competition action and is clearly recognizable under the term of Paragraph 4(b)(iv) of the Policy.

In addition the Panel has duly analyzed the exchange of correspondence related to the possible transfer of the disputed domain name. In this perspective it must be considered that the amount offered by the Complainant for purchasing the disputed domain name (EUR 250/300) seems more appropriate than the amount requested by the Respondent for selling it (EUR 25.000).

This, in consideration of the fact that the asset in question is not connected with any active web site and that, accordingly, the value of <corob.com> may only rely upon the expenses for registering and renewing the domain name.

The Respondent stated that the amount of EUR 25.000 corresponds to the cost sustained in relation to acquisition and maintenance of the domain name especially considering that the asset was purchased by a third party. However the Respondent has not indicated the amount of money paid to the previous domain name’s owner and has not offered any

evidence of payment effectuated in relation to acquisition and/or maintenance of the domain name <corob.com>

Therefore, the Panel's view is that Respondent attempted to sell the disputed domain name to the Complainant for an amount that appears to be in excess of the reasonable out-of-pocket expenses directly related to the disputed domain name.

In light of the above, the Panel is convinced that the Complainant has proven the third element 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 Complainant is a leading supplier of tinting solutions and has provided evidence of ownership on the trademark COROB in many countries. The word COROB exactly corresponds to the disputed domain name <corob.com>.

The Panel finds that the Complainant has established a prima facie lack of legitimate interest of the Respondent in the disputed domain name; the Respondent has not provided the Panel with convincing evidence of legitimate interest in the disputed domain name.

In addition, the Panel also finds that the disputed domain name has been used in bad faith since it includes a link to the "official" Respondent's web site and it is therefore utilized intentionally in order to attract for commercial gain internet users to the Respondent products and services.

Furthermore, records show that Respondent attempted to sell the disputed domain name to the Complainant for an amount that appears to be in excess of the reasonable out-of-pocket expenses directly related to the disputed domain name.

The Panel therefore orders that the domain name <corob.com> is transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COROB.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2010-08-02

Publish the Decision