Decision for dispute CAC-UDRP-100998

Case number	CAC-UDRP-100998
Time of filing	2015-06-02 14:13:50
Domain names	SOFTESSE.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Jacob Holm & Sons AG

Respondent

Organization	Privacy Protection Services Inc.

OTHER LEGAL PROCEEDINGS

None that the Panel has been made aware of.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the trade mark SOFTESSE for nonwoven textile fabric for use in medical gowns and surgical drapes (amongst other things) in the United States of America (trade mark n° 78194233 and n° 78194232), the European Union (trade mark n° 003009503 and n° 013689724) and several other jurisdictions (Australia, Taiwan, China, Bahrain, Egypt, Russian Federation, Saudi Arabia, Turkey, Ukraine, New Zealand, Switzerland, China, WIPO (international trade mark), Norway, Hong Kong, India, Malaysia, Singapore, Taiwan, Thailand, Japan and South Korea / Republic of Korea).

FACTUAL BACKGROUND

The Complainant was founded in 1794 and is headquartered in Switzerland. It produces spunlaced non-woven fabrics used in the home care, hygiene and industrial markets. SOFTESSE is one of the trade marks for products of the Sontara® business that was sold by E. I. du Pont de Nemours and Company Corporation to the Complainant in 2014. The first SOFTESSE trade marks were registered over ten years ago.

At the time that the Complaint was filed, the First Respondent appeared in the publicly available Whois database. However, when the CAC asked the Registrar for confirmation that the First Respondent was indeed the registrant of the disputed domain name, the Registrar lifted the privacy shield to reveal the underlying details of the Second Respondent (the First and Second Respondents are collectively referred to as the Respondent).

The disputed domain name was registered on 28 January 2015. It is currently pointing towards a webpage containing sponsored links and offering the disputed domain name for sale for USD 4,600.

PARTIES CONTENTIONS

Parties' Contentions

Complainant

Identical or confusingly similar

The Complainant states that the disputed domain name is identical to the Complainant’s SOFTESSE trade mark.

No rights or legitimate interests

The Complainant points out that the Respondent is not using the disputed domain name and has made no demonstrable preparations to use it for any bona fide offering of goods and services or any other legitimate purpose. The Respondent is not hosting any content on the website, except some links to third party websites and an offer to sell the domain name, as follows: "Buy this domain. The owner of softesse.com is offering it for sale for an asking price of 4.600 USD!"

In addition, the Complainant states that the disputed domain name was initially used to display third party trade marks as links: for instance the trade mark IVRAXO SOFT, registered in Germany by Peter Greven GmbH & Co KG for "liquid soap, soap crème and liquid hand cleaner" in class 3, and the trade mark LIFOSAN, registered in several jurisdictions for different goods in classes 3 and 5 by B. Braun Melsungen AG.

The Complainant argues that there is a general consensus that using a domain name for a parking page displaying sponsored links does not constitute bona fide use for the purposes of the Uniform Domain Name Dispute Resolution Policy (the Policy). Furthermore, to the best of the Complainant’s knowledge, the Respondent has no registered or unregistered trade mark rights in the term SOFTESSE, and there is no evidence that the Respondent is commonly known by the disputed domain name.

Finally, the Complainant points out that the Respondent has no connection or affiliation with the Complainant.

Registered and used in bad faith

In the Complainant's opinion, given that the Respondent does not use the disputed domain name for a bona fide offering of goods or services, the disputed domain name was primarily registered to be offered for sale, as shown by the wording on the corresponding website.

In addition, considering that the disputed domain name is identical to a trade mark that has been in use for well over ten years, and that the trade mark consists of a fanciful term, the Complainant argues that it must be inferred that the only potential buyer with a legitimate interest would be the owner of the trade mark. The Complainant also notes that the asking price of USD 4,600 is far in excess of any registration costs that the Respondent might have incurred.

Furthermore, the fact that the disputed domain name displays links to third party websites, from which the Respondent is likely to derive revenue, is further evidence of bad faith registration and use under the Policy. Finally, the Complainant points out that the use of a privacy service to hide the identity of the real registrant is another factor indicating the Respondent’s bad faith.

Respondent

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has shown, to the satisfaction of the Panel, that the disputed domain name is identical to a trade 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 shown, to the satisfaction of the Panel, that the Respondent has 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 shown, to the satisfaction of the Panel, 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

Further to the Registrar's removal of the privacy shield, the CAC offered the Complainant the opportunity to amend the Complaint, but the Complainant did not wish to do so.

However, under the Policy a Panel may use his or her discretion to decide on the proper Respondent(s), and so the Panel directed the CAC to add the Second Respondent on the basis that it registered and controlled the disputed domain name (and indeed now appeared in the publicly available Whois), and thus should be treated accordingly.

The Panel is satisfied that all procedural requirements under the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In this case the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel is therefore obliged to make its decision on the basis of the factual statements contained in the Complaint and the documents made available by the Complainant to support its contentions.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following for a panel to order a transfer of the domain name at issue:

(i) the domain name registered by the respondent is identical or confusingly similar to a trade mark or service mark in which Complainant has rights; and

(ii) the respondent has no rights or legitimate interests in the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has trade mark rights in the term SOFTESSE.

The Panel considers that, as previously held in numerous decisions, the generic Top Level Domain suffix .COM is without legal significance and has no effect on the issue of similarity.

On the basis of these considerations, the Panel finds that the disputed domain name is identical to a trade mark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element that the Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the disputed domain name (Policy, paragraph 4(a)(ii)).

Paragraph 4(c) of the Policy sets out various ways in which a respondent may demonstrate rights or legitimate interests in the domain name at issue, as follows:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you 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 (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

The Panel has considered the evidence put forward by the Complainant and is of the view that the Complainant has presented a clear prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name. As a result of its default, the Respondent has failed to rebut that showing.

Whilst sale of traffic (in other words pointing domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy, it is necessary to take into account all the surrounding circumstances in each case. In this particular instance, the Panel considers that the fact that the disputed domain name cannot be said to be descriptive is crucial, as well as the fact that the Complainant has produced evidence that the advertising links on the corresponding website have made reference to other trade marked terms. It may well be that such links have been placed there automatically, but this is not relevant as the use to which the disputed domain name is put ultimately remains the responsibility of the Respondent.

Thus the Respondent cannot be considered to be making a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy referred to above. Nor can such use be said to be a legitimate non-commercial or fair use of the domain name within the meaning of paragraph 4(c)(iii), as, in the Panel's opinion, the Respondent is undoubtedly earning revenue via the click-through links.

Given the above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The third element that the Complainant must prove is that the disputed domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy sets out various circumstances which may be treated by the Panel as evidence of the registration and use of a domain name in bad faith, as follows:

"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 you have registered or you have 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 trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have 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 your website or location or of a product or service on your website or location."

On the balance of probabilities, the Panel is satisfied that the Respondent's conduct falls within paragraph 4(b)(i) of the Policy, given the fact that the disputed domain name appears to be for sale for USD 4,600 on the corresponding website. Whilst trading in domain names for profit is of itself a lawful activity, this is not the case when the domain name in question is clearly not a generic or descriptive term.

On the basis of the evidence put forward by the Complainant, the Panel is also satisfied that the Respondent's conduct falls within paragraph 4(b)(iv) of the Policy. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SOFTESSE.COM**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2015-07-15

Publish the Decision