# Decision for dispute CAC-UDRP-101403

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| Case number | CAC-UDRP-101403 |
| Time of filing | 2017-01-05 09:41:08 |
| Domain names | perspirexplusvn.com |

## Case administrator

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| Name | Aneta Jelenová (Case admin) |

## Complainant

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| Organization | Riemann Trading ApS |

## Complainant representative

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| Organization | BrandIT GmbH |

## Respondent

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| Name | BUI QUANG PHUONG |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the international trademark registration No 770743 PERSPIREX in classes 3 and 5, which designates several countries all over the world, including Viet Nam.

The Complainant is also the owner of numerous domain name registrations containing the term PERSPIREX.

FACTUAL BACKGROUND

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

The Complainant is a Danish company established in 1979 that trades internationally, including in Asia, under the name "Perspirex" in the field of skin care products. The company currently focuses on two brands, the antiperspirant “Perspirex”, and the sunscreen “P20”.

The Complainant operates its main websites at www.riemann.com, www.p20.com and www.perspirex.com and owns a number of domain names consisting of the term "perspirex", including <perspirex.dk>, <perspirex.co.uk>, and <perspirex.vn>.

The Disputed domain name is <perspirexplusvn.com>. It was registered by the Respondent on 30 August 2016.

The Disputed domain name points to a website displaying text in Vietnamese and in English and pictures of products having the same shape and name of Perspirex products. Next to the picture of the products, the following text in English appears: "Perspirex - Don't Sweat it - Stay dry for up to 5 days" together with a list of advantages of the product and the mention that other Perspirex products are also available. The website includes a telephone number for ordering the product at a discounted price.

The Complainant claims it has registered the well-known trademark PERSPIREX as a word mark in classes 03 and 05 in numerous countries all over the world including Viet Nam being listed as a designation.

The Complainant observes that the above-mentioned international trademark registration of 2001 predates the registration of the Disputed domain name.

The Complainant contends it has registered more than 37 domain names under generic Top-Level Domains and country-code Top-Level Domains containing the term “PERSPIREX”, pointing to a website through which it informs potential customers about its products.

The Complainant contends that the Disputed domain name directly and entirely incorporates the Complainant’s trademark PERSPIREX.

The Complainant observes that the addition of the generic Top-Level Domains “.com” does not add any distinctiveness to the Disputed domain name.

The Complainant claims that the Disputed domain name incorporates the PERSPIREX trademark coupled with the term “plus”, which is a descriptive term for goods and services, and the term “vn”, which is the commonly known country code for Viet Nam, where the Respondent is located.

The Complainant asserts that the Disputed domain name should be considered as confusingly similar to the registered trademark PERSPIREX because it gives the impression that the Respondent is somehow affiliated with the Complainant, and that the Respondent is somehow legitimately doing business in Viet Nam using the Complainant's trademark.

The Complainant claims that it has not found that the Respondent is commonly known by the Disputed domain name.

The Complainant asserts that the Respondent has not, by virtue of the content of the website, nor by its use of the Disputed Domain Name, shown that they will be used in connection with a bona fide offering of goods or services.

The Complainant states that there is no evidence that the Respondent has a history of using, or preparing to use, the Disputed domain name in connection with a bona fide offering of goods and services.

The Complainant contends that it is clear that the Disputed domain name was registered with the intention of taking advantage of an association with the business of the Complainant.

The Complainant states that it does not have any agreement or association with the Respondent.

The Complainant observes that the layout of the Respondent’s website together with the prominent use of the PERSPIREX logo suggest that there is a connection with the Complainant.

The Complainant contends that the use of the word PERSPIREX in the Disputed domain name and also in the text of the website multiple times strongly suggests that there is some official or authorized link with the Complainant for the purposes of selling its products within Viet Nam.

The Complainant contends that it is undeniable that the Respondent was aware of the Complainant's trademark prior to the registration of the Disputed domain name and the establishment of the Respondent's website.

Moreover, the Complainant alleges that the Respondent has made no claims to either having any relevant prior rights of its own, or about having become commonly known by the Disputed domain name. The Complainant adds that the Respondent does not claim to have made legitimate, non-commercial use of the Disputed domain name.

The Complainant highlights that the Complainant's trademarks predate the registration of the Disputed domain name and the Respondent has never been authorized by the Complainant to register the Disputed domain name.

The Complainant observes that, in light of the website content, it is clear that the Respondent was aware of the Complainant's trademark at the time of registration and, therefore, the Disputed domain name was registered in bad faith.

The Complainant adds that the Respondent disregarded the Complainant's attempts to reach an amicable solution of the matter, failing to respond to its cease and desist letters.

The Complainant contends that the Respondent intentionally chose the Disputed domain name based on the registered and well-known trademark in order to generate more traffic to its own business.

The Complainant observes that the Respondent does not disclaim an association between itself and the Complainant.

The Complainant adds that the Disputed domain name is used for a website claiming to sell the Complainant's products, consequently, the Respondent is using the Disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

The Complainant found, by a reverse Whois lookup based on the Respondent's e-mail address, that the Respondent registered some domain names including well-known brands with protected trademarks such as HYUNDAI within the domain name.

The Complainant contends that such pattern of abusive registrations does not constitute bona fide use of the Disputed domain name and that it is clear that the Respondent is capitalizing on well-known trademarks.

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

Language of the Proceedings

Paragraph 11(a) of the Rules provides that "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".

The language of the Registration Agreement is Japanese, therefore the language of the proceedings should be Japanese, unless otherwise agreed by the parties. The Complaint, however, was filed in English. Further to the notification of the Complaint's deficiency, the Complainant submitted a request to change the language of the proceedings into English based, inter alia, on the following reasons:

1) the Respondent did not reply to the "cease and desist" letter and reminders sent in English, nor responded that he did not understand the content of the letters;

2) the trademark PERSPIREX, contained in the Disputed domain name, is owned by a company having a global presence and having English as main business language, as is evident from the language used in the Complainant's websites;

3) the Disputed domain name contains the English word "plus", which means "involving or noting addition" (as adjective) or "more by the addition of; increased" (as preposition);

4) the Respondent registered several domain names including well-known trademarks protected worldwide, corresponding to brands mainly advertised in English;

5) the Complainant is a Danish company and translating the Complaint into Japanese would cause unnecessary delay and cost.

Having considered the Complainant's submission regarding the language of the proceedings and the overall circumstances of this case, including the fact that also English is used in the Respondent's website, the Panel accepts the Complaint in English and shall render its decision in English.

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

## PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraphs 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate that:

(i) The Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed domain name; and

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

IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant has established that it has rights in the trademark PERSPIREX and has argued that the addition in the Disputed Domain Name of the terms "plus", which is a descriptive term of goods or services, and the term "vn", which makes reference to the country code for Viet Nam, is not sufficient to avoid confusion.

The Panel agrees with the Complainant's argument that the addition of a generic term (be it a geographical expression and/or a descriptive term of goods or services) is not sufficient to avoid confusion. See, for example, WIPO Case No. D2016-2210 for the addition of a descriptive term and CAC case No. 101270 for the addition of a term corresponding to a country code.

Moreover, it is well established that merely adding a TLD to a trademark is not sufficient to distinguish a domain name from a trademark. See, for example, CAC Case No. 100831.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed domain name.

The Respondent has no connection or affiliation with the Complainant.

The Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademark.

The Respondent does not appear to be commonly known by the name "perspirex" or by a similar name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the Disputed Domain Name, nor any use in connection with a bona fide offering of goods or services.

Indeed, the Respondent is using the Disputed Domain Name for a website which looks like an official PERSPIREX website.

In fact, the Respondent is using the Disputed Domain Name to attract Internet users to its website, where the Respondent claims to be selling PERSPIREX branded products from Denmark.

The Respondent's website, including in a prominent way the PERSPIREX trademark, strongly suggests that there is a connection with the Complainant.

Taking into account the fact that the Respondent has no connection or affiliation with the Complainant, and that the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademark, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the Disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the Disputed domain name was registered in bad faith and that it has been used in bad faith.

In particular, the Panel accepts the Complainant's unchallenged assertions that the Respondent is using the Disputed domain name with the aim of intentionally attracting, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

Indeed, it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark PERSPIREX when registering the Disputed domain name. If the Respondent had legitimate purposes in registering and using the Disputed domain name it would have responded to the Complainant's "cease and desist" letter, or filed a Response in this proceeding.

Accordingly, the Panel finds that the Disputed domain name was registered and is being used in bad faith within the

meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PERSPIREXPLUSVN.COM**: Transferred

## PANELLISTS

| Name | **Michele Antonini** |
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DATE OF PANEL DECISION 2017-02-07

Publish the Decision