Decision for dispute CAC-UDRP-101448

Case number	CAC-UDRP-101448
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Domain names	severina.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Name	Severina Kojić

Complainant representative

Organization	PETOSEVIC DOO

Respondent

Organization	Orbis d.o.o

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.

FACTUAL BACKGROUND

The Complainant, Severina Kojić, is a well-known music star in Croatia, Slovenia, Bosnia and Herzegovina, Macedonia, Montenegro and Serbia. The Complainant started her music career in the 1980s and is best known under her name SEVERINA. The Complainant's career of over thirty year has made her name famous in Croatia, other Balkan countries and beyond.

The Complainant owns a Serbian trademark registration no. 50376 with priority of January 22, 2004 as well as a Croatian and International Trademark application for SEVERINA logo with priority of January 19, 2017.

The Complainant has significant Internet presence in various medias with over 260 million views on YouTube and over a million and a half followers on Facebook and Instagram.

The disputed domain name was registered by the Respondent in 2008. The Respondent is not known by the disputed domain name, is using the disputed domain name as a parking site with active links comprising the name of the Complainant and to music related services.

PARTIES CONTENTIONS

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The Respondent did not reply to the Complainant's contentions.

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.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

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.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. In addition, personal names, especially when they are registered as trademarks, have long been recognized to be protected under the UDRP. (Julia Fiona Roberts v. Russell Boyd, WIPO Case No. D2000-0210; Jeanette Winterson v. Mark Hogarth, WIPO Case No. D2000-0235).

The Complainant’s name is Severna and she is the owner of a registered trademark and several applications for the mark SEVERINA. For example: Serbian trademark registration no. 50376, with the registration date of January 22, 2004; Croatian and International Trademark application for SEVERINA logo designating Slovenia, Bosnia and Herzegovina, Montenegro, Macedonia and Serbia with priority of January 19, 2017.

The disputed domain name <SEVERINA.com> is identical to the registered trademark SEVERINA. The disputed domain name integrates the Complainant’s trademark SEVERINA in its entirety.

The addition of the generic Top-Level Domain (“gTLD”) suffix “.com” does not have the capacity to distinguish the disputed domain name from the Complainant’s registered trademark and is disregarded when comparing the disputed domain name with the Complainant’s trademark. See Volkswagen AG v. Todd Garber, WIPO Case No. D2015-2175; see also Dassault (Groupe Industriel Marcel Dassault) v. Ma Xiaojuan, WIPO Case No. D2015-1733; Lego Juris A/S v. Chen Yong, WIPO Case No. D2009-1611; Dr. Ing. h.c. F. Porsche AG v. zhanglei, WIPO Case No. D2014-0080.

Consequently, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to the SEVERINA trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the disputed

domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 2.1.

In the present case, the Complainant has demonstrated to the Panel that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent had failed to assert any such rights or legitimate interests.

The Panel finds that the Complainant has established a prima facie case in this regard, inter alia, due to the fact that the Complainant has not licensed or otherwise permitted the Respondent to use the SEVERINA trademark, or a variation thereof.

The Respondent has not submitted a response and did not provide any evidence to show any rights or legitimate interests in the disputed domain name that is sufficient to rebut the Complainant's prima facie case.

In the circumstances of this case, and in light of the Respondent's use of the disputed domain name set out in more detail below, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence, which shows that the Respondent registered the disputed domain name long after the Complainant has registered her trademark in 2004 and many years after the Complainant started her musical career. The evidence provided by the Complainant shows that, by 2008, when the disputed domain name was acquired by the Respondent, the Complainant was already famous in Croatia and the Balkan countries. The Complainant also submitted evidence showing that the Respondent was aware of the Complainant and her work before he acquired the disputed domain name in 2008.

According to the evidence filed by the Complainant, the Complainant has owned a registration for the SEVERINA trademark in Croatia since at least the year 2004 and has been a famous music star since the 1980s. It is suggestive of the Respondent's bad faith in these particular circumstances that the trademark, owned by the Complainant, was registered long before the registration of the disputed domain name (Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735; Skattedirektoratet v. Eivind Nag, WIPO Case No. D2000-1314).

The disputed domain name is identical to the Complainant's trademark. Previous UDRP panels have ruled that "[a] likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see Edmunds.com, Inc v. Triple E Holdings Limited, WIPO Case No. D2006-1095). To this end, prior UDRP panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the Policy.

The Respondent's use of the trademark of the Complainant on a website under the disputed domain name is also suggestive of the Respondent's bad faith. The Respondent is providing links to musical services on the web site under the disputed domain name. It was held in previous UDRP decisions that it is presumptive that using a highly distinctive trademark with a longstanding reputation is intended to make an impression of an association with the Complainant (see Swarovski Aktiengesellschaft v. fan wu, WIPO Case No. D2012-0065). Indeed, "when a domain name is so obviously connected with a Complainant, it's very use by a registrant with no connection to the Complainant suggests 'opportunistic bad faith'" (Tata Sons Limited v. TATA Telecom Inc/Tata-telecom.com, Mr. Singh, WIPO Case No. D2009-0671).

Based on the Complainant's evidence presented to the Panel, it appears that the Respondent is parking the disputed domain name and provides related links including, the Complainant's name and links to music. These links are designed to attract Internet users searching for the Complainant and promote products associated with the Complainant or music alongside

those of the Complainant's competitors, without the Complainant's authorization for commercial gain. Thus, the Panel finds clear evidence that the Respondent registered and is using the disputed domain name with knowledge of the Complainant and its trademark, and indicates that the Respondent's primary intent with respect to the disputed domain name has been to trade off the value of the good will associated with the Complainant's mark. The Respondent's actions therefore constitute bad faith. (See Herbalife International, Inc. v. Surinder S. Farmaha, WIPO Case No. D2005-0765, stating that "the registration of a domain name with the knowledge of the complainant's trademark registration amounts to bad faith".)

The Complainant also provided evidence to show that while the disputed domain name was registered on the Respondent's name, the Complainant was named as the Administrative Contact for the disputed domain name, without her approval. This use of the Complainant's name as the Administrative Contact, when it is provided without her consent is an additional indication of bad faith registration and use of the disputed domain name.

The Complainant provided evidence that the Respondent has made an offer to sell the disputed domain name to the Complainant for USD30,000, which is above the cost of registration actually incurred. While offers for sale of domain names by themselves do not serve as indication of bad faith, under the present circumstances, when the disputed domain name was acquired by the Respondent long after the trademark registration of the Complainant's mark and in view of her fame, the use of the disputed domain name to profit from pay-per-click services or gain Internet traffic to be directed to services or products associated with the Complainant's business, is a clear indication of bad faith registration and use.

Finally, shortly after receiving a cease and desist letter from the Complainant's counsel, instead of responding to the Complainant's counsel, the Respondent activated a privacy shield, which was intended to obscure his identity, and prevent the Complainant from enforcing her rights in her trademark. Such behavior is also an indication of bad faith registration and use of the disputed domain name.

Based on the evidence presented to the Panel, including the late registration of the disputed domain name, the evidence of reputation of the Complainant and the Complainant's trademark, the Respondent's use of the disputed domain name, the failure of the Respondent to respond to the Complaint, the offer to sell the disputed domain name at more than cost incurred by the Respondent and the subsequent activation of the privacy shield, the Panel finds that the disputed domain name was registered and is being used in bad faith.

Accordingly, having regard to the circumstances of this particular case, the Panel finds that the Complainant has met its burden under paragraph 4(a)(iii) of the Policy.

Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <severina.com> be 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. **SEVERINA.COM**: Transferred

PANELLISTS

Name	**Jonathan Agmon**

DATE OF PANEL DECISION 2017-03-26

Publish the Decision