

Decision for dispute CAC-UDRP-104389

Case number CAC-UDRP-104389

Time of filing 2022-03-02 09:47:08

Domain names zinodavidoff.xyz

Case administrator

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

Complainant

Organization Zino Davidoff SA

Complainant representative

Organization BRANDIT GmbH

Respondent

Name QINGRU LIU

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 is the owner of the international trademark "ZINO DAVIDOFF", registration number 467511, registered from 27 January 1982 in classes 14, 15, 16, 18, 20, 21, 25 and 33.

The Complainant is also the owner of domain name <zinodavidoff.com> registered since 20 April 1998.

The disputed domain name <zinodavidoff.xyz> was registered on 4 January 2022.

FACTUAL BACKGROUND

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

The Complainant presented that it is incorporated in Switzerland and is a leading producer of fragrances, handbags, eyewear, as well as exclusive timepieces, writing instruments and leather accessories and other goods that enjoy a high reputation and use brands ZINO DAVIDOFF / DAVIDOFF. The Complainant and its trademarks enjoy a high reputation around the world, including China, where the Respondent is domiciled, due to the Complainant's long-term use and publicity. The Complainant's goods are also often sold on the flights to and from China and appear among others in in-flight catalogues

and magazines. Therefore, numerous passengers (including a number of Chinese passengers) have a very convenient way to directly access the Complainant's goods. In 2021, the Complainant had around 80 stores throughout China's major cities and its products were sold on popular online malls such as JD.com.

The Complainant's trademark registrations (international trademark ZINO DAVIDOFF no. 467511 and trademark DAVIDOFF in Chinese translation no. G467510) predates the disputed domain name registration by several years. The Complainant also owns various registrations for domain names that include its trademarks such as <zinodavidoff.com> or <zinodavidoff.asia>. The Complainant also operates its website in the Chinese language.

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name incorporates the Complainant's well-known trademark ZINO DAVIDOFF / DAVIDOFF in its entirety, which directly refers to the Complainant and its business activities. The addition of the gTLD ".xyz" does not add any distinctiveness to the disputed domain name.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the trademark in any forms, including the disputed domain name.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name. When searched for "ZINO DAVIDOFF" in the Google and Baidu (the leading search engine in China), the returned results all pointed to the Complainant and its business activities.

The Respondent could have easily performed a similar search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in China and many other countries worldwide. In addition, according to the registrar verification, the Respondent is an individual named "LIUQINGRU", which is not related to the Complainant nor to the term "ZINO DAVIDOFF" in any form.

By the time the Complainant prepared this Complaint on 28 February 2022, the disputed domain name resolved to a website offering the disputed domain name for sale for 955 USD or for leasing for 107 USD/month. The Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

When Internet users, who search for information about the Complainant and/or about the brand "ZINO DAVIDOFF", see the disputed domain name and the website under construction, would very likely be confused and be led to believe that the disputed domain name is somehow related to the Complainant and be disappointed as they would not find the information as expected – which will lead to trademark tarnishment for the Complainant.

From the Complainant's perspective, the Respondent deliberately chose to incorporate the well-known trademark ZINO DAVIDOFF in the disputed domain name, very likely with the intention to attract Internet traffic by benefiting from the Complainant's worldwide renown.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

Most of Complainant's trademark registrations predate the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to register the disputed domain name. Considering the renown of the Complainant and its trademark, and the overall composition of the disputed domain name, i.e. using the term "ZINO DAVIDOFF" in its entirety which refers directly to the Complainant and its business activities, it follows that the use of the well-known trademark ZINO DAVIDOFF / DAVIDOFF in the disputed domain name is a deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

Considering the facts that the Respondent very likely knew about the Complainant and its trademark the Complainant's

trademark is a well-known trademark worldwide and in China where the Respondent resides and the Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name, the disputed domain name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1. and para.3.1.4.

The Complainant noted that the Respondent has been listing the disputed domain name for sale for 955 USD or for leasing for 107 USD/month, which is excessive to its out-of-pocket expenses. Obviously, as the disputed domain name is identical to the Complainant's trademark, the Respondent "has intentionally attempted to attract, for commercial gain, Internet users to its 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."

In addition, the Complainant tried to reach the Respondent by a cease-and-desist letter and followed-up by sending a reminder. However, until the time the Complainant prepared this Complaint, it has not received response from the Respondent.

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

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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

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

I. Identical or Confusingly Similar

The Complainant presented that it owns trademark „DAVIDOFF“ in Chinese translation, registration number G467510, but did not provide any evidence related to such trademark. There have not been any G467511 trademark mentioned in the annexes provided by the Complainant and the annexes that should contain the Chinese registration of the trademark no. G467510 have not been presented in the English as the language of the proceedings. The Complainant further presented that it owns domain name <zinodavidoff.asia> registered since 27 December 1997, but the registration of this domain has not been confirmed by the registry of the .ASIA top level domain in its relevant WHOIS records.

However, the Complainant has established the fact that it has valid rights for the "ZINO DAVIDOFF", registration number 467511, registered from 27 January 1982 in classes 14, 15, 16, 18, 20, 21, 25 and 33 and that it owns domain name <zinodavidoff.com> that includes the same distinctive wording ZINODAVIDOFF.

The disputed domain name has been registered on 4 January 2022, i.e. almost 40 years after the ZINO DAVIDOFF trademark registration, and wholly incorporates the Complainant's trademark ZINO DAVIDOFF and is therefore identical to it. Two words of the trademark (ZINO and DAVIDOFF) are divided by the space which is deleted in the disputed domain name, but the replacement of the space is usually made by the deletion or by the hyphen as the space is not supported character to be used in the domain names. Therefore, the deletion of the space between two parts of the trademark does not distinguish the disputed domain name from the Complainant's trademark.

The generic top-level domain "XYZ" should be disregarded in the assessment under the Policy when comparing disputed domain name and trademark and does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain name to be identical to the Complainant's trademark ZINODAVIDOFF which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant. The disputed domain name is not used and is (or has been) offered to be sold or leased only, and therefore does not constitute a bona fide offering of goods and services or a legitimate non-commercial fair use. The Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication nor evidence that the Respondent is commonly known by the term "ZINODAVIDOFF" or its variations or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Panel therefore considers 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.

III. Registered and Used in Bad Faith

Considering the distinctiveness of the Complainant's trademark and reputation based on a long term worldwide use of the trademark (including the use on the territory of China where the Respondent is domiciled) it is evident that the Respondent had the Complainant and its trademark in mind when registering the disputed domain name and, therefore, the disputed domain name shall be deemed as registered in bad faith.

Furthermore, the disputed domain name has been offered for the sale or leasing only and there is no evidence that it has been really used. The incorporation of a famous trademark into a domain name, coupled with an offer to sale or lease of the disputed domain may be the evidence of bad faith use as well.

The Panel therefore considers 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.

The Panel finally considers that the Complainant has shown that the disputed domain name is identical to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

Accepted

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

1. ZINODAVIDOFF.XYZ: Transferred

PANELLISTS

Name	JUDr. Petr Hostaš
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DATE OF PANEL DECISION 2022-04-06

Publish the Decision
