

Decision for dispute CAC-UDRP-104600

Case number CAC-UDRP-104600

Time of filing 2022-05-24 09:25:16

Domain names ifixsurface.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Microsoft Corporation

Complainant representative

Organization Convey srl

Respondent

Name Wen Chen

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain name <ifixsurface.com> ("the disputed domain name").

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- International trade mark registration no. 1321384, registered on 12 August 2016, designating, inter alia, China, for the word mark SURFACE, in class 9 of the Nice Classification;
- International trade mark registration no. 1135373, registered on 10 August 2012, designating, inter alia, China, for the word mark SURFACE, in classes 9 and 15 of the Nice Classification;
- International trade mark registration no. 1508162, registered on 5 December 2019, designating, inter alia, China, for the word mark SURFACE DUO, in class 9 of the Nice Classification;
- International trade mark registration no. 1525697, registered on 10 March 2020, designating, inter alia, China, for the word mark SURFACE NEO, in class 9 of the Nice Classification;
- EU trade mark registration no. 005955018, registered on 6 March 2008, for the word mark MICROSOFT SURFACE, in class 9 of the Nice Classification; and
- EU trade mark registration no. 006340152, registered on 19 August 2008, for the word mark SURFACE, in class 9 of the Nice Classification.

(hereinafter, collectively or individually, “the Complainant’s trade mark”; “the Complainant’s trade mark SURFACE”; or “the trade mark SURFACE” interchangeably).

FACTUAL BACKGROUND

The Complainant’s contentions can be summarised as follows:

A. Background history

The Complainant is Microsoft Corporation, a company founded in 1975, and headquartered in Redmond, Washington, USA. The Complainant develops, manufactures, licenses, supports, and sells computer software, consumer electronics, personal computers, and related services.

The Complainant is amongst the leading players in the hi-tech world, with approximately 120 subsidiaries and 160,000 employees worldwide. Amongst its products, Microsoft Surface is a series of touchscreen-based personal computers, tablets and interactive whiteboards.

By way of relief, the Complainant seeks the transfer of the disputed domain name <ifixsurface.com> to the Complainant on the grounds advanced in section B below.

B. Legal grounds

I. The disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

The Complaint submits that the disputed domain name <ifixsurface.com> incorporates the Complainant’s trade mark SURFACE in its entirety; that the additional generic terms “I FIX” in the disputed domain name could suggest an association with, or an authorisation by, the Complainant; that such generic terms are insufficient to avoid the likelihood of confusion and, instead, can increase the confusing similarity between the disputed domain name and the Complainant’s trade mark; and that it is well established that generic Top-Level Domains (“gTLDs”), in this case <.com>, are not relevant in the appreciation of confusing similarity.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent does not carry out any activity for, or has any business with, the Complainant. Neither licence nor authorisation has been given to the Respondent to make any use of the Complainant’s trade mark SURFACE, or to apply for registration and use of the disputed domain name on the Complainant’s behalf. Moreover, the Respondent is not known by the disputed domain name.

The Complainant avers that the disputed domain name was registered on 21 September 2020, and that it resolves to a website dedicated to repair services for the Complainant’s products (“the Respondent’s website”). The Complainant further avers that the Respondent’s website demonstrates neither a bona fide offering of goods nor a legitimate interest of the Respondent. In addition, the Complainant claims that the Respondent has failed to meet the third requirement of the Oki Data test, namely the Respondent’s website does not disclose accurately and prominently the Respondent’s relationship with the trade mark holder.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

Registration

The Complainant states that the disputed domain name was registered many years after the registration of the Complainant's trade mark SURFACE; that the Complainant has extensively used the trade mark SURFACE on all Internet environments, including, but not limited to, the Complainant's official website; that the Complainant has had a presence in China for more than 20 years, where the Respondent appears to reside; and that in light of the intensive use of the trade mark SURFACE, coupled with the advertising and sales of the Complainant's products worldwide, the Respondent could not have ignored the existence of the Complainant's trade mark SURFACE.

Therefore, the Complainant states that the Respondent was well aware of the Complainant at the time of registration of the disputed domain name.

Use

The Complainant contends that the Respondent uses the disputed domain name in bad faith in so far as the Respondent's website is dedicated to repair services for the Complainant's products, however without authorisation being given to the Respondent to register and use the trade mark SURFACE.

Furthermore, the Respondent's website does not contain express disclaimers regarding the absence of relationship between the Claimant and the Respondent.

As additional indicia giving rise to a presumption of bad faith, the Complainant refers to the Respondent's failure to respond to the Complainant's cease-and-desist letter.

The Complainant states that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (paragraph 4(b)(iv) of the UDRP Policy).

In view of the above, the Complainant therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP 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 UDRP 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 UDRP Policy).

PROCEDURAL FACTORS

Preliminary matter – Language of Proceeding

A. The Complainant's language request

On the matter of the language of the proceedings, the Panel notes as follows:

- The Complainant submitted its Complaint in English and made a pre-emptive request that English be the language of the proceedings;
- The registrar’s verification response provided that the language of the registration agreement for the disputed domain name is Chinese; and
- The Complainant’s grounds for English to be the language of the proceedings can be summarised as follows: (i) the disputed domain name contains Latin characters, including the term “ifix”, and the Generic top-level domain (gTLD) <.com>; (ii) the Respondent’s website contains English words such as “laptop”, “new”, “book”, “pro” and “wifi”; (iii) the Respondent, being active in the high-tech industry sector, could not ignore English as the primary language for international relations and business; and (iv) a translation of the Complaint into Chinese would be unfair and cause additional expense and delays.

B. The Panel’s determination

The Panel is given discretion under Rule 11 of the UDRP Rules to determine the appropriate language of the proceedings. The Panel notes Rule 10 of the UDRP Rules, which vests the Panel with authority to conduct the proceedings in a manner it deems appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

On this particular matter, the Panel takes the liberty to adopt the language of proceeding test applied in CAC Case no. 104144, *Writera Limited v. alexander ershov*, which helpfully sets out the following six guiding factors:

- (i) the language of the disputed domain name string: the Panel accepts that English is the only identifiable language in the disputed domain name string;
- (ii) the content of the Respondent’s website: although the Respondent’s website is predominantly in Chinese language, there are various references in English, including a welcome message, in English, on the landing page “working for you anytime, anywhere”, which suggests to the Panel that the Respondent has knowledge of the English language;
- (iii) the language(s) of the Parties: the Complainant is originally from the US and the Respondent appears to reside in China. Neither English nor Chinese would be considered a common language between the Parties. Consequently, this factor is immaterial to the Panel’s determination on this occasion;
- (iv) the Respondent’s behaviour (pre-dispute and in the course of the proceedings): the Panel notes that the Respondent has shown no inclination to participate in the proceedings; the Respondent did not respond to the Complainant’s cease-and-desist letter, nor did it file a Response;
- (v) the Panel’s overall concern with due process: the Panel has discharged its duty under Rule 10 (c) of the UDRP Rules; and
- (vi) the balance of convenience: while determining the language of proceedings, the Panel has a duty to consider who would suffer the greatest inconvenience as a result of the Panel’s determination. On the one hand, the determination of English as the language of proceedings – a widely spoken language – is unlikely to cause the Respondent any inconvenience, not least given the Respondent’s default and overall disinterest pre- and throughout the proceedings. The determination of Chinese as the language of proceedings, on the other hand, is very likely to cause the Complainant inconvenience, and to interfere with the overall due expedition of the proceedings under the UDRP Rules.

In view of the above factors, the Panel has decided to accept the Complainant’s language request, such that the decision in the present matter will be rendered in English.

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.

The UDRP threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to divest the Respondent of the disputed domain name:

- i. The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- 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 are being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities, which lays down the foundations for panels to determine each of the three Policy elements.

I. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns trade mark rights in "SURFACE" since 2008.

The disputed domain name is <ifixsurface.com>, and the Complainant's trade mark is SURFACE.

The Panel has no difficulty in finding that the disputed domain name is confusingly similar to the Complainant's trade mark SURFACE, in accordance with paragraph 4(a)(i) of the UDRP Policy.

The adjacent term "ifix" in the disputed domain name string has no material impact on the confusing similarity assessment, such that the disputed domain name clearly evokes the Complainant's trade mark SURFACE.

Lastly, the gTLDs, in this case <.com>, are typically disregarded by UDRP panels under this Policy ground (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

II. Rights or Legitimate Interests

The Respondent has defaulted in these UDRP proceedings. Nevertheless, the Panel is empowered to draw adverse inferences from the Respondent's silence (Rule 14 (b) of the UDRP Rules).

The Panel notes that the Complainant firmly denies any affiliation and/or association with, or authorisation/endorsement/sponsorship for, the Respondent of any nature. Moreover, the Complainant argues that the Respondent is not known by the disputed domain name; and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

The Panel also notes that the Complainant claims not to have authorised the Respondent to use the Complainant's trade mark SURFACE nor to provide repair services for the Complainant's products on the Respondent's website. On this particular point, the Panel refers to paragraph 2.8 of the WIPO Jurisprudential Overview 3.0, according to which resellers, distributors

or service providers using a domain name containing a complainant's trade mark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services, and thus have a legitimate interest in such domain name. UDRP Panels have termed this as the "Oki Data test" (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

1. The respondent must actually be offering the goods or services at issue;
2. The respondent must use the site to sell only the trade marked goods or services;
3. The website must accurately and prominently disclose the registrant's relationship with a trade mark holder; and
4. The respondent must not try to "corner the market" in domain names that reflect the trademark.

The Respondent would fail to meet the Oki Data test, the Panel being unable to locate any disclaimer regarding the relationship between the Respondent and the Complainant (requirement 3. above).

The Panel is furthermore unconvinced that, before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services.

The Respondent has submitted no evidence to refute any of the Complainant's assertions. Instead, there is robust evidence on the available record suggesting that the Respondent has attempted to impersonate the Complainant, as discussed under item III. below.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

III. Registered and Used in Bad Faith

Registration

The following elements are compelling evidence to this Panel that the disputed domain name was registered in bad faith:

- The Complainant has been using the trade mark SURFACE since at least 2008, including in China where the Respondent appears to reside, whereas the disputed domain name <ifixsurface.com> was registered in 2020;
- UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known in its segment of business; and
- The Respondent's lack of participation pre- and in the course of these UDRP proceedings.

Use

The Complainant refers to the Respondent as being engaged in the conduct described in paragraph 4(b)(iv) of the UDRP Policy, which provides as follows:

"(iv) by using the domain name, 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."

At the time of writing, the Respondent's website appears to offer repair services for the Complainant's products, in an unauthorised manner, and absent any disclosure as to the relationship between the Respondent and the Complainant.

Furthermore, the Panel also notes that the Respondent's website displays the Complainant's figurative trade mark MICROSOFT in a rather prominent position.

The Panel considers that the Respondent has attempted to suggest an affiliation with, or a connection to, or an endorsement of the Complainant or, rather likely, to impersonate the Complainant through the use of the Complainant's trade marks SURFACE and MICROSOFT on the Respondent's website. The Respondent's behaviour would therefore fall into the remit of circumstance (iv) of paragraph 4(b) of the UDRP Policy.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. IFIXSURFACE.COM: Transferred

PANELLISTS

Name	Yana Zhou
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DATE OF PANEL DECISION 2022-06-24

Publish the Decision