

Decision for dispute CAC-UDRP-104599

Case number	CAC-UDRP-104599
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Time of filing	2022-05-23 09:03:41
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Domain names	hennessy24.biz
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Case administrator

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

Organization	Jas Hennessy & Co
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Ivan Karalenko
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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, among others, of the following trademarks "HENNESSY":

- international trademark HENNESSY no 315189 registered on June 16, 1966, for goods and services in classes 32 and 33;
- US trademark HENNESSY no 2133630 registered on November 10, 1994, for goods and services in classes 9 and 41.

The disputed domain name <hennessy24.biz> was registered on April 8, 2022.

FACTUAL BACKGROUND

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

Founded in 1765 by Richard Hennessy, the Complainant is a cognac house with headquarters in Cognac, France. As a part of the LVMH (Louis Vuitton Moët-Hennessy) group, the Complainant sells about 70 million bottles every year worldwide and is now

the top French wine and spirits brand by value in the world.

The Complainant is the owner of several international trademarks and of several domain names including the trademark HENNESSY.

The disputed domain name was registered on April 8, 2022 and redirected to an online shop offering drugs such as marijuana and cocaine. At the date of the complaint, the disputed domain name is inactive.

The Complainant states that the disputed domain name is confusingly similar to its trademarks HENNESSY and domain names associated.

The Complainant contends that the addition of the number “24” is not sufficient to escape the finding that the domain name is confusingly similar to the trademarks HENNESSY. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and domain names associated. It is well-established that a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP.

Furthermore, the Complainant contends that the addition of the generic top-level domain “.BIZ” does not change the overall impression of the designation as being connected to the trademarks HENNESSY. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and its domain names associated.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name.

The Respondent is not known by the Complainant. The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark, or apply for registration of the disputed domain name.

Furthermore, the disputed domain name redirected to an online shop dedicated to the sale of illegal products. At the date of the complaint, the disputed domain name is inactive. The Complainant contends that the Respondent is not making a bona fide offering of goods or services by means of the disputed domain name, or a legitimate non-commercial or fair use of it.

Thus, the Complainant contends that the Respondent has no rights or legitimate interest in the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its trademarks HENNESSY. All the Google results for the term “HENNESSY” refers to the Complainant. Thus, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks, which is a hallmark of bad faith.

Thus, the Complainant contends that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademark.

Furthermore, the disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate. As prior UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

On these bases, the Complainant 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 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

In accordance with paragraph 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 first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "HENNESSY", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark "HENNESSY" only by the addition of the number "24", and of the top-level domain ".BIZ".

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case, the number "24" has no impact on the distinctive part "HENNESSY". It is well established that where the relevant trademark is recognizable within the domain name, the addition of other elements like random numbers would not prevent a finding of confusing similarity (see, for example, WIPO case No. D2022-0073).

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark "HENNESSY".

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

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to [the Respondent] 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; or
- (ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or
- (iii) [the Respondent] [is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

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.

In particular, the Complainant states that:

- the Respondent is not identified in the WHOIS database as the disputed domain name;
- the Respondent is not affiliated with nor authorized by the Complainant in any way;
- the Complainant does not carry out any activity for, nor has any business with the Respondent;

- neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain name by the Complainant; and
- the disputed domain name redirected to an online shop dedicated to the sale of illegal products. At the date of the complaint, the disputed domain name is inactive.

Taking into account the fact that, based on the information of the Whois database, the Respondent is not commonly known by the disputed domain name, that no relationship exists between the Complainant and the Respondent, that the disputed domain name is not active, the Panel cannot imagine any possible legitimate justification for the use of the disputed domain name, 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

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

- (i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or
- (ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or
- (iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site 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] web site or location or of a product or service on [the Respondent's] web site or location.

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.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant's trademark would also satisfy the complainant's burden.

Taking into account the distinctiveness of the well-known trademark “HENNESSY”, the Panel agrees that in practice it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark “HENNESSY” when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name's registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel share this view.

The Panel notes that in the past the disputed domain name resolved to a website offering illegal drugs for sale, and that other panels considered such conduct as evidence of bad faith (see, for example, WIPO Case No. D2016-0910).

The fact that the disputed domain name is not currently used does not prevent a finding of bad faith (see, for example, WIPO Case No. D2018-1264). Previous panels have indeed confirmed that the prerequisites under paragraph 4(a)(iii) of the Policy can be met under the doctrine of passive holding, giving close attention to all circumstances of the Respondent's behaviour (see, for example, WIPO Case No. D2000-0003).

The Panel, having taken into account the distinctiveness of the well-known Complainant's trademark, the absence of any conceivable good faith use, and the passive holding of the disputed domain name, considers that in these circumstances the disputed domain name was registered and is being used in bad faith.

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. **HENNESSY24.BIZ**: Transferred

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION	2022-06-26
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Publish the Decision
