Decision for dispute CAC-UDRP-104728

Case number	CAC-UDRP-104728
Time of filing	2022-07-15 09:23:15
Domain names	microsoft800.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Microsoft Corporation

Complainant representative

Organization	Convey srl

Respondent

Name	qian su

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

Microsoft is the owner of various trademark registrations for MICROSOFT such as:
• International Trademark n. 1318242 – MICROSOFT - Cl. 9;
• International Trademark n. 1142097 – MICROSOFT - Cl. 9, 16, 25, 28, 35, 36, 38, 39, 41, 42, 45;
• European Union Trademark n. 000330910 – MICROSOFT – Cl. 35, 41, 42;
• European Union Trademark n. 000479956 – MICROSOFT – Cl. 9; and
• European Union Trademark n. 007138225 – MICROSOFT OFFICE - Cl. 9 and 42.

The trademark “MICROSOFT”, registered and used since many years, is distinctive and well-known all around the world.

FACTUAL BACKGROUND

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

The Complainant requested change of the language of the proceedings from Chinese to English and claims that the Respondent has familiarity with English in light of the following circumstances:

i. the Disputed Domain Name contains Latin characters and the ".com" Generic Top-Level Domain;
ii. prima facie the Respondent provides maintenance services for domestic appliances and he could not ignore English that actually is the primary language for business;
iii. the Respondent has registered various domain names and they are redirected to websites containing English words, see the screenshots in the;
iv. the translation of the Complaint into Chinese would also cause additional expense and delay, making unfair to proceed in Chinese.

The Complainant was founded by Bill Gates and Paul Allen in order to produce software for the Altair 8800, an early personal computer. The company went on to license its MS-DOS operating system to IBM for its first personal computer, which debuted in 1981. Afterward, other computer companies started licensing MS-DOS, which had no graphical interface and required users to type in commands in order to open a program.

In 1985, Microsoft released a new operating system, Windows, with a graphical user interface that included drop-down menus, scroll bars and other features. The following year, the company moved its headquarter to Redmond, Washington, and went public at $21 a share, raising $61 million of funds. By the late 1980s, Microsoft had become the world's biggest personal-computer software company, based on sales.

Microsoft Office, which was introduced in 1990, has bundled separate applications such as Microsoft Word and Microsoft Excel and, few years later, Microsoft began to expand its product line into computer networking and the World Wide Web releasing Windows 95 that included technologies for connecting to the internet, such as built-in support for dial-up networking, TCP/IP (Transmission Control Protocol/Internet Protocol), and the web browser Internet Explorer 1.0.

When Bill Gates stepped down as Microsoft's CEO in 2000, Microsoft entered the gaming and mobile phone market. The Windows Mobile OS has been used by numerous sellers including HTC, LG, Samsung, LG and, the subsequent year, Microsoft released the Xbox followed by Xbox Live in 2002. Both releases were very successful and placed Microsoft second in the video gaming market. The Xbox 360, released in 2005, was a very powerful gaming console.

In 2014, Microsoft has shifted away from consumer tech and toward business services, particularly subscription - or advertising-based online services such as cloud computing. In order to strengthen the new vision of the CEO Nadella for Microsoft as a company that provides business services tech, in 2016 the Complainant acquired the professional networking platform LinkedIn. Consequently, Microsoft has been reorganized into two main divisions: "Experiences & Devices" and "Cloud + AI."

Today, Microsoft is amongst the leading players in the world hi-tech, with about 120 subsidiaries and 160.000 employees worldwide. In 2021 the revenues were more than USD 168 billion and its ranked number 21 in the 2021 Fortune 500 rankings of the largest United States corporations by total revenue.

Microsoft is considered one of the Big Five companies in the U.S. information technology industry, along with Google, Apple, Amazon and Facebook; according to the Interbrand annual ranking of the best global brands, in 2021 it has been ranked in the third position.

The trademark "MICROSOFT", registered and used since many years, is distinctive and well-known all around the world.

The Complainant has extensively used the "MICROSOFT" denomination on all internet environments including and not limited to the company's official websites https://www.microsoft.com, www.office.com and its official accounts on the major social networks such as LinkedIn, Instagram, Facebook, Twitter and blog.

The Disputed Domain Name was registered, without authorization of Complainant, by the Respondent on April 21, 2021 and it is not redirected to an active website.

In light of the Respondent's registration and use of the Disputed Domain Name, confusingly similar to Complainant´s

registered and well-known trademarks MICROSOFT, the Complainant instructed its representative to address to the owner of the Disputed Domain Name a cease and desist letter in order to notify him of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer, of the Disputed Domain Name to the Complainant.

The cease-and-desist letter was therefore sent on July 8, 2022 to the Respondent's email indicated in the whois provided by the registrar following the disclosure on April 12, 2022. The Complainant did not receive a response.

A. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

The Disputed Domain Name incorporates the Complainant's MICROSOFT trademark in its entirety.
It is a well-established principle that domain names that wholly incorporate trademarks, in particular ones as famous MICROSOFT, are found to be confusingly similar for the purposes of the Policy, despite the circumstance that the Disputed Domain Name may also contain numbers, in the case at hand "800". See, among the decisions addressing situations where numbers are used in combination with trademarks WIPO Case No. D2015-2316 F. Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan: "it is also well-established that where a domain name incorporates a complainant's well-known and distinctive trademark in its entirety, it is confusingly similar to that mark despite the addition of words or numbers such as, in this case, "uk10": (see Wal-Mart Stores, Inc. v. Kuchora, Kal, WIPO Case No. D2006-0033; Hoffmann-La Roche Inc. v. Andrew Miller, WIPO Case No. D2008-1345)".

The addition of a number to a trademark or a misspelling in a domain name is also insufficient in itself to negate confusing similarity between a trademark and a domain name, in the present case the addition of "800" in the Disputed Domain Name can increase the confusing similarity, internet users could deem that 800 is a new software of the Complaint. Amongst others, GA Modefine S.A. v. Mark O'Flynn Case No. D2000-1424 "It is indeed obvious that although the Respondent's Domain Name is composed out of the word "armani" and the (descriptive) word "boutique", the first of these terms is incontestably the principal part of the Disputed Domain Name. In this view, the Administrative Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademarks".

Furthermore, the top level ".com" is merely instrumental to the use in Internet - as found in The Forward Association, Inc., v. Enterprises Unlimited (Forum case FA0008000095491, October 3, 2000) and numerous others - and not able to affect the confusing similarity of the Disputed Domain Name to the Complainant's trademark.
B. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name (s);
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))
According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent's rights or legitimate interests in respect of the Disputed Domain Name lies with the Complainant. It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for the Complainant to produce prima facie evidence in order to shift the burden of production to the Respondents. See, e.g., Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270.
As a preliminary note, along the lines set forth in Pharmacia & Upjohn Company v. Moreonline, WIPO Case No. D2000-0134 and National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net, WIPO Case No. D2000-0118, the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Respondent is not licensees, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. Specifically, the Respondent is not authorized reseller of the Complainant and has not been authorized to register and use the Disputed Domain Name.

Upon information and belief of the Complainant, the Respondent is not commonly known by the Disputed Domain Name as individual, business or other organization and his family name do not correspond to MICROSOFT or the Disputed Domain

Name.

The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods or services before any notice of the dispute.
The Disputed Domain Name is not redirected to an active website but the lack of use has been deemed in several UDRP decisions evidence of absence of rights or legitimate interests in respect of the Disputed Domain Name. On this point, the WIPO Case No. D2017-0246 “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc.: "The Panel further finds that the Respondent is neither making a bona fide offering of goods or services or a legitimate noncommercial or fair use of the Domain Name as the Domain Name is not resolving to an active website.[...] The Panel nevertheless finds that, taking into account the overall circumstances of this case, the Respondent’s lack of use of the Domain Name is a strong indication of its lack of rights or legitimate interests in the Domain Name".

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

C. The Disputed Domain Name (s) was/were registered and is/are being used in bad faith.

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))
As to the assessment of the Respondent’s bad faith at the time of registration, in light of the registration and intensive use of the trademark MICROSOFT since many years, the advertising and sales of the Complainant’s products worldwide, the Respondents could not have possibly ignored the existence of the Complainant’s trademark, confusingly similar to the Disputed Domain Name. The Complainant has many subsidiaries worldwide including in China, where the Respondent is based.

The aforesaid trademark of the Complainant enjoys worldwide reputation in the sector of hi-tech, Microsoft is amongst the leading players in the world hi-tech and, in 2021 the revenues were USD 168 billion million placing number 21 in the 2021 Fortune 500 rankings of the largest United States corporations by total revenue. Microsoft is also considered one of the Big Five companies in the U.S. information technology industry, along with Google, Apple, Amazon and Facebook; according to the Interbrand annual ranking of the best global brands, in 2021 it has been ranked in the third position.

By virtue of its extensive worldwide use, the Complainant’s trademark MICROSOFT has become well-known trademark in the sector of IT, as also indicated in many UDRP decisions: Microsoft Corporation v. Rdckon Web Tech LLP (There are no doubts that the Complainant’s trademark “MICROSOFT” is distinctive and well-known worldwide including the India where the Respondent is located according the WHOIS records), Microsoft Corporation v. StepWeb, WIPO Case No. D2000-1500 (It is not possible that Respondent was unaware of the famous Microsoft mark at the time it registered the <microsofthome.com> domain name three years ago); Microsoft Corporation v. Paul Horner Case No. D2002-0029 (Complainant holds rights in the well-known trademark and service mark "MICROSOFT". This fact has been determined in prior administrative proceedings); Microsoft Corporation v. Webbangladesh.Com, WIPO Case No. D2002-0769, (stating that MICROSOFT “is a world-famous mark. It is perhaps one of the most recognized international trademarks in existence”, Microsoft Corporation v. Charilaos Chrisochoou Case No. D2004-0186 (Previous Panel decisions under the UDRP have concluded that the addition of a generic term and/or a hyphen is not sufficient to prevent confusing similarity when the domain name contains a well-known trademark).

Therefore, it is clear that the Respondent was well aware of the Complainant’s trademark and he registered the Disputed Domain Name with the intention to refer to the Complainant and its trademarks. As noted in Ferrari S.p.A. v. Allen Ginsberg, WIPO Case No. D2002-0033, “Respondent has registered the domain name <maserati.org> corresponding to the well-known or even famous trademark MASERATI which he must have been aware of”. Having regard to the trademark’s distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant’s registered trademark at the time of the registration of the Disputed Domain Name, with which it is confusingly similar.

With reference to the use in bad faith, the Disputed Domain Name does not resolve to an active website but, according to the passive holding doctrine of the Telstra case, a domain name registrant can act in bad faith even if it is not actively using a

domain name when:

(i) the Complainant's trademark has a strong reputation and is widely known;
(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the Disputed Domain Name,
(iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,
(iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and
(v) taking into account all of the above, 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, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law."

In the case at hand, the trademark MICROSOFT is widely known and, in light of its use, has become well-known worldwide, the Disputed Domain Name is registered in the name of a privacy shield and the Respondent has not replied to the cease and desist letter and he has not revealed his identity following receiving it. In light of the above, it is impossible to conceive of any plausible active use of all the Disputed Domain Name by the Respondent.

As an additional circumstance demonstrating bad faith, prior Panels have also held that a failure to respond to a cease and desist letter can be evidence of bad faith. See, e.g.,: HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062: "such bad faith is compounded when the domain name owner or its duly authorized privacy service, upon receipt of notice that the domain name is identical to a registered trademark, refuses to respond or even to disclose the domain name owner's identity to the trademark owner... Such conduct is not consistent with what one reasonably would expect from a good faith registrant accused of cybersquatting".

In light of the above, the Complainant respectfully submits that the Disputed Domain Name was registered and are being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) of the Policy

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 Complainant requests that the language of this administrative proceeding be English pursuant to UDRP Rule 11(a): 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. Complainant makes this request in light of the potential Chinese language Registration Agreement of the Disputed Domain Name involved at this Complaint.

Paragraph 10 of the UDRP Rules vests a Panel with authority to conduct the proceedings in a manner it considers

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. UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios were summarized into WIPO Jurisprudential Overview 3.0, 4.5.1. In this particular instance, the Complainant tried to request change of languages of proceedings in light of Chinese language Registration Agreement by showing that: 1)The Disputed Domain Name is composed by the Complainant's trademark Microsoft and other Latin characters; 2) The Complainant's Reverse WHOIS search showed that the Respondent has registered various domain names and they are redirected to websites containing English words; 3) Moreover, a translation of the Complaint to Chinese would entail significant additional costs for the Complainant and delay in the proceedings. Relevant decisions have been cited to support the Complainant's positions.

In light of the scenarios and equity, the Panel is of the view that conducting the proceeding in English is unlikely to heavily burden the Respondent, and it is likely that the Respondent can understand the English language based on a preponderance of evidence test. Without further objection from the Respondent on the issue, the Panel will proceed to issue the decision in English.

PRINCIPAL REASONS FOR THE DECISION

1. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant contends that the Disputed Domain Name <microsoft800.com> is confusingly similar to the Complaint's trademark "Microsoft". The Complainant, Microsoft, is amongst the leading players in the world hi-tech, with about 120 subsidiaries and 160.000 employees worldwide. It was founded by Bill Gates and Paul Allen in 1981, and has its businesses ranging from consumer tech to business services through subscription. The Complainant is the owner of the distinctive and well-known trademark Microsoft registered used since many years. The Complainant has extensively used the "MICROSOFT" denomination on all internet environments including and not limited to the company's official websites https://www.microsoft.com.

The domain name <microsoft800.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 21 April 2021 according to the WHOIS records and registrar disclosures. It incorporates the Complainant's trademark MICROSOFT in its entirety, in combination with number "800" which can be associated by internet users as the launch of a new software of the Complainant. The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Name.

The Panel therefore concludes that the Disputed Domain Name is confusingly similar to a trademark in which the Complainants have rights within the meaning of paragraph 4(a)(i) of the Policy.

2. The Respondent to have no rights or legitimate interests in respect of the Disputed Domain Name.

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in the present case has not licensed or authorized the Respondent to register or use the trademark or the Disputed Domain Name. There is no evidence that the Respondent is known by the Disputed Domain Name or owns any corresponding registered trademarks including the terms "MICROSOFT" and/or "microsoft800".

The organization of the Respondent, "qian su", also has no connection with the Complainants' brand. The Complainants did not grant any license or authorization to the Respondent to register or use the Disputed Domain Name, nor the use of the Complainants' trademark on pages of the disputed websites.

In addition, The Respondent does not appear to have used the Disputed Domain Name in connection with active websites at

any time since the registrations. Currently, the Disputed Domain Name is not redirected to an active website, and as the Complainant has correctly pointed out, the lack of use has been deemed in several UDRP decisions evidence of absence of rights or legitimate interests in respect of the Disputed Domain Name (see WIPO Case No. D2017-0246 “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc.). Taking into overall circumstances, the Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the Disputed Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

3. The Disputed Domain Name has been registered and is being used in bad faith.

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(a)(iii) and 4(b)of the Policy.

Registration of the Disputed Domain Name in bad faith – As far as registration goes, UDRP panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Complainant’s trademark registrations predate the registration of the Disputed Domain Name. The fact that the Complainant’s trademark is a well-known and that the Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name implied that the Respondent may have had knowledge of the Complainant’s trademark at the time of registration of the Disputed Domain Name. It is reasonable to infer that the registrant registered the Disputed Domain Name with the knowledge of the complainant’s trademark and/or brand influence.

Use of the Disputed Domain Name in Bad Faith – Currently, the Disputed Domain Name does not resolve to any active site and has been “passively held” by the Respondent (see WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows). Panelists have consistently found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.” (WIPO Jurisprudential Overview 3.0 3.3). The Respondent is not making any active use of the Disputed Domain Name. At the same time, the Respondent could have registered the Disputed Domain Name to divert internet users to its own website. According to paragraph 4(b)(iv) of the Policy, “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location”, if found by the Panel, shall be considered evidence of registration and use of the domain name in bad faith.

Moreover, a cease and desist letter was sent to the Respondent on 8 July 2022 and the Respondent never responded. Prior panels have also held that a failure to respond to a cease and desist letter can be evidence of bad faith (see e.g., HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062).

Therefore, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the Complainants have failed to provide that Disputed Domain Name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MICROSOFT800.COM**: Transferred

PANELLISTS

Name	**Carrie Shang**

DATE OF PANEL DECISION 2022-08-13

Publish the Decision