

Decision for dispute CAC-UDRP-104735

Case number	CAC-UDRP-104735
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Time of filing	2022-07-20 09:43:58
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Domain names	shsurface.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Microsoft Corporation
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Complainant representative

Organization	Convey srl
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Respondent

Organization	duqiang qiang
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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 of many trade marks for SURFACE including, by way of example, International Trade Mark, registration, number 1321384, in class 9, registered on August 12, 2016.

FACTUAL BACKGROUND

The Complainant is a manufacturer and retailer of computer software and hardware. It was founded in 1975 and has its headquarters in Redmond, Washington, United States. It now has approximately 160,000 employees worldwide and in 2021 its revenues were in excess of USD 168 billion.

Since 2012, the Complainant has sold a series of touchscreen-based personal computers, tablets and interactive whiteboards. These are branded as SURFACE and the Complainant owns many trade marks to protect this trading style. In December 2015, the Complainant's SURFACE-branded tablet overtook Apple's iPad as the top-selling tablet online.

The disputed domain name was registered on February 2, 2022.

The disputed domain name is confusingly similar to a trade mark in which the Complainant has rights. It contains the Complainant's SURFACE trade mark in its entirety, preceded by the letters "sh". Internet users may believe that this additional term refers to new software of the Complainant or to an acronym of Shanghai.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not a licensee of the Complainant nor is it in any other way authorised to use the Complainant's trade marks. The Respondent is not commonly known by the disputed domain name, nor is there any evidence that the Respondent has been using, or has made demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods and services or that it has made a legitimate, noncommercial or fair use of the disputed domain name.

The Respondent has registered and is using the disputed domain name in bad faith. Having regard to the widespread reputability of the Complainant's SURFACE mark, the Respondent must have been aware of it as at the date of its registration of the disputed domain name. Moreover, the Respondent's identity has been concealed behind a privacy shield and the Respondent has failed to respond to the Complainant's cease and desist letter, which are further indicators of 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

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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.

Rights

The Panel finds that the disputed domain name is confusingly similar to the Complainant's SURFACE trade mark. The disputed domain name contains the Complainant's SURFACE mark in full, preceded by the letters "SH". Where a complainant's mark is

recognizable within a domain name, the addition of other terms, irrespective of their meaning, will not prevent a finding of confusing similarity; see, for example, CAC Case No. 102382, MAJE v enchong lin.

Rights and legitimate interests

The Policy sets out at paragraph 4(c) examples of circumstances, without limitation, by which a respondent may demonstrate rights or legitimate interests in a disputed domain name. These are, in summary: (i) if the respondent has been using the domain name in connection with a genuine offering of goods and services or has made demonstrable preparations to do so; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate noncommercial or fair use of the domain name.

The disputed domain name resolves to a gambling website with content in Chinese characters. The website branding states that the gambling services are provided by Suncity Group. The Panel considers, on a balance of probabilities, that the fact that the branding used on the Respondent's website has no connection with the term "shsurface" suggests that the Respondent is deliberately using the repute of the Complainant's SURFACE mark in order to attract Internet users to its website. The Respondent's activities do not therefore comprise a bona fide offering of goods and services because the Respondent is seeking to derive an unfair commercial advantage from its misuse of the Complainant's mark and the confusing similarity to it of the disputed domain name. Such use of the disputed domain name does not amount to a bona fide offering of goods; see, for example, Skyscanner Limited v. Qin Xian Sheng, WIPO Case No. D2021-2623.

There is no evidence that the Respondent has been commonly known by the disputed domain name, nor does the Respondent's use of the disputed domain name amount to making a legitimate, noncommercial or fair use of it. The Complainant having made out a prima facie case in relation to the second element, the burden of proof shifts to the Respondent to rebut it; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. In the absence of any response by it to the Complaint, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad faith

The repute of the Complainant's SURFACE mark as at the date of registration is such that the Panel finds, on a balance of probabilities, that the Respondent registered the disputed domain name with an awareness of the Complainant and its mark and in order to take unfair advantage of that mark. As has been found in many previous decisions under the Policy, the registration of a domain name by an unconnected party with knowledge of a complainant's well-known trademark registration is considered to be in bad faith. The Panel therefore finds the Respondent's registration of the disputed domain name to have been in bad faith.

The Respondent is using the Complainant's mark in order to attract Internet users to its website as they are apt to assume, from the confusing similarity between the disputed domain name and the Complainant's mark, that the disputed domain name is connected with the Complainant and its SURFACE-branded products. The fact that such users would, on reaching the Respondent's website, realize that this is not the case is immaterial because, by that point, the Respondent will have gained the opportunity of earning revenue from them; see Yahoo! Inc. v. Hildegard Gruener, WIPO Case No. D2016-2491. The Respondent's conduct therefore falls within the example of bad faith registration and use set out at paragraph 4(b)(iv) of the Policy namely that, by its use of the disputed domain name, it has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

The Panel therefore finds that the disputed domain name was both registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SHSURFACE.COM:** Transferred

PANELLISTS

Name	Antony Gold
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DATE OF PANEL DECISION	2022-08-23
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Publish the Decision
