Decision for dispute CAC-UDRP-102810

Case number	CAC-UDRP-102810
Time of filing	2021-02-01 09:04:19
Domain names	PEPSICO-INC.COM

Case administrator

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

Complainant

Organization	PepsiCo, Inc.

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Organization	PEPSICO INC

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 a number of trade marks for PEPSICO including, by way of example only, European Union Trade Mark, registration number EU013357637 for PEPSICO (word and device) in classes 16, 29 30, 32, 35, 36 and 41 registered on March 13, 2015.

FACTUAL BACKGROUND

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

The Complainant is a very well-known global consumer brand with its headquarters in New York, United States. Its worldwide revenues in 2019 were in excess of USD 67 billion. It has been using its PEPSI trade mark in connection with the sale of soft drinks since 1911. The Complainant also uses its PEPSICO trade mark in connection with a variety of goods and it also owns domain names incorporating this trade mark, including <pepsico.com>.

The disputed domain name was registered on November 25, 2020. It has been used in connection with the sending of fraudulent emails in which the Respondent has masqueraded as the procurement department of the Complainant.

The disputed domain name incorporates the Complainant's PEPSICO trade mark in its entirety and simply adds a hyphen and the corporate designation "inc". As the disputed domain name contains the Complainant's distinctive and widely known PEPSICO mark in full, it is confusingly similar to it.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not licensed or otherwise authorised to use the Complainant's name or mark. The Respondent is not commonly known by the disputed domain name and has registered it by misusing the Complainant's contact information. The disputed domain name has been registered to perpetuate harmful cyber-activity consisting of Business Email Compromise fraud. Use of domain name for illegal activity can never confirm rights or a legitimate interest on a Respondent.

The Respondent has registered and is using the disputed domain name in bad faith. Given the fame of the Complainant's mark, the mere registration of the disputed domain name by the Respondent creates a presumption of bad faith because the Respondent would have been well aware of the Complainant's exclusive rights in PEPSICO as at the time of registration. Moreover, the Respondent's use of the disputed domain name evidences an attempt intentionally to attract for commercial gain Internet users to the Respondent's website or other online location and creates a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Respondent's website or other online location. The Respondent has a pattern of registering domain names, masquerading as the Complainant which are used to send spear-phishing emails targeting vendors of the Complainant in an attempt to commit fraud. On each occasion, the Respondent has used the same Registrar. The Respondent has engaged in similar activities previously. See, by way of example only, CAC Case No 103393, PepsiCo, Inc. v Tim Keana. The Complainant asks the Panel to encourage the Registrar to consider how it may prevent similar activities occurring in the future.

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 has requested to redact the name of the Respondent. Under the Panels consideration this steps seems fair to both parties. Under paragraph 4 (j) of the Policy the Panel decides that the Respondent identification shall be redacted from the published decision.
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

So far as the first element is concerned, the Complainant's trade mark registrations for PEPSICO including the trade mark in respect of which full details are provided above, establish its rights in the trade mark.

For the purpose of comparing the disputed domain name with the Complainant's mark, it is established practice to disregard the generic Top-Level Domain, that is ".com" in the case of the disputed domain name, as this is a technical requirement of registration. The remaining element of the disputed domain name comprises the Complainant's trade mark, in full followed by a hyphen and the word "inc". The Complainant's mark is clearly recognizable within the disputed domain name and the additional elements do not serve to prevent the disputed domain name from being found confusingly similar to it. See, by way of example, CAC Case No. 103016, Novartis AG v unlocking guru; "T An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion". The Panel accordingly finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

Rights and legitimate interest

Paragraph 4(c) of the Policy sets out circumstances, without limitation, by which a respondent might demonstrate that it has rights or a legitimate interest in a domain name. These are, summarised briefly: (i) if the respondent has been using the domain name in connection with a bona fide offering of goods and services; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate non-commercial or fair use of the domain name.

The only known use of the disputed domain name, has been to enable the Respondent to send emails which masquerade, for fraudulent purposes, as having been sent by the Complainant. Self-evidently, this does not comprise a bona fide offering of goods and services for the purpose of the second element of the Policy. See also section 2.13.1 of the WIPO WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"); "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent".

There is no evidence that the Respondent has been commonly known by the disputed domain name, nor does the Respondent's holding of the disputed domain name amounts to making a legitimate non-commercial or fair use of it. Furthermore, as the disputed domain name, is very similar to the Complainant's mark, it carries with it a risk of implied affiliation.
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 Panel accepts the Complainant's submission that, given the distinctive nature of the Complaint's PEPSICO trade mark, it is highly improbable that the Respondent registered the disputed domain name without an awareness of the Complainant and its trade mark rights. Furthermore, having regard to the use to which the disputed domain name was put shortly following registration, it is clear that the Respondent registered the disputed domain name for those purposes. Accordingly, if the use of the disputed domain name is found to be in bad faith, the same principles will apply in relation to its registration.

So far as bad faith use is concerned, , the circumstances of the Respondent's registration and use of the disputed domain name fall within, or closely approximate to, the example of bad faith registration and use set out at paragraph 4(b)(iv) of the Policy, namely that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its web site or other online location. The fact that the disputed domain name does not resolve to a website is immaterial in these circumstances. As set out at section 3.4 of the WIPO Overview 3.0: "Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. …Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers". See also CAC Case No. 102290 Pepsico, Inc. v Bill Williamson.

For these reasons the Panel finds that the disputed domain name was both registered and used in bad faith.

Finally, whilst noting the Complainant's request with respect to the Registrar with whom the Respondent has repeatedly registered, for dishonest purposes, domain names which comprise variants of the Complainant's marks, the role of a panel in proceedings under the Policy is closely prescribed by the Rules and the Panel is not empowered to take steps which go beyond its defined function.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PEPSICO-INC.COM**: Transferred

PANELLISTS

Name	**Antony Gold**

DATE OF PANEL DECISION 2021-03-04

Publish the Decision