

Decision for dispute CAC-UDRP-104802

Case number	CAC-UDRP-104802
-------------	-----------------

Time of filing	2022-09-01 09:47:11
----------------	---------------------

Domain names	brooks-england.com
--------------	--------------------

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
--------------	---------------------------------

Complainant

Organization	Brooks England LTD
--------------	--------------------

Complainant representative

Organization	Convey srl
--------------	------------

Respondent

Name	Ahdh Fvdeh
------	------------

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 several trademarks consisting of the term "BROOKS ENGLAND" in particular the international trademark BROOKS ENGLAND® n° 1334158 registered since 30 November 2016 in classes 09 and 12.

Further, the Complainant operates under the official website www.brooksengland.com, registered to Selle Royal Spa, claimed to be an entity associated with Complainant.

FACTUAL BACKGROUND

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

The Complainant, originally based in Smethwick, West Midlands, England is a bicycle saddle manufacturer that is owned by Selle Royal Group S.P.A. The Complainant has been making leather goods since 1866, when it was founded in Hockley, Birmingham. In the 1880s, the production of bicycle saddles began, the first saddle patent having been filed in 1882 and, according to family legend, the company began when founder John Boulton Brooks, a horse saddle manufacturer, tried to use a bicycle after his horse died but found the wooden seat very uncomfortable. As a result, he vowed to set about solving this

problem and Brooks was born.

Raleigh Bicycle Company bought Brooks in 1962 and, when Raleigh collapsed in 1999, the Complainant was sold and subsequently went into liquidation. John Godfrey Macnaughtan and Adrien Williams were able to buy the company and keep production in England; in 2002, they sold Brooks to Selle Royal.

The Complainant owns several trademarks, characterised by the presence of the distinctive term "BROOKS ENGLAND". On 27 May 2022, the Respondent Ahdh Fvdeh, an individual located in Hong Kong, registered the disputed domain name <brooks-england.com>.

The disputed domain name resolves to a website offering for sale counterfeited products of the Complainant, and displaying Complainant's trademark and logo.

The Complainant sent a cease and desist letter to the Respondent on 12 July 2022, however no reply was received.

According to the information on the case file, the Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent because no Response was filed.

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

THREE ELEMENTS THE COMPLAINANT MUST ESTABLISH UNDER THE POLICY

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a disputed domain name should be transferred or cancelled:

- (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.

The Panel has examined the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term BROOKS ENGLAND for certain bicycle parts and related accessories. All of the above were created and registered well prior to 27 May 2022, the creation date of the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner

sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. As such, the Panel finds that the Complainant possesses rights in its BROOKS ENGLAND trademark.

In the present case, the disputed domain name consists of the BROOKS ENGLAND trademark reproduced in its entirety, merely with the addition of a hyphen between the two denominations.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of a hyphen does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., NG Biotech v. Whois Agent, Domain Protection Services Inc. Patrice SARDA WIPO Case No. 2021-0177 (“Previous UDRP decisions have found that the mere addition of symbols such as a hyphen to a trademark in a domain name do not avoid a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., Inter-IKEA Systems B.V. v. Evezon Co. Ltd., WIPO Case No. D2000-0437).”).

The TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant’s trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is confusingly similar to Complainant’s mark.

(B) RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, 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. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

However, the burden of proof still remains with the Complainant to make out its prima facie case on a balance of probabilities; see, for example, CAC Case No. 102263, Intesa Sanpaolo S.p.A. v Ida Ekkert. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

In the present case, the Complainant asserts that the Respondent is not commonly known by the disputed domain name, is not in any way related to the Complainant, nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent has not responded in any form and thus has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Further, there is no apparent 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. According to unrefuted evidence submitted by the Complainant, the disputed domain resolved to a website, with a similar look and feel to the Complainant’s website (including images protected by copyrights), where the Complainant’s trademarks BROOKS ENGLAND are published and counterfeit BROOKS ENGLAND branded products are offered for sale. The creation of a look-alike website to sell counterfeit goods is not a bona fide offering. Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The third element requires Complainant to show that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Hallmark Licensing, LLC v. EWebMall, Inc., WIPO Case No. D2015-2202 (“The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.”).

Further, Paragraph 4(b) of the Policy sets out four circumstances, in particular but without limitation, any one of which may be evidence of the registration and use of a domain name in bad faith. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 domain name; or

(ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's 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 site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general (ie under paragraph 4(a)(iii) of the Policy) and in particular because the Respondent's conduct puts the case within paragraph 4(b)(iv) of the Policy for the following reasons:

1. The Complainant's BROOKS ENGLAND trademark is distinctive and enjoys considerable reputation within the bicycle parts and accessories industry, and in particular for Complainant's bicycle saddles. According, it is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical, or confusingly similar to, the Complainant's trademarks and that they registered the disputed domain name with knowledge of the Complainant's trademarks.
2. The Respondent is not commonly known by the disputed domain name and Complainant asserts that the Respondent has never been authorized or licensed by the Complainant to use the Complainant's trademark(s) and/or register the disputed domain name, nor is there any business or other association between the Complainant and the Respondent.
3. There is compelling evidence of targeting by Respondent. The disputed domain name resolves to a look-alike website similar to Complainant's, including the incorporation of Complainant's trademark and logo, and copyright protected imagery. The website and the Complainant's legitimate site are similar such that a casual visitor would be unlikely to distinguish a difference. Complainant branded products are offered for sale on the website associated with the disputed domain name. The Panel finds that the products sold via the disputed domain name are highly likely to be counterfeit, as such products are offered at a disproportionately low price below market value, i.e. less than half the price of the products sold on Complainant's official website.
4. Respondent's subsequent use of the disputed domain name for the lookalike site demonstrates that Respondent had actual notice of the Complainant's trademark when registering the disputed domain name. It has regularly been held that to copy a trademark in a domain name, or use it with a slight variation, knowing that the disputed domain name is based on the trademark of another party, constitutes bad faith registration and use of the disputed domain name according to the Policy. The Panel makes that finding in the present case.
5. Even if the goods sold via the website associated with the disputed domain name are not counterfeit – which is unlikely given the below market prices of the goods on offer - the present case fails the "Oki Data test" for establishing legitimate interest as set out in Oki Data Americas, Inc. v. ASD, Inc WIPO Case No. D2001-0903 because the pages submitted as evidence do not appear to contain any information about the Respondent nor do they disclose the Respondent's relationship with the Complainant. There is no clear and prominent disclaimer that could support a finding that the Respondent has taken reasonable steps to avoid confusing consumers about the provenance of the website. Further, cases applying the Oki Data test usually involve a domain name comprising the trademark plus a descriptive term such as "parts" or "repairs". In the instant case there is no such descriptive term, and the domain name is identical to the Complainant's trademark, save for the addition of a hyphen.
6. By using the disputed domain name as noted above, the Respondent is clearly intending to attract internet users for commercial gain, in a manner which would generate confusion as to the legitimacy of any site to which the disputed domain name resolves. This brings the case within the provisions of paragraph 4(b) (iv) of the Policy.
7. As a final point, the Panel draws a negative inference from Respondent's failure to respond to the cease-and-desist letter, and silence through these proceedings.

This present case has similarities to Prada S.A. v. Chen Minjie, WIPO Case No. D2015-1466, where it was held, "The Respondent's registration of a domain name which incorporates the whole trade mark, PRADA, the use thereof for the purpose of selling what appears to be counterfeit PRADA products, and the creation of a web site which is intended to pass off as the authentic or official web site of the Complainant, are obvious signs of bad faith registration and use. This is the very kind of cybersquatting and illegitimate activity that the Policy is intended to address and deal with".

In light of the above analysis, the Panel concludes that the Complainant has made out its case that the disputed domain name was registered and is being used in bad faith, and thus has satisfied the requirement under 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. **BROOKS-ENGLAND.COM:** Transferred

PANELLISTS

Name	Claire Kowarsky, LL.M
------	------------------------------

DATE OF PANEL DECISION	2022-10-09
------------------------	------------

Publish the Decision
