

Decision for dispute CAC-UDRP-104567

Case number	CAC-UDRP-104567
Time of filing	2022-08-10 09:32:57
Domain names	biurberry.com, berberry.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Burberry Limited
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Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.
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Respondent

Organization	"Host Master" / Transure Enterprise Ltd
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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 names.

IDENTIFICATION OF RIGHTS

BURBERRY LIMITED is the owner, among others, of the following trademark registrations related to "BURBERRY":

- Word mark "BURBERRY", Australian TM Office, Registration No. 33672 for class 25, registered on July 5, 1922 and duly renewed;
- Word mark "BURBERRY", UK TM Office, Registration No. 1428264 for classes 14, 18 and 25, registered on November 29, 1991 and duly renewed; and
- Word mark "BURBERRY", EUIPO, Registration No. 1058312 for classes 3, 18 and 25, registered on March 27, 2000 and duly renewed.

FACTUAL BACKGROUND

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

1) BURBERRY LIMITED (hereinafter referred to as the Complainant) submits that, despite some differences in the details provided in the official WHOIS records for the two domains included in the complaint, the domains should be considered to

be under common control. This especially in consideration of the fact that there are substantial commonalities in the web sites to whom the disputed domain names resolved.

2) The Complainant declares to have continuously used the "BURBERRY" word mark in connection with its products and services all over the world. Currently, the Complainant operates over 400 retail, outlet and concession locations around the world. Its merchandise is also sold in well-known department stores, boutiques, in Burberry stores, online at Burberry.com, and in other Burberry-authorized retail establishments.

3) According to the Complainant, BURBERRY LIMITED maintains direct control over the character and quality of the products and services associated with the "BURBERRY" trademarks. Burberry has spent substantial time, effort and money advertising, promoting and protecting its various trademarks, including the "BURBERRY" word mark. As a result, the "BURBERRY" word mark has become internationally famous and has acquired enormous and valuable goodwill.

4) The Complainant informs that "BURBERRY" is considered one of the most valuable fashion brands worldwide and of course it is registered in many countries.

5) The Complainant also proves that according to established case law from civil courts as well as previous UDRP Panels, the Complainant's mark "BURBERRY" was considered as well-known and even famous trademark

6) The Complainant has also registered domain names including the term BURBERRY (i.e. <burberry.com> and <burberry.co.uk>).

7) According to the Complainant the disputed domain names are confusingly similar to the registered "BURBERRY" trademarks. The only difference between the disputed domain name <biurberry.com> and the distinctive BURBERRY trademarks is the insertion of the letter 'i' after the first letter while the only difference with the disputed domain name <berberry.com> is the changing of the letter 'u' to the letter 'e'. It is the Complainant's view that in both cases there are clear examples of the practice known as "typosquatting".

8) The Complainant informs that the Respondent was never authorized to use the trademark "BURBERRY" by the Complainant. Furthermore, the Complainant has not found that the Respondent is commonly known by the disputed domain names or that it has any protectable interest over the domain names in dispute.

9) The Complainant argues that by virtue of its extensive worldwide use, the Complainant's trademark "BURBERRY" has become a well-known trademark in the fashion sector. Therefore, it is clear, in the Complainant's view, that the Respondent was well aware of the trademark "BURBERRY" and registered the disputed domain names with the intention to refer to the Complainant and its trademark "BURBERRY".

10) According to the Complainant, the use of the disputed domain names in connection with a parked page comprising pay-per-click links does not represent a bona fide offering where such links capitalize on the reputation and goodwill of the Complainant's mark.

11) The Complainant argues that the Respondent is contravening paragraph 4(b)(i) of the Policy, by offering both domain names for sale, on multiple marketplaces, one of them showing a listing price of 'at least USD 2000' in excess of the Respondent's costs of registration.

12) The Complainant also informs that the Respondent is a serial domain name squatter, routinely targeting other English speaking consumers. The registration data for <berberry.com> shows the Registrant name as "WDAPL", with an address in The Hague (The Netherlands). The very same registration details were also used to register other trademark infringing domain names, as <capitalonefinancial.com> and <ripadvisor.com>. The Complainant, by a further reverse lookup of WHOIS data, discovered that the Respondent has also registered domains such as: <capitolon.com>, <tripadviso.com>, <triadvisor.com>, <rtipadvisor.com>, <tripadvior.com>, <tripaadvisor.com>, <adobepremier.com>, <adobepremierepro.com> <youtubl.com> and <yottube.com>. This, in the Complainant's view, clearly shows the Respondent's habit of registering

domain names infringing trademark owners rights which obviously amounts to a pattern of bad faith conduct.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

A. Consolidation of Respondents

According to Article 3(c) of Rules for Uniform Domain Name Dispute Resolution Policy ("Rules"), the Complaint may relate to more than one domain name, provided that the disputed domain names are registered by the same domain-name holder. According to Article 10(e) of Rules a Panel shall decide upon request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

The whois details for <biurberry.com> are as follows:

Name: Host Master
Company: Transure Enterprise Ltd
Email: hostmaster@transureent.com
Phone: 1.5016482820
Address: 1000 N West Street, Suite 1200
Address 2:
City: Wilmington
State: Delaware
Postcode: 19801
Country: US
Registry Domain ID: 2699291610_DOMAIN_COM-VRSN
Registrar WHOIS Server: whois.above.com
Registrar URL: <http://www.above.com>

Updated Date: 2022-05-27 08:00:28.361788+10
Creation Date: 2022-05-27 08:00:28.361788+10
Registrar Registration Expiration Date: 2023-05-27 08:00:28.361788+10
Registrar: ABOVE.COM PTY LTD.

The whois details for <berberry.com> are as follows:

Name: Domain Administrator
Company: WDAPL
Email: luckydragon@vistomail.com
Phone: 3170 2500908
Address: Elspeetstraat 21
Address 2:
City: Den Haag
State: ZH
Postcode: 2573HM
Country: AN
Registry Domain ID: 998132574_DOMAIN_COM-VRSN
Registrar WHOIS Server: whois.above.com
Registrar URL: <http://www.above.com>

Updated Date: 2019-07-05 20:06:45.295439+10
Creation Date: 2007-05-28 18:11:39+10
Registrar Registration Expiration Date: 2023-05-28 18:11:39+10
Registrar: ABOVE.COM PTY LTD.

Although the Whois details of the disputed domain names present many difference, the Panel is still convinced that one single entity controls both the disputed domain names since:

- (i) the provided identity data for <berberry.com> is likely false due to the fact that "WDAPL" does not correspond to a name of a person or to a company name and that the country code corresponding to the city of Den Haag is NL and not AN as shown in the WHOIS;
- (ii) both domain names use the same registrar, Above.com Pty Ltd;
- (iii) the layouts and graphic features of the websites corresponding to the disputed domain names are identical;
- (iv) both domain names are offered on the marketplaces at Above.com and at the SEDO domain name marketplace.

The Panel therefore accepts the Complainant's request to address all the disputed domain names in one case under the Rules, paragraphs 10(e) and 3(c). Accordingly, the Respondents will be collectively referred to as the "Respondent" hereinafter. The Panel also finds that the consolidation would be fair and equitable to all parties.

The Panel outlines that in previous cases a similar decision was taken (see in particular CAC Case no. 104157 - Deutsche Börse AG vs. Yang Tian Ping according to which: "Having reviewed the screenshots provided by the Complainant, the Panel agrees that the not only the design, color scheme but also the content of the websites resolved by the disputed domain names are almost identical. In addition, being a residence in Hong Kong, the Panel confirms that the address on the WHOIS of one of the disputed domain names, <eurexvip.com>, does not exist which the Panel could not rule out the possibilities that both disputed domain names are under common control").

B. Material Requirements of the Policy

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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.

1a) <biurberry.com>

The disputed domain name consists of the Complainant's whole trademark "BURBERRY, written in a misspelled way. The mere addition of the letter "i" in the disputed domain name is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark of the Complainant. This is a clear case of typosquatting. The conduct known as typosquatting tries to take advantages from errors by Internet users when typing domain names into their browser location bar. As previous Panels have held, a finding of typosquatting renders a domain name confusingly similar to a previous trademark especially when such a previous trademark is well-known as in the case at hand. As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

1b) <berberry.com>

The Panel finds that the letter "u" included in the Complainant's mark it is simply replaced by the letter "e" included in the disputed domain name. Also, in this case the Panel finds a conduct of typosquatting. Of course, even in this case, the gTLD ".com" does not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant demonstrated that the websites to which the disputed domain names are linked display pay-per-click links. The Complainant clearly considers that the Respondent has the hope and the expectation that Internet users looking for the brand "BURBERRY" will be directed to the websites corresponding to the disputed domain names. The Panel finds that said activity, of course, does not provide a legitimate interest in the disputed domain names under the Policy. Furthermore, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain names as it is not commonly known under the disputed domain names and was never authorized to use the "BURBERRY" trademark by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain names. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the Respondent has registered or 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 the 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 its website or other online 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 Respondent's website or location.

The Respondent registered the disputed domain names years after the use and registration of the "BURBERRY" mark by the Complainant. In consideration of the reputation achieved by "BURBERRY" it is clear that the Respondent was surely aware of the Complainant's trademark when he registered the domain names in dispute.

The disputed domain names resolve to parked pages with sponsored links. Such use here constitutes bad faith. In WIPO Case no. D2009-0258 Mpire Corporation vs. Michael Frey, the panel found that "While the intention to earn click-through-revenue is not in itself illegitimate, the use of a domain name that is deceptively similar to a trademark to obtain click-through-revenue is found to be bad faith use." It is the Panel's view that such conduct of using a domain name, to attract Internet users for commercial gain fall within the meaning of paragraph 4(b)(iv) of the Policy. Given the above, the Panel believes that the Respondent has registered the disputed domain names in order to trade off the reputation of the Complainant's trademark.

In addition, it must be noted that the domain names in dispute were offered for sale on domain marketplaces. In particular it has been proved that <berberry.com> was put in auction at the GoDaddy with a minimum offer of USD 2.000 most likely in excess of the out-of-pocket costs related to the domain name. This is further evidence of bad faith in accordance with paragraph 4(b)(i) of the Policy (see, between many others, WIPO Case no. D2020-3422, Sodexo vs. Domain Administrator, Fundacion Privacy Services LTD).

Finally, the Complainant has proved that the Respondent has engaged in a pattern of registering domain names that bear striking resemblance to famous marks. This pattern of conduct is expressly forbidden by the Policy and clearly demonstrates bad faith on the part of Respondent (see, between many others, WIPO Case No. D2009-0798 - Wikimedia Foundation Inc. vs. Kevo Ouz a/k/a Online Marketing Realty).

Therefore, the Panel concludes that the Respondent registered and is using the disputed domain names in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BIURBERRY.COM**: Transferred
2. **BERBERRY.COM**: Transferred

PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION	2022-09-21
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Publish the Decision