

Decision for dispute CAC-UDRP-105159

Case number	CAC-UDRP-105159
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Time of filing	2023-01-27 10:25:35
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Domain names	i-k-e-a.com
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Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Inter IKEA Systems B.V.
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Complainant representative

Organization	Convey srl
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Respondent

Name	Buffalo 716
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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 the trademark IKEA, with several international and national trademark registrations worldwide, including the following:

U.S. Trademark Registration n. 1661360 of October 22, 1991 in classes 30, 41, 18, 29, 39, 25, 36, 2, 35, 31;

U.S. Trademark Registration n. 1118706 of May 22, 1979 in classes 11, 20, 21, 24, 27;

European Union Trademark Registration n. 000109652 of October 1, 1998 in classes 2, 8, 11, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 35, 36, 39, 41, 42;

European Union Trademark Registration n. 000109637 of October 8, 1998 in classes 2, 8, 11, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 35, 36, 39, 41, 42;

International Trademark Registration n. 926155 of April 24, 2007 in class 16, 20, 35, 43.

FACTUAL BACKGROUND

The Complainant is the worldwide IKEA franchisor and responsible for developing and supplying the global IKEA range.

IKEA is one of the most well-known home furnishing brands in the world with more than four hundred stores and the IKEA Group has roughly 231,000 employees worldwide reaching more than sixty markets and 822 million visitors per year.

IKEA was founded in Älmhult, a small Swedish village in the countryside, in 1943 by Ingvar Kamprad to sell household goods like pens, wallets and picture frames. IKEA is named after the initials of founder Ingvar Kamprad, Elmtaryd, the farm on which he grew up, and Agunnaryd, the nearby village. This acronym has no meaning and was invented for the brand.

The IKEA catalogue began in 1951 and was published until 2021. The international expansion of the IKEA business began with establishments of small start-up stores in Norway in 1963 and in Denmark in 1969. Then, in 1973 the first IKEA store outside Scandinavia was established in Switzerland, followed by stores in Germany in the coming years. In 1980s IKEA expanded noticeably into new markets such as U.S., Italy, France and the UK. In the same period, the loyalty card "IKEA family" was launched by the Complainant. Nowadays, the card is available across the world free of charge and can be used to obtain discounts on certain products found in-store.

The Complainant started its retail operations in U.S. in 1985 and now operates with a network of fifty-three stores.

The IKEA concept involves large production volumes: the products are packed and shipped in space-efficient flat-packs enabling the reduction of storage and transportation costs.

Besides the furniture production, IKEA supports American forests to restore forests and reduce pollution and is involved in several international charitable causes, particularly in partnership with UNICEF. Indeed, the philanthropic arm of the Complainant is IKEA Foundation that aims to improve opportunities for children and youth in some of the world's poorest communities by focusing on four fundamental areas of a child's life: a place to call home; a healthy start in life; a quality education; and a sustainable family income. IKEA Foundation is also helping these communities fight and cope with climate change.

The Complainant's Museum, opened in 2016, of 7,000 m² is housed in what was once the very first IKEA and includes an exhibition area of approximately 3,500 m², as well as a restaurant, gift shop and educational facilities.

The use of the mark started more than 70 years ago and has been renowned for its business services and brand recognition. According to Best Global Brands of Interbrand, in 2022 the brand IKEA is ranked in the twenty-eighth position.

The Complainant holds trademark registrations in more than 80 countries around the world and the IKEA trademark has been extensively promoted, without limitation, in print advertisements, promotional materials and Internet forums acquiring a high international recognition.

The IKEA web site www.ikea.com was launched in 1997 and nowadays the Complainant has registered more than 441 domain names under generic Top-Level Domains ("gTLDs") and 294 domain names under country code Top-Level Domains ("ccTLDs") – among which are "ikea.com", "ikea.net", "ikea.us", "ikea.cn", "ikea.de", "ikea.it", "ikea.co.uk".

The trademark IKEA has been extensively used in the major social networks where the Complainant has multiple accounts on the same platform for each country.

The Complainant has recently launched the augmented reality and IKEA Place app to help customers imagine how the furniture will look and fit in their homes.

In view of the wide use, the trademark IKEA is distinctive and well known across the world.

The disputed domain name was registered by the Respondent on November 17, 2022, without the authorisation of the Complainant, and has been pointed to a third party website (<https://100hitsmix.com/shop>) not associated with the Complainant's products/services which promoted the Respondent and his choice of third party musical artists.

The website <https://100hitsmix.com/shop> is linked to the Facebook page <https://www.facebook.com/100HITSMIX/>. The admin of this page published on November, 25, 2022 content which is exploiting the IKEA renown trademark through quoting in the comment the misspelling "I-K-E-A" in association with the bad faith registration of the following domains profiting on the renown of third party trademarks: "I-K-E-A.com", "4-P-F.com", "7-u-p.com", "N-Y-S.com", "S-N-L.com", "Q-V-C.com", "W-W-E.com", "D-i-o-r.com", "E-I-o-n.com", "L-E-G-O.com", "S-E-G-A.com", "O-S-H-A.com" and "Y-E-T-I.com".

The website <https://100hitsmix.com/shop> is also linked to the Instagram page <https://www.instagram.com/100hitsmix/>. The page admin of that account published on November, 25, 2022, the same content.

The Respondent did respond to a cease and desist warning letter.

PARTIES CONTENTIONS

COMPLAINANT:

1) The 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 is confusingly similar to the trademark IKEA in which the Complainant has rights as it incorporates the mark in its entirety, only misspelling the IKEA trademark through using the term “i-k-e-a” instead of “ikea”.

The whole intention is to register an almost imperceptibly different domain name and rely on an Internet user’s mistake or inattention to attract traffic to the Respondent’s website.

The top level “.com” is a necessary tool for use on the Internet. Adding a gTLD is insufficient to negate confusing similarity between a domain name and the mark per Policy 4(a)(i). See *Western Alliance Bancorporation v. James Brandon*, FA 1783001 (Forum June 5, 2018) (“*Respondent’s <westernalliancebcorporation.info> domain name is confusingly similar to Complainant’s WESTERN ALLIANCE BANCORPORATION mark because it merely appends the gTLD ‘.info’ to a misspelled version of Complainant’s mark.*”).

Furthermore, the IKEA trademark is a distinctive, invented word and there is no plausible reason that the Respondent would register a domain incorporating a misspelled version of the IKEA word by chance.

In light of the foregoing, the Complainant concludes that the disputed domain name is confusingly similar to the prior registered trademark in which the Complainant has rights in satisfaction of paragraph 4(a)(i) of the Policy.

(2) The Respondent has no rights or legitimate interests in respect of the disputed domain name;

(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

Following *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 domain name.

The Complainant is not in possession of, nor aware of the existence of, any evidence demonstrating that the Respondent might be commonly known by the domain name or a name corresponding to the disputed domain name as an individual, business, or other organization.

In the case at hand, IKEA is neither a generic term, nor descriptive, and it is not a dictionary word, rather it is an inherently distinctive trademark which solely refers to - and should belong to the Complainant. As anticipated, the word IKEA is an acronym without meaning and completely original and creative; it was coined in 1943 from the initials of Complainant’s founder, i.e. Ingvar Kamprad, the farm on which he grew up, i.e. Elmtaryd, and the nearby village, i.e. Agunnaryd.

There has been no evidence showing that Respondent has any registered trademark rights with respect to the disputed domain name. Respondent registered the disputed domain name on November 17, 2022, long after the IKEA trademark became widely known, also in the United States, where the Respondent is prima facie based.

The Respondent has not provided the Complainant with any evidence of its 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.

Considering that no relationship has ever been established between the parties and no lawful connection to the denomination IKEA appears from the records, the Complainant could not find any evidence that the Respondent is making a bona fide offering of goods or services related to the denomination IKEA.

The Respondent has not provided evidence of a legitimate noncommercial use of the disputed Domain Name or reasons to justify the choice of the term IKEA in the disputed domain name. The Respondent has not replied to the cease and desist warning letter and has not provided any evidence of contemplated good-faith use.

The Respondent registered the disputed domain name in order to point it to a website not related to IKEA products/services, which does not represent a bona fide offering as the website capitalize on the reputation and goodwill of the Complainant’s mark and mislead Internet users.

See *Snap Inc. v. Alex Storgion*, FA 2208002007802 (Forum September 13, 2022): “*The Domain Name is inactive but prior to the commencement of this proceeding the Domain Name has been used to divert users to a website containing unrelated commercial content (namely a watersports company operating in Tennessee).*” **The use of a domain name to divert users, for commercial gain, to a website containing unrelated content is not a bona fide offering of goods or services or a legitimate noncommercial or fair use under Policy ¶ 4(c)(i) or (iii).** See also *Spike’s Holding, LLC v. Nexperian Holding Limited*, FA 1736008 (Forum July 21, 2017) (“*Using a confusingly similar domain to display unrelated content can evince a lack of a bona fide offering of goods or services or legitimate noncommercial or fair use... The Panel therefore finds that Respondent’s unrelated use of the <finishnline.com> domain name evinces a lack of rights and legitimate interests under Policy ¶ 4(c)(i) & (iii).*”).

(3) Holder of the disputed domain name registers or uses the disputed domain name in bad faith.

The disputed domain name was registered in November 2022, years after the Complainant obtained its trademark registrations, including in United States where the Respondent is located.

By virtue of its extensive worldwide use, the Complainant’s trademark IKEA has become a well-known trademark as indicated also in

several UDRP decisions. For instance, in the WIPO decision No. D2017- 2211: “At the time of the registration of the disputed domain name the Complainant’s trademark and business had both been very well-known for many years; it is not plausible that the Respondent stumbled on the name in the disputed domain name [...] by chance or serendipity.”

The disputed domain name pointed to the following website: <https://100hitsmix.com/shop>, which was advertising sound / electronic devices as Bluetooth speakers, earbuds and microphones, i.e. goods which are not related to IKEA products/services.

See also Snap Inc. v. Alex Storgion, FA 2208002007802 (Forum September 13, 2022): “Use of a confusingly similar domain name for commercial purposes unrelated to a complainant’s business can indicate bad faith registration and use per Policy ¶¶ 4(b)(iii) and/or (iv)”. Then see PopSockets LLC v. san mao, FA 1740903 (Forum Aug. 27, 2017) (“finding disruption of a complainant’s business which was not directly commercial competitive behavior was nonetheless sufficient to establish bad faith registration and use per Policy ¶ 4(b)(iii)”; see also Metro. Life Ins. Co. v. Bonds, FA 873143 (Forum Feb. 16, 2007) (“The Panel finds such use to constitute bad faith registration and use pursuant to Policy ¶ 4(b)(iv), because [r]espondent is taking advantage of the confusing similarity between the <metropolitanlife.us> domain name and Complainant’s METLIFE mark in order to profit from the goodwill associated with the mark.”).

The Respondent registered the disputed domain name in order to both capitalize on the renown of the IKEA trademark in order to advertise sound / electronic devices for sale for the sole Respondent’s commercial gain and also with the aim of preventing the Complainant, i.e. the owner of the IKEA trademark or service mark, from reflecting the mark in the corresponding domain name “i-k-e-a.com”.

The Respondent has engaged in a pattern of such conduct. In particular, the Respondent declared both on its Facebook page and on its Instagram page it had registered the following domain names unlawfully incorporating well-known trademarks: “4-P-F.com”, “7-u-p.com”, “N-Y-S.com”, “S-N-L.com”, “Q-V-C.com”, “W-W-E.com”, “D-i-o-r.com”, “E-l-o-n.com”, “I-K-E-A.com”, “L-E-G-O.com”, “S-E-G-A.com”, “O-S-H-A.com”, “Y-E-T-I.com”.

A history of registering domain names incorporating third-party trademarks can be evidence of a pattern of bad faith under Policy paragraph 4(b)(ii). See Australian Stock Exch. v. Cmty. Internet (Australia) Pty Ltd, D2000-1384 (WIPO Nov. 30, 2000) (finding bad faith under Policy paragraph 4(b)(ii) where the respondent registered multiple infringing domain names containing the trademarks or service marks of other widely known Australian businesses).

See also Chevron Intellectual Property LLC v. Carolina Rodrigues / Fundacion Comercio Electronico, FA2207002005830 that provides: “Finally, Respondent has engaged in a long-standing pattern of cybersquatting in registering multiple domains that infringe on the trademarks of other brand owners. Such cases demonstrate that Respondent has engaged in an extensive pattern of conduct designed to infringe upon the trademarks of others, indicative of bad faith. Evidence that a respondent previously registered domain names containing third-party trademarks establishes a pattern of cybersquatting, and demonstrates bad faith registration and use. See Liberty Mutual Insurance Company v. Gioacchino Zerbo, FA1299744 (Forum Feb. 3, 2010).”

RESPONDENT:NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Respondent reacted to the Providers’ information about the pending dispute by two emails. First email dated 2023-02-23 17:37 stated: “It aint yours hahaha l-e-g-o.com. Haha”, second email dated 2023-02-23 17:38 stated: “Haha it ain’t yours L-E-G-O.com next time I will sue you for harassment”. The Provider sent the Respondent information about the proceedings and information how to access the online case file. The Respondent never accessed the case file nor contacted the Provider again.

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

The disputed domain name registered in 2022 is confusingly similar to the Complainant's well known mark (registered in the USA where the Respondent is based since at least 1979) incorporating the Complainant's mark in its entirety adding only three hyphens and the gTLD .com. Hyphens being merely punctuation marks do not prevent confusing similarity between the Complainant's mark and the disputed domain name. Not does the addition of the gTLD .com prevent said confusing similarity.

The Respondent is not authorised by the Complainant and there is no evidence that the Respondent is commonly known by the disputed domain name.

The evidence submitted in this Complaint shows that the disputed domain name has been used for a web site promoting the Respondent and his choice of music by third party musical artists (rather than selling sound equipment as the Complainant contends). However, use of a domain name containing a well known trade mark for a third party commercial endeavour is not a bona fide offering of services or non commercial legitimate fair use under the Policy. It is registration and use in bad faith diverting Internet users for commercial gain and disrupting the Complainant's business.

Further the Respondent appear to have been involved in a pattern of similar activity involving domain names not the subject of this dispute containing other third party well known trade marks.

The Respondent has not answered this Complaint or rebutted the prima facie case evidenced by the Complainant herein.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **i-k-e-a.com**: Transferred

PANELLISTS

Name	Dawn Osborne
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DATE OF PANEL DECISION 2023-03-01

Publish the Decision