

Decision for dispute CAC-UDRP-105162

Case number	CAC-UDRP-105162
-------------	------------------------

Time of filing	2023-02-22 09:26:16
----------------	----------------------------

Domain names	cyclingbrooks.com
--------------	--------------------------

Case administrator

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

Complainant

Organization	Brooks England Ltd
--------------	---------------------------

Complainant representative

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

Respondent

Organization	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 various trademarks comprising the element "BROOKS", including but not limited to:

- Australian Trademark Registration No. 9257, BROOKS, registered on 10 May 1910;
- Danish Trademark Registration No. VR 1961 01006, BROOKS, registered on 4 November 1961;
- German Trademark Registration No. 1079874, BROOKS, registered on 25 July 1985;
- International Registration No. 1512125, BROOKS ENGLAND 1866, registered on 17 October 2019;
- Italian Trademark Registration No. 0001128087, BROOKS, registered on 17 July 2008; and
- New Zealand Trademark Registration No. 8715, BROOKS, registered on 9 August 1910.

FACTUAL BACKGROUND

Established in 1866, the Complainant is a manufacturer of bicycle components, notably leather saddles, grips and bar tape, bags, and other selected leather goods.

The Complainant operates a website at the domain name <brooksengland.com>, where it offers its products for sale to consumers in Europe, the United Kingdom, the United States and Canada, and elsewhere.

The disputed domain name was registered on 27 May 2022 using a privacy service.

The disputed domain name resolves to a website (the “Respondent’s website”) that prominently displays the Complainant’s BROOKS ENGLAND 1866 trademark in its top left corner, and offers for sale goods bearing the Complainant’s trademarks at substantially discounted prices.

On 20 January 2023, the Complainant’s representatives sent a cease-and-desist letter to the Respondent, putting the Respondent on notice of the Complainant’s trademarks, requesting inter alia transfer of the disputed domain name. The Respondent did not reply to the Complainant’s cease-and-desist letter.

PARTIES CONTENTIONS

Complainant

The Complainant asserts rights in various trademarks comprising the element “BROOKS”. The Complainant submits that the disputed domain name is confusingly similar to its trademarks.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant submits that the Respondent is using the disputed domain name to offer for sale goods bearing the Complainant’s trademarks that are advertised at prices that are disproportionately below their market value. According to the Complainant, the goods advertised at the Respondent’s website are counterfeit. As such, argues the Complainant, the Respondent is not using the disputed domain name in connection with any bona fide offering of goods or services. The Complainant further asserts that there is no evidence that the Respondent is commonly known by the disputed domain name, nor is the Respondent making any legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant argues that actual knowledge on the part of the Respondent may be inferred from the Respondent’s website, which purports to offer for sale goods bearing the Complainant’s trademarks, which the Complainant argues are counterfeit. The Complainant asserts that the disputed domain name was registered in order to capitalize on the reputation of the Complainant’s trademarks by diverting Internet users seeking the Complainant to the Respondent’s website. The Complainant argues that the Respondent’s offering for sale of counterfeit goods on the Respondent’s website disrupts the Complainant’s business. The Complainant submits that the Respondent’s failure to reply to the Complainant’s cease-and-desist letter further evidences the Respondent’s bad faith.

The Complainant requests transfer of the disputed domain name.

Respondent

The Respondent did not file a Response to the Complaint.

RIGHTS

The Panel finds that the Complainant has established rights in the trademark BROOKS, the registration details of which are provided above.

The disputed domain name consists of the term “cycling”, followed by the Complainant’s BROOKS trademark, under the generic Top-Level Domain (“gTLD”) “.com”. The Panel finds that the Complainant’s BROOKS trademark is recognizable in the disputed domain name, and that the addition of the term “cycling” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s BROOKS trademark.

The gTLD “.com” may be disregarded for purposes of comparison under the first element of the Policy.

The Panel finds the disputed domain name to be confusingly similar to the Complainant’s BROOKS trademark. The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

As stated above, the disputed domain name resolves to a website purporting to sell products bearing the trademarks. The Complainant alleges that these products are counterfeit. The Panel notes in this regard that the Respondent appears to have misappropriated copyrighted product images from the Complainant’s website, that the Respondent’s website lists a contact address located in Kansas, United States that corresponds to the location of an unrelated third-party business, and that the goods offered for sale via the Respondent’s website are offered at prices substantially below market value. In the absence of any reply from the Respondent, the Panel considers it entirely plausible that the goods offered for sale via the Respondent’s website are in fact counterfeit. Prior UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent; see WIPO Overview

Even if the Panel were to assume that the goods offered for sale are genuine, the Respondent has failed to accurately and prominently disclose its lack of relationship with the Complainant. Rather, the inclusion of the Complainant's BROOKS ENGLAND 1866 trademark in the header of the Respondent's website, and the appearance of the Respondent's website as a whole, give a misleading impression of authorization from or affiliation with the Complainant. The Panel therefore finds that the Respondent has no valid claim of rights or legitimate interests in the disputed domain name as an unauthorized reseller of the Complainant's products; see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903. The Panel finds that the Respondent has not made use of the disputed domain name in connection with a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy.

The Respondent's use of the disputed domain name does not support any legitimate claim of being commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy. The Panel further finds that the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii) of the Policy.

For the above reasons, the Panel finds that Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel notes that the registration of the Complainant's trademarks substantially predates the registration of the disputed domain name. Since its establishment, over 150 years ago, the Complainant has gained substantial international reputation in connection with its cycling-related leather goods. The Panel finds that actual knowledge of the Complainant and intent on the part of the Respondent to target the Complainant's trademarks through the disputed domain name may be inferred from the contents of the Respondent's website, which makes explicit reference to the Complainant and its products. In the circumstances, the Panel finds that the Respondent registered the disputed domain name, having no authorization to make use of the Complainant's trademarks in a domain name or otherwise, with a view to creating a misleading impression of association with the Complainant, in bad faith.

The Panel further finds that by using the disputed domain name in the manner described above, Internet users are likely to be misled as to the source of the goods offered for sale via the Respondent's website. Given that the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods can never confer rights or legitimate interests on a respondent, such behaviour is manifestly considered evidence of bad faith; see WIPO Overview 3.0, section 3.1.4. The Panel concludes that by using the disputed domain name, the Respondent is intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the goods advertised for sale therein, in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant has satisfied the requirements 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 Complainant has established rights in the BROOKS trademark. The disputed domain name is confusingly similar to the Complainant's BROOKS trademark. The Complainant has demonstrated that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in an attempt to create a misleading impression of association between the Complainant, its trademarks, the disputed domain name, and the website to which it resolves, in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **cyclingbrooks.com**: Transferred

PANELLISTS

Name **Jane Seager**

DATE OF PANEL DECISION 2023-04-03

Publish the Decision