

Decision for dispute CAC-UDRP-105255

Case number CAC-UDRP-105255

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Domain names corellehouse.com

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization Instant Brands LLC

Complainant representative

Organization Stobbs IP Ltd

Respondent

Name mikhail Artyukhin

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 owns the following Trademark Registrations for the mark CORELLE:

Canada Trademark Registration No. TMA167153 dated 02 January 1970 in Class 21.

United Kingdom Trademark Registration No. UK00904259231 dated 27 March 2006 in Class 21.

PARTIES CONTENTIONS

THE COMPLAINANT'S CONTENTIONS

The Complainant produces and sells dinnerware goods and related services and launched a product line under the trademark CORELLE in 1970. The CORELLE brand has extensive reach offering products and services worldwide and the mark is the subject of numerous trademark registrations in many countries. Since 2000, the Complainant's main operating website has been located at www.corelle.com. In 2019, a company named Corelle Brands LLC merged with the Complainant Instant Brands Inc, creating a company with an enterprise value over \$2 billion. The Complainant has built a significant reputation and has built up a vast amount

of goodwill in the CORELLE trademark.

The disputed domain name <corellehouse.com> was registered on September 14, 2021 and resolves to a website that displays the names and images of a number of the Complainant's products. Above these images the website displays the banner "Free Shipping fo [sic] all orders over \$35". This website previously offered for sale and/or advertised the sale of counterfeit and knockoff products but the infringing product listings have been removed after the Complainant submitted a takedown notice to the web host Shopify.

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

i. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrate its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. *Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant*, 103255 (CAC September 30, 2020) ("it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).").

The Complainant has submitted screenshots from the websites of the United Kingdom and Canadian intellectual property offices as evidence that it owns registered rights to its asserted CORELLE trademark in these jurisdictions. The earliest of these reflects a registration date of January 2, 1970. The Complainant also lists two trademark registrations in China but no supporting evidence has been provided and so the Panel will not consider these. Registration with such intellectual property offices has been found sufficient to satisfy the threshold requirement of proving trademark rights under Paragraph 4(a)(i) of the Policy. *Margaritaville Enterprises, LLC v. Neil Wein*, FA 1916531 (FORUM November 9, 2020) ("It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights"). The disputed domain name, which was registered on September 14, 2021, adds the word "house" to the CORELLE trademark. The Complainant asserts that the trademark is clearly recognizable in the disputed domain name and that the addition of the non-distinctive term "house" does not avoid a finding of confusing similarity. Finally, the Complainant notes that the domain name adds the ".com" gTLD and states that this "is merely a technical requirement". Thus, the Complainant asserts that the second level of the disputed domain name is confusingly similar to the asserted trademark and will lead internet users to wrongly believe that the disputed domain name is endorsed by the Complainant.

Prior panels have found confusing similarity under similar fact situations. Avast Software s.r.o. v. Milen Radumilo, 102384 (CAC April 19, 2019) (“it is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity.”). Also, the extension “.com” typically adds no meaning or distinctiveness to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. Novartis AG v. Wei Zhang, 103365 (CAC December 9, 2020) (“it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ‘.com’) is to be disregarded under the confusing similarity test”).

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of a descriptive word thereto in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant’s trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

ii. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Pursuant to Paragraph 4(a)(ii) of the Policy, the Complainant has the burden of making a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name. Cephalon, Inc. v. RiskIQ, Inc., 100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the Respondent to demonstrate that it does have rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

With reference to Paragraph 4(c)(ii) of the Policy the Complaint states that “Respondent has never legitimately been known by the name CORELLE at any point in time”. The Respondent has not participated in this case and so it does not contest this. There is also no evidence that Respondent is affiliated with the Complainant or is authorized or licensed to use the Complainant’s trademark or to seek registration of any domain name incorporating the asserted trademark. Furthermore, the Registrar for the disputed domain names identifies the Registrant as “mikhail Artyukhin”. There is no evidence that the Respondent is known otherwise and its use of the Complainant’s trademark in its domain name does not, alone, support a different conclusion. Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”, D2000-0847 (WIPO October 16, 2000) (“use which intentionally trades on the fame of another” should not be considered. “To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.”) Based upon the available evidence in this case, the Panel cannot conclude that the Respondent is commonly known by the disputed domain name.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. The disputed domain name resolves to a website that claims to offer online sales of products bearing the Complainant’s trademark. Using a confusingly similar domain name to pass oneself off as a Complainant is not a bona fide offering of goods or services or a legitimate noncommercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy. See Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund, FA 1790949 (FORUM July 9, 2018) (finding that the Respondent did not use the disputed domain name to make a bona fide offering of goods or services per Paragraph 4(c)(i) of the Policy or for a legitimate noncommercial or fair use per Paragraph 4(c)(iii) where the website resolving from the disputed domain name featured the Complainant’s mark and various photographs related to the Complainant’s business). Here, the Complainant claims that the Respondent uses the disputed domain name to pass itself off as the Complainant in order to sell counterfeit and knockoff products. The Complainant provides a screenshot of the Respondent’s resolving website and the Panel notes that the website displays a photo of the Complainant’s products along with the names of some of its product lines and the statement “Our most loved collection. Versatile, modern and perfect for any occasion”. Above this appears the statement “Free Shipping fo [sic] all orders over \$35” as well as a shopping cart icon in the top-right corner of the page. This appears, to the Panel, to be an online sales page but there is no indication that it does not originate with the Complainant or that the Respondent has no relationship with the Complainant. Oki Data Americas Inc v ASD Inc, D2001-0903 (WIPO Nov. 6, 2001). The Respondent has not filed a Response nor made any other submission in this case.

As the Complainant has made out a prima facie case of impersonation for commercial gain that has not been rebutted by the Respondent, upon a preponderance of the evidence before it the Panel finds that the Respondent fails to make a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

iii. The disputed domain name was registered and used in bad faith

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. Further guidance on that requirement is found in Paragraph 4(b) of the Policy, which sets out four examples of possible actions by the Respondent that may satisfy this burden of proof.

Inherently prerequisite to a finding of bad faith under Paragraph 4(a)(iii) of the Policy is some attribution of knowledge of the Complainant's claimed trademark, whether actual or based upon a conclusion that the Respondent should have known of the trademark. See, Domain Name Arbitration, 4.02-C (Gerald M. Levine, Legal Corner Press, 2nd ed. 2019) ("Knowledge and Targeting Are Prerequisites to Finding Bad Faith Registration"); USA Video Interactive Corporation v. B.G. Enterprises, D2000-1052 (WIPO December 13, 2000) (claim denied where "Respondent registered and used the domain name without knowledge of Complainant for a bona fide commercial purpose."). See also, WIPO Overview 3.0, par. 3.1.1 (when examining whether "circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark", Panels may consider such issues as "the respondent's likely knowledge of the complainant's rights"). Here, the Complainant claims that it "has built a significant reputation and has built up a vast amount of goodwill in the CORELLE trade marks", that it "has extensive reach offering its products and services worldwide", and that "is also active on social media and has generated a significant level of endorsement." It "submits based on the extensive trade mark registrations and the wide reputation the Complainant enjoys in the CORELLE brand, the Respondent's actual knowledge when registering the Disputed Domain Name is unequivocal." However, apart from evidence of two of its trademark registrations and a single archival screenshot of its www.corelle.com website dated from the year 2000, the Complainant has not submitted any documentary evidence to support its claims of brand reputation or scope. Nevertheless, the Complainant also claims that "based on the Respondent's use of the CORELLE mark to sell counterfeit product, the Respondent has actual knowledge of the complainant's rights in the CORELLE Registered Trade Marks at the time of registering the Disputed Domain Name." The Panel agrees with this latter claim that Respondent's actual use of the Complainant's trademark and an image of the Complainant's products, does indicate that it had prior knowledge of such trademark at the time the disputed domain name was registered.

Next, the Complainant argues that the Respondent registered and uses the disputed domain name in bad faith as the Respondent fraudulently impersonates and passes itself off as the Complainant. Using a confusingly similar domain name to pass oneself off as a complainant can demonstrate bad faith under Paragraphs 4(b)(iii) and (iv) of the Policy. See *Abbvie, Inc. v. James Bulow, FA 1701075* (FORUM November 30, 2016) ("Respondent uses the <abbvie.com> domain name to impersonate Complainant's CEO. Such use is undeniably disruptive to Complainant's business and demonstrates bad faith pursuant to Policy Paragraph 4(b)(iii), and/or Policy Paragraph 4(b)(iv)"). The Complainant asserts that the Respondent's use of the disputed domain name "disrupts the Complainant's business by diverting potential customers to the Infringing Website selling counterfeit product. Using a confusingly similar domain name in a manner disruptive of a Complainant's business by trading upon the goodwill of a Complainant for the commercial gain evinces bad faith". The evidence in this case shows that the Respondent has, for commercial gain, used its website at the disputed domain name to pass itself off as the Complainant to actual and potential customers in furtherance of allegedly promoting the sale of products bearing the Complainant's trademark. The Respondent has not participated in this case to explain its actions and so, based upon a preponderance of the available evidence, the Panel finds it highly likely that the Respondent registered and uses the disputed domain name in bad faith by disrupting the Complainant's business, per Paragraph 4(b)(iii) of the Policy, and by seeking commercial gain through confusion with the Complainant's trademark, per Paragraph 4(b)(iv).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. corellehouse.com: Transferred

PANELLISTS

Name	Steven Levy
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DATE OF PANEL DECISION 2023-04-03

Publish the Decision
