

Decision for dispute CAC-UDRP-105418

Case number CAC-UDRP-105418

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Domain names crank-brothers.com

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization Crankbrothers Inc.

Complainant representative

Organization Convey srl

Respondent

Name Jbdg Ybeue

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 trademark registrations such as:

European Union Trademark n. 018042430 – CRANKBROTHERS - Cl. 25, registered on 25 September 2019;

European Union Trademark n. 010163459 – CRANKBROTHERS - Cl. 8, 12, 18, 21, 25, registered
on 3 January 2012;

US Serial n. 88435952 – CRANKBROTHERS – Cl. 25, registered on 5 May 2020;

WIPO Trademark n. 1338382 – CRANKBROTHER – Cl. 8, 12, registered on 8 December 2016.

It also has other trademarks worldwide, including in China:

“CRANKBROTHERS” CN TM n° 6105103 – Nice Cl. 12;

“CRANKBROTHERS” CN TM n° 26641479 – Nice Cl. 25.

FACTUAL BACKGROUND

Crankbrothers Inc., the Complainant in this proceeding, is located in the United States, with registered offices at 580 Broadway St, Suite 101, Laguna Beach, CA 92651, US. It also has an operating

hub in Taiwan. The business was founded in 1997 in a garage in Laguna Beach, California, when it began manufacturing tools, pumps, wheels, handlebars, stems and seat posts. It has grown to be a manufacturer of components for bicycles and today it is owned by Selle Royal Group S.P.A. Its products are appreciated by mountain bike professionals for the technology and quality of Crankbrothers products.

The Complainant states that “[f]rustrated by complicated clipless pedals, Complainant’s engineers Carl Winefordner and designer Frank Hermansens developed the Eggbeater pedal in 2001 – a milestone in the company’s history construction with 4 entry sides offers twice as many as conventional clipless pedals and thus makes it easier to click in and out - a great benefit especially in difficult terrain.” It also has many other bicycle products that it has developed including the Stamp pedal as well as pumps and multitools. In addition, its products include wheels and seat posts. The Complainant states that much of its products are revolutionary.

In 2022, the Complainant celebrated the 25th anniversary with offices in the HQ at Laguna Beach, as well as in San Clemente CA, and in Taiwan.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant alleges that the at issue domain name, <crank-brothers.com> (the „Disputed Domain Name“) resolves to an active website having the appearance of being Complainant’s website and offering or appearing to offer Complainant’s products. In view of its world-wide reputation and the fact that it has a market presence in China and Chine trademarks, the Respondent could not ignore the existence of the trademark CRANK BROTHERS trademarks and decided to register the disputed domain name to gain profit from the sales of counterfeit products bearing the Complainant’s trademarks and to illegitimately trade on the Complainant’s fame for commercial gain.

RESPONDENT:

The Respondent has not appeared formally or informally to controvert the evidence submitted by the Complainant.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Pursuant 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 domain name should be cancelled or transferred:

- (i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (ii) respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations and adduced proof pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint and annexes as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, WIPO Case No. D2000-0009 (WIPO February 29, 2000) ("In the absence of a response, it is appropriate to accept as true all [reasonable] allegations of the Complaint.").

Identical or Confusingly Similar to a Mark in which Complainant has a Right:

To succeed under the first element, a complainant must pass a two-part test by first establishing that it has rights, and if it does it must then show that the disputed domain name is either identical or confusingly similar to the mark. The first element of a UDRP complaint "serves essentially as a standing requirement."

Here, the Complainant has established that it has rights in the word mark CRANKBROTHERS by providing the Panel with the evidence that it has numerous registrations in many jurisdictions for its mark. The consensus view which the Panel adopts is that a national or an international trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established that it has a right in the word mark CRANKBROTHERS.

The second part of the test which calls for comparing the Complainant's mark with the Disputed Domain Name entails "a straightforward visual or aural comparison of the trademark with the alphanumeric string in the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark." WIPO Jurisprudential Overview 3.0 at section 1.7.

The Panel observes that the single difference in this case is the addition of a hyphen between the words "Crank" and "Brothers." Such changes including the addition of grammatical markers are immaterial. Where the relevant trademark is recognizable within the disputed domain name it is sufficient to establish confusing similarity. The addition of the gTLD ".com" does not have any impact on the overall impression of the dominant portion of the disputed domain name and is therefore irrelevant in determining the confusing similarity between CRANKBROTHERS and <crank-brothers.com>.

Accordingly, Complainant has satisfied Paragraph 4(a)(i) of the Policy.

Determining Whether Respondent Lacks rights or legitimate interests in the Disputed Domain Name:

To establish the second of the three elements, the Complainant must first demonstrate that Respondent lacks rights and legitimate interests in the disputed domain name. Recognizing that the proof for establishing this element is under the Respondent's control, the Complainant's may satisfy this burden by offering a prima facie case based on such concrete, circumstantial, or presumptive evidence as there is thus shifting the burden to the Respondent to produce evidence to overcome the presumption that it lacks rights or legitimate interests in the Disputed Domain Name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. It states that it did not authorize the Respondent to register the Disputed Domain Name, the Respondent is not using the domain name for any bona fide use, nor can it claim to be known by the name "CRANKBROTHERS" as it has been identified in the Whois directory as Jbdg Ybeue.

Further, the Complainant has adduced evidence based on the use of the Disputed Domain Name that Respondent is not using it for any non-commercial or fair use. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (Forum November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

Here, the Complainant's contentions satisfy the presumptive burden that Respondent lacks rights or legitimate interests in the Disputed Domain Name. A respondent has the opportunity to controvert the prima facie case by adducing evidence demonstrating that it has rights or legitimate interests.

The Policy sets forth the following nonexclusive list of factors:

- (i) "[B]efore any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services."
- (ii) "[Y]ou (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights."
- (iii) "[Y]ou are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

Evidence of any one of these defences will satisfy a respondent's rebuttal burden, but the absence of any evidence supports a complainant's contention that the Respondent lacks rights or legitimate interests in the disputed domain name. The failure of a party to submit evidence on facts in its possession and under its control may permit the Panel to draw an adverse inference regarding those facts. See *Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown, doing business as Big Daddy's Antiques*, WIPO Case No. D2000-0004. Here, the Disputed Domain Name is virtually identical to the Complainant's mark. The sole difference is the addition of a hyphen between the words "Crank" and "Brothers." This strategy of introducing grammatical markers or additions to a mark does not support a right or legitimate interest in a disputed domain name and the Panel so finds in this matter. See *Chernow Communications, Inc. v. Jonathan D. Kimball*, WIPO Claim No. D2000-0119 ("If the dissent's reasoning were accepted it would be very easy in the future for a prospective cybersquatter, by inserting or deleting a hyphen.") *Oxygen Media, LLC v. Primary Source*, WIPO Claim No. D2000-0362 (holding: "The substitution of the digit zero for the letter "o" appears calculated to trade on Complainant's name by exploiting likely mistake by users when entering the url address.").

Noteworthy also is that <crank-brothers.com> resolves to an active website impersonating the Complainant by offering or appearing to offer its products. Where the "only apparent purpose would be to trade on mistakes by users seeking Complainant's web site" the registration is abusive, *Oxygen Media, LLC v. Primary Source*, WIPO Claim No. D2000-0362 (holding: "The substitution of the digit zero for the letter "o" appears calculated to trade on Complainant's name by exploiting likely mistake by users when entering the url address.").

As the Respondent has not controverted the evidence that it lacks right or legitimate interests in the Disputed Domain Name, and for the reasons herein stated, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad faith:

Finally, it is the Complainant's burden under Paragraph 4(a)(iii) of the Policy to prove that the Respondent both registered and is using the Disputed Domain Name in bad faith. It is not sufficient for a complainant to rest its case on the finding under Paragraph 4(a)(ii) of the Policy, although the fact that the Respondent lacks rights or legitimate interests in the Disputed Domain Name will be a factor in assessing its motivation for registering a domain name that is virtually identical to the Complainant's mark.

In this case, the Respondent employs a strategy of use known as typosquatting, which is defined as the "intentional misspelling of words with intent to intercept and siphon off traffic from its intended destination, by preying on Internauts who make common typing errors," *Nat'l Ass'n of Prof'l Baseball League, Inc. v. Zuccarini*, WIPO Case No. D2002-1011. The addition of a hyphen is a purposeful attempt to disguise the Disputed Domain Name as sponsored by the Complainant and is likely to confuse Internet viewers. *Cost Plus Management Services, Inc. v. xushuaiwei*, FA 1800036 (Forum Sep. 7, 2018) ("Typosquatting itself is evidence of relevant bad faith registration and use.").

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 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 the 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 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 preamble to Paragraph 4(b) states: "For the purposes of Paragraph 4(a)(iii) [the finding of any of the circumstances] shall be evidence of the registration [...] of a domain name in bad faith." In the absence of a respondent to explain and justify its registration and use of a domain name corresponding to a famous or well-known mark, a Panel is compelled to examine the limited record for any exonerative evidence of good faith. The Respondent has not appeared and based on the evidence of record, the Panel finds

none.

The Complainant's proof in this case focuses the Panel's attention on the fourth factor. As there is no proof that would support the other factors, the Panel will not address them. The Complainant argues and the evidence supports that the Respondent redirects the Disputed Domain Name to a website where counterfeited products of the Complainant are offered for sale. Indeed, as highlighted in the comparison evidenced there are huge differences between the Complainant's prices and the ones indicated in the Respondent's website. Such conduct constitutes a further evidence as stated in the paragraphs 2.13.2 and 3.1.4 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition. In *Oakley, Inc. v. Victoriaclassic.Inc.*, WIPO Claim No. D2012-1968 a proceeding commenced by Complainant (and its authorized distributors) for products on their websites comparable in appearance to those offered by Respondent on its websites [...] The Panel finds Respondent has "direct[ed] Internet users for commercial gain to websites where it offers and sells products that have not been made under authority of Complainant or authorized for sale under Complainant's trademark ("counterfeit" trademark products on its websites). Respondent has intentionally attempted to attract for commercial gain Internet users to its websites by creating a likelihood of confusion with Complainant's using the disputed domain names in bad faith within the meaning of paragraph 4(b)(iv) of the Policy."

The evidence establishes that the Respondent has appropriated a well-known mark to serve an infringing purpose. See *Royal Bank of Canada - Banque Royale Du Canada v. Registration Private, Domains By Proxy, LLC / Randy Cass*, WIPO Case No. D2019-2803, the Panel noted: "It is clear that where the facts of the case establish that the respondent's intent in registering or acquiring a domain name was to unfairly capitalize on the complainant's [...] trademark, panels have been prepared to find the respondent acted in bad faith."

Further, the evidence here is such that the only inference that can be drawn from the use of a virtually identical domain name that the Respondent is using the Disputed Domain Name as a vehicle to cash-in on Complainant's goodwill and reputation. See *Singapore Airlines Ltd. v. European Travel Network*, WIPO Case No. D2000-0641 (holding that "[t]he registration of domain names obviously relating to the Complainant is a major pointer to the Respondent's bad faith and desire to 'cash in' on the Complainant's reputation.").

The Complainant's argument that the Respondent's failure to reply to a cease-and-desist notice has been held evidence of bad faith is a factor among others. Here, it is unnecessary to comment on it at length because the evidence of abusive registration of the Disputed Domain Name is so overwhelming that it becomes surplusage. The Respondent is an impersonator of the Complainant. It has registered a domain name that corresponds virtually with the Complainant's mark and is offering counterfeit products and by this duplicity is "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." Absent a remedy consumers will undoubtedly be taken in by the low pricing in the belief they were purchasing genuine products manufactured by the Complainant.

As the Complainant has demonstrated that the Respondent registered and is using the Disputed Domain Name in bad faith, it has satisfied 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. **crank-brothers.com**: Transferred

PANELLISTS

Name	Gerald Levine Ph.D, Esq.
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DATE OF PANEL DECISION 2023-06-13

Publish the Decision
