

Decision for dispute CAC-UDRP-105399

Case number	CAC-UDRP-105399
Time of filing	2023-05-09 10:34:28
Domain names	osprey-chile.com, osprey-nederland.com, osprey-polska.com, osprey-wien.com, ospreybackpackaustralia.com, ospreybackpackireland.com, ospreybackpackscanada.com, ospreybackpackphilippines.com, ospreybackpacksingapore.com, ospreycanadasale.com, ospreyenchile.com, ospreyencolombia.com, ospreyenespana.com, ospreyoutletdeutschland.com, ospreyoutletmexico.com, ospreysaleaustralia.com, ospreysalesingapore.com, ospreysaleuk.com, ospreysbelgie.com, ospreysdeutschland.com, ospreysnederland.com, ospreysschweiz.com, ospreyudsalg.com, ospreyuksale.com, ospreybackpacksnz.com, ospreybatoh.com, ospreyenmexico.com, ospreysacs.com, ospreysdanmark.com, ospreyzaino.com, ospreyirelandsale.com, ospreyoutletbelgie.com, ospreyoutletschweiz.com, osprey-philippines.com, osprey-portugal.com

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization Osprey Packs, Inc

Complainant representative

Organization Coöperatie SNB-REACT U.A.

Respondents

Organization Web Commerce Communications Limited

Name Paul Beyer

Name Yvonne Weissmuller

Name Patrick Abt

Name Anna Dresner

Name Michael Dietrich

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Names.

IDENTIFICATION OF RIGHTS

Complainant states, and provides relevant evidence, that it is the owner of a number of trademark registrations for OSPREY since 2002, including Int'l Reg. No. 1049358 (registered August 11, 2010), Int'l Reg. No. 1074730 (registered August 26, 2010), EUIPO Reg. No. 004312534 (registered June 28, 2007), EUIPO Reg. No. 004312518 (registered February 14, 2006), and U.S. Reg. No. 2,571,330 (registered May 21, 2002). These registrations are referred to herein as the "OSPREY Trademark."

FACTUAL BACKGROUND

Complainant states that it "designs, sources, distributes, sells and markets outdoor backpacks since its foundation in 1974"; that its global revenue was US \$60 million in 2022; and that it sells its products online at a website using the domain name <osprey.com>, which was created on April 11, 1999.

The Disputed Domain Names were created on dates ranging from December 25, 2022, to February 24, 2023. Each of the Disputed Domain Names is used in connection with a website that, as described by Complainant (and as confirmed by screenshots submitted as evidence), "prominently feature[es] the Complainant's 'OSPREY' figurative trademark at the top of every page, on each of its 35 substantially identical websites in connection with the sale of backpacks."

PARTIES CONTENTIONS

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that each of the Disputed Domain Names "incorporate[s] the 'OSPREY' trademark(s) in their entirety, plus an additional term" and that "panels have held domain names to be confusingly similar if the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name."

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Complainant has no relationship whatsoever with the Respondent and has never licensed or otherwise authorized the Respondent to use the 'OSPREY' trademark on the websites or in the disputed domain names"; "Complainant has exclusive trademark rights which predate the registration of the disputed domain names"; Respondent has produced "[n]o such credible evidence" to demonstrate that it is "commonly known" by any of the Disputed Domain Names; "Respondent does not hold any genuine trademark or service mark right"; and "[i]t is clear that Respondent has registered and used the disputed domain names for the purpose of passing itself off as being (connected with) the Complainant."

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, Respondent has engaged in a pattern of conduct under paragraph 4(b)(ii) of the Policy by registering and using the 35 Disputed Domain Names; and Respondent has created a likelihood of confusion under paragraph 4(b)(iv) of the Policy by "offering goods similar to those of the Complainant under the Complainant's trademarks."

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 UDRP).

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 UDRP).

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 UDRP).

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.

The Panel has considered whether consolidation is appropriate in this case and concludes that “(i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 4.11.2.

Further, to the extent that the language of the proceeding may be an issue, the Panel concludes that English is appropriate here considering “the language/script of the domain name,” “any content on the webpage under the disputed domain name,” “potential unfairness or unwarranted delay in ordering the complainant to translate the complaint,” and “in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names.” WIPO Overview 3.0, section 4.5.1

PRINCIPAL REASONS FOR THE DECISION

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the OSPREY Trademark.

As to whether the Disputed Domain Names are identical or confusingly similar to the OSPREY Trademark, the relevant comparison to be made is with the second-level portion of each of the Disputed Domain Names only because “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” WIPO Overview 3.0, section 1.11.1.

Here, each of the Disputed Domain Names contains the OSPREY Trademark in its entirety, plus one or more descriptive, geographic or other words and, in some cases, a hyphen. As set forth in section 1.8 of WIPO Overview 3.0: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because, inter alia, “Complainant has no relationship whatsoever with the Respondent and has never licensed or otherwise authorized the Respondent to use the ‘OSPREY’ trademark on the websites or in the disputed domain names”; “Complainant has exclusive trademark rights which predate the registration of the disputed domain names”; Respondent has produced “[n]o such credible evidence” to demonstrate that it is “commonly known” by any of the Disputed Domain Names; “Respondent does not hold any genuine trademark or service mark right”; and “[i]t is clear that Respondent has registered and used the disputed domain names for the purpose of passing itself off as being (connected with) the Complainant.”

WIPO Overview 3.0, section 2.1, states: “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has 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 complainant, for valuable consideration in excess of the registrant’s documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’s 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 registrant's website or location or of a product or service on the registrant's website or location.

The Panel agrees with Complainant that bad faith exists here pursuant to both paragraph 4(b)(ii) and paragraph 4(b)(iv) of the Policy. Under paragraph 4(b)(ii), the registration and use of the 35 Disputed Domain Names as described above clearly evidences a "pattern" of conduct. And, clearly, by using the 35 Disputed Domain Names in connection with websites that appear to be for, or at least associated with, Complainant, Respondent has created a likelihood of confusion. See, e.g., *DocuSign, Inc. v. Traffic CPMiPV, Maria Carter*, WIPO Case No. D2010-0344 (creating a website that appears to be a website for a complainant is "likely fraudulent" and "indicates an intent to deceive or, at a minimum, act in bad faith with the intent for commercial gain."); *Emu (Aus) Pty Ltd. and Emu Ridge Holdings Pty Ltd. v. Antonia Deinert*, WIPO Case No. D2010-1390 ("a reasonable person who visited the Respondent's website was likely to be misled in relation to the source, sponsorship, affiliation, or endorsement of the website and the products purportedly made available for online sale on the website"); and *Houghton Mifflin Co. v. The Weathermen, Inc.*, WIPO Case No. D2001-0211 ("a visitor to Respondent's site would be likely to believe that it was Complainant's official site" where Respondent's site contained the complainant's mark and character).

Accordingly, the Panel finds that Complainant has proven 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. **osprey-chile.com**: Transferred
2. **osprey-nederland.com**: Transferred
3. **osprey-polska.com**: Transferred
4. **osprey-wien.com**: Transferred
5. **ospreybackpackaustralia.com**: Transferred
6. **ospreybackpackireland.com**: Transferred
7. **ospreybackpackscotland.com**: Transferred
8. **ospreybackpackphilippines.com**: Transferred
9. **ospreybackpacksingapore.com**: Transferred
10. **ospreycanadasale.com**: Transferred
11. **ospreyenchile.com**: Transferred
12. **ospreyencolombia.com**: Transferred
13. **ospreyenespana.com**: Transferred
14. **ospreyoutletdeutschland.com**: Transferred
15. **ospreyoutletmexico.com**: Transferred
16. **ospreysaleaustralia.com**: Transferred
17. **ospreysalesingapore.com**: Transferred
18. **ospreysaleuk.com**: Transferred
19. **ospreysbelgie.com**: Transferred
20. **ospreysdeutschland.com**: Transferred
21. **ospreysnederland.com**: Transferred
22. **ospreysschweiz.com**: Transferred
23. **ospreyudsalg.com**: Transferred
24. **ospreyukseale.com**: Transferred
25. **ospreybackpacksnz.com**: Transferred
26. **ospreybatoh.com**: Transferred
27. **ospreyemexico.com**: Transferred
28. **ospreysacs.com**: Transferred
29. **ospreysdanmark.com**: Transferred
30. **ospreyzaino.com**: Transferred
31. **ospreyirelandsale.com**: Transferred
32. **ospreyoutletbelgie.com**: Transferred
33. **ospreyoutletschweiz.com**: Transferred
34. **osprey-philippines.com**: Transferred

35. osprey-portugal.com: Transferred

PANELLISTS

Name Douglas Isenberg

DATE OF PANEL DECISION 2023-06-14

Publish the Decision
