Decision for dispute CAC-UDRP-105419

Case number	CAC-UDRP-105419
Time of filing	2023-05-18 16:28:39
Domain names	icemadeeasy.com

Case administrator

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

Complainant

Organization	Roesch Inc.

Complainant representative

Organization	UDRPKing.com

Respondent

Name	DJA DANNER

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 an US company founded in 1916, which provides consistent expertise in porcelain enamel, stainless steel, other metals fabrication; food equipment manufacturing; home appliance manufacturing; Heating Ventilation Air Conditioning (HVAC); hearth, patio and BBQ manufacturing; construction and ICE Products, including its own line of Ice Merchandisers (Ice Maid Merchandisers) and related products.

The Complainant, among others, owns the following Trademarks:

- US Trademark ICE MAID, Reg. No. 1485183, IC 11, filed on January 6, 1986, registered on April 19, 1988 and in force until April 19, 2028;

- US Trademark ICE MAID, Reg. No. 4108191, IC 16, filed on June 23, 2011, registered on March 6, 2012, and in force until March 8, 2032;

- US Trademark ICE MADE EASY, Reg. No. 5223627, IC 16, filed on March 11, 2015, with a first use in commerce of August 31, 2016; registered on June 13, 2017; maintenance filed on March 10, 2023, most probably in force until June 14, 2027;

- US Trademark DEVICE Penguin Snowflakes Ice Cubes, IC 16, Reg. No. 5210953, filed on July 28, 2016, registered on May 23, 2017, and in force until May 24, 2027; and

- US Trademark YOUR ONE-STOP SHOP FOR ALL THINGS ICE, IC 16, Reg. No. 5210954, filed on July 28, 2016, registered on May 23, 2017, and in force until May 24, 2027.

The disputed domain name <**icemadeeasy.com**> was created on **January 7, 2014,** and resolves to an active website with 'Ice Vending Business' references, listing Complainant's competitors and potential malicious links.

FACTUAL BACKGROUND

The Complainant, was founded in 1916 as a porcelain enamel contract manufacturer. During the 1920s, the Complainant manufactured coal and gas residential cooking ranges. In the 1940's the Complainant added metal fabrication capabilities, expanding its business activities as a custom job shop to the Heating Ventilation Air Conditioning (HVAC) and major cooking appliance manufacturers. In the 1970s, in order to offset cyclical sales of its products and services, the Complainant developed its line of Ice Merchandisers (Ice Maid Merchandisers) and related products. Today, the Complainant has developed expertise in food equipment manufacturing; home appliance manufacturing; HVAC; hearth, patio and BBQ manufacturing; construction and ICE Products.

Apart from its Trademarks, the Complainant owns the following domain names: <roeschinc.com>, created on July 16, 1996, and active since 1999; <icemaid.com>, <icemadeasy.com> (activated after the lapse of the disputed domain name <icemadeeasy.com>); <icedmaideasy.com>, <icedmadeeasy.com>, and <icedmadeasy.com> redirected to <icemadeasy.com>.

The disputed domain name <**icemadeeasy.com**> was created and registered by the Complainant on **January 7, 2014**; and renewed on December 2021 until its expiration date, being January 7, 2023. The Complainant inadvertently missed out the disputed domain name's renewal. By February 14, 2023, the disputed domain name appeared registered by the Registrant with a different Registrar. By the time of this Decision, the disputed domain name, resolves to an active website with 'Ice Vending Business' references, listing Complainant's competitors and potential malicious links.

PARTIES CONTENTIONS

Response

On the same date of the Notification of Complaint and Notification of Administrative Proceeding by the CAC, on May 23, 2023, the Respondent replied, contacting the CAC stating:

"Could you let me know what the problem is?

It is an expired domain that was bought.

Regards."

On the same date the CAC, replied as follows:

Dear Sir,

Please be informed, that the complainant claims that the domain name violates its trademark rights. If you want to study the complaint and comment on it, please log in to the case file.

Kind regards."

However, the Respondent did not submit its Administrative Response replying to Complainant's contentions.

Complainant Contentions:

- The Complainant contends that it has been in existence since 1916 and that is the only one in the world to have conceived and adopted the trademark ICE MADE EASY in 2015-16, duly registered before USPTO; that the disputed domain name <.**com**> is confusingly similar to its trademark ICE MADE EASY (based on Section 1.7 of the WIPO Overview 3.0).

- The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, due to the Respondent is not affiliated with the Complainant in any way to make use of the ICE MADE EASY trademark; that the disputed domain name is the result of a recent acquisition date of mid-February, 2023, while the Complainant has painstakingly built up a global reputation and has invested a substantial amount of resources in promoting its product under the trademarks ICE MADE EASY, ICE MAID EASY, ICE MAID.

- The Respondent had no rights to incorporate the trademark ICE MADE EASY in the disputed domain name or otherwise to

render any services, in relation to Ice Merchandisers or Ice Bags or Ice Vending Machines; that the misleading webpage at the disputed domain name along with active MX records only reinforces the (false) association between the Complainant and the disputed domain name and leads to confusion and deception.

- The Complainant contends that has not authorized the Respondent either as a licensee, vendor, supplier, distributor, or customer relations agent for Complainant's products or related services; that any person or entity using the mark/name ICE MADE EASY in any manner is bound to lead customers and users to infer that its product or service has an association or nexus with the Complainant and lead to confusion and deception.

- That due to Complainant's prior rights in the trademark ICE MADE EASY and the goodwill and reputation vested in the Trademark in terms of the prior use, it is evident from the current website that the sole purpose behind the Respondent in registering the disputed domain name was to take undue advantage of the Complainant's trademark ICE MADE EASY; that the current web pages use referral links (to earn commission) to Amazon.com/.in and specifically provide for the competing websites that sell ICE Merchandisers; that the Respondent's registration and use of the disputed domain name is a clear case for cyber-squatting, that its intention was to take advantage of the Complainant's substantial reputation and goodwill in order to confuse the public and the viewer by offering similar products/services, divert business, tarnish the reputation and goodwill of the Complainant; that the said usage is certainly not in terms of paragraphs 4(c)(i) or 4(c)(iii) of the Policy, as neither the demonstrable preparation to use is a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name; that instead, the Respondent is deliberately trying to portray a connection between the disputed domain name and the Complainant.

- The Complainant also contends, that the disputed domain name incorporates a trademark neither owned by Respondent nor is the Respondent commonly known by the disputed domain name <icemadeeasy.com> either as an individual, business or any other organization.

- The Complainant asserts that it is inconceivable that the disputed domain name was registered without full knowledge of the existence of the Complainant and its trademark; that the present webpage displaying information about products, previously featured on the Complainant's official website, clearly indicates the Respondent's actual knowledge; that the initial parking page at the disputed domain name, made reference to Ice Bags, covered explicitly by the Complainant's trademark registration. Moreover, the current webpage includes references to products offered by the Complainant through the disputed domain name till January 2023 - Ties, Koolaire Ice Machine, Leer Ice Merchandiser and also lists competitor 'Sites that Sell Ice Merchandisers', showing the actual knowledge of the Respondent as to the Complainant and the website previously at the disputed domain name <icemadeeasy.com>; that the Respondent/Registrant must have obtained such knowledge at the time of acquisition/registration of the disputed domain name from the search at WIPO Trademark database or Web archives at <archive.org> or otherwise even a simple Google search for "ICE MADE EASY" which evidences the popularity of the Complainant's trademark and its previous use.

- That the Respondent cannot be said to have legitimately chosen to use the disputed domain name unless it sought to create an impression of an association with the Complainant. Since there is no such authorized association, the Respondent's use of the disputed domain name cannot be said to be legitimate; that rather, there is prima facie proof of the Respondent's intent to usurp the reputation of the Complainant and make illegal gains off its worldwide reputation and goodwill. Suffice it to state that the said usage of the disputed domain name by the Respondent has the propensity to cause irreparable loss to the goodwill and reputation of the Complainant.

- The Complainant contends that the disputed domain name resolves to a website displaying products that were previously being sold through the disputed domain name. The Complainant submits that the Respondent is not authorized by the Complainant to make use of the disputed domain name in any form, instead, it has been registered to impersonate in order to create consumer confusion and lure prospective customers seeking the Complainant's products, in accordance to paragraph 4(b)(iv) of the Policy: "By using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

- The Complainant asserts that on March 23, 2023, attempted to serve a Cease & Desist notice to the Respondent, through the Domain Registrar, but that the Domain Registrar did not cooperate and alternatively, the Complainant's officer had filled up the contact form on GoDaddy WhoIs page. Later, a misleading website came up at the disputed domain name, offering products previously offered by the Complainant.

- The Complainant asserts that there are active MX Records, indicating that the disputed domain name is in use for phishing or other illegal activities; that the Complainant used the disputed domain name <icemadeeasy.com> for more than seven (7) years and uses more similar domain names like <icemaid.com> and <icemadesay.com>. Hence, any individual coming across the disputed domain name or an associated email ID ending with "@icemadeeasy.com" may assume it to be the Complainant's website/e-mail and instantly associate the same with the Complainant; that the same is very much evident from the active MX records for the disputed domain name.

- That the Respondent made use of a Domain Proxy service by the Domain Registrar to shield its identity. Although the use of a privacy or proxy registration service does not indicate bad faith as such, however the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith; that the use and registration of the disputed domain name are clearly intended to capitalize on consumer confusion for Respondent's profit, a bad faith use under the Policy's 4(a)(iii).

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 Complainant has sufficiently proved before the Panel, that owns Trademark Rights over the following terms, valid for the purposes of the Policy and of this case:

- US Trademark ICE MAID, Reg. No. 1485183, IC 11, filed on January 6, 1986, registered on April 19, 1988 and in force until April 19, 2028;

- US Trademark ICE MAID, Reg. No. 4108191, IC 16, filed on June 23, 2011, registered on March 6, 2012, and in force until March 8, 2032; and

- US Trademark ICE MADE EASY, Reg. No. 5223627, IC 16, filed on March 11, 2015, with a first use in commerce of August 31, 2016; registered on June 13, 2017; maintenance filed on March 10, 2023, most probably in force until June 14, 2027.

The Panel notes that the relevant Trademarks submitted by the Complainant being Roesch Inc. has been assigned to Roesch Acquisitions, LLC. Despite that the Complainant has not provided the required authorization from the current Trademark Owner, the Panel based on Paragraph 10 of the Rules, exceptionally, considering the nature of this case, and the extensive evidence submitted for this case, is ready to infer the affiliation between the two entities and the issuance of such authorization without interferences.

The disputed domain name <**icemadeeasy.com**> reproduced in its entirety the Complainant's Trademark ICE MADE EASY, being identical; or confusingly similar in respect of Complainant's Trademarks ICE MAID.

> "It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name.
>
> This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. (This may also include recognizability by technological means such as search engine algorithms.) In some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain name to ascertain confusing similarity.
>
> While each case is judged on its own merits, 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 for purposes of UDRP standing." (see Section 1.7 of the WIPO Overview 3.0).

Regarding the gTLD, it is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLD ".com", "is viewed as a standard registration requirement and as such is disregarded under the first

element confusing similarity test" (see Section 1.11.1 of the WIPO Jurisprudential Overview 3.0).

Therefore, the disputed domain name **<icemadeeasy.com>** is identical or confusingly similar to Complainant's Trademarks.

According to the evidence submitted before this Panel, in relation to the Second UDRP Element, to this Panel it is clear that:

- the Respondent registered the disputed domain name on February 14, 2023, previously owned by the Complainant since its creation/registration on January 7, 2014, and built a website who looks for revenues, based on Complainant's original website, Complainant's Ice line of business and its Trademark Rights owned at least since 2016 (Reg. No. 5223627);

- the Complainant has never granted the Respondent any authorization, license or right to make any use of the Complainant's trademark ICE MADE EASY, or apply for registration of the disputed domain name by the Complainant; that nor is the Respondent affiliated to the Complainant in any form nor a vendor, supplier, distributor, or customer relations agent for Complainant's products or related services;

- the Respondent´s use of the disputed domain name is far from being a legitimate noncommercial or fair use of the domain name, or even less, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue, in accordance to paragraph 4(c)(iii) of the Policy, since not only leads customers into a false association and confusion, which could it be the "best-worst" scenario, but certainly the potential risks for customers' data, and complex fraud's online scenarios, where any Internet user can be involved;

- the Respondent has been identified as "DJA DANNER", and no evidence suggests that it corresponds or has become commonly known by the disputed domain name or owns any corresponding registered trademark including the terms "icemadeeasy.com".

Therefore, this Panel finds that Complainant has successfully made a prima facie case, which was not rebutted in any manner by the Respondent, and concludes that the Respondent have no rights or legitimate interests in respect of the disputed domain name.

In relation to the Third Element of the UDRP, this Panel finds the following:

Registration in Bad Faith:

It is a fact that the change of Registrant in the disputed domain name, it is the result of a [significant] Complainant's omission. Fact that, solely, does not necessarily constitute evidence of a respondent´s bad faith registration.

As described along the present Decision, on March 23, 2023 immediately after the Notification of the Complaint and Commencement of Administrative Proceeding, the Respondent provided an answer, wondering 'what the problem was about, since the domain name has been expired, and it was bought'.

In the present case, according to the Registrar Verification, the Respondent acquired the disputed domain name on April 27, 2023. However, according to the Complainant's submitted [substantive] evidence, the Complainant lost control over the disputed domain name by February 14, 2023. Despite such differences in the timeline, this Panel, considering the Complainant's prior Trademark Rights existence (since 2016), consistent presence and relevance of its business (since 1916), the nature of the disputed domain name's website content which is based in the Complainant's Trademark ICE MADE EASY, for which, the Complainant has submitted sufficient evidence of its distinctiveness, supported by its duration (at least since 2016), by its inherent capacity of being recognized by its source among its customers, its extensive commercial use, the recognized quality of its products and services in the market, including through e-commerce, in particular by its Ice Bags and Ice Merchandiser suppliers provided across the United States, and at international level for different jurisdictions as Australia, Brazil, Canada, Italy, Switzerland and The United Kingdom (where the Respondent is located); use that it has been in fact, replicated by the Respondent and the absence of Respondent's Administrative or Formal Response, replying to Complainant's Contentions, concludes that the Respondent at the time of the registration/acquisition of the disputed domain name did it with Complainant's on mind.

The Complainant owned the disputed domain name for 9 consecutive years, and performed a substantive investment of time and resources on its Intangible Assets, in particular over its Trademarks, to develop, maintain, and provide its products and services for its customers in the market, including in the online one. Therefore, this Panel is convinced, that the acquisition of the disputed domain name by the Respondent was not coincidental (see IDR Solutions Ltd. v. Whois Privacy Corp, WIPO Case No. D2016-2156 and Supermac's (Holdings) Limited v. Domain Administrator, DomainMarket.com, WIPO Case No. D2018-0540).

Section 3.2.1 of the WIPO Overview 3.0, provides the following consensus view in terms of additional bad faith consideration factors:

> "Particular circumstances panels may take into account in assessing **whether the respondent's registration of a domain name is in bad faith include**: […] (iii) **the content of any website to which the domain name directs, including any changes in such content and the timing thereof**, (iv) **the timing and circumstances of the registration (particularly** following a product launch, **or the complainant's failure to renew its domain name registration)**, […] **(vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant**." (emphasis added).

Therefore, this Panel concludes that the disputed domain name has been registered in bad faith.

Bad Faith Use

According with the records, and as stated by the Complainant, this Panel notes, that on its registration, on February 2023, the webpage at the disputed domain name hosted PPC links for the initial period that included reference to the ICE BAGS, and related products, linking to Complainant's competing sites. Later, after the Complainant's Cease and Desist Notice of March 23, 2023, the website's content changed, offering products previously offered by the Complainant through the [older] disputed domain name's website.

By the time of this Decision, the [main] text's content of the disputed domain name's website is as follows:

> "How To Start An Ice Vending Business
>
> Download Our Ice Vending Business
>
> Start Up Guide
>
> Starting a Successful Ice Vending Business
>
> Free Ice Vending
>
> Business Start Up Guide
>
> How To Buy An Ice Vending Machine
>
> Sample Ice Vending Machine Business Plans
>
> How To Pick A Location For Your Ice Vending Machine
>
> Enter your Name and Email Below For Instant Access
>
> Free Reports:
>
> Bread Ties For Sale on Amazon
>
> Koolaire Ice Machine Reviews
>
> Leer Ice Merchandiser Reviews
>
> Sites That Sell Ice Merchandisers
>
> Ice Made Easy".

To this Panel, it is evident that the Respondent not only has full knowledge about the Complainant, but understands its business and the value of a distinctive Trademark as ICE MADE EASY. Such use, mislead and generates confusion among the Complainant's customers, which are not only from the US market, but the existence of the disputed domain name with active MX records, which enables the use for emails, in the wrong hands, in this case, has the potential, as addressed before by this Panel, not only to tarnish the Complainant's Trademark efforts, goodwill, and prestige, but to put on risk the data, including the financial one, of any Internet User (see Telefonaktiebolaget LM Ericsson v. Registration Private, Domains By Proxy, LLC / Aha Tek, WIPO Case No. D2021-2813; BOLLORE SE. v. amadi bon, CAC-UDRP-105470; Novartis AG v. Kim Feltham, CAC-UDRP-105438) Hence, to this Panel, the disputed domain name's use, unequivocally falls into paragraph 4(b)(iv) of the Policy.

Therefore, this Panel concludes that, the disputed domain name is being used in faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **icemadeeasy.com**: Transferred

PANELLISTS

Name	**María Alejandra López García**

DATE OF PANEL DECISION 2023-06-23

Publish the Decision