

Decision for dispute CAC-UDRP-105468

Case number	CAC-UDRP-105468
-------------	-----------------

Time of filing	2023-05-24 09:27:26
----------------	---------------------

Domain names	Corelle-Brand.com, corelle-collection.com, corelleonline.com
--------------	--

Case administrator

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

Complainant

Organization	Instant Brands LLC
--------------	--------------------

Complainant representative

Organization	Stobbs IP Ltd
--------------	---------------

RESPONDENTS

Name	Yan Hu
------	--------

Name	Hai Ling Huang
------	----------------

Name	Rong He
------	---------

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 names.

IDENTIFICATION OF RIGHTS

The Complainant, Instant Brands Inc. claims ownership rights to various trademark registrations in the United Kingdom, Canada, and China. The trademark issued through the Canada trademark office, Registration No. TMA167153 issued January 2, 1970 reflects the Complainant as the current owner of CORELLE, by transfer from Corelle Brands, Inc. The UK trademark reflects Corelle Brands, Inc. as the mark owner. The Complainant explains this discrepancy in the Amended Complaint that Corelle Brands, Inc. and Instant Brands Inc. merged in 2019, which is corroborated in the Canada trademark filing.

FACTUAL BACKGROUND

The Complainant alleges that since launching the CORELLE brand in 1970, it has built a significant reputation and has built up a vast amount of goodwill in the CORELLE trade marks in the UK and abroad, including China in relation to dinnerware goods and related services. It further alleges that the CORELLE brand has extensive reach offering its products and services worldwide. In 2019, Corelle Brands LLC merged with Instant Brands Inc, creating a company with an enterprise value over \$2 billion. The Complainant has an

active online presence including owning the domain name <corelle.com> which is used for the main operating website at (<https://www.corelle.com/>) ("Official Website"), with the website being live since at least as early as November 9, 2000. The Complainant also alleges that it is active on social media and has generated a significant level of endorsement from consumers.

PRELIMINARY ISSUES

1. CONSOLIDATION

The Complainant requests consolidation of <corelle-Brand.com>, <corelle-collection.com>, and <corelleonline.com> (the "Disputed Domain Names"). It asserts that all the disputed domain names are owned or under the effective control of a single person or entity, or a group of individuals acting in concert. According to the provisions of paragraph 10(e) of the Rules, the Panel has the power to decide the consolidation of multiple domain names disputes. Further, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. The Complainant requests consolidation of all the disputed domain names into this single case.

The consensus view of consolidation is addressed in WIPO Overview 3.0, at paragraph 4,11.2. Specifically, "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario."

Thus, while consolidation would be efficient in this case the question is whether it complies with the conditions set forth in the Policy and Rules. The Whois directory readouts which the Complainant attaches to its complaint reflects that there are three separate registrations by different registrants located in different postal zones. On first glance, this would undercut the request for consolidation, but the Complainant answers this question of consolidating being "fair and equitable to all parties" by showing that:

1. all three Disputed Domain Names were registered 30 June 2022;
2. all three Disputed Domain Names use a privacy protect service to mask the registrant;
3. all three Disputed Domain Names use Cloudflare proxy services to mask the web hosting service provider;
4. all three Disputed Domain Names resolve to a website with the primary purpose of advertising counterfeit product infringing the rights of the Complainant;
5. the similarity of Disputed Domain Names' anatomy to one another; and
6. evidence of identical and/or highly similar content (including website UI and look and feel) at the resolving websites.

The Panel attempted to access the websites of the Disputed Domain Names without success to two of them and the other, <corelleonline.com> offered products that may or may not be counterfeit goods although one of the items most likely is, but whether this is so and regardless whether the goods are counterfeit, the websites impersonate the Complainant by inviting Internet searches to purchase those goods in the belief they are purchasing genuine products. The Complainant's Annex 4 is a picture of the landing page for <corelle-brand.com> in which the Complainant identifies counterfeit products.

The evidence of record although sketchy as to the look and feel of the infringing websites allows the Panel to infer that more likely than not there is a common beneficial owner of the Disputed Domain Names. Accordingly, the Complainant's application is granted and the Disputed Domain Names shall be consolidated into this single case.

2. LANGUAGE OF THE PROCEEDINGS

The Disputed Domain Names having been consolidated the next question is in what language should the proceedings be conducted?

- The Disputed Domain Names are all formed by words in the Latin script and not in Chinese characters;
- All of the Disputed Domain Names include the English-language trademark(s);
- All of the Disputed Domain Names are in the international .com zone. The Respondent uses English on the Disputed Domain Names, demonstrating that Respondent is familiar with the English language;
- The WHOIS data mentions: "Registrar URL: <http://www.alibabacloud.com>, meaning that Respondent used the Registrar's English language website to register the Disputed Domain Names. Furthermore, the registrar, Alibaba Singapore, uses an English language domain name registration agreement (<https://www.alibabacloud.com/>).

Requiring the Complainant to translate the Complaint into another language would create an undue burden and delay. Respondent has not brought forward any arguments that using the English language in this proceeding would not be fair and efficient.

The Panel concurs with Complainant. Respondents are catering to an English language audience and as such must be considered as having fluency in English. Accordingly, for the reasons Complainant states as well as the Panel's conclusion that the content of the websites to which the Disputed Domain Names resolve and Respondents' evident purpose of trafficking Complainant's mark by pretending to be Complainant is a clear violation of the Policy.

On these grounds, Complainant argues that "it is reasonable to infer that the Respondent must have a good grasp of the English language such that he would be able to understand the language of the Complaint." The Panel agrees that for the reasons set forth above it is not unfair that the proceedings be conducted in English. See PaySendGroup Limited v Quan Zhongjun, Quan Zhong Jun Case No. CAC-UDRP-104808.

For the reasons set forth above, the proceeding shall be conducted in English.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant alleges that the Disputed Domain Names resolve to active websites 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 China trademarks, the Respondents could not ignore the existence of the trademark CORELLE.

The Complainant alleges further that it has no business relationship with the Respondents and their registrations of the Disputed Domain Names are unauthorized, being merely intentional attempts to gain profit from the sales of goods, which it does by pretending to be the Complainant. And through this impersonation it is offering unsuspecting consumers counterfeit products bearing the Complainant's trademarks. By so doing it is illegitimately trading on the Complainant's fame for commercial gain.

RESPONDENT:

The Respondents have 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 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 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 Names (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 Names have been registered and are 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 registered trademark rights in the word mark CORELLE by providing the Panel with the evidence that it has registrations in a number of jurisdictions for its mark. The consensus view which the Panel adopts is that a national or 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 CORELLE.

The second part of the test which calls for comparing the Complainant's mark with the Disputed Domain Names 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 differences in this case are additions of words that are consistent with the Complainant's line of business: a hyphen plus "brand" in one, a hyphen plus "collection" in another and in the third domain name the addition of "online." Such additions are immaterial in determining the question of confusing similarity. 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 CORELLE and <corelle-brand.com>, <corelle-collection.com>, and <corelleonline.com>. It is well settled that the addition of other terms does not avoid a finding of confusing similarity, see *UEFA v Wei Wang* easy king, Case No. CAC-UDRP-104875.

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

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

To establish the second of the three elements, the Complainant must first demonstrate that Respondent lacks rights and legitimate interests in the Disputed Domain Names. 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 Names.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. It states that it did not authorize the Respondent to register the Disputed Domain Names, the Respondent is not using the domain name for any bona fide use, nor can it claim to be known by the name "CORELLE" as it has been identified in the Whois directories respectively as Yan Hu, Hai Ling Huang and Rong He.

Further, the Complainant has adduced evidence based on the use of the Disputed Domain Names 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 and evidence satisfy the presumptive burden that Respondent lacks rights or legitimate interests in the Disputed Domain Names. 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 Names. 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 plus "brand" in one, a hyphen plus "collection" in another, and in the third the addition of the word "online."

A 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 is that the Disputed Domain Names resolve to active websites impersonating the Complainant by offering or appearing to offer counterfeits of Complainant's 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.") Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonating/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. (WIPO Overview 3.0, paragraph 2.13.1).

As the Respondent has not controverted the evidence that it lacks right or legitimate interests in the Disputed Domain Names, 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 Names 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 Names will be a factor in assessing its motivation for registering a domain name that is virtually identical to the Complainant's mark.

Here, the addition of hyphens and words that reinforce and reference the Complainant's business is a purposeful attempt to disguise the Disputed Domain Names as sponsored by the Complainant and is likely to confuse Internet viewers into believing that the websites are sponsored by the Complainant. The factors necessary to prove registration and use in bad faith are set forth in Paragraph 4(b). This paragraph provides a non-exclusive list of four circumstances that evidence registration and use of a domain name in bad faith.

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." As there is no proof that would support factors (i), (ii) and (iii), the Panel will not address them. Of the four circumstances the relevant factor in this case is factor (iv) which reads as follows:

(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 Complainant's proof in this case focuses the Panel's attention on the fourth factor. The Complainant argues and the evidence supports that the Respondent redirects the Disputed Domain Names to websites in which 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 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, 3.0.

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 conclusion that can be drawn from the use of virtually identical domain names is that the Respondent is using them vehicles 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.").

Complainant argues that Respondent's failure to respond has been held as evidence of bad faith. While this is a factor for consideration, it is one among others. It does not have to be singled out as there are other indicators of abusive use that together constitute conclusive proof of abusive registration. The evidence taken as a whole is so overwhelming that analyzing failure to respond would amount to

unnecessary surplusage. The Respondent passes itself off as the Complainant and through this impersonation infringes Complainant’s rights and commits fraud on consumers. It has registered domain names that correspond 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 are purchasing genuine products manufactured by the Complainant.

As the Complainant has demonstrated that the Respondent registered and is using the Disputed Domain Names 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. **Corelle-Brand.com**: Transferred
- 2. **corelle-collection.com**: Transferred
- 3. **corelleonline.com**: Transferred

PANELLISTS

Name	Gerald Levine Ph.D, Esq.
------	--------------------------

DATE OF PANEL DECISION	2023-06-29
------------------------	------------

Publish the Decision