Decision for dispute CAC-UDRP-105436

Case number	CAC-UDRP-105436
Time of filing	2023-05-10 09:57:02
Domain names	ampawssadors.com

Case administrator

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

Complainant

Organization	The Codeero Group

Respondent

Organization	Buy this domain on Dan.com ----

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 EU trademark application Appl. number 018871222 for the word mark "Ampawssadors" with priority from May 6, 2023. This trademark application was published for oppositions on May 15, 2023 and the opposition period ends on August 16, 2023. This application has not been registered yet as a trademark.

The Complainant claims that it owns unregistered trade mark/service mark "Ampawssadors" to which it acquired rights based on advertising and publicity prior to use of mark (use analogous to trade mark use).

FACTUAL BACKGROUND

The Complainant applied on May 6, 2023 for the EUTM word mark Ampawssadors.

The Complainant claims to have used the name Ampawssadors on Instagram and on its website https://www.nutrified.vet/.

The Complainant claims that it has registered also domain names such as <ampawssadors.co> and <ampawssdors.org>.

The disputed domain name <ampawssadors.com> was registered on May 6, 2023. The Complainant acquired this domain name on May 9, 2023.

PARTIES CONTENTIONS

1. **Complainant**

The Complainant contends that the Respondent lacks any rights or legitimate interests in the disputed domain name, mentioning domain parking, use of privacy or proxy registration services and non-use/passive holding.

The Complainant argues that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant contends that the domain name <ampawssadors.com> was acquired using an automated process through API offered by Global Domain Group (domain name reseller), in the hours following the registration and publication of the application of the application on the EUIPO website. The domain was bought with malicious intent for commercial gain and was immediately pointed to the dan.com marketplace where it started to be offered as domain for sale for 1200+ USD. The domain name is now redirected to: https://dan.com/buy-domain/ampawssadors.com. The Complainant argues that the Respondent, identified by blazingdot@gmail.com, by the Registrar, has a history of similar bad-faith actions, registering domains once they become published on the EUIPO or USPTO office websites.

The Complainant also claims to have tried to register the domain name immediately after filing its EU trademark application however registration failed due to the domain name becoming unavailable.

The Complainant further alleges that the bad faith is documented inter alia by use of privacy or proxy registration services, that this is automated domain name registration and that the Respondent acquired the domain name for purposes of selling, licensing or renting which is documented by the fact that the Respondent is trying to sell the disputed domain name for 1200+ USD. The Complainant also mentions that the disputed domain name is passively hold.

2. **Respondent**

No administratively compliant response has been submitted by the Respondent.

RIGHTS

The Complainant has not, 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 to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

The Complainant has not shown to have rights to any trademark and/or service mark.

A. EU trademark application Number 018871222 for the word mark "Ampawssadors"

The Complainant owns the EU trademark application Appl. number 018871222 for the word mark "Ampawssadors" with priority from May 6, 2023 which was published for oppositions on May 15, 2023 and the opposition period ends on August 16, 2023.

Under point 1.1.4 of the WIPO Jurisprudential Overview 3.0 a pending trademark application would not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i).

The question if a pending trademark application can establish rights under UDRP paragraph 4(a)(i) has been thoroughly analyzed in the Fashiontv.com GmbH v. Mr. Chris Olic WIPO Case No. D2005-0994
https://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0994.html.

The Panel shares the view that unless a trademark application has proceeded to grant it does not constitute a trademark in which the Complainant has UDRP-relevant rights (see Fashiontv.com GmbH v. Mr. Chris Olic WIPO Case No. D2005-0994).

Since the opposition period for the Complainant's EU trademark application is still open until August 16, 2023, it cannot be concluded at this stage that the Complainant has established trademark rights. Therefore, the Complainant has not shown that its trademark application constitutes rights in a trademark for the purposes of paragraph 4(a)(i) of the Policy. Filing a UDRP complaint based on this trademark application before the registration of the Complainant's EU trademark was premature, and the Complainant should have waited until the grant of the registration.

B. Unregistered or common law trademark rights

The Complainant asserts unregistered and/or common law trademark rights based on the use of the Ampawssadors mark on its website and Instagram in relation to domestic pets, which shall be brand ambassadors for Complainant´s products, prior to the registration of the disputed domain name.

Under point 1.3 of the WIPO Jurisprudential Overview 3.0 to establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning.

The Panel also notes that common law rights / unregistered trademark rights exist in specific jurisdictions but not on a worldwide basis. Therefore, it is for the Complainant to identify the jurisdiction or jurisdictions in which the rights are alleged to arise and to provide details of the activities in that jurisdiction which are the source of those rights. The Complainant failed to demonstrate this in its Complaint (see also point 7.34 of Fashiontv.com GmbH v. Mr. Chris Olic WIPO Case No. D2005-0994).

To support its claim of unregistered/common law trademark rights the Complainant has merely submitted the following evidence:

Printscreens from the website www.nutrified.vet captured by Wayback machine on March 8, 2023 https://web.archive.org/web/20230308015546/https://www.nutrified.vet/.

The website which the Panel opened using this wayback machine link mentions the mark in the wording Ampaw-ssadors twice as "Our Four-Legged AmPaw-ssadors" accompanied by the images of pets and in small letters at the bottom of the website. The Complainant is not mentioned on this website, there is only a phrase "Brought to Pets Worldwide by MINEO" whereas The Panel notes that the word MINEO likely refers to the co-applicant of the EUTMA No. 018871222 which is Mineo Minerals Ltd.

The three Instagram printouts from December 2022 confirm existence of an Instagram account under the name Ampawsssadors however no further conclusions can be taken by the Panel from these printscreens including but not limited to whether this Instagram account belongs to the Complainant.

Based on the examination of this evidence the Panel concludes that the Complainant failed to demonstrate the acquired distinctiveness of and its common and/or unregistered trademark rights to the AmPawssadors mark. The evidence provided merely shows AmPawssadors mark was used prior to the registration of the disputed domain name but no further relevant conclusions, particularly with respect to the use of extent, nature, location, duration and scope of use by the Complainant which are relevant for establishment of the unregistered/common law trademark rights can be made based on this very limited evidence.

Therefore, the Panel concludes that the Complainant failed to demonstrate that the mark has become a distinctive identifier which consumers associate with the Complainant's goods and/or services and consequently existence of any common/unregistered trademark 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).

A complainant is required to establish a prima facie case that the respondent lacks rights or legitimate interests. Once such a case is made, the burden of proof shifts to the respondent to demonstrate their rights or legitimate interests in the disputed domain name. Failure to do so results in the complainant satisfying paragraph 4(a)(ii) of the Policy (as per Article 2.1 of WIPO Jurisprudential Overview 3.0).

Based on the contentions of the Complainant, the Panel finds that the Complaint has successfully established a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

BAD FAITH

If the Complainant were able to establish the existence of trademark rights within the meaning of paragraph 4(a)(i) of the Policy, it is likely that the Panel would conclude that the disputed domain name has been registered and is being used in bad faith. The Panel notes that the Respondent acquired the disputed domain name shortly after the Complainant filed its trademark application. Given that the mark "Ampawssadors" is clearly a distinctive sign, it is reasonable to assume that the Respondent was aware of the Complainant and its trademark when registering the domain name.

The mere registration of a domain name that fully incorporates the Complainant's mark "Ampawssadors" could, in this case, be considered evidence of bad faith registration.

The disputed domain name incorporates the Complainant's mark and creates a likelihood of confusion with the goods or services associated with the mark.

The evidence submitted by the Complainant, specifically the fact that the domain name is being offered for sale for an amount exceeding USD 1,200, would typically be sufficient to infer that the Respondent registered the domain name primarily for the purpose of selling, renting, or transferring it to the Complainant or a competitor for valuable consideration, as outlined in paragraph 4(b)(i) of the Policy.

However, in the absence of establishing trademark rights under paragraph 4(a)(i) of the Policy, the Panel cannot conclude that the Complainant has demonstrated that 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 not shown to have rights to any trademark and/or service mark within the meaning of paragraph 4(a)(i) of the Policy.

Therefore, for the aforementioned reasons, the Panel concludes that the Complaint must be rejected.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **ampawssadors.com**: Remaining with the Respondent

PANELLISTS

Name	**Karel Šindelka**

DATE OF PANEL DECISION 2023-06-23

Publish the Decision