

## Decision for dispute CAC-UDRP-105529

Case number CAC-UDRP-105529

Time of filing 2023-06-14 09:10:24

Domain names fernob.com

### Case administrator

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

### Complainant

Organization FERMOB

### Complainant representative

Organization NAMESHIELD S.A.S.

### Respondent

Organization Blue Boar Cafeterias

#### 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

In this proceeding the Complainant relies on the following trademark registrations:

- The French trademark registration No. 3243498 "Fermob" (word + device), applied on September 1st, 2003;
- The EU trademark registration No. 6952758 "Fermob" (word), registered on January 29, 2009 and
- The international trademark registration No. 829242 "Fermob" (word + device), registered on March 1st, 2004 and protected inter alia in the Benelux, Italy, Germany, Switzerland and Turkey.

The Complainant also refers to various domain names that incorporate the "Fermob" trademark, including <fermob.com> registered since December 24, 1996.

#### FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states that it is a French company that has been designing and manufacturing metal and colored outdoor furniture

since 1989.

The disputed domain name was registered on March 28, 2023 and resolves to an inactive page, while MX servers are configured.

The Complainant states that the disputed domain name is confusingly similar to its trademark and its domain names and is an example of typosquatting.

The disputed domain name represents an obvious misspelling of the Complainant's trademark "FERMOB", i.e. the substitution of the letter "M" by the letters "R" and "N". The Complainant alleges this practice is characteristic of a typosquatting intended to create confusing similarity between the Complainant's trademark and the disputed domain name.

The <.com> gTLD is not relevant in the appreciation of confusing similarity as it does not change the overall impression of the designation as being connected to the Complainant's trademark.

Thus, the Complainant contends the disputed domain name is confusingly similar to the Complainant's trademark.

#### THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name, is not related in any way with the Complainant and the Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain name.

According to the Complainant, the disputed domain name is a typosquatted version of its trademark and "typosquatting" itself can be evidence of lack rights and legitimate interests.

The disputed domain name resolves to an inactive page and the Complainant asserts that since the Respondent did not make any use of disputed domain name since its registration this confirms that the Respondent has no demonstrable plans to use the disputed domain name and demonstrates a lack of legitimate interests in respect of the disputed domain name.

#### THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant's submissions on the bad faith element of the UDRP can be summarized as follows:

1. The Complainant asserts that the disputed domain name is confusingly similar to its distinctive trademark "FERMOB". The Respondent registered the disputed domain name several years after the registration of the Complainant's trademarks, and the Complainant has established a strong reputation while using its trademarks. The Complainant contends that the term "FERMOB" does not have any meaning (as a contraction of French term "FER" ("steel") and MOB (for French term "Mobilier" – "Furniture"), except in relation to the Complainant as confirmed by "Google" search results provided by the Complainant as an annex.
2. The Complainant claims that given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.
3. The Complainant states the misspelling of the trademark "FERMOB" by the Respondent was intentionally designed to be confusingly similar with the Complainant's trademark. Previous UDRP Panels have considered such actions as evidence of bad faith.
4. The Complainant relies on the passive holding doctrine and the "Telstra" decision (WIPO Case No. D2000-0003, "Telstra Corporation Limited v. Nuclear Marshmallows") and alleges that passive holding in the present case indicates bad faith of the Respondent since it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.
5. The Complainant alleges that while the disputed domain name appears to be unused, it has been set up with MX records which suggests that it may be actively used for email purposes.

Therefore, the Complainant claims the disputed domain name was registered and being used in bad faith.

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#### PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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#### 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).

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#### 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).

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#### 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

##### A. Identical or confusingly similar

The Complainant provides evidence of the registrations for the trademark “FERMOB” protected in various jurisdictions.

As confirmed by the “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition” (“WIPO Overview 3.0”): “where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case” (see par. 1.2.1).

The disputed domain name represents a misspelling of the Complainant’s mark “FERMOB”, namely substituting the letter “m” by the combination of the letters “r” and “n”. Replacement of “m” by a combination of “rn” is a typical pattern of cybersquatting as confirmed by previous UDRP decisions, see e.g. CAC Case No. 103539 (<boursorarna.com>), CAC Case 103303 (<aperarn.com>) and “ALSTOM vs. donny star”, WIPO Case No. D2022-0169.

As stated in the WIPO Overview 3.0: “A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element” (see par. 1.9). In the present case, the Complainant’s trademark “FERMOB” is clearly recognizable within the disputed domain name.

The gTLD “.com” is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

##### B. Rights or Legitimate Interests

The general rule is the following:

- (i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
- (ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110.

The disputed domain name was registered on May 8, 2023. It does not resolve to any active page.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and CAC Case No. 101284: “A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant”.

The Complainant has made a prima facie case of Respondent’s lack of rights or legitimate interests.

The Respondent is not known by the disputed domain name and has no apparent connection to the Complainant’s business or to the disputed domain name.

The Complainant has not granted any license or authorization to use its trademark to the Respondent and the Complainant is not doing any business with the Respondent.

The disputed domain name represents a misspelling of the Complainant’s trademark.

Typosquatting does not create any rights or legitimate interests of the Respondent.

Previous UDRP panels noted that in such circumstances respondent does not have rights or legitimate interests, see e.g. CAC Case No. 104715: "These circumstances suggest to the Panel that the Respondent is seeking to capitalize deliberately on a predictable pattern of mistyping of the Complainant's mark by such users..." and CAC case No. 105088: "Here, the Disputed Domain Name is virtually identical to the Complainant's mark. The sole difference is the displacement of one letter for another. This strategy does not support a right or legitimate interest in a Disputed Domain Name and the Panel so finds in this matter".

The nature of the disputed domain name is such that it creates an association with the Complainant and its business as it represents an obvious misspelling of the Complainant's mark.

Passive holding of the disputed domain name in the circumstances of this case does not create any rights or legitimate interests of the Respondent.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith. These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see par. 3.1 of the WIPO Overview 3.0). Targeting is important in establishing bad faith under the UDRP.

The Panel finds that the Complainant provided sufficient evidence that the disputed domain name was registered and is being used in bad faith based on the following:

1. The nature of the disputed domain name ("typosquatting") and the timing of the registration of the disputed domain name – March 28, 2023, many years after the Complainant obtained protection for its trademarks and registered its main domain name <fermob.com>. The nature of the disputed domain name indicates that the Respondent was most likely aware of the Complainant and its trademarks when he/she registered the disputed domain name. As noted in the leading treatise on UDRP and domain disputes by Gerald Levine in relation to typosquatting: "where intent to take advantage of the trademark is evident knowledge is implied" (see "Domain Name Arbitration", Gerald M. Levine, 2019, Second edition, "Legal Corner Press", page 496).
2. The strength and reputation of the Complainant's trademark. The Panel notes that the Complainant provided only limited evidence of well-known character of the "FERMOB" trademark (Company profile with figures and various references to Complainant's own website and "Google" search results). Normally, more evidence is required to establish that a trademark is well-known/ has a strong reputation (e.g. evidence of awards, publications by independent sources, media reports, etc.). However, this is not fatal to the Complainant in the present dispute taking into account other evidence available as well as facts of the dispute including the nature of the disputed domain name and the fact that the Complainant is also active in Spain, a country of the Respondent's residence.
3. Passive holding of the disputed domain name in the circumstances of this case indicates both registration and use in bad faith. The WIPO Overview 3.0 states that "from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding" and the panelists "will look at the totality of the circumstances in each case" (par. 3.3). The Panel notes that passive holding per se does not indicate bad faith. However, the totality of the circumstances of this dispute proves bad faith of the Respondent, in particular: i) strength of the Complainant's mark and timing of registration of the disputed domain name, ii) the nature of the disputed domain name ("typosquatting"), iii) failure of the Respondent to respond and take part in this proceeding and iv) the implausibility of any good faith use to which the disputed domain name may be put. Any possible explanation of a potential legitimate use is solely within the Respondent's knowledge and the Respondent failed to respond and provide any explanations.
4. The fact that the disputed domain name is not used but MX records are configured is an additional indication of bad faith in the circumstances of this case (see CAC Case No. 105370: "Although the disputed domain name appears to be inactive, it has been set up with MX records, which suggests that it may be actively used for fraudulent email purposes" and CAC Case No. 105258: "the fact that MX servers are configured suggests that the disputed domain name may be actively used for email purposes").
5. The Panel finds, on the balance of probabilities, that this is a case of targeting and an attempt to take unfair advantage of the Complainant's trademark by the Respondent. There are no rights or legitimate interests of the Respondent taking into account evidence on the record and facts of this case and in the absence of the response the only apparent reason for registration of the disputed domain name appears to be an intent of the Respondent to take unfair advantage of the Complainant's mark.

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent takes unfair advantage of the Complainant's mark.

The Panel holds that the third requirement of the Policy has been satisfied.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

**Accepted**

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

1. **ferrnob.com**: Transferred
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## **PANELLISTS**

Name	<b>Igor Motsnyi</b>
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DATE OF PANEL DECISION **2023-07-14**

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**Publish the Decision**

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