

Decision for dispute CAC-UDRP-105503

Case number	CAC-UDRP-105503
Time of filing	2023-06-07 09:20:23
Domain names	canyonmakesale.com, tiendacanyon.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Canyon Bicycles GmbH
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Complainant representative

Organization	Convey srl
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RESPONDENTS

Organization	YuqingLv
Organization	YongzhuoWang

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 is the owner of various trademark registrations CANYON such as:

- German Trademark n. 976036 – CANYON - 25;
- International Trademark n. 441840 – CANYON - Cl. 25;
- Canadian Trademark n. TMA409557 – CANYION - Cl. 12;
- International Trademark n. 687879 – CANYON – Cl. 11 and 12;
- European Union Trademark n. 1158094 – CANYON - Cl. 8, 9, 11, 12, 21, 35, 37, 41;

The trademark CANYON, registered since many years, is distinctive and well known all around the world in the sector of manufacturing of cycling.

FACTUAL BACKGROUND

The Complainant is one of the world's leading manufacturers of road bikes, mountain bikes, hybrid bikes, triathlon bikes and e-bikes mainly based in Koblenz, Germany. In 1985, Roman Arnold and his brother Franc Arnold founded "Radsport Arnold GmbH" as a

supplier of bike parts for cycling and in 1996 they assembled the first bikes with the brand name CANYON. From the beginning, Radsport Arnold adopted a direct sales strategy via the Internet.

In 2002, Radsport Arnold GmbH was officially renamed Canyon Bicycles GmbH and has become directly a cycle manufacturer working hand-in-hand with the best athletes to produce an array of award-winning bikes. With a strong reputation for true innovation, implementing leading technologies, clean and clear design as well as the highest standards in quality and service, the Complainant continues to expand worldwide, selling more bikes outside of Germany than within since 2008.

In the area of road racing the Complainant has been in cooperation with various teams. In 2007 CANYON bicycles first equipped the team Unibet.com, which took part in the UCI ProTour. Currently, among UCI WORLD teams, the Movistar men's and women's teams, Alpecin-Fenix and Canyon-SRAM teams compete on CANYON racing bikes.

Nowadays, the Complainant counts roughly 1.400 employees worldwide.

The Complainant has been extensively using the "CANYON" denomination on all internet environments including and not limited to the company's official website <https://www.canyon.com> and its official accounts on the major social networks such as Facebook, Instagram, YouTube, Twitter, Strava and TikTok.

The Domain Names were registered by the Respondent April 9, 2023, without authorization of Complainant, and have been pointed to websites where Complainant's counterfeit products are offered for sale.

In light of the Respondent's registration and use of the Domain Names confusingly similar to its registered and well-known trademark CANYON, the Complainant instructed its representative to address to the owner of the Domain Names a cease and desist letter in order to notify the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer, of the Domain Names to the Complainant.

The cease and desist letter was therefore sent on May 17, 2023 to the email indicated in the whois and in the Privacy Policy page of the website related to the Domain Name canyonmakesale.com but the Respondent has not deemed appropriate to answer.

In light of the absence of a reply and the failure to comply with the request for transfer of the Domain Names, the Complainant instructed its representative to file the present Complaint in order to obtain the transfer of the Domain Names under its ownership and control.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

The Domain Name are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

The Domain Names registered by the Respondent are confusingly similar to trademarks in which Complainant has rights.

The Domain Names incorporate the whole of the Complainant's trademark CANYON and the fact that they include non-distinctive elements, such as "make", "sale" and "tienda" (translation of store in Spanish), and the generic Top Level Domain .com does not affect the confusing similarity.

It is a well-established principle that domain names that wholly incorporate trademarks, in particular ones as famous as CANYON, are found to be confusingly similar for the purposes of the Policy, despite the fact that the Domain Names may also contain descriptive, generic or geographical terms. See, among the decisions addressing situations where generic terms are used in combination with trademarks, Wal-Mart Stores, Inc. v. Henry Chan, WIPO Case No. D2004-0056 ("chase", "girlsof", "jobsat", "sams", "application", "blackfriday", "blitz", "books", "career(s)", "check", "flw", "foundation", "games", "mart", "photostudio", "pictures", "portrait", "portraitstudio(s)", "registry", "retailink" and "wire" added to WALMART mark).

The combination of the trademark CANYON with generic terms, connected to the sector where the Complainant is active, could suggest improperly to consumers that the Domain Names and corresponding websites might be controlled by the Complainant or with the Complainant's authorization, furthermore the Complainant is active online.

The addition of generic words to a trademark in domain names is also insufficient in itself to negate confusing similarity between a trademark and a domain name. Amongst others, the Panel in Britannia Building Society v. Britannia Fraud Prevention, WIPO Case No. D2001-0505, "the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark". See also GA Modelfine S.A. v. Mark O'Flynn Case No. D2000-1424 "It is indeed obvious that although the Respondent's Domain Name is composed out of the word "armani" and the (descriptive) word "boutique", the first of these terms is incontestably the principal part of the Domain Name. In this view, the Administrative Panel finds that the Domain Name is confusingly similar to the Complainant's trademarks." Red Bull GmbH v. PREGIO Co., Ltd., WIPO Case No. D2006-0909 "the trademark RED BULL is clearly the most prominent element in this combination, and that may cause the public to think that the domain name <redbull-jp.net> is somehow connected with the owner of RED BULL trademark".

Furthermore, the top level “.com” is merely instrumental to the use in Internet - as found in *The Forward Association, Inc., v. Enterprises Unlimited* (Forum case FA0008000095491, October 3, 2000) and numerous others - and not able to affect the confusing similarity of the Domain Names to the Complainant’s trademark.

In light of the above, the Domain Names are certainly confusingly similar to the prior registered trademarks in which the Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

The Respondent has no rights or legitimate interests in respect of the Domain Names;

(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent’s rights or legitimate interests in respect of the Domain Names lies with the Complainant. It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for the Complainant to produce prima facie evidence in order to shift the burden of production to the Respondent. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

As a preliminary note, along the lines set forth in *Pharmacia & Upjohn Company v. Moreonline*, WIPO Case No. D2000-0134 and *National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co.*, a/k/a *chargergirls.net*, WIPO Case No. D2000-0118, the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Respondent is not licensee, authorized agent of the Complainant or in any other way authorized to use Complainant’s trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the Domain Names.

Upon information and belief, the Respondent is not commonly known by the Domain Names as individual, business or other organization and its name does not correspond to CANYON or the Domain Names.

The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the Domain Names in connection with a bona fide offering of goods or services before any notice of the dispute.

The Domain Names are redirected by the Respondent to websites where the Complainant’s trademark CANYON is published and counterfeit products are offered for sale.

Moreover, there is no disclaimer as to the Respondent’s lack of relationship with the Complainant.

It is apparent that the Respondent’s uses could be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the Domain Names. Such willful conduct clearly demonstrates, to the contrary, that Respondent is not intended to use the Domain Names in connection with any legitimate purposes.

In light of the low prices the items, offered for sale via the websites corresponding to the Domain Names, are counterfeit and therefore such use of the Domain Names cannot be deemed a legitimate non-commercial or fair use without intent for commercial gain. The sale of counterfeit products is a circumstantial evidence supporting the illegal Respondent activity and, consequently the absence of any rights or legitimate interests in respect of the domain names as indicated in the paragraphs 2.13.2 and 3.1.4 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition and in several decisions, among others, *Guccio Gucci S.p.A. v. Zhang Jiawen / Zeng Aiqin / Zhou Honghai / Zhuhonghai / Zhou Hong Hai / Honghai Zhou / Liu Min / Jianghong Wang* Case No. D2015-2088 where the Panel stated that “the websites at the Disputed Domain Names offer for sale prima facie counterfeit GUCCI products, along with products of the Complainant’s competitors, which does not support a finding of rights or legitimate interests”.

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

The Domain Name were registered and are being used in bad faith.

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

As to the assessment of the Respondent’s bad faith at the time of registration, in light of the registration and intensive use of the trademark CANYON since many years, the Respondent could not have possibly ignored the existence of the Complainant’s trademark, confusingly similar to the Domain Names.

The aforesaid trademarks of the Complainant enjoy worldwide reputation in the sector of cycling and the Domain Names were registered between in May 2023, which is more than 20 years after the Complainant adopted the sign CANYON for its bicycles.

Furthermore, the actual knowledge CANYON trademark by Respondent at the time of the registration of the Domain Names is demonstrated by the facts that the Respondent has offered for sale counterfeited items of the Complainant in the websites corresponding to the Domain Names.

By virtue of its extensive worldwide use, the Complainant’s trademark CANYON has become a well-known trademark in the sector of cycling. Therefore, it is clear that the Respondent was well aware of the trademark CANYON and he has registered the Domain Names with the intention to refer to the Complainant and its trademarks. As noted in *Ferrari S.p.A. v. Allen Ginsberg*, WIPO Case No. D2002-

0033, "Respondent has registered the domain name <maserati.org> corresponding to the well-known or even famous trademark MASERATI which he must have been aware of". Considering the trademark's distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant's registered trademarks at the time of the registration of the Domain Names, with which it is confusingly similar.

With reference to the above, the Complainant highlights that it has been stated in various decisions that the registration of a domain name with the knowledge of the Complainant's trademark is evidence of bad faith, i.a. in *Belstaff S.R.L. v. jiangzheng ying* Case No. D2012-0793, "the Panel notices that the word "belstaff" is distinctive and the Complainant had expended substantial efforts to create and maintain the reputation of the mark BELSTAFF. Use of the Domain Names by the Respondent took place only long after the trademark BELSTAFF had become well known in the relevant public sector. Therefore, the Respondent should have been aware of the mark BELSTAFF when it applied to register the Domain Names. In this Panel's view, the Respondent's reproduction of the Complainant's trademark BELSTAFF (both word and device trademarks) on the Websites, as well as its offering of purported Belstaff products is sufficient to show that it knew of the BELSTAFF mark when registering the Domain Names. Incorporation of the BELSTAFF mark in the Domain Names without any reasonable justification is sufficient evidence of bad faith by the Respondent".

Indeed, the fact that replicas of the Complainant's cycling items, including bicycles, are offered for sale on the websites corresponding to the Domain Names indicates that the Respondent has been fully aware of the Complainant's mark's reputation and association with the Complainant and that his purpose in registering the Domain Names, which incorporates the Complainant's trademark CANYON, was solely to capitalize on the reputation of Complainant's marks by diverting Internet users seeking products under the CANYON mark to its own commercial web sites.

As highlighted in *Swarovski Aktiengesellschaft v. Jun Qiao*, WIPO Case No. D2013-1617, "the fact that purported Swarovski goods were offered at the relevant website indicates that the Respondent was fully aware of the Swarovski mark's distinct reputation and association with the Complainant. There is no reason to choose such a distinctive mark, and also to include other terms in a domain name that are suggestive of the very business of the Complainant, other than a bad faith attempt to ride on the coattails of the trademark owner".

The use of the Domain Names in connection with commercial websites where the Complainant's trademarks are misappropriated and where counterfeit cycling components are offered for sale clearly indicates that the Respondent's purpose in registering the Domain Names was to capitalize on the reputation of the Complainant's trademarks by diverting Internet users seeking CANYON products to his websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites, according to paragraph 4(b)(iv) of the Policy.

Moreover, on the web site corresponding to the Domain Names, there are no disclaimer informing the users as to the Respondent's lack of relationship with the Complainant and the Respondent.

Furthermore, in light of the high discounts proposed to the internet users and of low prices of the bicycles sold via the websites corresponding to the Domain Names, prima facie the Respondent sells counterfeit goods (as indicated also in the decision *Belstaff S.R.L. v. jiangzheng ying* WIPO Case No. D2012-0793 "the Panel also notes the goods offered on the Websites are of low prices compared to the genuine goods of the Complainant. In all the circumstances, the Panel is satisfied that the Respondent appears to be using the Domain Names to facilitate the sale of counterfeit products) or Respondent utilizes the low prices of the shoes as bait to obtain personal data or payments by the internet users without providing the goods".

Indeed the Respondent offers for sale the Complainant's components disproportionately below the market value: for the same bicycle there are huge differences between the Complainant's price (i.e. EUR 3.999) and the prices indicated in the Respondent's websites (i.e. EUR 100,00). Such conduct constitutes a further evidence that the items offered for sale are counterfeited and that the Domain Names have been registered and used in bad faith, as stated in the paragraphs 2.13.2 and 3.1.4 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition and in several decisions, *inter alia* *Oakley, Inc. v. Victoriaclassic.Inc* WIPO Case No. D2012-1968 "Complainant has provided strong circumstantial evidence in the differential between the prices charged 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 registered the disputed domain names incorporating Complainant's distinctive trademark and used the disputed domain names to direct 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 (i.e. Complainant has established by strong circumstantial evidence, unrebutted by Respondent, that Respondent is offering "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 mark as to Complainant as a source, sponsor, affiliate or endorser of Respondent's websites. Respondent registered and is using the disputed domain names in bad faith within the meaning of paragraph 4(b)(iv) of the Policy."

As an additional circumstance demonstrating bad faith, prior Panels have also held that a failure to respond to a cease-and-desist letter can be evidence of bad faith. See, e.g., *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. D2007-0062: "such bad faith is compounded when the domain name owner or its duly authorized privacy service, upon receipt of notice that the domain name is identical to a registered trademark, refuses to respond or even to disclose the domain name owner's identity to the trademark owner... Such conduct is not consistent with what one reasonably would expect from a good faith registrant accused of cybersquatting".

In view of the above, the Complainant respectfully submits that the Domain Names were registered and are being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) of the Policy.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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).

It is well established that the specific top level of a domain name such as “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar. Neither does the mere addition of generic terms like in this case "make-sale" and "tienda". Therefore, the Domain Names are confusingly similar to the Complainant’s trademark CANYON.

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 Domain Names (within the meaning of paragraph 4(a)(ii) of the Policy).

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use his trademarks in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant’s trademark CANYON and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the Domain Names without prior knowledge of the Complainant and the Complainant’s mark.

The Panel therefore finds that the Domain Names were registered in bad faith.

The Domain Names currently resolve to an active website selling counterfeit goods and it is indisputable that the disputed domain names use Complainant’s trademark to facilitate the sales of these counterfeit products or the low prices of the products as bait to obtain personal data or payments from internet users without actually providing the goods offered for sale. Furthermore, the Panel finds it is not possible to conceive of any plausible actual or contemplated active use of the Domain Names by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law. The Panel finds that the mere registration of a domain name that is identical or confusingly similar to a well-known or widely-known trademark by an unaffiliated entity is sufficient to create a presumption of bad faith. The Panel finds that the Respondent has intentionally attempted to attract for commercial gain internet users to its websites by creating a likelihood of confusion with Complainant’s mark as to Complainant as a source, sponsor, affiliate or endorser of Respondent’s websites

Accordingly, the Panel finds that the Domain Names were registered and are being used in bad faith.

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

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

i. the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has

rights; and

- ii. the respondent has no rights or legitimate interests with respect to the domain name; and
- iii. the domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the Disputed Domain Names, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the Disputed Domain Names are identical to its trademarks and its domain names.

Indeed, the trademark is fully incorporated in the disputed domain names.

The Disputed Domain Names are therefore deemed confusingly similar.

b) The Respondent is not generally known by the disputed domain names and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the Disputed Domain Names.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the Disputed Domain Names.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain names were registered. The disputed domain names resolve to websites offering counterfeit goods. It is concluded that the Respondent by attempting to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain names resolve makes bad faith use of the Disputed Domain Names.

The Panel therefore finds that the Disputed Domain Names have been registered and are being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **canyonmakesale.com**: Transferred
- 2. **tiendacanyon.com** : Transferred

PANELLISTS

Name	Lars Karnoe
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DATE OF PANEL DECISION 2023-07-20

Publish the Decision
