

Decision for dispute CAC-UDRP-105601

Case number CAC-UDRP-105601

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Domain names instapot.cc

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization Instant Brands LLC

Complainant representative

Organization Stobbs IP Ltd

Respondent

Name LY HOANG

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 the owner of multiple trademark registrations in various jurisdictions, in particular:

Trade Mark	Device	Register	Registration No.	Reg. Date.	Class
Instant Pot	Instant Pot	USA	3887207	07 December 2010	11
INSTANT POT	INSTANT POT	USA	6291537	16 March 2021	7, 9, 11, 16, 17, 21, 25, 29, 30, 32, 35, 38
INSTANT POT	INSTANT POT	USA	6907251	22 November 2022	9, 11, 16, 21, 25

The Complainant proved its ownership of the aforementioned trademark registrations by the submitted excerpts from the Trademark Registers.

FACTUAL BACKGROUND

The Complainant states that since launching the "INSTANT POT" branded multicooker in 2008, the brand has gained widespread acclaim and commercial success. On Amazon Prime Day 2016, the Instant Pot multicooker sold 215,000 units alone. The "INSTANT POT" brand has extensive reach offering its products and services worldwide.

The Complainant has an active online presence including owning the domain name <instanthome.com> which is used for the main operating website at (<https://www.instanthome.com/>), with the website being live since at least as early as 22 May 2009.

The Complainant is also active on social media and has generated a significant level of endorsement (thousands of followers on social media).

According to the Registrar, the Respondent is 'LY Hoang'. The Respondent's provided address as being at Los Angeles, the USA. The Respondent registered the disputed domain name <instapot.cc> on 13 June 2023 (hereinafter "disputed domain name").

PARTIES CONTENTIONS

COMPLAINANT:

1. The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks.

The Complainant owns numerous trademark registrations for "INSTANT POT" and his registered trademarks pre-date the registration of the disputed domain name and obtained substantial recognition in the relevant public. Therefore, the Complainant maintains that he holds rights in the "INSTANT POT" brand/trademark.

The Complainant asserts that the disputed domain name is confusingly similar to his registered trademarks because the disputed domain name includes the Complainant's registered trademarks as the dominant element. The Complainant adds that the disputed domain name contains common and intentional misspelling of the Complainant's trademark. In that consequence, the Complainant points out that "INSTAPOT" is a widespread misspelling by fans of the Complainant's product on social media (when using hashtags).

According to the Complainant, the contraction "INSTAPOT" is merely two-letters shorter (omission of "NT") than the Complainant's trademark and the missing letters are in the middle of a longer string, thereby having a lower impact on the distinctiveness of the disputed domain, name and therefore, the misspelling does not impair the ability to easily recognize the Complainant's registered trademarks within the disputed domain name.

The Complainant contends that the use of "INSTAPOT" as a trademark, as denoted by generally accepted means of trademark indicators ™ and ®, in relation to identical goods and services as the Complainant evinces a lack of independent meaning other than riding on the coattails of the Complainant's trademarks in a deliberate attempt to trade upon their reputation.

Searches on Google for "INSTA POT" and "INSTAPOT" return the Complainant's official stores on Amazon and on the Complainant's Official Website, and the Complainant's Wikipedia page entry. Furthermore, the disputed domain name is visually, aurally, and conceptually similar to the Complainant's trademarks; thereby all measures of recognizability, whether via human or technological means, demonstrate the disputed domain name is not sufficiently distinctive to escape a finding of confusing similarity.

2. The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant contends there is no credible, believable, or realistic reason for registration or use of the disputed domain name other than to take advantage of the Complainant's rights and trademarks' reputation. The disputed domain name was registered on 13 June 2023. By this point, the Complainant already had extensive rights (both registered and unregistered) in "INSTANT POT".

The Complainant submits that the Respondent is using the disputed domain name to resolve to an active website (the "Infringing Website") which offers for sale and/or advertises the sale of a widely available, white-label electric cooker under the infringing sign "INSTAPOT", infringing various intellectual property rights held by the Complainant, including but not limited to his registered trademarks. The white-label electric cooker is offered under various brands which do not infringe the Complainant's trademarks, a non-exhaustive list is provided in Annex 9.

The Infringing Website's use of "INSTAPOT" as a trademark in relation to identical goods and services as the Complainant evinces the Respondent's use of the disputed domain name is not in relation to a bona fide offering of goods or services. The Respondent is free-riding on the coattails of the Complainant's famous trademarks in a deliberate attempt to trade upon his reputation.

The Complainant states that prior panels have consistently held that using domain names for illegal activity (in this case the sale of counterfeit goods and impersonation) is high evidence of illegitimate intent. 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).

According to the Complainant, it is clear that the Respondent does not have a legitimate interest in the disputed domain name. The Respondent's use of the disputed domain name is merely to impersonate/pass off as the Complainant in order to create a false association with and trade upon the reputation of the Complainant's famous trademarks to sell a white-label product, this shows that they are not using them in relation to a bona fide offering of goods or services. Consequently, the Respondent cannot claim a defense under the UDRP.

Moreover, upon information and belief, the Complainant submits that the Respondent has never legitimately been known by the name "INSTAPOT" at any point in time. As stated in the WIPO case No. D2000-1244, Vestel Elektronik Sanayi ve Ticaret AS v. Kahveci: 'merely registering the domain name is not sufficient to establish rights or legitimate interests for purposes of paragraph 4(a)(ii) of the Policy'. This factor leads the Complainant to conclude that the only reason why the Respondent registered the disputed domain name was to take advantage of the Complainant's goodwill and valuable reputation.

The Complainant submits that nothing about the disputed domain name suggests that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name. As mentioned above, the disputed domain name is being used to impersonate/pass off as the Complainant in order to sell white-label products free-riding on the reputation of the Complainant's famous trademarks, this is a clear commercial activity.

3. The Complainant contends that the domain name has been registered and is being used in bad faith.

The Complainant reiterates the comments made above that its trademarks for "INSTANT POT" pre-dates the registration of the disputed domain name and "INSTANT POT" enjoys a wide reputation. Furthermore, the Respondent was unequivocally aware of the "INSTANT POT" brand given the Respondent's significant use of the trademarks on the Infringing Website, and that the Infringing Website is set up to impersonate/pass off as the Complainant in order to ride on the coattails of Complainant's famous trademarks in a deliberate attempt to trade upon his reputation without incurring their owning advertising or branding expenditure. The Respondent's intention to imitate the Complainant's trademarks renders an obviously unfair commercial advantage to them, particularly against the myriad brands and entities offering the same white-label product.

The Complainant submits that the Respondent had knowledge of "INSTANT POT" and that the disputed domain name is registered with the sole purpose of targeting the Complainant's trademarks to derive an unfair commercial advantage.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith by intentionally attempting to attract, for commercial gain, Internet users to the Infringing Website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Infringing Website under the UDRP, Paragraph 4(b)(iv).

The Respondent has registered the disputed domain name in order to drive Internet traffic to the Infringing Website in order to impersonate/pass off as the Complainant to sell a white-label product. Using a trademark to divert traffic to the Respondent's own website is consistently held by panelists to amount bad faith registration and use under the UDRP, Paragraph 4(b)(iv). An example of such findings can be found in the decision between Booking.com BV v. Chen Guo Long. WIPO Case No. D2017-0311 where the panelist, held that: 'The Respondent uses the disputed domain name, which is confusingly similar to the Complainant's BOOKING.COM trademark, in connection with a video-on-demand website displaying links to many other websites. The disputed domain name operates by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. This use is intentional. It is more likely than not that the website operates for the commercial gain of the Respondent or the operators of the linked websites, or both. Therefore, the facts satisfy the requirements of paragraph 4(b)(iv) of the Policy.'

The Complainant submits based on the Respondent's use of the Complainant's trademarks to sell white-label products, the Respondent has actual knowledge of the Complainant's rights in the trademarks at the time of registering the disputed domain name. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name evinces bad faith under paragraph 4(a)(iii) of the UDRP.

The Complainant submits based on the extensive trademark registrations and the wide reputation the Complainant enjoys in the "INSTANT POT" mark, the Respondent's actual knowledge when registering the disputed domain name is unequivocal.

The Complainant further submits that the Respondent disrupts the Complainant's business by diverting potential customers to the Infringing Websites selling white-label goods. Using a confusingly similar domain name in a manner disruptive of a Complainant's business by trading upon the goodwill of a Complainant for commercial gain evinces bad faith under paragraph 4(b)(iii) and (v) of the UDRP. The Complainant submits that the goods offered on the Infringing Website are unaffiliated with the Complainant and infringe various intellectual property rights owned by the Complainant, including but not limited to the trademarks.

Based on the submissions above, the Complainant maintains that the disputed domain name was registered and is used in bad faith and all elements of the Policy are satisfied.

RESPONDENT:

No administratively Complaint Response has been filed.

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 UDRP).

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 UDRP).

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 UDRP).

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

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them (Paragraph 5(f) of The Rules).

I. CONFUSING SIMILARITY

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark "INSTANT POT".

Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter referred to as "The WIPO Overview 3.0") in Paragraph 1.2.1 states: "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".

The WIPO Overview 3.0 in Paragraph 1.3 states: "The fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier".

The WIPO Overview 3.0 in Paragraph 1.7 states: "[...] 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."

The WIPO Overview 3.0 in Paragraph 1.9 states: "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".

In the WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin, the panel stated that: "In numerous cases, it has been held that a domain name that wholly incorporates a Complainant's registered mark may be sufficient to establish confusing similarity for purposes of the UDRP."

In CAC Case No. 105391, Instant Brands LLC v. Robert Roxas, the Panel stated that: "the disputed domain names incorporate the dominant feature of the Complainant's trademark, i.e. "INSTAPOT", which is clearly recognizable in the disputed domain names [...] the omission of the letters "nt" (that are part of the Complainant's trademark INSTANT POT, while not a dominant element) do not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain names".

In the WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., the Panel stated that: "It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar".

The Complainant has established that owns numerous trademark registrations in various jurisdictions for the wording "INSTANT POT", designated for the classes in connection with electric cookers (proven by excerpts from Trademark Registers).

The Complainant's trademark wording "INSTANT POT" is incorporated in its entirety and clearly recognizable in the disputed domain name <instapot.cc>. The misspelling, regarding the omission of the "NT" letters, cannot prevent finding confusing similarity between the disputed domain name and the Complainant's trademarks.

The addition of the gTLD <.cc> does not change the overall impression of the disputed domain name either.

The disputed domain name <instapot.cc>, as it reproduces the "INSTANT POT" trademark in its entirety, is considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make a case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfills this condition, the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman). Moreover, past panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the UDRP, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

The WIPO Overview 3.0 in Paragraph 2.5.1. states that: "[...] Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [...]"

The WIPO Overview 3.0 in Paragraph 2.13.1 states that: "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, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. Particularly in the case of counterfeits and pharmaceuticals, this is true irrespective of any disclosure on the related website that such infringing goods are "replicas" or "reproductions" or indeed the use of such term in the domain name itself."

In the present case, the Complainant claims that the Respondent's intention when registering and using the disputed domain name was to take advantage of the Complainant's rights and brand/trademark reputation.

The Complainant submitted evidence of active use of the disputed domain name for the sale of a white-label electric cooker under the "INSTAPOT" mark (using ® sign) (evidenced by print-screen of the website available under the disputed domain name). This Panel agrees with the Complainant that such use represents illegal activity (counterfeiting goods and impersonation) which cannot confer rights or legitimate interests on the Respondent.

Moreover, the Respondent is not identified and not legitimately known under the disputed domain name. The Respondent cannot be identified from the Whois database as demonstrated by print-screen from the Whois database) and a simple Internet/Google search shows that the disputed domain name "INSTAPOT" leads Internet users to the Complainant's website (proven by Google search results).

To the satisfaction of this Panel, the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent failed to provide an administrative response to the Complaint and so failed to prove its rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the UDRP.

III. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.4 states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the panel stated: "when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted."

In the present case, the Complainant has established that it owns numerous trademark registrations in various jurisdictions for

“INSTANT POT”, protected for electric cookers. The Complainant launched the “INSTANT POT” cooker in 2008, the first trademark was registered in 2010. The Complainant obtained a certain reputation among the public, concerning an enterprise value of over \$2 billion and thousands of followers and fans on social media. The disputed domain name was registered on 13 June 2023. This Panel agrees with the Complainant that the Respondent must have been aware of the Complainant’s trademark and its reputation before the registration of the disputed domain name.

In that regard, the disputed domain name was registered with the purpose of targeting the Complainant and its reputation, by attracting Internet users (via creating the likelihood of confusion) for the Respondent’s own commercial gain. Such use also disrupts the Complainant’s business activities by diverting potential consumers to the disputed domain name. Therefore, the Respondent’s activity cannot be considered good faith.

Following the above-mentioned, the Panel finds that the Complainant has satisfied Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **instapot.cc**: Transferred

PANELLISTS

Name	Radim Charvát
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DATE OF PANEL DECISION **2023-08-10**

Publish the Decision
