

Decision for dispute CAC-UDRP-105618

Case number CAC-UDRP-105618

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Domain names plumbingobrien.com

Case administrator

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

Complainant

Organization O'Brien Glass Industries Limited

Complainant representative

Organization HSS IPM GmbH

Respondent

Organization sales oldschoollhandmade

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 - among others - the following trademarks for O'BRIEN covering Australia:

| COUNTRY | TM | REG. NO. | REG DATE | OWNER |
|-----------|------------------|----------|-------------------|-------------------------------|
| AUSTRALIA | O'BRIEN | 903535 | February 15, 2002 | O'Brien Glass Industries Ltd. |
| AUSTRALIA | O'BRIEN (& logo) | 1427832 | May 30, 2011 | O'Brien Glass Industries Ltd. |
| AUSTRALIA | O'BRIEN (& logo) | 1480652 | March 16, 2012 | O'Brien Glass Industries Ltd. |

FACTUAL BACKGROUND

The Complainant is an Australian company operating under the trademark and business name O'BRIEN for over 95 years.

The disputed domain name <plumbingobrien.com> was registered on May 23, 2023 and has been used in an unlawful attempt to fraudulently impersonate the Complainant's franchisee by way of an e-mail scam.

PARTIES CONTENTIONS

No administratively compliant 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 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).

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).

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 DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO THE COMPLAINANT'S TRADEMARK

The Panel finds that the disputed domain name <plumbingobrien.com> is confusingly similar to the trademark O'BRIEN registered and used by the Complainant in Australia, where the latter has proven to have prior rights since many decades.

In particular, the Panel agrees that <plumbingobrien.com> is almost identical to O'BRIEN, as the only difference is the addition of the term "plumbing", which is a clear reference to the Complainant's business activity.

As correctly indicated, the mere addition of a generic term to a trademark does not avoid a finding of confusion: *Sharman License Holdings, Limited v. Mario Dolzer*, Case No. D2004-0935 (WIPO Jan. 31, 2006); see also, e.g., *Fujitsu Ltd. v. Thomas Ruben*, Case No. 101592 (CAC Jul. 18, 2017) (stating, "It is well established that the addition of a generic term to a trademark does not avoid a finding of confusion.") and - in this case - the confusion is even worse considering the descriptive nature of the term added.

Further, the addition of the generic top-level domain ".com" does nothing to distinguish the Disputed Domain from Complainant's mark. See, e.g., *Alibaba Group Holding Limited v. Huang Guofeng*, Case No. D2018-2450 ("The addition of the gTLD extension ".com" and ".org" in domain names may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark . . ."); *Open Society Institute v. Admin Contact, PrivateName Services Inc. / Axel Feldt*, Case No. D2018-0816 (WIPO Jun. 13, 2018).

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

According to the information provided by the Complainant, the Respondent is not affiliated nor authorized by the Complainant in any way. Likewise, the Complainant neither licensed nor authorized the Respondent to make any use of its trademark O'BRIEN, or to apply for registration of the disputed domain name on behalf of the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

It is undeniable that Complainant is only required to make out a prima facie case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

Given all the above and taken into account the fact that the Respondent did not provide any response within the present proceeding, the Panel accepts the contentions of the Complainant that the Respondent has no such rights or legitimate interests in the disputed domain name.

THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH

The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name. This prima facie evidence was not challenged by the Respondent.

There is a substantial case-law according to which fraudulent and/or criminal activity constitutes bad faith under the Policy. See, e.g., *The Lincoln Electric Company v. David Vargo*, Claim No. FA1704001725364 (Nat. Arb. Forum May 10, 2017) (finding inactive use of a domain name is not a bona fide offering of goods or services, and further, that using the disputed domain as part of a phishing scheme "is not a bona fide offering of goods or services"); *Chevron Intellectual Property LLC v. Thomas Webber / Chevron Ronoil Recreational Sport Limited*, Claim No. FA 1661076 (Nat. Arb. Forum Mar. 15, 2016) (finding that the respondent had failed to provide a bona fide offering of goods or services because "[r]espondent is using an email address to pass themselves off as an affiliate of Complainant." The Panelist further found that the evidence showed that the "email address that Respondent has created is used to solicit information and money on false pretenses"); *Chevron Intellectual Property LLC v. Richard Bailey / Jacobs*, Claim No. FA1588430 (Nat. Arb. Forum Dec. 9, 2014) (finding no bona fide offering of goods or services where the respondent's use of the disputed domain name was in furtherance of fraudulent activity under the misleading guise of the domain name and associated e-mail addresses).

There is no doubt that impersonating the Complainant's franchisee by way of an email scam is bad faith registration and use per the Policy and the Respondent did not deny such circumstance.

Given also the absence of a Response from the Respondent, the Panel infers that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **plumbingobrien.com**: Transferred

PANELLISTS

| | |
|------|-------------------------|
| Name | Tommaso La Scala |
|------|-------------------------|

DATE OF PANEL DECISION **2023-08-31**

Publish the Decision
