

Decision for dispute CAC-UDRP-105632

Case number	CAC-UDRP-105632
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Time of filing	2023-07-25 08:48:45
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Domain names	upowerscarpe.shop
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Case administrator

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

Organization	U-POWER GROUP S.p.A.
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Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.
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Respondent

Name	Brigitte Bellamy
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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 the multiple trademark registrations containing the verbal element "U POWER" in a combination with other word and/or figurative elements, particularly

- International trademark n. 1575166 for the word mark „U POWER RED UP”, registered on 14 September 2020, in classes 09 and 25 inter alia in Norway, Turkey, Tunisia and Switzerland;
- International trademark n. 1681180 for the figurative mark registered on 30 May 2022 in class 9 inter alia in the United Kingdom;
- European Union trademark n. 017880035 for the figurative mark, registered on 25 August 2018 in classes 9 and 25; and
- International trademark n. 1681229 for the figurative mark registered on 30 May 2022 in classes 9 inter alia in the United Kingdom (collectively referred to as "U-POWER" trademarks").

FACTUAL BACKGROUND

The Complainant is an Italian company, part of the U-Power Group active in the field the distribution and marketing of personal protective devices.

The U POWER brand and trademark is used internationally and in the EU in relation to of accident prevention and personal protective equipment.

The companies belonging to the U-Power Group also own multiple top-level and country code top-level domain names, constituted by the verbal elements "UPOWER", for instance <u-power.it>, <u-powergroup.it>, <u-powergroup.com> etc.

The disputed domain name <upowerscarpe.shop> was registered by the Respondent on 8 September 2022.

PARTIES CONTENTIONS

1. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its "U-POWER" trademarks and related domain names, pointing out that the domain name incorporates the dominant element "UPOWER" of its trademarks in its entirety.

The Complainant contends that the addition of the generic terms "scarpe" (which means "shoes" in Italian) and the gTLD .shop are not sufficient to escape the finding that the disputed domain name is confusingly similar to its "U-POWER" trademarks, but, on the contrary, increase the likelihood of confusion, as Internet users could wrongly believe that this domain name designates the official e-commerce for the "U-POWER" products, considering that footwear is one of the key products of the "U-POWER" brand.

The Complainant further submits that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant notes that the Respondent is not an authorised dealer, agent, distributor, wholesaler or retailer of U-Power or U-Invest. In fact, the Complainant has never authorised any third party to include its trademarks in the disputed domain name or otherwise use its trademarks in any manner. The Complainant further submits that it does not possess, nor is it aware of the existence of, any evidence that the Respondent is commonly known by the domain name as an individual, company, or other organisation.

The Complainant alleges that the Respondent has registered and is using the disputed domain name in bad faith.

With respect to the bad faith registration, the Complainant alleges, inter alia, that (i) the disputed domain name was registered long after the filing/registration of the Complainant's trademarks and domain names; (ii) the disputed domain name contains the Complainant's trademarks in their entirety, consisting of a fanciful word "U POWER"; and (iii) the "U POWER" mark is a well-known trademark, given its extensive use and international distribution.

On the basis of the foregoing, it is reasonable to conclude that the Respondent registered the domain name with full knowledge of the Complainant's trademark in order to capitalise on the reputation of the Complainant's trademarks by diverting Internet users seeking information about the Complainant's trademark.

With respect to bad faith use, the Complainant contends that the disputed domain name is not actively used, but that, given the circumstances of the case, in particular the high degree of distinctiveness and reputation of the U-POWER trademarks and the Respondent's use of a privacy protection service to hide its identity, such passive ownership of the disputed domain name supports a finding of bad faith use.

2. Respondent

No administratively compliant response has been submitted by the Respondent.

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).

The Complainant has demonstrated that it is the rightful owner of several word and figurative marks which include the word "U-POWER" or "U POWER" as their dominant and distinctive element and which enjoy legal protection in the European Union and/or several other countries. The Panel acknowledges that the aforementioned dominant and word element "U POWER" is clearly identifiable in the disputed domain name and agrees with the Complainant that the additional verbal elements contained in the disputed domain name, namely "SCARPE" and "SHOP" (GTLD), are generic and insufficient to prevent a likelihood of confusion with the Complainant's trademark. The Panel also agrees that the use of the word "scarpe" in the disputed domain name increases the degree of similarity, as footwear is one of the main products sold by the Complainant under the U-POWER trademarks and brand.

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 and WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

Based on the contentions of the Complainant, the panel finds that the Complainant 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

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).

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 Article 3.1. of WIPO Jurisprudential Overview 3.0).

Registration in bad faith

In determining the bad faith registration of the disputed domain name, the Panel considered, in particular, the following factors

(a) the longstanding presence of the Complainant's "U-POWER" trademark on the market and its market recognition, whereas the disputed domain name was registered only in 2022; and

(b) the Respondent's use of the words "SCARPE", i.e., footwear, which the Complainant has successfully demonstrated through the evidence submitted, is one of the Complainant's main products sold under the "U-POWER" trademark.

Based on the foregoing, the Panel concludes that the Respondent must have been aware of the Complainant and its U-POWER trademarks when it registered the disputed domain name.

Therefore, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Bad faith use

The Panel considered whether, in the circumstances of this particular case, the Respondent's passive holding of the domain name could be considered to constitute use of the disputed domain name in bad faith. According to the WIPO Jurisprudence Overview 3.0, non-use of a domain name would not preclude a finding of bad faith under the passive holding doctrine. Factors considered relevant in the application of the passive holding doctrine include (i) the degree of distinctiveness or reputation of the complainant's mark; (ii) the respondent's failure to file a response or to provide evidence of actual or contemplated good faith use; (iii) the respondent's concealment of its identity or use of false contact information (found to be in violation of its registration agreement); and (iv) the implausibility of any good faith use to which the domain name might be put (see also Telstra Corporation Limited vs. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>).

In the circumstances of this case, the Panel finds that the Complainant has successfully demonstrated, through the evidence submitted, the high degree of acquired distinctiveness of the Complainant's U-POWER mark, particularly in relation to work shoes. In addition, the Panel notes that the Respondent has not provided a response or evidence of actual or intended use in good faith. The Panel also notes that, according to the Czech Arbitration Court ("CAC"), neither the written complaint nor the notice of service of the complaint was returned to the CAC. As to the e-mails, the CAC received notifications that the e-mails sent to postmaster@upowerscarpe.shop and to bellamy12213@gmail.com (which is the registered contact e-mail) were returned undelivered due to permanent fatal errors in the e-mail addresses. This indicates that the Respondent's contact information may be incorrect or false.

Therefore, the Panel is satisfied that the totality of the circumstances of this case weigh in favour of finding that the Respondent's non-use of the domain name is in bad faith. These circumstances include the strength and reputation of the Complainants' U-POWER marks, the Respondent's failure to participate in this proceeding, and the use of false or non-functional contact information to conceal the Respondent's identity.

On this basis, the Panel finds that, in this case, the passive holding of the disputed domain name constitutes use of the disputed domain name 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

The Panel has determined that the disputed domain name is confusingly similar to the Complainant's trademark.

Based on the contentions presented by the Complainant, the Panel has found that the Complainant has satisfactorily made 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.

The Panel finds that, based on the Complainant's contentions and evidence, it can be concluded that the Respondent must have been aware of the Complainant's trademarks when it registered the disputed domain name, and as such, the Respondent has registered the disputed domain name in bad faith.

Lastly, the Panel has concluded that the Complainant has successfully proven that the disputed domain name is being used in bad faith.

Therefore, for the aforementioned reasons, the Panel orders that the disputed domain name <upowerscarpe.shop> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **upowerscarpe.shop**: Transferred

PANELLISTS

Name	Karel Šindelka
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DATE OF PANEL DECISION	2023-09-04
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Publish the Decision
