

Decision for dispute CAC-UDRP-105654

Case number CAC-UDRP-105654

Time of filing 2023-07-25 08:49:46

Domain names coffeedavidoff.com

Case administrator

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

Complainant

Organization Zino Davidoff SA

Complainant representative

Organization BRANDIT GmbH

Respondent

Name Irakli Zavlunishvili

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 numerous registrations of the trademark DAVIDOFF, inter alia, the international trademark DAVIDOFF (Reg. No. 857686), registered on May 24, 2005, in classes 9, 16 and 30.

FACTUAL BACKGROUND

Zino Davidoff SA (the "Complainant") is a Swiss-based family business which is famous for providing luxury goods such as beautifully crafted leather goods, writing instruments, fragrances, watches, eyewear, fashion accessories, coffee and cognac. The Complainant's products are sold worldwide, including the USA.

The Complainant is the owner of numerous registrations of the trademark DAVIDOFF, inter alia, the international trademark DAVIDOFF (Reg. No. 857686), registered on May 24, 2005, in classes 9, 16 and 30.

The Complainant also owns domain names containing the trademark DAVIDOFF, including <zinodavidoff.com> (registered on April 20, 1998), <davidoff-coffee.com> (registered on March 16, 2010) and <davidoff-cafe.com> (registered on April 14, 2003), which resolve to Zino Davidoff group's official websites through which it informs Internet users and potential consumers about its DAVIDOFF mark and its related products.

The disputed domain name <coffeedavidoff.com> was registered on September 16, 2019, many years after the first registrations of the Complainant's DAVIDOFF widely known trademark. and resolves to a Pay-Per-Click page. The Complainant sent a cease-and-desist letter to the Respondent informing of the Complainant's rights regarding the DAVIDOFF trademark, to which the Respondent did not reply.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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 Panel agrees with the Complainant that the disputed domain name is confusingly similar to Complainant's trademark DAVIDOFF. The Complainant's trademark is included in the disputed domain name in its entirety. The adding of the generic word "coffee" does not change the fact that the disputed domain name and the registered trademark are confusingly similar as it does not change the overall impression of the designation as being connected to the Complainant's trademark and it does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and domain names associated. On the contrary, the addition of the word "coffee" increases the likelihood of confusion with the Complainant's trademarks and activity, because "coffee" refers to the Complainant's product of coffee and the website under the Complainant's domain names <davidoff-coffee.com> (registered on March 16, 2010) and <davidoff-cafe.com> (registered on April 14, 2003). It is well established in the UDRP case-law, that the addition of a generic term associated to a trademark does not create a new or different right to the mark or diminish confusing similarity (eg. see WIPO Case No. D2016-0239, LEGO Juris A/S v. Viktor Tkachev, Lego Town, <lego-town.com>; WIPO Case No. D2021-3735 <original-timberland.com>). Numerous UDRP panels have considered that the addition of other terms (whether descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name is not sufficient to escape a finding of confusing similarity (see section 1.8 of the WIPO Overview 3.0).

The Panel acknowledges that the Complainant presented prima facie evidence that the Respondent is not sponsored by or affiliated with Complainant in any way. Furthermore, the Complainant has not licensed, authorized, or permitted Respondent to use Complainant's trademarks in any manner, including in domain names. The Respondent's name (Irakli Zavlunishvili) does not resemble the disputed domain name in any manner. Respondent's use of the disputed domain name does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use.

As no administratively compliant response has been provided to the Panel and the prima facie evidence was not challenged by the Respondent, the Panel concludes that the Respondent meant Complainant's trademark DAVIDOFF when he/she registered the

disputed domain name <coffeedavidoff.com> (see WIPO Overview 3.0, para. 3.1.3 and 3.2). Previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Accordingly, the Panel finds that the disputed domain name was registered in bad faith.

The disputed domain name was used as the pay-per-click page which displayed links to the third parties' merchants of coffee and other related products. This means that the Respondent could have obtained financial gain by advertising the aforementioned links on the website associated to the disputed domain name. In conclusion, the Respondent was using the disputed domain name to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's DAVIDOFF trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Therefore, this is nothing else but the use of the domain name in bad faith (para. 4(b)(iv) of the Policy).

Finally, the Complainant sent a cease-and-desist letter to the Respondent informing of the Complainant's rights regarding the DAVIDOFF trademark, to which the Respondent did not reply. Such behavior may also infer bad faith (see *Altarea v. Loretta Zayas*, WIPO Case No. D2020-2337).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. coffeedavidoff.com: Transferred

PANELLISTS

Name	Darius Sauliūnas
------	-------------------------

DATE OF PANEL DECISION **2023-10-03**

Publish the Decision
