Decision for dispute CAC-UDRP-106171

Case number	CAC-UDRP-106171
Time of filing	2024-01-22 08:45:54
Domain names	tomtom.shop

Case administrator

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

Complainant

Organization	Tomtom International B.V.

Complainant representative

Organization	Convey srl

Respondent

Name	hussain Abdosa

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 several international, European Union and the United States trademark registrations consisting of or containing the verbal element “TOMTOM” alone or in a combination with other figurative elements, in particular:

- International trademark n. 801582 for the word mark „TOMTOM”, internationally registered on March 07, 2003, in Classes 9, 38 and 42 in multiple countries of the world including but not limited to Australia, Great Britain and Turkey;
- International trademark n. 969888 for the figurative mark “tomtom & device”, registered on August 21, 2007 in classes 9, 38, 39, 42 inter alia in the European Union, Australia and China;
- International trademark n. 990177 for the figurative mark “tomtom”, registered internationally on August 21, 2008, in Classes 9, 38, 39 and 42 inter alia in Switzerland;
- United States trademark Registration No. 3409331 for the word “TOMTOM” registered on April 8, 2008;
- European Union trademark n. 18762544 for the figurative mark “tomtom & device”, registered on February 7, 2023 in Classes 9, 35, 38, 39 and 42;

(collectively referred to as the “TOMTOM trademarks”).

FACTUAL BACKGROUND

The Complainant is a Dutch multinational developer and creator of location technology and consumer electronics, headquartered in Amsterdam, with over 3,800 employees worldwide and operations in several countries around the world, including Europe, Asia-Pacific, and the Americas, with its main locations in the Netherlands, India, Poland, Germany, the United States, and Belgium.

The TOMTOM brand and trademarks have been used worldwide for decades in connection with consumer electronics, in particular satellite navigation devices, including but not limited to the Complainant's official website https://www.tomtom.com and its official accounts on major social networks such as Facebook, LinkedIn, Twitter, Instagram and YouTube.

The disputed domain name <tomtom.shop> was registered by Respondent on March 16, 2023.

PARTIES CONTENTIONS

1. **Complainant**

The Complainant argues that the disputed domain name is confusingly similar to the TOMTOM trademarks, pointing out that the disputed domain name includes the TOMTOM trademarks in their entirety and that the .shop top level is merely instrumental for use on the Internet.

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 mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name. The Complainant further states that the Respondent is not a licensee or authorized dealer of the Complainant and has not been authorized by the Complainant to use the TOMTOM trademark in the disputed domain name or in any other manner. The Complainant also does not possess, nor is the Complainant aware of the existence of, any evidence that the Respondent, as an individual, business, or other organization, is commonly known by the domain name or a name corresponding to the disputed domain name.

The Respondent has not provided the Complainant with evidence that the Respondent is using, or is demonstrably preparing to use, the disputed domain name in connection with a bona fide offering of goods or services. There is no evidence that the Respondent is commonly known by the Complainant's trademark, and if it were, its knowledge of the Complainant's mark would negate any claim of legitimate use under Paragraph 4(c)(ii) of the Policy. The Respondent has not attempted to rebut the Complainant's prima facie case, nor has it responded to the Complainant's prima facie case.

With respect to bad faith registration, Complainant contends that Complainant's TOMTOM Trademarks have become well known in the location technology and consumer electronics industries as a result of Complainant's long-term and extensive use throughout the world, and that it is therefore obvious that Respondent was well aware of the TOMTOM Trademarks and registered the disputed domain name with the intention of referring to Complainant and its TOMTOM trademarks.

With respect to bad faith use, the Complainant contends that the redirection of the disputed domain name to a parking page where it is offered for sale amounts to passive holding of the disputed domain name, citing WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows. The Complainant further contends that the bad faith use is evidenced by the fact that the TOMTOM trademark has a high degree of distinctiveness, and that the Respondent has not responded to the cease-and-desist letter and has not changed the redirect to a website other than the parking page on which the disputed domain name is offered for sale upon receipt of the cease-and-desist letter. Moreover, the disputed domain name is offered for sale on the Afternic platform for USD 2,500.

The Complainant further alleges that the Respondent has concealed its identity in the Whois and that there is no possibility of good faith use by the Respondent.

Finally, the Complainant alleges that the conduct consisting of offering the disputed domain name for sale both directly on the relevant website and on the Afternic platform for $2,500 constitutes bad faith registration and use under the circumstances described in Paragraph 4(b)(i) of the Policy.

2. **Respondent**

According to the Czech Arbitration Court (“CAC”), the Respondent (a) never accessed the Online Platform, (b) the e-mail notice of the Complaint sent to postmaster@tomtom.shop was returned as undeliverable, and (c) the e-mail notice of the Complaint sent to the registered e-mail contact abdosa333@gmail.com was not returned as undeliverable, but there is no proof of delivery.

The CAC also informed the parties that the written Complaint Notice was properly delivered to Respondent's address, but the return receipt did not show the date of delivery.

In sum, the Respondent failed to provide an administratively compliant response.

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 consist of or include the word "TOMTOM" as their dominant and distinctive element and which enjoy legal protection in the European Union and/or several other countries. The Panel recognizes that the word element "tomtom" is clearly identifiable in the disputed domain name, and that the presence of the generic top level domain name "shop" has no effect on preventing a likelihood of confusion with the Complainant's trademarks.

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).

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 that the disputed domain name was registered in bad faith, the Panel considered, in particular, the following factors

(a) the nature of the disputed domain name, which fully incorporates a well-known brand and trademark that has been registered and used by the Complainant for decades in connection with consumer electronics (international trademark No. 801582 for the word mark "TOMTOM" was internationally registered as early as March 7, 2003, while the disputed domain name was registered almost 20 years later); and

(b) the inherent distinctiveness of the term "TOMTOM", which is a fanciful word with no specific meaning.

Based on the foregoing, the Panel concludes that the Respondent must have been aware of the Complainant and its TOMTOM marks at the time it registered the disputed domain name because it is highly unlikely that the Respondent would have registered the disputed domain name by mistake without knowledge of the Complainant's marks and brand.

While it is theoretically possible that the Respondent may have intended to register the disputed domain name for its subsequent bona fide offering of the Complainant's goods or services (if such use would satisfy the OKI data test under Article 2.8 of the WIPO Jurisprudential Overview 3.0), the circumstances following the registration of the disputed domain name, in particular that the Respondent offered the disputed domain name for sale shortly after the registration of the disputed domain name on the corresponding website, and that the Respondent has not offered any plausible interpretation of the registration of the disputed domain name either in response to the Complainant's cease and desist letter or in response to the Complaint, indicate that the Respondent did not have a bona fide intent 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 disputed domain name resolves to a website offering the domain for sale. The Panel considers that an active attempt to sell the disputed domain name constitutes use of the domain name by the Respondent and that the circumstances of this case therefore differ to some extent from a typical passive holding of the domain name as referred to in Telstra Corporation Limited vs. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, where there was no active use of the domain name.

In weighing whether the use of the disputed domain name was in bad faith, the Panel considered (i) the high degree of both inherent and acquired distinctiveness of the Complainant's TOMTOM mark; (ii) the lack of any plausible interpretation for the Respondent's

registration of the disputed domain name (see WIPO Case No. D2016-2140), in particular due to the Respondent's failure to file a response or to provide evidence of actual or intended good faith use; and (iii) the fact that the disputed domain name was offered for sale shortly after its registration, which indicates the implausibility of any good faith use to which the domain name might be put.

Therefore, the Panel is satisfied that the totality of the circumstances of this case supports a finding that the Respondent's use of the disputed domain name is in bad faith.

With respect to the Complainant's argument that the circumstances set forth in paragraph 4(b)(i) of the Policy, which provides that the respondent has registered the disputed domain names primarily for the purpose of selling or otherwise transferring the domain name registrations to the complainant or its competitors for an amount likely to exceed the documented out-of-pocket costs, the Panel finds that the evidence submitted is inconclusive in this regard. The Complainant has not provided any evidence that the Respondent intends to sell the disputed domain name to the Complainant and/or its competitors for an amount likely to exceed the documented out-of-pocket costs. While it is true that the disputed domain name is offered for sale on an Afternic website for the amount of USD 2,500 and that this amount is likely to exceed the documented out-of-pocket expenses, no link has been established between this offer and the Complainant.

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 identical with 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 <tomtom.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. **tomtom.shop**: Transferred

PANELLISTS

Name	**Karel Šindelka**

DATE OF PANEL DECISION 2024-02-28

Publish the Decision