Decision for dispute CAC-UDRP-106244

Case number	CAC-UDRP-106244
Time of filing	2024-02-13 11:12:29
Domain names	marshallvn.store

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Marshall Amplification plc

Complainant representative

Organization	Stobbs IP

Respondent

Name

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, Marshall Amplification plc, is the registered proprietor of trademarks and other intellectual property rights worldwide consisting of or containing 'MARSHALL'[word], 'MARSHALL' (stylised), 'MARSHALL HEADPHONES' and 'MARSHALL AMPLIFICATION'. A non-exhaustive list of the Complainant's trademarks is as the followings:

- The Chinese trademark MARSHALL No. 216918, registered on December 15, 1984, in classes 9;
- The Chinese trademark MARSHALL No. 14091406, registered on August 14, 1996, in classes 15;
- The Chinese trademark MARSHALL No. 22757761, registered on January 28, 2019, in classes 9.

FACTUAL BACKGROUND

The Complainant is an English company that is renowned for designing, amongst other products, music amplifiers, speaker cabinets, brands personal headphones and earphones, and, having acquired Natal Drums, drums and bongos.

The Complainant was founded in 1962 and initially incorporates as Jim Marshall (Products) Limited in 1964. In 1992, the Complainant changed its name to Marshall Amplification PLC.

Some of the Complainant's most well-known products include, but are not limited to the: Acoustic Series, Astoria Series, Code, DSL

Series, Handwired Series, JVM2 Series, JVM4 Series MG Carbon Fibre Series, Micro Amp Series, Mini Jubilee Series, Rak Power Amps, Signature Series, Vintage Reissue Series, 2536, 2551BV, 2551AV, 1960A, 1960B.

The Complainant has gained a large customer and fan base due to their product lines. There is a vast amount of information through blogs, online articles, and music forums where the technicalities of the MARSHALL amplifiers are discussed.

In 2012, the Complainant celebrated 50 years in the music amplifying industry which was commemorated with a large concert held at London's Wembley Arena, featuring Joe Satriani, Paul Gilbert, Yngwie Malmsteen, Zakk Wylde, Kerry King, Doug Aldrich, Billy Duffy, Phil Campbell, Glenn Hughes, Corey Taylor, Nicko McBrain, Mike Portnoy and Brian Tichy among others. Furthermore, their products, specifically the 1959 Super Lead have been used by established bands and musicians, including Jimi Hendrix, Joe Perry and Kurt Cobain.

The Complainant has also acquired domain names, which incorporate the MARSHALL trade mark and which are used as active websites. Examples include <marshall.com>, <marshallheadphones.com> and <marshallamps.com>.

The Complainant sells their products in more than 100 countries, which can be accessed at https://marshall.com/recommended-retailers.

The Complainant is also heavily active on social media and can be found using the following links:
Instagram - https://www.instagram.com/marshallamps/ - 1,300,000 followers
Facebook - https://www.facebook.com/marshallamps - 623,000 followers
YouTube - https://www.youtube.com/user/insidemarshall - 72,900 subscribers
Twitter - https://twitter.com/MarshallAmps - 295,700 followers

The Respondent appears to be an individual domiciled in Guangxi, China.

The disputed domain name was registered on June 3, 2023.

PARTIES CONTENTIONS

The Complainant contends 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).

The Complainant claims rights in the MARSHALL mark through its international trademark registrations including China where the Respondent is domiciled. By virtue of its trademark registrations with China National Intellectual Property Administration, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

The disputed domain name includes the geographic designation "VN". The inclusion of the geographic designation alongside the MARSHALL trademark does not alter the overall impression in the eyes of the average Internet user. See Boehringer Ingelheim Pharma GmbH & Co.KG v opio bros, 105869, (CAC 2023-11-07).

The Complainant requests that the Panel omit the TLD suffix '.store' when assessing the disputed domain name, as they are merely a technical requirement, used for domain name registrations.

By doing a side-by-side comparison, the Panel agrees that the disputed domain name is confusingly similar to Complainant's trademark, see paragraph 1.7 of the WIPO Jurisprudential Overview 3.0.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the

considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant submits that the disputed domain name at present does not resolve to a live site. The fact that the Respondent has not and is not using the disputed domain name, suggests that they have registered the disputed domain name purely to prevent the Complainant from reflecting their MARSHALL brand in the ".store" domain spaces. The Complainant has never granted the Respondent any right to use the MARSHALL trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant further submits that to the best of their knowledge, the Respondent has never legitimately been known as MARSHALL at any point in time and nothing about the disputed domain name suggest that they are being used by the Respondent legitimately or for non-commercial and fair use.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertions within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

The Complainant claims that the registration of the MARSHALL trademarks significantly pre-dates the registration of the disputed domain name. Furthermore, the Complainant's MARSHALL brand has received widespread recognition, supported by their endorsement on social media. In addition to circumstantial evidence, the Complainant submits that the Respondent had actual knowledge of the Complainant's brand. The Complainant further submits that the disputed domain name was registered with prior knowledge of the Complainant and their MARSHALL brand. As the result, the disputed domain name was registered with the sole purpose of creating an association with the Complainant.

The Complainant further alleges that the passive holding of disputed domain name constitutes bad faith considering the Complainant's trademark is well-known via its substantial use and the Respondent has not provided any evidence on any actual or contemplated good faith use of the disputed domain name.

Having considered the overall circumstances, the Panel is of the view that the Respondent likely has actual knowledge of Complainant's MARSHALL trademark during the registration of the disputed domain name considering Complainant's reputation and its prior trademark rights on MARSHALL, the registration of the disputed domain name constitutes bad faith. At the meantime, the Panel also accepts that passively holding the disputed domain name confusingly similar to a well-known trademark evinces the use of the disputed domain name in bad faith. See REGIE AUTONOME DES TRANSPORTS PARISIENS (RATP) v. Rivaldo Tantowi Suhandi, 106152 (CAC 2024-02-22) ("Considering the Respondent's overall behaviour, the Panel cannot conceive of any plausible actual or contemplated active use of <bonusratp.biz>, <bonusratp.info>, or <bonusratp.net> by the Respondent that would not be just as illegitimate as the Respondent's active use of <bonusratp.com>. The Panel therefore finds that the Respondent's passive holding of the disputed domain names <bonusratp.biz>, <bonusratp.info>, or <bonusratp.net> also constitutes use in bad faith. ")

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that the disputed domain name should 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. **marshallvn.store**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-03-06

Publish the Decision