Decision for dispute CAC-UDRP-106169

Case number	CAC-UDRP-106169
Time of filing	2024-02-21 06:53:40
Domain names	GENTLEMONSTER-OFFICIAL.COM, GENTLEMONSTERON.COM

Case administrator

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

Complainant

Organization	IICOMBINED Co., Ltd.

Complainant representative

Organization	Coöperatie SNB-REACT U.A.

Respondent

Name	Juju Zxh

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several international trademark registrations for the wording “GENTLE MONSTER”, including:

- South Korean trademark "GENTLE MONSTER" n° 4011621100000 registered on 23 February, 2016;
- EU trademark "GENTLE MONSTER" n° 1124449 registered on 7 June, 2012;
- US trademark "GENTLE MONSTER" n° 4303384 registered on 19 March, 2012;
- Taiwanese trademark "GENTLE MONSTER" n° 01621455 registered on 16 January, 2014.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant states that it is a global company operating in the online retailing business through many different brands, including "GENTLE MONSTER", which denotes a South Korean eyewear brand launched in 2011, with over 50 Flagship stores worldwide (USA, UK, China, Korea, and more).

The Complainant further states that it is the owner of the trademark “GENTLE MONSTER” since 2012.

The disputed domain names were registered between July 12 and August 31, 2023; one of them (<gentlemonster-official.com>) redirects to a website which impersonates the Complainant's authorized stores.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names 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 names are 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 names (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 names have been registered and are 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 NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO THE COMPLAINANT`S TRADEMARK

The disputed domain names are confusingly similar to the “GENTLE MONSTER” trademark, as they all incorporates it in their entirety, with the mere addition of terms such as “official” and “on”, which are not sufficient to avoid the likelihood of confusion.

As a matter of fact, such variations do not change the overall impression of the designation as being connected to the Complainant’s trademark (“a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”, see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin) and actually the addition of a word like “official” even increases the confusing similarity, as it suggests that the domain name is authorized/owned/managed by the “GENTLE MONSTER” trademark owner (the Complainant).

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

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 "GENTLE MONSTER", or to apply for registration of the disputed domain names 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 names. Once such prima facie case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain names. 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 names.

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THE DISPUTED DOMAIN NAMES HAVE BEEN REGISTERED AND ARE 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, neither of the disputed domain names 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 names.

As for <gentlemonster-official.com>, such domain name resolves to a webpage which presents itself as an official website for the brand of "GENTLE MONSTER" offering sunglasses and relevant WIPO, ADR.EU and FORUM case law (see, among others, Dream Horse Classifieds v. Mosley, FA 381256) confirmed that no bona fide offering of goods or services, nor any legitimate noncommercial or fair use can be found where the respondent uses a domain name to pass its self-off as affiliated with the complainant (see, among others, Dream Horse Classifieds v. Mosley, FA 381256).

For what concern <gentlemonsteron.com>, such disputed domain name is inactive. However, since the Respondent has not demonstrated any activity in respect of the disputed domain names, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. In this case and bearing in mind the use of <gentlemonsteron.com>, passive holding is a demonstration of bad faith.

Consequently, the Panel believes that both the disputed domain names were registered and are 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. **GENTLEMONSTER-OFFICIAL.COM**: Transferred
2. **GENTLEMONSTERON.COM**: Transferred

PANELLISTS

Name	**Tommaso La Scala**

DATE OF PANEL DECISION 2024-03-24

Publish the Decision