Decision for dispute CAC-UDRP-106264

Case number	CAC-UDRP-106264
Time of filing	2024-02-19 07:53:16
Domain names	marshallshops.xyz, marshallshops.site

Case administrator

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

Complainant

Organization	Marshall Amplification plc

Complainant representative

Organization	Stobbs IP

Respondent

Name	Jayhind Pal

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 has submitted evidence, which the Panel accepts, showing that it is the registered owner of the trademarks bearing “MARSHALL”, inter alia, the following:

- Canadian trademark “MARSHALL” n°TMA175777, registered on April 30, 1971;
- European Union trademark “MARSHALL” n° 012996427, registered on November 4, 2014;
- International trademark “MARSHALL” n°1230803, registered on June 26, 2014, designating India;
- Indian trademark “MARSHALL” n°653153, registered on March 21, 2005.

Moreover, the Complainant is also the owner of the domain names bearing the sign “MARSHALL” such as the domain names <marshall.com> (registered on June 24, 1994) and <marshallheadphones.com> (registered on December 16, 2009).

FACTUAL BACKGROUND

The Complainant, Marshall Amplification PLC, 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. It

was established in 1962. In 1992, the Complainant changed its name to Marshall Amplification PLC.

The Complainant holds many trademark registrations including “MARSHALL” phrase going back to 1969 and the Complainant also holds the domain names bearing “MARSHALL”, such as <marshall.com> and <marshallheadphones.com>.

On July 26, 2023; the Respondent registered the disputed domain names <marshallshops.xyz> and <marshallshops.site>. The disputed domain names are currently inactive and parked.

PARTIES CONTENTIONS

COMPLAINANT:

1. THE DISPUTED DOMAIN NAMES ARE CONFUSINGLY SIMILAR

The disputed domain names are confusingly similar to the Complainant’s formerly registered distinctive trademarks, as they bear the Complainant’s “MARSHALL” trademark as a whole with the addition of the descriptive term “shops”, which would not prevent a finding of confusing similarity.

The Complainant refers to earlier decisions and claims that the top level domains “.site” and “.xyz” are merely technical requirements and will be disregarded, so the domain names remain confusingly similar despite their inclusion.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Complainant states that given the considerable reputation of the MARSHALL trademark, there is no believable or realistic reason for registration or use of the disputed domain names, other than to take advantage of the Complainant’s rights.

The Complainant submits that the disputed domain names resolve to pay-per-click (PPC) pages and refers to WIPO Overview 3.0, section 2.9 (‘applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalise on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.’).

The Complainant also states that the Respondent is neither affiliated nor authorized by the Complainant in any way and neither license nor authorization has been granted to the Respondent to use the Complainant’s trademarks “MARSHALL”.

The Respondent has no rights on the disputed domain names as the Respondent is not known as the disputed domain names and as the Respondent does not hold any trademark or domain name with “MARSHALL”.

The Complainant argues that the Respondent is not using the disputed domain name in connection with bona fide offering of goods or services or a legitimate non-commercial or fair use.

3. THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE USED IN BAD FAITH

The Complainant claims that Complainant’s “MARSHALL” trademarks significantly predate the disputed domain names. The Complainant states that “MARSHALL” is a well-known trademark. It is claimed that by conducting a simple online search regarding the term “MARSHALL”, the Respondent would have inevitably learned about the Complainant, its trademark and business.

The Complainant asserts that it is inconceivable for the Respondent to be unaware of the existence of the Complainant when he registered the disputed domain names. The fact that the Respondent registered the disputed domain names while knowing about the trademarks of the Complainant constitutes bad faith in registering the disputed domain names. The Complainant claims that by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to their website or other online location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of their website or location or of a product or service on their website or location.

The Complainant also points out that the disputed domain names are currently parked, with PPC links to mostly women’s clothing. Whilst not the Complainant’s core business, the Complainant offered clothing through its merchandise line and therefore, the disputed domain names are being used with the sole purpose of creating an association with the Complainant, which is further highlighted by these links, and profiting from this association.

Accordingly, the Complainant alleges that the disputed domain names were registered and are being used in bad faith.

RESPONDENT:

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 name 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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

1. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of “MARSHALL” trademark.

The Panel finds that the disputed domain names are confusingly similar to the Complainant’s “MARSHALL” trademark and the addition of the term “shops” is not sufficient to vanish the similarity.

Moreover, the addition of the TLDs “.site” and “.xyz” are not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain names are official domain names of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain names are confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

2. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant and any use of the trademark “MARSHALL” has to be authorized by the Complainant but there is no such authorization. Moreover, the disputed domain names have no relation with the Respondent and the Respondent is not commonly known as the disputed domain names. Also, the Complainant submits that the disputed domain names resolve to pay-per-click (PPC) pages, which does not represent a bona fide offering where such links compete with or capitalise on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.

In the absence of a response, the Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain names.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain names, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

The Panel concludes that the Complainant's “MARSHALL” trademark is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the “MARSHALL” trademark, the Respondent was aware of the Complainant and its trademarks at the time of registration of the disputed domain names (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant’s trademark at the time of the registration of the disputed domain names is to be considered an inference of bad faith registration.

Moreover, the disputed domain names are currently parked and resolve to pay-per-click (PPC) pages. WIPO Overview 3.0, section 3.5 states that “Particularly with respect to “automatically” generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith.”

All the circumstances of the case must be examined to determine whether the Respondent is acting in bad faith. The cumulative circumstances for an indication of bad faith include the Complainant having a well-known trade mark, no response having been filed, and the disputed domain names being parked and resolve to pay-per-click pages, which all happened in this case.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain names have been registered and are being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **marshallshops.xyz**: Transferred
2. **marshallshops.site**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2024-03-27

Publish the Decision