Decision for dispute CAC-UDRP-106265

Case number	CAC-UDRP-106265
Time of filing	2024-02-20 09:38:02
Domain names	marstore.site, marshallphilippines.online, marstore.website

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Marshall Amplification plc

Complainant representative

Organization	Stobbs IP

Respondent

Name	Nong Thi Le

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 proved to own several trademark rights which can be traced back as early as 1984 such as MARSHALL, MARSHALL (stylized), MARSHALL HEADPHONES and MARSHALL AMPLIFICATION. Examples are listed below:

- UK trademark registration n. UK00915249535 “MARSHALL”, registered on November 2, 2016, in classes 9; 35; 38; 41;
- EU trademark registration n. 015178239 “MARSHALL”, registered on June 16, 2016, in class 9;
- International trademark registration n. 1388778 “MARSHALL” (stylized) , registered on July 10, 2017, in classes 3, 6, 7, 8, 9, 11, 12, 14, 15, 16, 20, 21, 24, 26, 27, 28, 32, 33, 34, 35, 38, 39, 41, 42 and 43, designating inter alia Australia, China, Korea, United States of America, India, Indonesia.

Complainant also owns the following domain name <marshall.com> registered in June, 24, 1994.

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 (in 1964) as Jim Marshall (Products) Limited. In 1992, the Complainant changed its name to Marshall Amplification PLC.

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.

The Respondent registered the disputed domain names <marstore.site> on May 25, 2023; <marshallphilippines.online> on June 14, 2023; <marstore.website> on June 11, 2023. The disputed domain names <marstore.website> and <marshallphilippines.online> directs to an e-commerce site that uses Complainant's branding and sells our Complainant's products. The disputed domain name <marsore.site> is inactive.

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 name <marshallphilippines.online> 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).

However, the Complainant has not, to the satisfaction of the Panel, shown the disputed domain names <marstore.website> and <marstore.site> 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 name <marshallphilippines.online> (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 <marshallphilippines.online> 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

Identity (paragraph 4(a)(i) of the Policy)

The Panel finds that the domain name <marshallphilippines.online> is confusingly similar to the Complainant's MARSHALL trademarks.

Firstly, the Complainant's MARSHALL trademark is incorporated in the disputed domain name in its entirety. Secondly, in the Panel's

opinion, the mere addition of the geographic term “Philippines” does not prevent the similarity between the Complainant’s trademarks and the aforementioned domain name.

However, the Panel finds that the domain names <marstore.site> and <marstore.website> are not confusingly similar to the Complainant’s MARSHALL trademarks.

Only the first three letters of the Complainant’s MARSHALL trademark are incorporated in the disputed domain name. The disputed domain names do not reproduce in its entirety Complainant’s word trademark MARSHALL. Thus, the mere partial reproduction of the word MARSHALL in the disputed domain name is not sufficient to prove similarity. Indeed, the Complainant does not own a right on the letters “MAR”. More, there is no evidence that “mar” is a well-known or recognized abbreviation of any of Complainant’s trademarks.

The addition of the word “STORE” prevents even more the similarity between the disputed domain name and the Trademarks aforementioned.

The fact that the Panel has found that <marshallphilippines.online> is confusingly similar to Complainants’ MARSHALL trademarks does not necessarily support a determination that an abbreviation for MARSHALL is also confusingly similar. Each domain name must be analyzed separately as to whether it is identical or confusingly similar to a complainant’s trademark (See, WIPO, Case No. D2011-0220, Group Kaitu, LLC, Darkside Productions, Inc. v. NetDirect).

The Complainant has therefore not met its burden to prove that the disputed domain names <marstore.site> and <marstore.website> are confusingly similar or identical to its trademarks.

The Panel finds that disputed domain name <marshallphilippines.online> is confusing and does not provide additional specification or sufficient distinction from the Complainant or its mark.

Absence of Rights or Legitimate Interests (paragraph 4(a)(ii) of the Policy)

The Complainant asserted that the Respondent has never legitimately been known as MARSHALL at any point in time. In addition, the Respondent never sought the consent of the Complainant in order to register the aforementioned domain name. Consequently, the Panel finds that the Respondent lacks any right or legitimate interest in using the disputed domain name <marshallphilippines.online>.

The Complainant also highlighted that the disputed domain name resolves to a website reproducing Complainant’s genuine website. Therefore, the Panel finds that the Respondent did not intend to use the disputed domain name in connection with any legitimate purpose.

Finally, the Respondent had the opportunity to provide its arguments in support of its rights or legitimate interests in the disputed domain name. However, by failing to file a response, the Respondent has missed this opportunity and the Panel is entitled to draw such inferences from the Respondent's failure as it considers appropriate in accordance with Paragraph 14 of the Rules.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name <marshallphilippines.online>.

Bad faith (paragraph 4(a)(iii) of the Policy)

In the light of the records, the Complainant showed the disputed domain name <marshallphilippines.online> is consequently similar to MARSHALL trademark. Moreover, the time of the registration, namely June 14, 2023, is well posterior to the registration of MARSHALL trademark.

Furthermore, the Panel finds that the Respondent cannot reasonably pretend he was intending to develop a legitimate activity through the disputed domain name. Indeed, the disputed domain name resolves to a website which imitates Complainant’s genuine site.

Therefore, it is clear to the Panel that the Respondent was well aware of the MARSHALL trademark and has registered the dispute domain name with the intention to refer to the Complainant and to its trademarks.

Furthermore, it seems that the Respondent has registered the dispute domain name in bad faith for the sole purpose to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant’s trademarks. Indeed, the disputed domain resolves to a website imitating Complainant’s product for which the Complainant’s trademarks are registered and used. The website links to a page where users can enter personal details, which suggest phishing purposes.

To the Panel’s opinion, this shows that the disputed domain name <marshallphilippines.online> was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **marstore.site**: Remaining with the Respondent
2. **marshallphilippines.online**: Transferred
3. **marstore.website**: Remaining with the Respondent

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2024-04-02

Publish the Decision