Decision for dispute CAC-UDRP-106310

Case number	CAC-UDRP-106310
Time of filing	2024-03-12 09:25:07
Domain names	workprogreece.com

Case administrator

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

Complainant

Organization	HangZhou Great Star Industrial Co., Ltd.

Complainant representative

Organization	Chofn Intellectual Property

Respondent

Name	Jack law

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 claims to own exclusive rights to the WORKPRO trademark in a number of countries, including but not limited to the following trademark registrations:

- CN trademark WORKPRO No. 7191268, registered on September 14, 2010;
- CN trademark WORKPRO No. 14641211, registered on August 7, 2015;
- EU trademark WORKPRO No. 018054598, registered on September 11, 2019;
- EU trademark WORKPRO No. 018162610, registered on May 22, 2020;
- EU trademark WORKPRO No. 018494851, registered on October 15, 2021;
- CN trademark WORKPRO No. 56787502, registered on January 7, 2022;
- CN trademark WORKPRO No. 56814470, registered on January 7, 2022.

FACTUAL BACKGROUND

The Complainant was established in 1993 and is one of the leaders in the tools and storage industry manufacturing hand tools & storage, power tools, laser measurement and power stations, which are mainly used in the fields of home maintenance, construction, vehicle maintenance, map measuring and surveying, and home energy management. WORKPRO is one of the Complainant's important private brands, which is a well-known hand tool brand marketed in the U.S. and Canada. The WORKPRO

brand has production, sales and service partners in 21 sites around the world, and its products are exported all over the world.

Founded in 2009, WORKPRO is a comprehensive tool brand created by the Complainant, with more than 20 categories of tools, including hand tools, power tools, garden tools, air tools, welding tools, PPE, PTA, illumination, and tool storage, etc., which can provide DIY consumers and professional users with a full range of tool solutions for DIY consumers and professional users. Up to now, the Complainant has become one of the largest suppliers of tools and storage to a number of large supermarket chains such as Home Depot in the United States, Walmart in the United States, Lowes in the United States, Kingfisher in Europe, and CTC in Canada. At present, there are more than 20,000 large hardware, building materials, auto parts and other chain supermarkets around the world selling the Complainant's various products, and these channels effectively ensure the rapid development of the Complainant's various innovative products. At the same time, cross-border e-commerce direct has become a new channel of the Complainant in addition to the traditional large supermarket chains the most important sales channels. In 2021, WORKPRO's global sales totalled more than $100 million units. As of 2022, according to the Complainant's annual report published on the Shenzhen Stock Exchange, the Complainant achieved operating revenues of more than RMB 12.6 billion in 2022. The sales revenues of brands such as WORKPRO, DURATECH, SWISSTECH, and PREXISO increased significantly year-on-year, and the sales revenues of its own brands accounted for more than 40% of its revenues for the first time. In 2021, WORKPRO was honoured with the PTIA 2021 Pneumatic Tools and Nailers Awards and the PTIA 2021 Accessories Awards. Between 2021 and 2023, the Complainant actively participated in relevant industry exhibitions in various countries and regions and increased its promotional efforts globally.

The Complainant has an experienced R&D team for professional tool products and non-tool consumer goods, which is always committed to development and innovation of new products and upholds the concept that details determine success or failure to improve product functionality and added value, as well as to ensure the Company's long-term core competitiveness. During the 2022 reporting period, the Complainant invested CNY 319 million in R&D, designing 2,105 new products. The numbers of new patents applied for and patents granted both exceeded 300.

The Respondent appears to be an individual domiciled in Bergamo, Italy.

The disputed domain name was registered on November 9, 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 WORKPRO mark through its international trademark registrations including EU where the Respondent is domiciled. By virtue of its trademark registrations with the EUIPO, 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 Complainant further contents that the disputed domain name includes a generic word "greece". The inclusion of a generic word designation alongside the WORKPRO trademark does not alter the overall impression in the eyes of the average Internet user. The Complainant also argues that the meaning of the generic top-level domain (gTLD) .com does not affect the determination of the first element in this case, the gTLD suffix .com does not have the capacity to distinguish the disputed domain name from the Complainant’s prior rights.

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. See also Pentair Flow Services AG vs. Victor Panasyuk, 105848 (CAC 2023-11-13) ("The Panel notes that the Complainant's trade mark PENTAIR is wholly incorporated into the disputed domain name, the only difference being the contiguous geographical term 'europe'. This additional term has no material bearing on the confusing similarity assessment, such that the disputed domain name clearly evokes the Complainant's trade mark PENTAIR.").

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 effectively impersonates or suggests sponsorship or endorsement by the owner of the trademark and does not constitute fair use. Base on the research conducted by the Complainant, the Respondent does not have any trademark rights in the name of WORKPRO and is not one of the distributors or partners of the Complainant. The Complainant has never directly or indirectly authorized the Respondent to use the trademarks and the corresponding domain names in any form.

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 it has prior rights to WORKPRO, and it’s WORKPRO trademark is highly distinctive and well-known. According to the Complainant’s investigation, the content of the website resolved by the disputed domain name impersonates the Complainant. This clearly shows that the Respondent knew or should have known the Complainant's business name and trademark when registering the disputed domain name. The Complainant believed that the Respondent did not avoid the Complainant’s trademark even with prior knowledge of the Complainant’s trademark, and the act of choosing to apply for the dispute domain name was malicious.

The Complainant reiterates that the Respondent has pointed the disputed domain name to a website related to the Complainant's business, and Complainant's WORKPRO trademark has been published on different parts of the website. The Complainant submits that the Respondent's use of the disputed domain name to deliberately imitate the Complainant's WORKPRO brand for profit is consistent with paragraph 4B(iv) of the Policy.

Having considered the screenshots provided by the Complainant, the Panel is of the view that the Respondent likely has actual knowledge of Complainant's WORKPRO trademark during the registration of the disputed domain name considering Complainant's reputation and its prior trademark rights on WORKPRO, the registration of the disputed domain name constitutes bad faith. At the meantime, the Panel also accepts that the Respondent's act of deliberately impersonating the Complainant for commercial gain constitutes bad faith. See Esselunga S.p.A. vs. xuxu, 105785 (CAC 2023-11-13) ("the Panel is persuaded that the Domain Name comprising the Complainant’s fanciful trade mark and the ordinary word “shop”, inherently impersonates the Complainant. By reason of the nature of the Domain Name and the size and reputation of the Complainant’s business under the ESSULUNGA mark the Panel is also persuaded that this impersonation is deliberate on the part of the Respondent.")

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. **workprogreece.com**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-04-06

Publish the Decision