Decision for dispute CAC-UDRP-106330

Case number	CAC-UDRP-106330
Time of filing	2024-03-19 07:52:38
Domain names	burberrymail.site, burberryceo.site, burberrymail.shop, burberrymail.space, burberry-mail.shop

Case administrator

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

Complainant

Organization	Burberry Limited

Complainant representative

Organization	Coöperatie SNB-REACT U.A.

Respondent

Name	Marco Polo

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 many trademarks registered all around the world, including the following EU trademarks:

- word trademark BURBERRY, reg. no. 1058312, registration date 27 March 2000, in Nice classes 3 (perfumes), 18 (luggage, suitcases, bags) and 25 (clothing); and
- word trademark BURBERRY. reg. no. 2680460, registration date 31 July 2003, in Nice classes 9 (sunglasses, spectacles), 14 (watches, jewellery), and 16.

("**Complainant's Trademarks**").

The disputed domain names were registered on the following dates:

- burberrymail.site - 15 January 2024;
- burberryceo.site - 13 January 2024;
- burberrymail.shop - 15 January 2024;
- burberrymail.space - 15 January 2024; and
- burberry-mail.shop - 13 February 2024.

FACTUAL BACKGROUND

As the Respondent did not file any response to the complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) The Complainant's brand was founded in 1856 by Thomas Burberry and has since become a global fashion powerhouse, involved in the design, manufacture, advertising, distribution, and sale of high-quality apparel, bags, scarves, cosmetics, perfumes, glasses, and other accessories. Since 1856, Complainant has continuously used the BURBERRY word mark in connection with its products and services. Currently, the Complainant operates over 400 retail, outlet and concession locations around the world. Its merchandise is also sold in well-known department stores, boutiques, Burberry stores, online at Burberry.com, and in other Burberry-authorized retail establishments.

(b) The Complainant owns the Complainant's Trademarks.

(c) The Complainant has also registered the <burberry.com> domain name in 1997 as well as the <burberry.co.uk> domain name in 1999. In total, Complainant operates e-commerce websites in over 27 countries.

(d) No active website is operated under disputed domain names, most of them have active MX records and pay per click links scheme is operated under the disputed domain name <burberry-mail.shop>. Also e-mails were sent from disputed domain names <burberryceo.site> and <burberrymail.site> shortly after their registration. In both e-mails, the Respondent falsely claimed to be from Burberry and provided links to access Dropbox and Google Drive files containing, supposedly: contracts, promotional videos, and license agreements for potential collaboration. The recipients of said e-mails could only access the so-called package by entering the passwords Burberry24 and Burberry. Presumably, the recipients were to sign the contract or license agreement, at which point the Respondent would have access to their personal data including even their signature. Alternatively, the Respondent sought to have Internet users download malware (which would also explain the password protection of the archive files, to prevent virus scanners on the aforementioned cloud services from immediately removing the files). Thus, the Respondent used the deliberate false association the disputed domain names convey with Complainant's Trademarks to send fraudulent e-mails for the assumed purpose of actively phishing for personal information or spreading malware.

PARTIES CONTENTIONS

THE COMPLAINANT:

In addition to the above factual assertions, the Complainant also contends the following:

(i) The disputed domain names are confusingly similar to Complainant’s Trademarks. They contain Complainant’s Trademark followed by a generic terms "mail" or "ceo", . Adding such non-distinctive terms does not diminish confusing similarity of the disputed domain names to Complainant's Trademarks.

(ii) The Respondent is not affiliated with the Complainant nor authorized by it in any way to use Complainant’s Trademarks. The Respondent does not carry out any activity for, nor has any business with the Complainant. Neither license nor authorization has been granted by the Complainant to the Respondent to make any use of the Complainant’s Trademark or apply for registration of the disputed domain names. The Respondent does not operate any website under the disputed domain names and used some of the disputed domain names for fraudulent e-mail activities (as described above). Therefore, the Respondent has no rights or legitimate interest in respect of the disputed domain names.

(iii) Given the distinctiveness of the Complainant's Trademarks and its reputation, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's Trademarks. It is not possible to conceive of any plausible actual or contemplated active use of such domain names 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 fact, some of the disputed domain names have already been used for fraudulent e-mail activities. This amounts to bad faith in registration and use of the disputed domain names.

For these reasons, the Complainant seeks transfer of disputed domain names to the Complainant.

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 Uniform Domain Name Dispute Resolution Policy ("**UDRP**" or "**Policy**")).

For details, please see "Principal Reasons for the Decision".

NO RIGHTS OR LEGITIMATE INTERESTS

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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).

For details, please see "Principal Reasons for the Decision".

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).

For details, please see "Principal Reasons for the Decision".

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 4(a) of the Policy requires that the Complainant proves each of the following three elements to obtain an order that a disputed domain name should be transferred or revoked:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in these proceedings.

RIGHTS

The disputed domain names are confusingly similar to Complainant’s Trademarks. They contain the Complainant's Trademarks "BURBERRY" and then a non-distinctive term "mail" or "ceo" is added which is not sufficient to distinguish disputed domain names from Complainant's Trademarks.

For sake of completeness, the Panel asserts that the top-level suffixes in the disputed domain names (i.e. the ".shop", ".space" and ".site") must be disregarded under the identity / confusing similarity test as they are a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTEREST

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, a respondent carries the burden of demonstrating rights or legitimate interests in a domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (for example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

There are no websites under the disputed domain names. As asserted by the Complainant (and unchallenged by the Respondent), the Respondent is not commonly known by the disputed domain names. Neither is the Respondent in any way related to the Complainant. The Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a) (ii) of the Policy). Moreover, some of the disputed domain names were used for fraudulent activities which certainly cannot constitute legitimate interest in respect of such disputed domain names.

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Panel agrees with the Complainant that given the distinctiveness of the Complainant's Trademarks and their reputation, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of Complainant's Trademarks. In this respect, the Panel also deems appropriate to refer to paragraph 2 of the Policy under which it is the responsibility of the Respondent as the registrant of disputed domain names to determine whether its registration infringes or violates someone else's rights.

In the light of the above circumstances the Panel failed to find any plausible good faith reasons for registration and use of the disputed domain names by the Respondent. The Respondent has not submitted any response to the Complaint and therefore has not presented any facts or arguments that could counter the above conclusions of the Panel. Moreover, some of the disputed domain names were used for fraudulent e-mail activities where the Respondent exploited the false association with the Complainant's brand to disseminate malicious content from e-mail addresses created under the disputed domain names. Such conduct is clear evidence of bad faith of the Respondent in registration and use of the disputed domain names in question.

As a result, the Panel holds that the disputed domain names have been registered and are being used by the Respondent in bad faith (within the meaning of 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. **burberrymail.site**: Transferred
2. **burberryceo.site**: Transferred
3. **burberrymail.shop**: Transferred
4. **burberrymail.space**: Transferred
5. **burberry-mail.shop**: Transferred

PANELLISTS

Name	**Michal Matějka**

DATE OF PANEL DECISION 2024-04-20

Publish the Decision