Decision for dispute CAC-UDRP-106323

Case number	CAC-UDRP-106323
Time of filing	2024-03-15 10:01:45
Domain names	continentalsuomi.com, continentaldanmark.com, continentalsverige.com, continentalnorge.com, continentalbelgique.com, continentalcanada.com, continentalsouthafrica.com, continentalsuisse.com, continentalireland.com, continentalaustralia.com, continentaldeutschland.com, continentalfrance.com, continentalbelgie.com, continentalitalia.com, continentalnederland.com, continentalespana.com, continentalschweiz.com, continentalosterreich.com, continentalportugal.com, continentalmagyarorszag.com, continentalbulgaria.com, continentallietuva.com, continentalslovenija.com, continentalsrbija.com, continentalromania.com, continentalgreece.com, continentalturkiye.com, continentaleesti.com, continentalchile.com, continentalhrvatska.com, continentalcolombia.com, continentalmexico.com, continentaluruguay.com, continentalargentina.net, continentalisrael.com, continentaljapan.com, continentalkuwait.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Continental Reifen Deutschland GmbH

Complainant representative

Organization	Göhmann Rechtsanwälte Abogados Advokat Steuerberater Partnerschaft mbB

Respondents

Name	Charlie Long
Name	Dylan Pratt
Name	James Booth
Name	Maya Howe
Name	Amber Eliott

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 Complaint is based on several trademarks of the Complainant which consist or include the sign "Continental" and which are registered in several countries worldwide for different goods and services in different classes. Among these trademarks, the Complainant cites in particular the following:

- CONTINENTAL (figurative), International registration No. 1196449, registered on 9 August 2013, for goods and services in classes 01, 04, 06, 07, 08, 09, 11, 12, 16, 17, 18, 19, 20, 22, 24, 25, 28, 35, 37, 40, 41, 42, designating various jurisdictions worldwide;

- CONTINENTAL (figurative), International registration No. 1462355, registered on 24 May 2018, for goods and services in classes 04, 07, 09, 11, 12, 17, 27, 37, 38, 42, designating various jurisdictions worldwide;

- CONTINENTAL (figurative), International registration No. 876054, registered on 18 July 2005, for goods and services in classes 01, 06, 07, 09, 12, 14, 16, 17, 18, 19, 20, 22, 24, 25, 28, 35, 37, 40, 41, 42, designating various jurisdictions worldwide;

- CONTINENTAL (figurative), International registration No. 455510, registered on 1 July 1980, for goods and services in classes 01, 07, 09, 12, 16, 17, 20, 24, 25, designating various jurisdictions worldwide;

- CONTINENTAL (word), International registration No. 159256, registered on 28 January 1952, for goods and services in classes 01, 02, 03, 04, 05, 06, 07, 08, 09, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 34, designating various jurisdictions worldwide, including Italy;

- CONTINENTAL (figurative),International registration No. 1767662, registered on 22 December 2022, for goods and services in classes 01, 06, 07, 08, 09, 10, 11, 12, 14, 15, 16, 17, 18, 19, 20, 21, 22, 24, 25, 27, 28, 30, 35, 36, 37, 38, 39, 40, 41, 42, designating various jurisdictions worldwide;

- CONTINENTAL (figurative), EUTM registration No. 17555731, registered on 22 May 2020, for goods and services in classes 1, 4, 6, 7, 8, 9, 10, 11, 12, 14, 16, 17, 18, 19, 20, 22, 24, 25, 27, 28, 35, 37, 38, 40, 41, 42;

- CONTINENTAL (figurative), EUTM registration No. 017563032, registered on 5 December 2017, for goods and services in classes 1, 4, 6, 7, 8, 9, 10, 11, 12, 14, 16, 17, 18, 19, 20, 22, 24, 25, 27, 28, 35, 37, 38, 40, 41, 42.

Further, the Complainant holds rights in its company name, which is Continental Reifen Deutschland GmbH, and is the owner of a number of domain names, including <continental-reifen.de/continental-tyre.com>, which resolves to the Complainant's official website, and <continental.com>.

FACTUAL BACKGROUND

The Complainant is a German company part of the Continental-Group. Founded in 1871, the Complainant's group offers safe, efficient, intelligent and affordable solutions for vehicles, machines, traffic and transportation at an international level. The Complainant is one of the world's leading tyre manufacturers.

The disputed domain names have all been registered on 9 November 2023.

The disputed domain names <continentalsuomi.com>, <continentaldanmark.com>, <continentalsverige.com>, <continentalnorge.com>, <continentalbelgique.com>, <continentalcanada.com>, <continentalsouthafrica.com>, <continentalsuisse.com>, <continentalireland.com> and <continentalaustralia.com> have been registered by the Respondent Charlie Long.
The disputed domain names <continentaldeutschland.com>, <continentalfrance.com>, <continentalbelgie.com>, <continentalitalia.com>, <continentalnederland.com>, <continentalespana.com>, <continentalschweiz.com>, <continentalosterreich.com> and <continentalportugal.com have been registered by the Respondent Dylan Pratt.
The disputed domain names <continentalmagyarorszag.com>, <continentalbulgaria.com>, <continentallietuva.com>, <continentalslovenija.com>, <continentalsrbija.com>, <continentalromania.com>, <continentalgreece.com>, <continentalturkiye.com> and <continentaleesti.com> have been registered by the Respondent James Booth.
The disputed domain names <continentalchile.com>, <continentalhrvatska.com>, <continentalcolombia.com>, <continentalmexico.com>, <continentaluruguay.com> and <continentalargentina.net> have been registered by the Respondent Maya Howe.
The disputed domain names <continentalisrael.com>, <continentaljapan.com> and <continentalkuwait.com> have been registered by the Respondent Amber Elliott.

The disputed domain names resolve to websites displaying, and purportedly offering for sale, tyres bearing the Complainant’s mark at discounted prices.

On March 1, 2024 and on March 7, 2024, the Complainant sent to the Registrar of the disputed domain names two cease and desist letters. In said letters, the Complainant informed the Registrar of the Complainant's earlier rights on the CONTINENTAL mark and asked for the Registrar’s assistance to remedy to the registration and use of the allegedly infringing disputed domain names.

Moreover, the Complainant asked the Registrar to provide the contact information of the holders of the disputed domain names. Neither the Registrar, nor the Respondents, replied to the Complainant's cease and desist letters.

PARTIES CONTENTIONS

Preliminary, the Complainant requests the consolidation of the Respondents in respect of the disputed domain names, maintaining that all of them are under common control. In particular, the Complainant notes similarities in the naming pattern of the disputed domain names as all of them contain the word “continental”, combined with a geographical indicator. Moreover, the Complainant points out that the content on the disputed domain names has exactly the same layout, headers, footers and products offered for sale. The disputed domain names were registered by the various Respondents within a closely aligned timeframe and all the disputed domain names have the same Registrar. The contact details of the registrants of the disputed domain names are also similar, especially the city and country of the registrants is the same and the provided email addresses have a similar pattern.

The Complainant contends that the disputed domain names are confusingly similar to the Complainant's mark as they all include the trademark CONTINENTAL together with different country names. The country names will be seen as an intention to refer to a country version of the Complainant's website at "www.continental.com".

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain names. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent is not a licensee of the Complainant's mark and the Complainant did not authorise the Respondent to make any use of its CONTINENTAL mark, including as part of domain names. The Respondent has not been commonly known by the disputed domain names. Considering the history and the economic success of the Complainant and its group under the trademark / tradename CONTINENTAL, this sign is exclusively associated with the Complainant and its group of companies throughout the world. Before any notices about the administrative proceedings were sent to the Respondents, there is no evidence of the Respondent’s use of the disputed domain names in connection with a bona fide offering of goods or services. The Respondent does not use the disputed domain names as a legitimate noncommercial or fair use. The disputed domain names resolve to websites that are copies of the Complainant's official website where the Respondent offers counterfeit Complainant's products or at least collects customers' information. According to the Complainant, customers who bought products on the Respondent's websites never received them. Accordingly, the Complainant maintains that the Respondent intends to use the disputed domain names to misleadingly divert consumers or to tarnish the Complainant's mark.

Lastly, the Complainant maintains that the disputed domain names have been registered and are being used in bad faith. The Complainant's trademark CONTINENTAL is internationally well-known. Moreover, this trademark is exclusively associated to the Complainant as evidenced by an Internet search on the Google search engine. Therefore, the Respondent clearly knew the Complainant and its CONTINENTAL trademark when it registered the disputed domain names. The Respondent is using the disputed domain names to promote goods identical to those that the Complainant sells under the CONTINENTAL trademark. Accordingly, the Complainant affirms that the Respondent is using the disputed domain names to intentionally attempt to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s websites. Moreover, the Complainant sent the Registrar of the disputed domain names a letter asking to take down the disputed domain names and/or to provide the Complainant with the information of the Registrants before commencing this UDRP proceedings. However, the Complainant never received a reply to its letter. This should be considered further evidence of bad faith in the registration and use of the disputed domain names.

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

1. Preliminary Considerations - Consolidation

This case concerns a Complaint against five Respondents. The Complainant has requested to consolidate the Respondents into a single Complaint as all the disputed domain names are under a common control. Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided the domain names are registered by the same domain-name holder. According to section 4.11.2, of the WIPO Overview Jurisprudential Overview 3.0 (hereinafter the "WIPO Overview"), a consolidation of multiple respondents is possible whenever the domain names are subject to common control and the consolidation would be fair and equitable and procedurally efficient to all parties.

Panels have considered a range of factors, typically present in some combination, as useful to determine whether such consolidation is appropriate, such as similarities in or relevant aspects of: (i) the registrants' identities and/or contact information including email and/or postal addresses, or phone numbers, including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhosts, (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue, (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent's behaviour, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

In the case at issue, the Panel notes that all the disputed domain names have been registered on the same day and within a very short time span. All the Respondents have similar contact details: they are all based in Bologna, Italy, their email addresses are all similar as they all consist of the Respondent's name followed by a number and ending with "@cxtmail.com". Furthermore, all the disputed domain names have the same Registrar and the same name pattern consisting of the Complainant's trademark CONTINENTAL followed by a country name in the language of the relevant country. The Respondent's websites are also very similar. They all have the same layout, display the same type of products and offer discounts. The only differences among the websites lie in the language of their contents and in the currency displayed, which may occasionally vary according to the type of currency adopted in the relevant country.

The Panel thus concludes that on the balance of probabilities it is likely that the disputed domain names are under common control. The five Respondents did not react to the Complainant's request for consolidation. Accordingly, the Panel finds that it is appropriate in this case to allow consolidation as it increases the efficiency of the proceeding without affecting the right of the parties to be equally treated.

In the rest of this decision, the five Respondents are collectively referred to as the "Respondent".

2. Confusing Similarity

The Complainant has shown that it is the owner of the trademark CONTINENTAL, registered in various jurisdictions worldwide since as early as 1952. All the disputed domain names consist of the CONTINENTAL mark followed by a country name.

It is well accepted that the first element functions primarily as a standing requirement. The standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (section 1.7 of the WIPO Overview). As highlighted above, all the disputed domain names incorporate the Complainant's CONTINENTAL mark followed by a geographical indicator. The Complainant's mark is the first element of the disputed domain names and therefore is clearly recognizable. In light of this circumstance, the addition of geographical terms would not prevent a finding of confusing similarity under the first element (section 1.8 of the WIPO Overview).

For all the reasons mentioned above, the Complainant is satisfied that the first condition under the Policy is met.

3. Rights or Legitimate Interests

As also confirmed in the WIPO Overview, a 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, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Based on the available evidence, the Respondent does not appear to be commonly known by the disputed domain names. The Respondent is not affiliated, nor is engaged in any business with the Complainant. The Respondent is not a licensee of the CONTINENTAL mark, nor was ever authorised to include the Complainant's mark in the disputed domain names. UDRP panels have largely held that the composition of a domain name consisting of a trademark plus an additional term cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The addition of a geographical term to a domain name is usually seen as tending to suggest sponsorship or endorsement by the trademark owner (section 2.1.1. of the WIPO Overview). The disputed domain names are highly misleading for the potential customers looking for the Complainant and its products on the Internet since they could easily believe that they have reached the Complainant's local websites. Moreover, the Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services. At the time of the filing of the Complaint, the disputed domain names resolved to websites in the languages of the geographical designations of each of the disputed domain names, displaying the Complainant's figurative trademark and offering for sale alleged Complainant's tyres at discounted prices. In light of the general powers conferred to the Panel, inter alia by paragraphs 10 and 12 of the UDRP Rules, the Panel has reviewed the contents of the Respondent's websites and noticed that at the bottom of their home pages they include a 2024 copyright notice where the Complainant's mark is associated with the name of the country corresponding to the disputed domain names. None of the websites contains a disclaimer informing Internet users of the lack of association with the Complainant. Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (section 2.13.1. of the WIPO Overview).

Accordingly, the Panel finds that the Complainant has successfully established a prima facie case that the Respondents lacks rights or legitimate interests in the disputed domain names. The Respondent has failed to rebut to the Complainant's arguments. Therefore, the Panel is satisfied that also the second condition of the Policy is met.

4. Bad faith

As far as bad faith is concerned, the Panel notes that the Complainant contends that its CONTINENTAL mark enjoys reputation. In a prior UDRP decision, the panel found that the CONTINENTAL trademark enjoyed reputation (see Continental Reifen Deutschland GmbH v. Goldman David, AUTO-SCANER Ltd., WIPO Case No. D2016-1449). Moreover, the first results of an Internet search the keyword "continental" has returned hits exclusively related to the Complainant. It is therefore highly likely that the Complainant was aware of the Complainant's mark when it registered the disputed domain names. This prior knowledge appears to be confirmed by the high number of domain names registered and the pattern of these domain names, all incorporating the CONTINENTAL mark followed by a geographical designation, and by the corresponding websites' contents. These websites also display the Complainant's figurative trademark in a prominent way, include the word mark CONTINENTAL in the copyright notice, and promote the sale of alleged Complainant's goods at discounted prices. The registration of the disputed domain names incorporating a third party's well-known and distinctive mark without rights or legitimate interests amounts to registration in bad faith.

The Respondent is using the disputed domain names to capitalize on the Complainant's CONTINENTAL marks for potential phishing purposes. The Respondent has in fact been using the disputed domain names to intentionally attempt to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites. Previous UDRP panels have held that the use of a domain name for illegal activity as applicable to this case such as the sale alleged counterfeit copies of the Complainant's products at discounted prices constitutes bad faith (see section 3.4 of the WIPO Overview).

Moreover, the Respondent failed to reply to the Complainant's warning letter sent before the filing of the Complaint. This lack of cooperation from the Respondent is further evidence of the Respondent's bad faith.

In light of the circumstances reported above, the Panel finds that the Complainant has established the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **continentalsuomi.com**: Transferred
2. **continentaldanmark.com**: Transferred
3. **continentalsverige.com**: Transferred
4. **continentalnorge.com**: Transferred
5. **continentalbelgique.com**: Transferred
6. **continentalcanada.com**: Transferred
7. **continentalsouthafrica.com**: Transferred
8. **continentalsuisse.com**: Transferred
9. **continentalireland.com**: Transferred
10. **continentalaustralia.com**: Transferred

11. **continentaldeutschland.com**: Transferred
12. **continentalfrance.com**: Transferred
13. **continentalbelgie.com**: Transferred
14. **continentalitalia.com**: Transferred
15. **continentalnederland.com**: Transferred
16. **continentalespana.com**: Transferred
17. **continentalschweiz.com**: Transferred
18. **continentalosterreich.com**: Transferred
19. **continentalportugal.com**: Transferred
20. **continentalmagyarorszag.com**: Transferred
21. **continentalbulgaria.com**: Transferred
22. **continentallietuva.com**: Transferred
23. **continentalslovenija.com**: Transferred
24. **continentalsrbija.com**: Transferred
25. **continentalromania.com**: Transferred
26. **continentalgreece.com**: Transferred
27. **continentalturkiye.com**: Transferred
28. **continentaleesti.com**: Transferred
29. **continentalchile.com**: Transferred
30. **continentalhrvatska.com**: Transferred
31. **continentalcolombia.com**: Transferred
32. **continentalmexico.com**: Transferred
33. **continentaluruguay.com**: Transferred
34. **continentalargentina.net**: Transferred
35. **continentalisrael.com**: Transferred
36. **continentaljapan.com**: Transferred
37. **continentalkuwait.com**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2024-04-20

Publish the Decision