Decision for dispute CAC-UDRP-106400

Case number	CAC-UDRP-106400
Time of filing	2024-04-09 09:43:40
Domain names	instant-online.shop

Case administrator

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

Complainant

Organization	IB Appliances US Holdings, LLC

Complainant representative

Organization	Stobbs IP

Respondent

Name	Zhen Sheng Dai

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 INSTAND and INSTANT-formative trademarks in a number of jurisdiction, including but not limited to the following trademark registrations:

- International trademark INSTANT No. 1511837, registered on June 17, 2019 designating CN;
- International trademark INSTANT No. 1514565, registered on June 17, 2019 designating CN;
- International trademark INSTANT No. 1519935, registered on June 17, 2019;
- International trademark INSTANT No. 1523958, registered on June 17, 2019.

FACTUAL BACKGROUND

Since launching the INSTANT POT branded multicooker in 2008, the Complainant has gained widespread acclaim and commercial success. On Amazon Prime Day 2016, the Instant Pot multicooker sold 215,000 units alone. The Complainant has extensive reach offering its products and services worldwide.

The Complainant has an active online presence including owning the domain name <instanthome.com> which is used for the main operating website on <instanthome.com>, with the website being live since at least as early as 22 May 2009.

The Complainant is also active on social media and has generated a significant level of endorsement as shown below:

https://www.facebook.com/instantpot/ (805,000+ followers)
https://www.instagram.com/instantpotofficial/ (524,000+ followers)
https://twitter.com/instantpot (23,000+ followers)

The Respondent appears to be an individual based in Shandong, China.

The disputed domain name was registered on May 30, 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 INSTANT mark through its international trademark registrations for INSTANT POT, INSTANT CONNECT, INSTANT CRISP, INSTANT BRANDS, CONNECT, and INSTANT OVEN. By virtue of its trademark registrations, the 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 non-distinctive term "online". The inclusion of the non-distinctive term does nothing to alter the overall impression in the eyes of the average Internet user and the TLD suffix '.shop' can be omitted when assessing the disputed domain name, as it is merely a technical requirement, used for domain name registrations.

By doing a side-by-side comparison, the Panel agrees that the disputed domain name is confusingly similar to Complainant's trademark, see Intesa Sanpaolo S.p.A. v. Gabriella Campora, 104465 (CAC 2022-05-02) ("Addition of a non-distinctive element – descriptive term "ONLINE" - cannot prevent the association in the eyes of internet consumers between the disputed domain names and the Complainant's trademarks and thus the likelihood of confusion still exists. On the contrary, it may mislead the internet users that the disputed domain name is somehow related to Complainant's internet (online) business.").

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 Respondent has never legitimately been known by the name INSTANT at any point in time. Furthermore, the Respondent is using the disputed domain name to resolve to an active website impersonating as the Complainant and offering for sale and/or advertising the sale of counterfeit product infringing various intellectual property rights held by the Complainant.

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

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 reiterates that its INSTANT trademarks predate the registration of the disputed domain name and the INSTANT brand enjoys a wide reputation. Furthermore, the Respondent was unequivocally aware of the INSTANT brand and INSTANT POT product line, given the website resolved by the disputed domain name is offering for sale counterfeit INSTANT branded goods. Therefore, the Complainant submits that the Respondent had knowledge of INSTANT and that the disputed domain name is registered with the sole purpose of targeting the Complainant's INSTANT trademarks.

The Complainant also submits that the Respondent has registered the disputed domain name in bad faith by intentionally attempting to attract, for commercial gain, Internet users to the website resolved by the disputed domain name by creating a likelihood of confusion with the Complainant's INSTANT trademarks as to the source, sponsorship, affiliation, or endorsement of the Infringing Website under Policy, Paragraph 4(b)(iv). Furthermore, the Complainant alleges that the Respondent disrupts the Complainant's business by diverting potential customers to the Infringing Website selling counterfeit product. Using a confusingly similar domain name in a manner disruptive of a Complainant's business by trading upon the goodwill of a Complainant for the commercial gain evinces bad faith under paragraph 4(b)(iii) and (v) of the Policy. The Complainant asserts that the goods offered on the website resolved by the disputed domain name were counterfeit, therefore the disputed domain name is used to disrupt the Complainant's business.

Having reviewed the website content resolved by the disputed domain name, the Panel is of the view that the Respondent does have actual knowledge of Complainant's INSTANT trademark during the registration of the disputed domain name. 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.") See also TOD'S S.p.A. v. Lang Shunan, 105947 (CAC 2023-12-11).

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.

PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreement is Chinese as confirmed by the Registrar. The Complaint was submitted in English and no Response was received within the required period of time. Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests to use English as the language of proceeding, with the arguments that the disputed domain name contains Latin characters and the content accessible via the disputed domain name is also in English. This supports the fact that the Respondent understands, or at the very least, is competent in the English language and that they would not put at a disadvantage, if the Complaint is to be conducted in English. The Complainant further argues that translating the Complaint into Chinese would imply significant of time to the Complainant and also delay the proceedings.

The Panel is bilingual and well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances and with Respondent's default, the Panel is of the view that English is the most widely spoken language in the world and there is no evidence showing that the Respondent cannot understand English. The Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied, and decides that the language of proceeding to be English.

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. **instant-online.shop**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-05-02

Publish the Decision