Decision for dispute CAC-UDRP-106348

Case number	CAC-UDRP-106348
Time of filing	2024-04-05 09:39:04
Domain names	aman.gifts

Case administrator

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

Complainant

Organization	Aman Group S.á.r.l.

Complainant representative

Organization	HSS IPM GmbH

Respondent

Organization	Aman Gifts

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

Complainant is the owner of several trademark registrations for the mark "AMAN", either as a word or in stylized letters, including, but not limited to, European Union trademark No. 5892757 for the word "Aman", registered on March 4, 2008, and International Trademark Registration No. 1295187 for the word "AMAN" in stylized letters, registered on August 14, 2015 for, inter alia, Bahrain, where Respondent is alleged to be located according to WHOIS.

FACTUAL BACKGROUND

Complainant is a luxury hotel and lodging company with approximately 35 destinations in 20 countries.

Complainant also owns the domain name <aman.com>, which was registered on July 22, 1997.

The disputed domain name <aman.gifts> was registered on December 10, 2023.

PARTIES CONTENTIONS

1. **Complainant**

The Complainant argues that the disputed domain name is confusingly similar to the Complainant's trademark, noting that the domain name contains its trademark AMAN in its entirety.

The Complainant contends, with reference to the WIPO Overview, that the addition of the generic Top-Level Domain (gTLD) ".gifts" is a standard registration requirement and, as such, should be disregarded under the first element of the confusing similarity test.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant notes that the disputed domain name is not used in connection with a bona fide offer of goods or services, noting that the disputed domain name does not resolve to an active website, but instead redirects to the parking page hosted by Hover, which states that ''byaman.co is a totally awesome idea still being worked on. Check back later. The Complainant is also concerned that there may be more malicious intent motivating the registration of the disputed domain name due to the presence of active Mail Exchange Records (MX records).

Further, the Complainant alleges that the Respondent is not commonly known by the domain name. According to the WHOIS information, the Respondent's first name is "Aman" and his last name is "Gifts". However, there is no indication that the Respondent is actually called "Aman Gifts," which appears to be a pseudonym rather than an indication that the Respondent is commonly known by that name. Furthermore, when the terms "AMAN" and "AMAN GIFTS" are entered into the Google search engine, the results returned are indicative of the Complainant and its business.

Finally, Complainant contends that it has found no evidence that Respondent has any known legitimate, non-commercial use of the disputed domain name.

Complainant alleges that Respondent has registered and is using the disputed domain name in bad faith. Complainant's AMAN trademarks long predate the registration of the disputed domain name, and Respondent was never authorized by Complainant to register it, nor does Complainant have any affiliation with Respondent. Complainant's active business presence in various markets and on a significant scale throughout the world makes it apparent that Respondent was aware that the registration of the disputed domain name was unauthorized and improper.

The Complainant contends that its trademark is widely known in the luxury gift and hospitality industry and that, in this case, the deliberate combination of the trademark "AMAN" with the chosen top-level domain "GIFT" suggests an association with the Complainant's activities in the luxury gift industry - indicating that the Respondent was aware of the Complainant and its trademarks at the time the disputed domain name was registered. Complainant asserts that the prior panels also confirmed the notoriety of Complainant's AMAN mark.

Complainant further alleges that the disputed domain name has been set up with MX records that would allow e-mails to be sent from an "aman.gifts" email address that would likely lead a recipient to believe that it is a legitimate communication from Complainant, or at least somehow associated with or endorsed by Complainant. This is of great concern to Complainant, as there can be no ''good'' reason for a party to be able to impersonate Complainant with respect to a domain called ''aman.gifts.''

The Respondent failed to respond to a Cease and Desist Letter sent to the Respondent in which the Complainant advised that the unauthorized use of its trademark in the disputed domain name violated the Complainant's trademark rights and requested a voluntary transfer of the disputed domain name.

To date, Respondent has not actively used the disputed domain name for a legitimate website. Further, Complainant alleges that Respondent has concealed its true identity and used false contact information, noting that "Aman Gifts" does not appear to be a real name and that the street address only mentions "Bahrain, Manama, Capital" with the postal code 973, which is the country code for Bahrain and, to Complainant's knowledge, is not a postal code.

Finally, Complainant's trademark registrations long predate Respondent's registration of the disputed domain name, as Complainant's trademark AMAN was filed in 2000, while the disputed domain name was registered in 2024. This constitutes bad faith because there is a gap of more than ten years between Complainant's trademark registrations and Respondent's registration of the disputed domain name.

2. **Respondent**

No administratively compliant response has been submitted by the Respondent.

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 has successfully demonstrated that it is the rightful owner of the trademark "AMAN". The Panel recognizes that the Complainant's trademark AMAN is the only distinctive element of the disputed domain name, while the .gifts gTLD must be disregarded for purposes of the confusing similarity analysis under the first element.

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).

A complainant is required to establish a prima facie case that the respondent lacks rights or legitimate interests. Once such a case is made, the burden of proof shifts to the respondent to demonstrate their rights or legitimate interests in the disputed domain name. Failure to do so results in the complainant satisfying paragraph 4(a)(ii) of the Policy (as per Article 2.1 of WIPO Jurisprudential Overview 3.0 and WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

Based on the contentions of the Complainant, the Panel finds that the Complainant has successfully established a prima facie case that the Respondent lacks rights or legitimate interests. The Panel also notes that the Respondent is registered in the WHOIS as Aman Gifts. In the Panel's view, the mere presence of the name Aman Gifts in the Respondent's contact information does not in itself demonstrate that the Respondent is known by the domain name, and without further allegations and evidence to support this indication, which the Respondent has failed to provide, the Panel cannot conclude that such rights exist.

As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

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).

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark (see Article 3.1. of WIPO Jurisprudential Overview 3.0).

Registration in bad faith

In determining whether the disputed domain name was registered in bad faith, the Panel specifically considered the following factors

(a) The reputation and acquired distinctiveness of the AMAN marks. The Panel finds that the evidence submitted by the Complainant in this proceeding and the reference to prior UDRP decisions in which the reputation of the AMAN mark has been recognized by various UDRP panels (e.g., CAC-UDRP-106335 <amanresidensesmiami.com>) are sufficient to establish the reputation of the Complainant's mark. In considering whether this Panel may rely on prior UDRP decisions in which the reputation of the AMAN mark has been recognized by different UDRP panels, the Panel has considered Article 4.1 of the WIPO Jurisprudence Overview 3.0 and finds it consistent with the conclusion that, in the same or similar circumstances, recognition of a mark's reputation in a prior UDRP decision should be considered as a factor in determining whether the complainant's mark enjoys such reputation. On this basis, the Panel concludes that the Complainant has sufficiently demonstrated that the AMAN mark has a reputation worldwide.

(b) The long-term registration of the Complainant's trademark AMAN, while the disputed domain name was registered in December 2023.

(c) That the Respondent's AMAN trademark is registered in Bahrain and that the Respondent also claims to be domiciled in Bahrain.

(d) That the Respondent has used the .gifts gTLD, while the Complainant is also known for offering luxurious "gifts", as confirmed by Google search results.

Based on the foregoing, the Panel concludes that the Respondent must have been aware of the Complainant and its trademark when it registered the disputed domain name.

Therefore, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Use in bad faith

The disputed domain name contains the Complainant's trademark in its entirety, creating an impression of association with the goods/services marketed by the Complainant and creating a likelihood of confusion with the AMAN trademark. This is supported by the fact that the disputed domain name is registered in the .gifts gTLD, which is the product for which the Complainant is best known.

There is no active website associated with the disputed domain name. In this regard, the Panel considered whether, in the circumstances of this particular case, the Respondent's passive holding of the disputed domain name could be considered a use of the disputed domain name in bad faith. According to the WIPO Jurisprudence Overview 3.0, non-use of a domain name would not preclude a finding of bad faith under the passive holding doctrine. Factors considered relevant in applying the passive holding

doctrine include (i) the degree of distinctiveness or reputation of the complainant's mark; (ii) the respondent's failure to file a response or to provide evidence of actual or intended good faith use; (iii) the respondent's concealment of its identity or use of false contact information (in violation of its registration agreement); and (iv) the implausibility of any good faith use to which the domain name might be put (see also Telstra Corporation Limited vs. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>).

In the circumstances of this case, the Panel finds that the Complainant has successfully demonstrated the acquired distinctiveness and reputation of the Complainant's AMAN mark. In addition, the Panel notes that the Respondent has not provided any response or evidence of actual or intended use in good faith and nor has it responded to the Complainant's cease and desist letter.

Finally, the Panel verified that MX records were set up for the disputed domain name. An MX record is a resource record in the Domain Name System that specifies which e-mail server is responsible for accepting e-mail on behalf of a domain name (see WIPO Case No. D2022-0479 CKM Holdings Inc. v. Grant Chonko, Genesis Biosciences). The Panel notes that it is not necessary to assign MX records to a domain name if the registrant does not intend to use the domain name to send and receive e-mail. The activation of MX records to designate an e-mail server and enable e-mail is an action that goes beyond the mere registration of the disputed domain name and indicates that the Respondent has associated the disputed domain name with e-mail servers, which creates a risk that the Respondent may use the disputed domain name for misrepresentation and/or phishing and spamming activities.

Therefore, the Panel is satisfied that the totality of the circumstances of this case supports a finding that the Respondent's failure to use the domain name for a functional website, coupled with the setting of MX records, supports the Panel's finding that the disputed domain name is being used in bad faith.

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

The Panel has determined that the disputed domain name is identical with the Complainant's trademark.

Based on the contentions presented by the Complainant, the Panel has found that the Complainant has satisfactorily made a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

The Panel finds that, based on the Complainant's contentions and evidence, it can be concluded that the Respondent must have been aware of the Complainant's trademarks when it registered the disputed domain name, and as such, the Respondent has registered the disputed domain name in bad faith.

Lastly, the Panel has concluded that the Complainant has successfully proven that the disputed domain name is being used in bad faith.

Therefore, for the aforementioned reasons, the Panel orders that the disputed domain name <aman.gifts> 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. **aman.gifts**: Transferred

PANELLISTS

Name	**Karel Šindelka**

DATE OF PANEL DECISION 2024-05-27

Publish the Decision