Decision for dispute CAC-UDRP-106469

Case number	CAC-UDRP-106469
Time of filing	2024-05-13 10:14:23
Domain names	workproespana.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	Chloe Clements

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, HangZhou Great Star Industrial Co., Ltd., is the owner, among others, of the following trademark registrations:

- EU Trade Mark No. 018054598 for WORKPRO, registered on 11 September 2019, designating goods and services in the International Class 20;
- EU Trade Mark No. 018494851 for WORKPRO, registered on 15 October 2021, designating goods and services in international classes 6-9, 11, 12, 17, 18, 20, 21.

Complainant has submitted evidence of the above-mentioned registrations.

Complainant also submits certificates of other trademark registrations but as they are not in English, the Panel will disregard them. Besides that, those are also not mentioned in the Complaint itself.

Respondent registered the domain name <workproespana.com> on 9 November 2023.

FACTUAL BACKGROUND

Complainant, HangZhou Great Star Industrial Co., Ltd., was established in 1993 in China and is active in the tools & storage industry. Their main products include hand tools, storage-, power tools and laser measurement and power stations. All are mainly used in the fields of home maintenance, construction, vehicle maintenance, map measuring and surveying, and home energy management. The biggest share of the business is the home building industry and its related repair and maintenance.

Complainant alleges that it is the number one market player in Asia in this industry and belongs to the top 6 of biggest market players in the world.

WORKPRO is one of Complainant's most important trademarks. It is used for a well-known hand tool consisting of 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 'do it yourself' consumers and professional users with a full range of tool solutions

The products under the trademark WORKPRO are marketed in a large number of 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. Further WORKPRO has production, sales and service partners in 21 sites around the world, and its products are exported all over the world. Also, E-Commerce has become a large part of the turnover of Complainant. 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. Part of the revenues are related to WORKPRO. The annual report is included in the Complaint.

Complainant further encloses an award and examples of participation in exhibitions between 2021 and 2023 all over the globe. Also, Complainant alleges that their research and development activities are big. This can be read in the annual report of 2022 which is enclosed in the Complaint. During the 2022 reporting period, 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.

According to Complainant WORKPRO is a highly recognizable brand in the world and this is demonstrated with a Google search on WORKPRO that shows that the vast majority of results refer to Complainant in the 8 pages enclosed.

Respondent is an individual named Chloe Clements with a telephone number in Spain and a physical address in Italy.

Respondent is selling hand tools on which the trademark WORKPRO is applied under the disputed domain name.

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

According to the Policy paragraph 4(a)(i) it needs first to be established that:

(i)The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Erroneously mentioning of wrong trademark

In its Complaint, Complainant describes its two European trademark rights with registration numbers and dates and Complainant mentions that these belong to the trademark ZENDURE. However, in the enclosures it appears that the numbers and registration dates belong to the trademark WORKPRO.

The Panel has to decide whether the invoked trademark rights are admissible now that the information in the Complaint and the information in the enclosure do not correspond.

According to article 10 of the UDRP Rules 'General Powers of the Panel' it is determined under (d):

The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

It follows from this rule that the Panel may consider the material submitted at its own discretion.

The Panel concludes that the evidence submitted is in line with the purpose of the Complaint at stake and as it is official evidence, originating from the European Office for Intellectual Property, it will put more weight to the present Complaint than the wordings in the Complaint itself, written by an attorney representing Complainant. The Complaint wordings mentioning ZENDURE instead of WORKPRO must be an overlook when using a former Complaint as template for writing the present Complaint.

The Panel will thus rely on the evidence instead of Complainant's statement as the Panel considers that the evidence is the determinative factor in the Complaint, not an erroneously mentioned wrong trademark name.

Comparison of trademark and disputed domain name

Complainant alleges that the disputed domain name <workproespana.com> consists of combination of ”workpro” and ”espana”, and ”espana” is a commonly used English word, mainly used as a noun, and its meaning is equal to Spain. Complainant alleges that Espana is not part of the trademark, that is only WORKPRO.

The Panel cannot follow the reasoning of Complainant but at its own discretion concludes that Complainant may have meant that WORKPRO is the part of the disputed domain name that must be compared with the invoked trademark as Espana is a geographical indication referring to the country where the products can be bought, which is Spain. The Spanish people to which the disputed domain name is directed will understand Espana as a geographical indication as it means Spain in Spanish. Thus, the part ‘Espana’ of the disputed domain name is not part of the invoked trademark but merely describes where the trademark is used. Therefore, the trademark used in the disputed domain name is identical to the invoked trademark or at least confusingly similar as Espana is just a descriptor and the fact that it is Spanish does not block the understanding of the word. In fact, it is a commonly used word.

Further, the trademark registrations of Complainant predate the registration of the disputed domain name and thus the trademark rights prevail.

Consequently, the Panel agrees with this assertion of Complainant that trademark and disputed domain name are identical or at least confusingly similar. For the sake of good order, the Panel here notes that it is standard practice to disregard the Top-Level suffix under the confusing similarity test, except where the applicable Top-Level suffix may itself form part of the relevant trademark, which is not the case here.

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 Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

According to the Policy paragraph 4(a)(ii) it needs further to be established that:

(ii) Respondent has no rights or legitimate interests in respect of the domain name

Paragraph 4 (c) of the Policy provides circumstances that could demonstrate that Respondent has no rights to and legitimate interests in the disputed domain name. These circumstances are not exclusive. Circumstance that are providing rights or legitimate interests to the domain name are:

(i) before any notice to the Respondent of the dispute, the use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if though it has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

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

Complainant alleges that Respondent has no rights on the disputed domain name, as it is not Complainant’s distributor or partner and Complainant never authorized, whether directly or indirectly Respondent to use the trademark WORKPRO and the disputed domain name

Further, Complainant provides screenshots of Respondent’s website showing that the disputed domain name effectively impersonates or suggests sponsorship or endorsement by the owner of the trademark and that does not constitute fair use.

Lastly, Complainant claims that it searched various national and regional trademark databases in the name of the Respondent and did not find that the Respondent had trademark rights in the name of WORKPRO.

The Panel notes that Respondent has no rights of its own and accepts as true that Respondent is not authorized to use Complainant’s trademark as Respondent did not counterargue.

The Panel further notes that Respondent sells hand tools, like Complainant, under the trademark WORKPRO under the disputed domain name. It is not clear whether these products are offered in connection with a bona fide offering of goods, meaning that the goods offered are genuine.

In case the goods offered under the disputed domain name are genuine there is a legitimate interest of using the trademark WORKPRO but this legitimate interest is bound by rules as set in the Oki Data Americas, Inc. v. ASD, Inc. Case No. D2001-0903, 6 December 2001, and since then called the Oki Data Test.

The Oki Data Test provide that an offering of goods or services in the circumstances set out above may be bona fide where all of the following conditions are met:

1. Respondent must actually be offering the goods or services at issue;
2. Respondent must use the relevant website to sell only the trademarked goods;
3. the site must accurately disclose the respondent's relationship with the trademark owner; and
4. Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

From the screenshots of the webpages of Respondent it is clear that rules 3 and 4 of the test are not met: Respondent is not disclosing a relationship with the trademark owner but rather is using the disputed domain name to create its own market under the trademark of Complainant.

Complainant has, to the satisfaction of the Panel, shown 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).

BAD FAITH

According to the Policy paragraph 4(a)(iii) it finally needs to be established that:

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

Paragraph 4 (b) of the Policy provides circumstances on that demonstrate that Respondent has registered and used the domain name in bad faith. These circumstances are not exclusive. Those circumstance are for example:

(i) circumstances indicating that Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Complainant asserts that its trademark WORKPRO has acquired a high degree of distinctiveness through Complainant's extensive use.

Complainant's worldwide reputation, and presence on the Internet, indicates that Respondent was or should have been aware of the trademark prior to registering the disputed domain name. Therefore, the registration of the disputed domain name is in bad faith.

Complainant alleges that Respondent's use of the disputed domain name to deliberately imitate Complainant's WORKPRO brand for profit is consistent with Policy 4B(iv):

by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Complainant therefore concludes that Respondent acted in bad faith by using the disputed domain name.

Based on the above the Panel has the following findings.

Bad faith circumstances occur mainly when a Respondent sees financial gain on riding on the coat tails of Complainant’s success. This is mostly profitable when Complainant has a reputation. Therefore, first it needs to be established whether Complainant has such a reputation.

To substantiate its reputation Complainant submits an annual report, industry honours certificate and pictures of participation in exhibitions between 2021 and 2023 in many countries in the world including China, Germany, United Arabic Emirates and southern Russia. Moreover, it shows that Complainant sponsored 8 Nascar Xfinity Series Races in 2021.

Further, Complainant submits a Google search on WORKPRO identifying its own brand with 8 pages of results.

On the reputation the Panel finds that, alt the above evidence material demonstrates sufficiently that Complainant’s trademark WORKPRO enjoys a reputation.

On the use of the disputed domain name through the underlying website Respondent is not disclosing his relationship with the trademark owner but rather is using the disputed domain name to create its own market under the trademark of Complainant. This will create a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s web site.

It is therefore likely that Respondent has chosen the disputed domain name in order to attract internet users to its website for commercial gain. Given that it is also demonstrated that Respondent uses the disputed domain name to sell identical goods under the website it is established according to the Panel that the disputed domain name is also used in bad faith.

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).

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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **workproespana.com**: Transferred

PANELLISTS

Name	**Marieke Westgeest**

DATE OF PANEL DECISION 2024-06-12

Publish the Decision