Decision for dispute CAC-UDRP-106470

Case number	CAC-UDRP-106470
Time of filing	2024-05-14 09:28:31
Domain names	workproportugal.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	HangZhou Great Star Industrial Co., Ltd.

Complainant representative

Organization	Chofn Intellectual Property

Respondent

Name	Hannah Savage

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 owns the EU trademark registration n. 018494851 “WORKPRO” (figurative), registered on October 15, 2021, for numerous goods in classes 6, 7, 8, 9, 11, 12, 17, 18, 20, 21.

The disputed domain name was registered on November 9, 2023, i.e., the Complainant’s trademark registration cited above predates the registration of the disputed domain name.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant was founded in 1993 and is active in the tools and storage industry. The Complainant’s main products include hand tools and related storage products, power tools, laser measurement, and power stations, which are used in various fields such as home maintenance, construction, or vehicle maintenance. The Complainant claims to be the leading manufacturer of such products in Asia and among the top six worldwide.

“WORKPRO” is one of Complainant's major private tool brands, which was created in 2009 and is marketed primarily (and well known) in the United States and Canada, with manufacturing, sales and service partners in 21 locations around the world.

The disputed domain name resolves to a website advertising the sale of various hand tools, power tools, and related storage solutions. The product name “WORKPRO” is used numerous times on the website.

The Complainant contends that the Respondent is neither affiliated with nor authorized by the Complainant in any way. The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s “WORKPRO” trademark, or to apply for registration of 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

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).

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).

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).

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 disputed domain name is confusingly similar to the Complainant’s trademark “WORKPRO”. The addition of the geographical term “...portugal” does not change the overall impression of the designation as being connected to the Complainant’s trademark “WORKPRO”.

The Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain name, nor is the Respondent commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

It is not clear whether or not the products being offered for sale on the Respondent’s website are genuine “WORKPRO” products, i.e., whether the Respondent is a legitimate reseller or distributor of the Complainant’s own products. It is possible that resellers, distributors, or service providers use domain names like the disputed domain name for a bona fide offering of goods and services (within the meaning of paragraph 4(c)(i) of the Policy), and thus have a legitimate interest in such domain name. However, under the well-established “Oki Data test” (see Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903, <okidataparts.com>; please see section 2.8 of the WIPO Jurisprudential Overview 3.0 for more details), the following cumulative requirements must be met in such cases:

(i) the Respondent must actually be offering the goods or services at issue;

(ii) the Respondent must use the site to sell only the trademarked goods or services;

(iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and

(iv) the Respondent must not try to "corner the market" in domain names that reflect the trademark.

The Respondent does not meet requirement (iii) and therefore fails the Oki Data test.

Given the Respondent's prominent use of the Complainant's "WORKPRO" name and logo on the website it is evident that the Respondent had the Complainant's trademark in mind when registering the disputed domain name. In the absence of a Response, the Panel infers that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to his website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of this website and the Respondent's services offered on it (within the meaning of paragraph 4(b)(iv) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **workproportugal.com**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2024-06-24

Publish the Decision