Decision for dispute CAC-UDRP-106524

Case number	CAC-UDRP-106524
Time of filing	2024-05-13 10:44:11
Domain names	oscaro.online

Case administrator

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

Complainant

Organization	OSCARO.COM

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Domain Name Privacy Inc

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 submitted evidence that it is the registered owner of the following trademark registrations:

- French word trademark “OSCARO” No. 3230038 registered since 11 June 2003;

- European figurative trademark “OSCARO” No. 018457859 registered since 28 December 2021;

- international trademark registration for the word “OSCARO” No. 950157 registered since 17 August 2007;

- international trademark registration for the logo “OSCARO” No. 1105585 registered since 27 October 2011.

FACTUAL BACKGROUND

The Complainant sells since 2001 new and original automotive spare parts as well as used automotive spare parts and car accessories to consumers through its websites and app. The Complainant has a strong reputation in the automotive spare parts market and is part of Parts Holding Europe Group, a European leader in the sale of auto parts which is owned by D’Ieteren Group SA.

The Complainant has registered 372 domain names, notably domain names containing the term “OSCARO”, in particular

<oscaro.com>, registered since 8 March 2000 which it has operated for many years in connection with the sale of automotive spare parts. The Complainant operates through several websites, such as <https://www.oscaro.com/>; <https://www.oscaro.es>; <https://www.oscaro.be>; <https://www.oscaro.de>; <https://www.oscaro.pt>.

The disputed domain name was registered on 26 March 2024 and redirects to a parking page containing commercial links. The disputed domain name has been offered for sale for USD 2,888. MX servers are configured in respect of the disputed domain name.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name, and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

The Complainant made the following contentions:

A. The Complainant contends that the disputed domain name is identical to the Complainant's trademarks as it contains the Complainant's trademark in its entirety, without addition or deletion, as well as its corporate name. Therefore, the disputed domain name is very likely to generate a significant likelihood of confusion in the mind of the public, which will think that the disputed domain name is derived from, or at least related to the trademarks owned by the Complainant. Besides, it is well established that the TLD is viewed as a standard registration requirement and as such is disregarded.

B. The Complainant suggests it has made a prima facie case that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Complainant further asserts that the Respondent: (i) is not identified in the Whois database as the disputed domain name; (ii) is not related in any way with the Complainant; (iii) has no business with the Complainant; and (iv) has not been granted any license or authorization to the Complainant's trademark. Besides, the disputed domain name resolves to an index page. The Complainant contends that the Respondent has not used the disputed domain name since its registration, and it confirms that the Respondent has no demonstrable plan to use it, which further demonstrates the Respondent's lack of legitimate interest in the disputed domain name.

C. The Complainant states that the disputed domain name is identical to its trademark OSCARO. The Complainant further contends that the Respondent knew about the Complainant and its rights at the time of the registration of the disputed domain name. Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks and rights.

Furthermore, the disputed domain name points to a parking page with commercial links, whereas the Complainant emphasizes that according to the browsing history, some of these commercial links can refer to direct competitors of the Complainant specialized in the sale of automotive accessories and products. The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain. Moreover, the disputed domain name is offered for sale for USD 2,888. The Complainant contends that the Respondent has registered the disputed domain name only in order to sell it back for out-of-pockets costs, which evinces bad faith registration and use. Finally, the disputed domain name has been set up with MX records which suggests that it may be actively used for e-mail purposes.

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

This is a proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, a complainant must prove each of the following: (A) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (B) the respondent has no rights or legitimate interests in respect of the domain name; (C) the domain name has been registered and is being used in bad faith.

Identical or confusingly similar domain name

The Complainant demonstrated that it owns the asserted trademark registrations for the “OSCARO” trademark, which were registered long before the Respondent registered the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix may be disregarded when considering whether a disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, as it is a necessary technical requirement of a domain name. This is true also for the so-called new generic top-level suffixes. Indeed, it has been repeatedly held in numerous UDRP cases that gTLDs such as ".online", ".site", and ".website" have no distinctive character (see CAC Cases No. 103323, 103114 and 102865) and would most likely be disregarded by web users, especially given that these words are descriptive for use on the Internet.

The disputed domain name incorporates the Complainant's trademark "OSCARO" in its entirety. It is, therefore, easy for this Panel to hold that the disputed domain name is identical to the trademark in which the Complainant has rights.

Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not in any way connected with the Complainant, nor is it authorized to use the Complainant’s trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy.

Furthermore, the evidence submitted by the Complainant demonstrated that the disputed domain name had not been used for a bona fide offering of goods or services or a legitimate non-commercial or fair use because it resolves to an index page with commercial links.

The Panel finds that the Respondent has no rights or legitimate interest in the disputed domain name.

Registration and use of the disputed domain name in bad faith

Concerning the bad faith argument, the Complainant states, in summary: (a) that the disputed domain is identical to the Complainant's trademark; (b) that the Respondent must have had actual knowledge of the Complainant's rights in its trademarks; (c) that the disputed domain name resolves to an index page with commercial links; (d) that the disputed domain name was offered for sale to third parties; and (e) that the disputed domain name was set up with MX records.

The Panel has already found that the disputed domain name is identical to the Complainant's trademark “OSCARO”. It is well established that the mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith.

In this case, the Panel concurs with the Complainant that the Respondent must have and should have been aware of the Complainant, its trademark and its business name before it registered the disputed domain name.

Given the facts of this matter and the lack of proper use of the disputed domain name, as described above, the Panel believes that the Respondent must have registered and used the disputed domain name in bad faith, either for commercial gain or for fraudulent purposes. It is difficult to imagine any good-faith reason for the Respondent's registration or use of the disputed domain name, and the Respondent failed to suggest any in these proceedings.

The offer for sale is indicative of registration and use of the domain name in bad faith, as confirmed by previous panels (CAC Case No. 101285), and the same applies to the configuration of MX records for e-mail purposes (CAC Case No. 102827 and CAC Case No. 102380).

Consequently, the Panel finds that the disputed domain name was registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **oscaro.online**: Transferred

PANELLISTS

Name	**Vojtěch Chloupek**

DATE OF PANEL DECISION 2024-07-08

Publish the Decision