Decision for dispute CAC-UDRP-106742

Case number	CAC-UDRP-106742
Time of filing	2024-07-29 08:56:24
Domain names	instantpotemporium.shop, instantpotcentral.shop, instantpothaven.shop

Case administrator

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

Complainant

Organization	IB Appliances US Holdings, LLC

Complainant representative

Organization	Stobbs IP

Respondents

Name	mike simon
Name	Karmiri Karmiri

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 names.

PARTIES CONTENTIONS

The Complainant's Request for Consolidation and Submissions

Preliminary Application for Consolidation

The Complainant requests that its complaint against the disputed domain names <instantpotemporium.shop>, <instantpotcentral.shop>, and <instantpothaven.shop> should be considered and determined as a single consolidated brought against multiple Respondents, arguing that the disputed domain names are under the control of a common operator, and submitting that the commonalities between the disputed domain names, and the websites to which they resolve and their overall use demonstrate that they are interconnected as part of an organized infringement network.

The Complainant bases its application on the following submissions:

- the disputed domain names use NameSilo as the registrar;
- the disputed domain names were registered within close temporal proximity, with approximately 1-month from the earliest registration (1 March 2024) and the latest registration (15 April 2024);
- the disputed domain names use a privacy protect service to mask the registrant;

- the disclosed registrant information relating to each Respondent is falsified;
- the disputed domain names use Cloudflare proxy services to mask the web hosting service provider; the disputed domain names use Cloudflare nameservers;
- the disputed domain names resolve to a website with the primary purpose of advertising counterfeit product infringing the rights of the Complainant; the similarity of disputed domain names' anatomy to one another; and the evidence of identical and/or highly similar content (including the user interfaces, and the look and feel at the resolving websites.

The Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") at rule 10 (e) empowers the Panel to decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and the Rules.

Having considered the Complainant’s submission this Panel is satisfied that on the balance of probabilities the disputed domain names were all registered by the same person or group acting in concert.

The disputed domain names were each registered with the same Registrar, on the same gTLD <.shop>, the disputed domain name <instantpothaven.shop> was registered on 1 March 2024, <instantpotemporium.shop> was registered on 8 April 2024, and <instantpotcentral.shop> was registered on15 April 2024.

Each of the disputed domain names was registered using a privacy service to conceal the identity of the registrant. Each has the Complainant’s distinctive INSTANT POT as its initial and dominant element.

This Panel accepts the Complainant’s submission that the registration of the three domain names in such circumstances, within seven-week period is more than a coincidence.

This Panel finds and directs therefore that the disputed domain names should be considered and determined as a single consolidated proceeding and that the Respondent is a single person or group acting in concert.

The Complainant's Submissions on Substantive Issues

The Complainant claims extensive rights in its INSTANT POT trademark established by its portfolio of trademark and service mark registrations described herein, and extensive use of the mark since launching the INSTANT POT branded multicooker in 2008.

The Complainant asserts that on Amazon Prime Day 2016, the Instant Pot multicooker sold 215,000 units alone, and since then the Complainant has extended its range of products and services worldwide, and its social media accounts have generated a significant level of support on Facebook (805,000+ followers), Instagram (524,000+ followers), Twitter (23,000+ followers).

The Complainant first alleges that the disputed domain names are identical or confusingly similar to the INSTANT POT trade mark in which the Complainant has rights, because each wholly incorporates the INSTANT POT mark as its dominant element, along with a non-distinctive term, respectively "emporium", "central", and "haven".

The Complainant argues that in each case the inclusion of the non-distinctive term does nothing to alter the overall impression in the eyes of the average Internet user. Indeed, prior Panels have consistently held that the addition of other terms do not avoid a finding of confusing similarity, see Instant Brands LLC v Liam Frisina, Case No. CAC-UDRP-105254.

The Complainant adds that the INSTANT POT mark is clearly recognisable as the dominant element within the disputed domain name, and in similar circumstances prior panellists have concluded that the addition of descriptive and/or non-distinctive terms does not prevent a finding of confusing similarity. The Complainant cites in a recent example of Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico.

Case No. 103973 [<boehringeringelheimequinerebate.com>], where panelist Victoria McEvedy held that: “... additional material cannot prevent the inevitable association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion is real and serious. The addition of a non-distinctive term cannot sufficiently distinguish the disputed domain name from the Complainant's name and trademarks.”

The Complainant adds that the generic Top Level Domain extension (“gTLD”) suffix <.shop> is merely a technical requirement, used for domain name registrations, and so is to be disregarded under the confusing similarity test.

The Complainant next alleges that the Respondents have no rights or legitimate interests in the disputed domain names and argues that:

- upon information and belief, the Respondents have never legitimately been known by the name INSTANT POT at any point in time;
- nothing about the disputed domain names suggests that the Respondent is making a legitimate non-commercial or fair use of the disputed domain names;
- the Complainant submits based on the trade mark registrations and the wide reputation the Complainant enjoys in the INSTANT POT brand, the Respondent's actual knowledge when registering the disputed domain names is unequivocal;
- as shown in the screen captures of the websites to which the disputed domain names resolve, the disputed domain names are being used to impersonate/pass off as the Complainant in order to sell counterfeit and competing goods;

- the Respondents are using the disputed domain names merely to pass itself off as being the Complainant in order to sell counterfeit and competing goods;

- such use does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain names, without intent or commercial gain to misleadingly divert consumers.

The Complainant next alleges that the disputed domain names were registered and are being used in bad faith, arguing that based on the considerable reputation of the INSTANT POT brand, there is no credible, believable, or realistic reason for registration or use of the disputed domain names other than to take advantage of the Complainant's rights and brand reputation.

The Complainant adds that the disputed domain names were registered between March 1, 2024, and April 15 2024, by which dates, the Complainant had already established both registered and unregistered rights in the INSTANT POT mark and brand.

Furthermore, the Complainant submits that the Respondents are using the disputed domain names to resolve to active websites as shown in the screen captures annexed to the Complaint. The resolving websites purporting to offer products for sale, have neither nor authorisation nor consent from the Complainant to use the INSTANT POT mark.

The Complainant further submits that the evidence shows that the Respondents have intentionally attempted to attract, for commercial gain, internet users to the Infringing Websites, by creating a likelihood of confusion with the Complainant’s registered trade marks as to the source, sponsorship, affiliation, or endorsement of the goods offered.

It is additionally contended that the Respondents were unequivocally aware of the INSTANT POT brand given the Respondents´ websites make substantial use of INSTANT POT brand assets in order to sell counterfeit and competing goods.

Using a trade mark to divert traffic to the Respondent's own website is consistently held by panelists to amount bad faith registration and use under the Policy.

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

The Respondent's Submissions

No administratively compliant Response has been filed and the Respondents have not engaged in this proceeding.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 Respondents to have no rights or legitimate interests in respect of the disputed domain names (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 have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel reviewed the case file and upon consideration of Complainant´s annexes to the complaint issued a procedural order on August 30, 2024 inviting the Complainant to submit evidence of ownership of its trademark registrations.

The Complainant complied with this procedural order on September 2, 2024.

The deadline for issuing the panel decision was postponed to provide the Respondent with an opportunity to reply to Complainant´s submission. No response was delivered to the CAC.

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 Complainant has provided uncontested convincing evidence of its rights in the INSTANT POT trademark and service mark established by its the ownership of the abovementioned portfolio of registrations in the United States and the United Kingdom.

The disputed domain names <instantpotemporium.shop>, <instantpotcentral.shop> and <instantpothaven.shop> are each composed of Complainant's mark in its entirety, followed by the English language words "emporium" "central", and "haven "respectively, and in each case, the generic Top Level Domain (" gTLD") extension <.shop>.

The Complainant's mark is contained in its entirety, as the initial, dominant and only distinctive element in each of the disputed domain names, which is sufficient to establish that the confusing similarity for the purposes of the Policy.

Furthermore, in each case the additional elements "emporium" "central", and "haven" are generic and descriptive within the respective disputed domain name and do not prevent a finding that each of the disputed domain names is confusingly similar to the INSTANT POT mark in which Complainant has rights.

Additionally, the gTLD extension <.shop> within each of the disputed domain names may be ignored for the purposes of comparing the mark and the disputed domain name, because it would be considered by Internet users to be a necessary technical element for a domain name.

This Panel finds therefore that each of the disputed domain names is identical to INSTANT POT mark in which the Complainant has rights and Complainant has therefore succeeded in the first element of the test in Policy 4(a)(i).

The Complainant has made out a prima facie case that the Respondents have no rights legitimate interests in the disputed domain names as set out in the Complainant's detailed submissions above.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondents have failed to discharge that burden and therefore this Panel must find that the Respondents have no rights or legitimate interests in the disputed domain names.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

Complainant's distinctive INSTANT POT mark is clearly recognizable and is the initial and dominant element within each of the disputed domain names.

The Complainant next alleges that the disputed domain names were registered and are being used in bad faith, arguing that based on the considerable reputation of the INSTANT POT brand, there is no credible, believable, or realistic reason for registration or use of the disputed domain names other than to take advantage of the Complainant's rights and brand reputation.

Furthermore, as alleged, the disputed domain names were registered in a series of registrations between March 1, 2024 and April 15, 2024, by which dates, the Complainant already established both registered and unregistered rights in the INSTANT POT mark and brand.

INSTANT POT mark is a distinctive mark, so in the circumstances as described above, on the balance of probabilities the Respondents were aware of the Complainant and its POT NOODLES mark when the disputed domain name was chosen and registered.

This Panel finds therefore that the disputed domain names were registered in bad faith to take predatory advantage of the Complainant's goodwill.

Furthermore, the Complainant submits that the Respondents are using the disputed domain names to resolve to active websites as shown in the screen captures annexed to the Complaint. The exhibited screen captures show that the domain names <instantpotemporium.shop> and <instantpotcentral.shop> resolve to websites which purport to offer for sale household and kitchen appliance, whereas the domain name <instantpothaven.shop> resolves to a website that purports to offer men's casual wear and underwear.

On the balance of probabilities therefore, Respondents are using the disputed domain names to confuse Internet users and to intentionally attract, and divert Internet traffic to the Respondent's websites, by creating a likelihood of confusion with the Complainant's registered trade marks as to the source, sponsorship, affiliation, or endorsement of the goods that Respondent purports to offer for sale.

Such use of the Complainant's mark within the disputed domain names to divert traffic in this manner constitutes bad faith registration and use under Policy.

As this Panel has found that the disputed domain names were registered and are being used in bad faith and Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(ii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **instantpotemporium.shop**: Transferred
2. **instantpotcentral.shop**: Transferred
3. **instantpothaven.shop**: Transferred

PANELLISTS

Name	**James Bridgeman**

DATE OF PANEL DECISION 2024-09-10

Publish the Decision