

Decision for dispute CAC-UDRP-106825

Case number	CAC-UDRP-106825
Time of filing	2024-09-03 09:09:21
Domain names	instantpotkingdom.shop, instantpotmaster.shop

Case administrator

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

Organization	IB Appliances US Holdings, LLC
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Complainant representative

Organization	Stobbs IP
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RESPONDENTS

Name	Richard Bergeron
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Name	TU bu
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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.

IDENTIFICATION OF RIGHTS

AU TM Registration No. 1755921 INSTANT POT registered from 1 March 2016 for various cooking apparatus in class 11.

FACTUAL BACKGROUND

The Complainant has used the trademark INSTANT POT in relation to its multicooker products since 2008. Whilst it has provided limited corroborative evidence of its use of the mark, it has asserted, and the Respondents have not contested, that;

- On a single day in 2016 it sold 215,000 multicooker units branded INSTANT POT through an Amazon Prime sale;
- Its INSTANTPOT Facebook page has over 805,000 followers;
- Its INSTANTPOT Instagram page has over 524,000 followers;
- Its INSTANTPOT Twitter page has over 23,000 followers;
- It owns the domain name <instantpot.com> and has used that domain name for its main operating website since at least 2009.

Further, the Complainant asserts, and the Respondent does not contest, that it is the owner of numerous trade marks around the world containing or consisting of the words INSTANT POT. This includes the above mentioned registration.

Turning to the Respondents, whilst the disputed domain names are registered with different registrant names, they use the same nameservers and webhosting provider. Further, both disputed domain names direct to websites that use very similar distinctive logos and layout and both were registered recently on 6 August 2024 and 7 August 2024. The Complainant has therefore asserted, and the Respondents have not contested, that the disputed domain names are both subject to common control and it has requested that the Panel consolidate the disputes in relation to both of the disputed domain names.

The said websites to which the disputed domain names direct both promote and offer for sale multicooker products that carry the Complainant's INSTANT POT branding. The Complainant asserts, and the Respondent does not contest, that these are counterfeit goods and hence not genuine products produced by the Complainant.

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 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 Respondent 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 names 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 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

CONSOLIDATION REQUEST

Paragraph 10(e) of the Rules grants the Panel the power to consolidate multiple domain name disputes. Paragraph 3(c) of the Rules notes that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

Paragraph 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ('WIPO Overview 3.0') notes that 'Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.'

The disputed domain names are registered under two different registrant names. However, it is quite clear that the same person has directed the registration of both of the disputed domain names. Aside disputed domain names being registered within a one day of each other and using the same nameservers, the use of the domain names is telling. Both domain names direct web users to websites that use very similar distinctive logos and layout.

The Panel is satisfied that "Richard Bergeron" and "Tu Bu" are in fact the same person. Hence in the reasoning below the Panel will

simply refer to the "Respondent" (i.e. not Respondents). The Panel accepts the Complainant's request to consolidate the disputes in relation to both of the disputed domain names.

SUBSTANTIVE LAW

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain names registered by the Respondent (being the one person using two names) be transferred to the Complainant:

- 1) the disputed domain names are identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- 3) the disputed domain names have been registered and are being used in bad faith.

The Panel is satisfied that the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant claims registered rights over a number of trade marks containing or consisting of INSTANT POT. However, the Panel has focused on one trademark registration in particular, being AU TM Registration No. 1755921 INSTANT POT.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a single trademark in a single jurisdiction that predates the registration of the disputed domain names (even if that single jurisdiction is not one in which the Respondent resides or operates) (*Koninklijke KPN N.V. v. Telepathy, Inc* D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436. The Complainant has satisfied this requirement.

The next question is whether the disputed domain names are confusingly similar to the INSTANT POT trademark.

INSTANT POT is not directly descriptive of multicooker products. Whilst it does allude to the function of such products, it still carries distinctiveness as a trademark. Turning to the disputed domain names, the additional elements "kingdom.shop" and "master.shop" appearing after the "instantpot" element merely indicate a trade outlet that provides INSTANT POT products.

The Panel is therefore satisfied that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

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

The registrant names for the disputed domain names bear no resemblance to the disputed domain names. Further, the two disputed domain names resolve to websites that display the Complainant's trademark and promote and offer for sale counterfeit goods. That does not indicate a legitimate interest, it in fact indicates the contrary.

There is no basis to conclude that the Respondent has any rights or legitimate interests in the disputed domain names.

BAD FAITH

The Complainant has provided very little corroborative documents to verify that it has a reputation in INSTANT POT. However, this proceeding has not been contested by the Respondent and, based on the above stated undisputed facts, the Panel accepts that INSTANT POT is a well known trademark in relation to multicooker products. That finding alone would make it unlikely that the Respondent could have registered the disputed domain names without knowing of the Complainant. However, what puts the matter of the Respondent's knowledge of INSTANT POT beyond doubt is the display of that trademark on websites promoting and selling counterfeit goods. Again, the Respondent does not contest the assertion that these goods are in fact counterfeit.

The Respondent has registered and used both the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **instantpotkingdom.shop**: Transferred
2. **instantpotmaster.shop**: Transferred

PANELLISTS

Name **Andrew Sykes**

DATE OF PANEL DECISION 2024-10-01

Publish the Decision