Decision for dispute CAC-UDRP-106873

Case number	CAC-UDRP-106873
Time of filing	2024-10-09 14:23:50
Domain names	thebaerskin.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Global Innovation Ventures AG

Complainant representative

Organization	Trama Legal s.r.o.

Respondent

Name	Terry Ly

OTHER LEGAL PROCEEDINGS

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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 owner of the following trademarks:

- The US wordmark “BAERSKIN”, registration number 6879944, filed on January, 18, 2022, registered on October 18, 2022, in class 25;
- This Trademark has been registered by the legal entity “Digital Innovation Ventures GmbH”. However, the Complainant has shown that this was the prior name of the Complainant;
- The US combined mark “BAERSkin”, registration number 7 499 380, filed on August 22, 2023, registered on September 10, 2024, in classes 5 and 25;
- The Swiss combined mark “BAERSkin”, trademark number 819456, filed on July, 22, 204, registered on August, 30, 2024, in classes 5 and 25;

Hereinafter the “**Trademark**” or the “**Trademarks**”.

The Complainant also submitted evidence that it filed the following trademark applications:

- The EU combined mark “BAERSkin”, application number 019056352, filed on July 18, 2024, in classes 5 and 25;
- The UK combined mark “BAERSkin”, trademark number UK00004077110, filed on July 18, 2024, in classes 5 and 25;

- The Australian combined mark “BAERSkin”, trademark number 2467451, filed on July, 19, 2024, in classes 5 and 25;
- The Canadian combined mark “BAERSkin”, application number 2339416, filed on July, 19, 2024, in classes 5 and 25;
- The New Zealand combined mark “BAERSkin”, trademark number 1269488, filed on July, 23, 2024, in classes 5 and 25.

However, pending trademark applications do not by themselves establish trademark rights and shall therefore not be considered by the Panel (see WIPO Overview 3.0, 1.1).

The Complainant also claims to be the owner of 43 domain names containing the words “BAERSkin” or “BAER”. However, since the Complainant does not provide evidence thereof, this shall not be considered by the Panel.

FACTUAL BACKGROUND

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

The Complainant provided evidence that it is the registered owner of the Trademarks.

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

Confusing similarity

The Disputed Domain Name <thebaerskin.com> consists of the word element of the Complainant’s Trademarks “BAERSKIN” with the mere addition of the English word (definite article) “the” and the “.com” gTLD.

The Complainant states that the addition of non-distinctive term “the” and the non-distinctive gTLD “.com” does not differentiate the Disputed Domain Name from the Trademark(s). The Complainant argues that the overall impression of the Disputed Domain Name is dominated by the term “BAERSkin”, which is identical to Trademark(s). Therefore, the Complainant concludes that the Disputed

Domain name is confusingly similar to the Trademark(s).

The Panel notes that the Disputed Domain Name incorporates the entirety of the Complainant's "BAERSKIN" Trademark(s) (at least the "BAERSkin" word element of the Trademarks, which is the dominant element of the Trademarks), with the addition of the English definite article "the".

The Panel remarks that Section 1.7 of WIPO Overview 3.0, clearly states that, "in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status".

The Panel finds that the addition of the English definite article "the" does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy, since "the" is a functional word used to specify or define nouns without adding a description or a unique meaning to the noun.

This is supported by section 1.8 of WIPO Overview 3.0, which clearly states: "Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element".

It is well-established that the gTLD ".com" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which a complainant has rights. Moreover, section 1.11.1 of WIPO Overview 3.0 clearly states: "The applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.".

For these reasons, the Panel concludes that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the Panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues that:

- The Respondent has no earlier registered rights.
- The Respondent was not authorized to use the Trademark(s) in the Disputed Domain Name or in any other form.
- The Respondent does not use the Disputed Domain Name in connection with a legitimate offering of goods and services.
- The Respondent has hosted infringing content on the website linked to the Disputed Domain Name.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that he has rights or legitimate interests in the Disputed Domain Name.

The Panel finds that the Respondent does not appear to have any rights or legitimate interests in the Disputed Domain Name from the following facts:

- There is no evidence that the Respondent is or has been commonly known by the Disputed Domain Name or by the term "BAERSKIN". The Respondent did not show to have any trademark rights or other rights regarding the term "BAERSKIN".
- One of the Trademarks was registered before the registration date of the Disputed Domain Name. The Disputed Domain Name was registered on October 22, 2023, whereas the first Trademark of the Complainant was registered on October 18, 2022.
- There is no evidence that shows that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers. On the contrary, it seems that the Respondent has used the Disputed Domain Name to mimic the Complainant.
- The Respondent does not seem to have any consent or authorisation to use the Trademarks of the Complainant and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

Bad faith

The Complainant argues that:

- The Respondent uses the Disputed Domain Name for cybersquatting, since the Disputed Domain Name incorporates the “BAERSkin” Trademark(s). The Respondent registered the Disputed Domain Name to exploit the goodwill associated with the Complainant’s Trademark(s), disrupt the business of the Complainant, and to divert consumers regarding the commercial origin of its website.
- The Respondent tries to mislead consumers into believing that the Disputed Domain Name is associated with, endorsed by, or affiliated by the Complainant.
- The Respondent has hosted a copy of the Complainant’s website, including the use of the Trademark(s) and copyrighted materials. The Respondent has listed products identical or similar to the products of Complainant on the website linked to the Disputed Domain Name and intended to facilitate payment for the goods offered for sale, without any possibility of delivering the goods of the Complainant.

The Panel weighs these arguments and facts as follows:

- As mentioned already, the Disputed Domain Name reproduces the word element "BAERSKIN" (i.e., the dominant element) of the Complainant's Trademark(s) entirely, with the addition of the definite article “the”. This Disputed Domain Name clearly refers to the Complainant.
- The first of the Complainant’s Trademarks predates the registration of the Disputed Domain Name.
- The Respondent uses the Disputed Domain Name for illegal activities. The Respondent pretends to be the Complainant and sells goods, or pretends to sell goods, to consumers. These goods are covered by the Complainant’s registered Trademarks. Consumers are tricked into buying goods from the Respondent and are let to believe that the goods are originated from the Complainant. The Respondent uses copyrighted images of the Complainant and uses the Disputed Domain Name to profit from or to exploit the Trademarks. The Respondent intends to mislead consumers.
- It is inconceivable that the Respondent would have come up with a domain name consisting of the term “BAERSKIN”, for selling goods that are covered by the Complainant’s Trademarks, without having prior knowledge of the Complainant, its Trademark, and its activities. On the balance of probabilities, it seems evident that the Respondent had actual knowledge of the existence of the Complainant and its activities, and of the Complainant's Trademarks and the scope of the Trademarks at the time of registration and use of the Disputed Domain Name. The Panel is convinced that the Respondent had the Trademark(s) of the Complainant in mind when registering and using the Disputed Domain Name.
- The Respondent did not contest any of the Complainant’s arguments and did not provide any explanation concerning its choice for registering and/or using a domain name that includes the word element “BAERSKIN” (i.e., the dominant element) of the Complainant’s registered Trademarks in combination with the definite article “the”.

Given the above elements, the Panel concludes that the Disputed Domain Name is being used for the purpose of misleading internet users. There is no evidence whatsoever of any bona fide offering of goods or services. The Panel concludes that the Disputed Domain Name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **thebaerskin.com**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2024-11-15

Publish the Decision