Decision for dispute CAC-UDRP-106925

Case number	CAC-UDRP-106925
Time of filing	2024-10-21 10:53:19
Domain names	warhammerpaint.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Games Workshop Ltd

Complainant representative

Organization	Coöperatie SNB-REACT U.A.

Respondent

Name	Michael Montelongo

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 is the owner of various trademark registrations for WARHAMMER, including the following:

Canadian trademark registration No. TMA40830, registered on February 12, 1992;

International trademark registration No. 1205352, registered on September 5, 2013;

U.S. trademark registration No. 6192634 registered on November 10, 2020; and

EU trademark registration No. 018096144, registered on February 5, 2020.

FACTUAL BACKGROUND

The Complainant is one of the world's leading tabletop fantasy and futuristic battle games company. It sells its products via Games Workshop hobby centres and stores, of which there are more than 540 worldwide, and via independent toy and hobby shops, of which there are over 7,000 worldwide. He Complainant also sells its products online through its main website at www.warhammer.com. The Complainant's products include miniature figurines and paint for such figurines.

Customers of the Complainant's products can customize their miniature figurines with its paint range, brushes and accompanying painting system. The Complainant continually develops new types of paints and ways of using them.

The Complainant's domain name <warhammer.com> was registered on January 28, 1997.

The Respondent is Michael Montelongo of 407 Ball Airport Road, Victoria, Texas, 77904, United States.

The Respondent registered the disputed domain name on June 30, 2023. At the time of filing the Complaint, the disputed domain name was used to redirect to a website of a direct competitor of the Complainant, known as "Monument Hobbies". Monument Hobbies produces a range of paints which competes with the Complainant's. It also offers for sale toys and figurines and accessories for painting miniature figurines.

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 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

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns registered trademark rights in the word "Warhammer".

The disputed domain name contains the entirety of the Complainant's WARHAMMER trademark with the addition of the term "paint", which is descriptive of some of the products sold by the Complainant. In this case, the Complainant's WARHAMMER trademark is recognizable within the disputed domain name. The addition of the descriptive term "paint" does not prevent a finding of confusing similarity but in fact adds to the confusion with the Complainant's trade mark. See sections 1.7 and 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("the WIPO Overview 3.0").

Consequently, the Panel finds that the Complainant has shown that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Once a complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see WIPO Overview 3.0, section 2.1).

In the present case, the Complainant has demonstrated a prima facie case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The Complainant provided evidence that it owns trademark rights in the WARHAMMER mark long before the date that the disputed domain name was registered. The Respondent is not affiliated with the Complainant and there is no evidence that the Respondent was licensed or otherwise authorized by the Complainant to use the Complainant's WARHAMMER trademark or to register it in a domain name.

The Respondent did not submit a formal Response and did not provide any explanation or evidence to show he has rights or legitimate interests in the disputed domain name which would be sufficient to rebut the Complainant's prima facie case.

The Center, however, received an email on October 24, 2024 from the Respondent, stating that he would be open to selling the disputed domain name to the Complainant for the sum of USD$10,000, that being his initial asking price. The Respondent did not assert that he has rights or legitimate interests in the disputed domain name or show any of the circumstances enumerated in paragraph 4(c) of the Policy to demonstrate that he has rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant must also show that the Respondent registered and is using the disputed domain name in bad faith (see Policy, paragraph 4(a)(iii)).

The WARHAMMER mark is a distinctive and well-established mark, having been registered and used for many years across many countries. The Respondent registered the disputed domain name long after the Complainant registered the WARHAMMER trade mark.

The Panel notes the use of the disputed domain name to direct traffic to a competitor's website and the offer for sale of the to the Complainant for the sum of USD$10,000, which is a sum that is far in excess of any out-of-pocket registration fees that would have been incurred by the Respondent. The Panel is persuaded that the Respondent was well aware of the Complainant and its trademark rights in WARHAMMER when he registered the disputed domain name, and to divert Internet traffic away from the Complainant's own website for profit. The Panel finds that the circumstances of this case fall within what is described in paragraphs 4(b)(i) and (iv) of the Policy. Additionally, it finds guidance from WIPO Overview 3.0 section 3.1.1 which states, inter alia, the following:

"If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, … (iv) website content targeting the complainant's trademark, e.g., through links to the complainant's competitors, … (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name …".

The Panel therefore concludes that the disputed domain name was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **warhammerpaint.com** : Transferred

PANELLISTS

Name	**Francine Tan**

DATE OF PANEL DECISION 2024-11-25

Publish the Decision