Decision for dispute CAC-UDRP-107065

Case number	CAC-UDRP-107065
Time of filing	2024-11-19 10:15:12
Domain names	tomtom-app.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Tomtom International B.V.

Complainant representative

Organization	Convey srl

Respondent

Organization	Xdomain Xserver 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 owns the TOMTOM trademark under the following international registrations extended to Japan:

- International trademark reg. no. 905070, registered on May 4, 2006;
- International trademark reg. no. 969888, registered on August 21, 2007;
- International trademark reg. no. 969890, registered on August 21, 2007;
- International trademark reg. no. 1003535, registered on January 15, 2009;
- International trademark reg. no. 1008053, registered on January 15, 2009.

FACTUAL BACKGROUND

The Complainant, a Dutch multinational company specializing in location technology and consumer electronics, was founded in 1991 and is headquartered in Amsterdam, with major offices across Europe, Asia-Pacific, and the Americas. Its first satellite navigation devices were launched in 2004, and the company went public on the Amsterdam Stock Exchange in 2005 with a valuation of nearly €50 million. In 2014, it partnered with Volkswagen Group on Highly Automated Driving (HAD) systems. Key customers include Stellantis, Volkswagen Group, Microsoft, BMW, and Uber. By 2023, the Complainant employed over 3,800 people and operated in 29 countries, offering products like fleet management solutions through its TomTom WORK division.

The disputed domain name, registered on October 18, 2018, directs to a website that unlawfully uses the Complainant's trademarks to promote games for commercial purposes. Despite a cease-and-desist letter sent on October 30, 2024, the Respondent has failed to respond.

PARTIES CONTENTIONS

COMPLAINANT:

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

(i) The Complainant has rights in the TOMTOM mark, as identified in the section "Identification of Rights" above. The disputed domain name is confusingly similar to the Complainant's TOMTOM mark because it incorporates the Complainant's mark in full, adding only the generic term "app" and the ".com" generic top-level domain (gTLD).

(ii) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name, nor has the Complainant authorized or licensed the Respondent to use its TOMTOM mark in the domain name. The Respondent has not provided the Complainant with any evidence of its use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute.

(iii) The Respondent has registered and is using the disputed domain name in bad faith. The Respondent's bad faith at the time of registration is evident, given the long-standing and extensive use of the TOMTOM trademark, which is widely recognized worldwide, including in Japan, where the Respondent is presumed to be based. The disputed domain name, registered in 2018, years after the Complainant's trademark became well-known in the location technology and consumer electronics sectors, is identical to the TOMTOM trademark. The Respondent's awareness of the trademark and intent to reference the Complainant are clear, as supported by the lack of response to the cease-and-desist letter and the continued misuse of the disputed domain name.

RESPONDENT:
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

Language of the Proceedings

The Panel notes that the Registration Agreement is in Japanese, which would typically make Japanese the language of the proceedings. However, the Complainant has requested that the proceedings be conducted in English. Under UDRP Rule 11(a), the Panel has the discretion to determine the appropriate language of the proceedings, considering the particular circumstances of the case. See Section 4.5, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition; see also Lovehoney Group Limited v yan zhang, CAC 103917 (CAC August 17, 2021) (finding it appropriate to conduct the proceeding in English under Rule 11, despite Japanese being designated as the required language in the registration agreement).

The Complainant contends that:
(i) the disputed domain name incorporates Latin characters, including "GPS" and the ".com" Generic Top-Level Domain;
(ii) the Respondent, seemingly active in the gaming sector, is unlikely to be unaware of English, the primary language for

international business and communication;
(iii) translating the Complaint into Japanese would incur additional costs and delays, making it unfair to proceed in Japanese;
(iv) WHOIS history database searches suggest that the Respondent is the apparent owner of two other domain names containing English words and globally recognized trademarks; and
(v) the Respondent's website prominently displays various English words and phrases, including: "App," "Game," "Search," "Best App Games," "Merge Match March," and "©Copyright2024 tomtomapp. All Rights Reserved."

In accordance with UDRP Rule 11(a), the Panel finds the Complainant's arguments compelling. Considering the circumstances of the case, and in the absence of a Response or any objection to the Complainant's request, the Panel decides that English shall be the language of the proceeding.

The Panel is satisfied that all other 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

Rights

The Complainant asserts ownership of the registered trademark TOMTOM, as detailed in the section "Identification of Rights" above. The Panel acknowledges that a trademark registration with an international trademark authority is sufficient to establish rights in a mark. Accordingly, the Panel finds that the Complainant has demonstrated its rights in the TOMTOM trademark.

The Complainant also argues that the disputed domain name, **<tomtom-app.com>**, is confusingly similar to its TOMTOM trademark, as it incorporates the mark in its entirety with the addition of the generic term "app," a hyphen, and the ".com" gTLD. The Panel notes that incorporating a trademark in full, combined only with a descriptive or generic term and a gTLD, does not distinguish a disputed domain name for the purposes of paragraph 4(a)(i) of the Policy. See MTD Products Inc v. J Randall Shank, FA 1783050 (Forum June 27, 2018) ("The disputed domain name is confusingly similar to Complainant's mark as it wholly incorporates the CUB CADET mark before appending the generic terms 'genuine' and 'parts' as well as the '.com' gTLD."); see also Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (Forum Jan. 22, 2016) (Finding that the addition of a generic term and gTLD does not sufficiently distinguish a disputed domain name from a mark under Policy paragraph 4(a)(i).).

The Panel concludes that the disputed domain name incorporates the TOMTOM trademark in its entirety, with only the addition of the generic term "app," a hyphen, and the ".com" gTLD. Therefore, the Panel determines that the disputed domain name is confusingly similar to the TOMTOM trademark under paragraph 4(a)(i) of the Policy.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Section 2.1, WIPO Jurisprudential Overview 3.0 ("Where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.").

Complainant argues that Respondent has no rights or legitimate interest in the disputed domain name as Respondent is not commonly known by the disputed domain name, nor has Respondent been authorized by Complainant to use Complainant's mark, and Respondent is not affiliated with Complainant. Relevant information, such as WHOIS information, can be used as evidence to show a respondent is or is not commonly known by the disputed domain name under Policy paragraph (c)(ii). The Panel notes that the unmasked WHOIS data lists "Tomohiro Sakaue" as the registrant, and there is no evidence in the record to suggest Respondent was authorized to use the mark. Therefore, the Panel finds that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).

Next, the Complainant contends that the Respondent has not provided the Complainant with any evidence of its use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute.

The Panel notes that the Respondent uses the disputed domain name to redirect Internet users to a website that unlawfully employs the Complainant's trademarks to promote games for commercial purposes. Specifically, the Panel observes that the website associated with the disputed domain name features a Japanese menu bar positioned at the top of the webpage, which includes the following options: "If You're Unsure, Try This Game," "RPG," "Action," "Puzzle Games," "Strategy," "Rhythm Games," "Sitemap," "Privacy Policy," and "Contact Us." Additionally, the webpage offers a variety of games across different genres.

The Panel agrees and finds that the Respondent's use of the Complainant's mark and the goodwill surrounding it as a means of attracting Internet users to its unrelated business is not a bona fide offering of goods or services. See UUL Labs, Inc. v. Harry L. Werner, FA 1880938 (Forum Mar. 10, 2020) ("Additionally, the Complainant alleges the Respondent fails to make a bona fide offering or goods or services or legitimate noncommercial or fair use because Respondent attempts to disrupt the Complainant's business by diverting internet users to a scam website where it sells unauthorized products. Use of a domain name to disrupt complainant's business in order to sell unauthorized products may be evidence that a respondent does not make a bona

fide offering of goods or services or a legitimate noncommercial or fair use of a disputed domain name under Policy paragraph 4(c)(i) or (iii)").

The Panel concludes that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant asserts that the Respondent has registered and is using the disputed domain name in bad faith. The Panel notes that the website associated with the disputed domain name includes a Japanese menu bar positioned at the top of the webpage, featuring options such as: "If You're Unsure, Try This Game," "RPG," "Action," "Puzzle Games," "Strategy," "Rhythm Games," "Sitemap," "Privacy Policy," and "Contact Us." Additionally, the webpage offers a variety of games across multiple genres.

The Panel finds that the Respondent uses the disputed domain name to misdirect Internet users, capitalizing on the goodwill associated with the Complainant's TOMTOM trademark for commercial gain. Accordingly, the Respondent registered and uses the disputed domain name in bad faith. See Todd McFarlane and TMP International LLC v. tim wang, FA 2073747 (January 1, 2024) ("Respondent disrupted Complainant's business by diverting users to its purported scam commercial website to sell products unrelated to the Complainant's business. The Panel finds that Respondent uses the disputed domain name to attempt to redirect Internet users by passing itself off as Complainant for commercial gain, and thus Respondent registered and used the disputed domain name in bad faith.").

The Complainant further argues that the Respondent's bad faith at the time of registration is evident, given the Complainant's long-standing and extensive use of the TOMTOM trademark, which is globally recognized, including in Japan, where the Respondent is presumed to be based. The disputed domain name, registered in 2018, came years after the TOMTOM trademark became well-known in the location technology and consumer electronics sectors and is identical to the trademark. The Respondent's awareness of the trademark and intent to target the Complainant are evident, as demonstrated by the Respondent's failure to respond to the cease-and-desist letter and continued misuse of the disputed domain name.

While constructive notice alone is insufficient to establish bad faith, actual knowledge of the trademark may support such a finding. Given the notoriety of the Complainant's TOMTOM mark and the Respondent's use of the disputed domain name, the Panel concludes that the Respondent had actual knowledge of the Complainant's rights at the time of registration. Accordingly, the Respondent registered the disputed domain name in bad faith under Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **tomtom-app.com**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2024-12-16