Decision for dispute CAC-UDRP-107216

Case number	CAC-UDRP-107216
Time of filing	2025-01-27 10:29:57
Domain names	prexiso.shop

Case administrator

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

Complainant

Organization	Prexiso AG
Organization	HangZhou Great Star Industrial Co., Ltd.

Complainant representative

Organization	Chofn Intellectual Property

Respondent

Organization	Muray Associats S.L.

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 the following trademark registrations:

MADRID Trademark No. 946914 for PREXISO, registered on 30 July 2007, designating goods and services in the International Class 9, 35;

U.S. Trademark No. 4220009 for PREXISO, registered on 9 October 2012, designating goods and services in international classes 9; and

Chinese Trademark No. 27247162 for PREXISO, registered on 7 January 2019, designating goods and services in international classes 9.

FACTUAL BACKGROUND

The first Complainant, Prexiso Ag, was established in 2009 and is a Swiss company who specializes in offering simple and affordable measurement tools for everyone. The second Complainant, HangZhou Great Star Industrial Co., Ltd., was established in 1993 and is focussed on the tools and storage industry. Its main products include hand tools, storage, power tools, laser measurement devices, power stations, which are mainly used in the fields of home maintenance, construction, vehicle maintenance, map measuring and surveying, and home energy management. The registered PREXISO trademark is used for line of professional laser measurement/mapping tools including laser rangefinders and laser levels. On August 2, 2018, the second Complainant acquired 100% of the equity of the first Complainant thus forming a parent-subsidiary relationship. The disputed domain name was registered on October 30, 2023.

PARTIES CONTENTIONS

COMPLAINANT

The disputed domain name is identical or confusingly similar to the PREXISO trademark by copying the trademark and adding only the ".shop" TLD.

The Respondent has no rights or legitimate interests in the disputed domain name where it is not commonly known thereby and it resolves the domain name to a website that displays photos of the Complainants' PREXISO products and claims to offer such goods for sale while also offering for sale products under the LEICA trademark which are directly competitive to those offered by the Complainants.

The disputed domain name was registered and it is used in bad faith where the Respondent had actual prior knowledge of the Complainants' PREXISO trademark and hosts a website offering products that compete with the Complainants.

RESPONDENT

No administratively compliant response has been filed although the Respondent submitted an email stating, in full, "The domain was released last week".

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.

Preliminary Issue – Multiple Complainants

In the instant proceedings, there are two named Complainants. The relevant rules governing multiple complainants are Rule 3(a) and the Czech Arbitration Court's Supplemental Rule Article 3. Rule 3(a) states that "Any person or entity may initiate an administrative

proceeding by submitting a complaint". The Supplemental Rule Article 3 states that "The Class Complaint is based on legal arguments applicable equally, or substantially in the same manner, to all the disputed domain names".

The two named Complainants in this matter are Prexiso AG and HangZhou Great Star Industrial Co., Ltd. and the Complaint states that HangZhou Great Star Industrial Co. "acquired 100% equity of Prexiso AG through an agreement transfer".

Previous panels have allowed multiple parties to proceed as one where they can show a sufficient link to each other. For example, in Athleta (ITM) Inc., Banana Republic (ITM) Inc., and Gap (ITM) Inc. v. Web Commerce Communications Limited, UDRP-105823 (CAC November 7, 2023) (the three named "Complainants are subsidiaries of The Gap, Inc" and "[t]herefore, the Panel finds that consolidation would be fair and equitable"). See also Procter & Gamble Business Services Canada Company, The Gil-lette Company LLC, Braun GmbH and The Procter & Gamble company v. Whois privacy protection service, Internet Invest, Ltd. dba Imena.ua / Ar-tem Shostak, Private person 66478, Whois privacy protection service, In-ternet Invest, Ltd. dba Imena.ua / Artem Shostak, Private person 53397, Privacy Protection, HOSTING UKRAINE LTD / Коваленко Валерий/Konovalenko Valeriy, Privacy Protection, HOSTING UKRAINE LLC / Коваленко Валерий/Konovalenko Valeriy, D2017-1493 (WIPO Oct. 6, 2017) (consolidation of multiple complainants found to be equitable and procedurally efficient where "[t]he Complainant Procter & Gamble is a parent company of the First Three Complainants. Therefore, the evidence shows that the Complainants have a common grievance against the Re-spondents by virtue of having common legal interest.").

In the present case, the Complaint has noted the relationship between the two named Complainants as a parent and a subsidiary company. The Respondent has provided no substantive response in this case and so it has not contested this relationship. Under the circumstances the Panel finds that there is a link between the two named Complainants and that they have a specific common grievance against the Respondent who has engaged in a common action that has affected the Complainants in a similar fashion.

For the sake of simplicity, Prexiso AG and HangZhou Great Star Industrial Co., Ltd. will hereafter be referred to in this decision as "the Complainant" unless otherwise noted.

PRINCIPAL REASONS FOR THE DECISION

1. Confusing Similarity

The Complainant has established its rights to the PREXISO trademark through its submission into evidence of various trademark registration certificates, the earliest of which dates back to 2007, covering a number of countries such as the United States of America, China, and others. It also submits screenshots of its own www.prexiso.com website showing actual use of the trademark. The second level of the disputed domain name consists entirely of the Complainant's trademark and the full disputed domain name only adds the ".shop" gTLD. This does not dispel the confusing similarity between the disputed domain name and the Complainant's trademark in a side-by-side comparison appropriate to Paragraph 4(a)(i). Entain Operations, Ltd. v. Chai Rui Chen, UDRP-106451 (CAC May 26, 2024) (bwin.tokyo found to be identical or confusingly similar to the BWIN trademark).

Also, top-level extensions such as ".shop" and ".com" typically add no meaning or distinctiveness to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. Novartis AG v. Wei Zhang, 103365 (CAC December 9, 2020) ("it is generally accepted that the addition of the top-level suffix in the domain name (e.g., '.com') is to be disregarded under the confusing similarity test").

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of a gTLD thereto in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant's trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

2. Rights or Legitimate Interests

The Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii). Should it succeed in that effort, the burden then shifts to the Respondent to show that

it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, UDRP-102378, (CAC March 8, 2019) ("The Panel finds 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.").

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent is not commonly known by the disputed domain name, nor has the Complainant authorized the Respondent to use the PREXISO trademark in any way. Where a response is lacking, relevant information includes the WHOIS record and any other assertions by a complainant regarding the nature of its relationship with a respondent. See LABORATOIRE NUXE v. Domains For Sale, UDRP-106079 (CAC January 25, 2024) ("Past panels have held that a respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name."). The WHOIS record for the disputed domain name identifies the registrant as "Jordi Muray / Muray Associats S.L.". The Complaint further asserts that "the Complainant as well as its affiliates have never directly or indirectly authorized the Respondent to use the trademark PREXISO and the corresponding domain name in any form". Panels may use these assertions as evidence of lacking rights or legitimate interests. Accordingly, the Panel agrees that the Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).

Next, the Complainant asserts that the "Respondent is not its contracted dealer. And the Complainant also noticed that the Respondent claimed to be the official distributor of the Leica Geosystems brand in Spain. The Complainant needs to emphasize here that since the full acquisition of the PREXISO brand in 2018, PREXISO has no relationship with Leica.". The selling of a complainants' products, whether as an authorized or unauthorized dealer, is subject to the now-familiar four-part test set out in the seminal UDRP decision of Oki Data Americas, Inc. v. ASD, Inc., D2001-0903 (WIPO Nov. 6, 2001).

This considers:

1. it is actually offering the goods or services at issue;
2. it uses its website to sell only the trademarked goods or services and not those of a complainant's competitors or other third-parties;
3. the website accurately discloses the registrant's relationship (or lack thereof) with the trademark owner; and
4. the Respondent has not tried to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

Of most relevance to the current case are the second and third elements of the Oki Data test. The Complainant claims that the Respondent is not an authorized distributor of its products. However, the Panel deems this factual question to be of limited impact in the present case because, even assuming arguendo that the Respondent is an authorized dealer, it sells competing goods and fails to clearly disclose its lack of a relationship with the Complainant on its website. The Complainant provides screenshots of the resolving website associated with the disputed domain name, which displays images of certain of the Complainant's PREXISO products and packaging as well as those of other laser measuring tools sold under the trademark LEICA. The "About Prexishop" page of site also contains the statement "Prexishop is owned by Instop SLU, the official distribution company for the Leica Geosystems brand in Spain for the past 27 years. We specialize in the trade of measuring instruments, providing sales, technical service, and support for these devices.". Finally, the footer of each page displays the copyright notice "© 2024 Prexishop".

Here, based on the presented evidence, the Panel finds that the disputed domain name features the Complainant's PREXISO trademark and adds only the ".shop" gTLD. This clear attempt to create an association with the Complainant, combined with use of the trademark on the Respondent's website, the offering for sale of competing products, and the lack of a disclaimer of affiliation with the Complainant, fails to satisfy the second and third elements of the Oki Data test. Thus, the Respondent is not using the domain name in connection with a bona fide offering of goods or services under Policy paragraph 4(c)(i), or a legitimate noncommercial or fair use per Policy paragraph 4(c)(iii).

In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) and of the Policy and demonstrated that the Respondent has no rights or legitimate interests in the disputed domain name.

3. Bad Faith Registration and Use

The Complainant argues that the Respondent had prior knowledge of the PREXISO mark at the time of registering the disputed

domain name. Actual knowledge of a complainant's trademark, through reputation of the trademark and/or through the use made of the disputed domain name, may form the foundation upon which to build a case for bad faith under Policy paragraph 4(a)(iii). See, Xiaomi Inc. v. Nguyễn Đức Đạt (N/A), UDRP-107237 (CAC February 12, 2025) ("The Panel infers that the Respondent had actual knowledge of the Complainant's rights in the XIAOMI mark at the time of registration, as demonstrated by the Respondent's use of the mark, its offering of competing products, and the widespread recognition of the Complainant's trademark."). Here, as the Respondent's website displays images of the Complainant's PREXISO products and offers them for sale, the Panel finds it quite certain that the Respondent knew of the trademark at the time that it registered the disputed domain name.

The Complainant further claims that the Respondent attempts to create a likelihood of confusion regarding the Complainant's affiliation with the Respondent's website in order to further a business where products are distributed for commercial gain and in competition with the Complainant. Using a disputed domain name to trade upon the goodwill of a complainant for commercial gain can demonstrate bad faith under Policy paragraph 4(b)(iv). See Koninklijke Philips N.V. v. hossein gholamrezaei hossein gholamrezaei, meysam habibvand meysam habibvand, and Mohsenkamali Mohsenkamali, UDRP-107218 (CAC February 19, 2025) (finding that where "all disputed domain names resolve to websites showing the PHILIPS mark and offering products similar or at least related to the Complainant's products for sale", this "indicates that the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain by creating a likelihood of confusion with the Complainant's trademark"). As noted above, the Complainant provides screenshots of the resolving website associated with the disputed domain name, which offers the Complainant's products for sale alongside those of its competitor. It asserts that the Respondent's choice of the disputed domain name was "malicious" and that "the Respondent's use of the disputed domain name to deliberately imitate the Complainant's PREXISO brand for profit is consistent with Policy 4B(iv).". The Panel agrees and finds that the Respondent registered and uses the disputed domain name to commercially benefit from confusion with the Complainant's trademark in bad faith under Policy paragraph 4(b)(iv).

In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) and that the disputed domain name has been 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. **prexiso.shop**: Transferred

PANELLISTS

Name	**Steven Levy**

DATE OF PANEL DECISION 2025-03-03

Publish the Decision