

Decision for dispute CAC-UDRP-104379

Case number	CAC-UDRP-104379
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Time of filing	2022-03-01 08:44:34
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Domain names	viooh.xyz
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Case administrator

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

Organization	VIOOH Limited
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	LIUQINGRU
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following trademarks "VIOOH":

- French trademark VIOOH no. 4404784 registered since November 15, 2017, for goods and services in classes 9, 35, 36, 38, 41 and 42;
- international trademark VIOOH no. 1436571, registered on May 14, 2018, for goods and services in classes 9, 35, 36, 38, 41 and 42;
- international trademark VIOOH no. 1434610, registered on May 14, 2018, for goods and services in classes 9, 35, 36, 38, 41 and 42.

The disputed domain name <viooh.xyz> was registered on February 21, 2022.

FACTUAL BACKGROUND

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

Launched in 2018, VIOOH Limited is a leading global digital out of home marketplace, combining data and technology,

connecting buyers and sellers, all with full transparency.

The Complainant contends that addition of the gTLD suffix “.XYZ” is not sufficient to escape the finding that the disputed domain name is identical to the Complainant's trademark and does not change the overall impression of the designation as being connected to its trademark.

Therefore, the Complainant contends that the disputed domain name <viooh.xyz> is identical to Complainant's trademark VIOOH.

The Complainant asserts that the Respondent is not identified in the WHOIS database as the disputed domain name. 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. Thus, the Respondent is not known as the disputed domain name.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark VIOOH, or apply for registration of the disputed domain name by the Complainant.

The disputed domain name points to a webpage where the domain name is offered for sale. The Complainant contends that this general offer to sell the disputed domain name evidences the Respondent's lack of rights or legitimate interest.

Therefore, the Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain name.

The Complainant states that the disputed domain name is identical to its trademark VIOOH, which has been registered several years before the registration of the disputed domain name.

Moreover, the trademark VIOOH is registered in the Trade Mark Clearing House since April 12, 2018.

Besides, the term “VIOOH” is highly related to the Complainant, as all the results of a simple Google search are related or refers to the Complainant and its financial support JCDECAUX.

Therefore, the Complainant contends that it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of Complainant's rights in the trademark.

Moreover, the Respondent does not make any use of the disputed domain name. The disputed domain name resolves to a webpage displaying a general offer to sell the domain.

The Complainant claims that the Respondent fails to make an active use of the disputed domain name. Past panels have held that failure to actively use a domain name is evidence of bad faith registration and use.

Furthermore, the Complainant contends that the Respondent has registered the disputed domain name only in order to sell it back, which evinces bad faith registration and use.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "VIOOH", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark only by the addition of the top-level domain ".xyz".

It is well established that merely adding a top-level domain to a trademark is not sufficient to distinguish a domain name from a trademark (see, for example, CAC Case No. 100831).

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or
- (iii) [the Respondent] [is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Respondent is not identified in the WHOIS database as the disputed domain name;
- the Respondent is not affiliated with nor authorized by the Complainant in any way;
- the Complainant does not carry out any activity for, nor has any business with the Respondent;
- neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark VIOOH, or apply for registration of the disputed domain name by the Complainant; and
- the disputed domain name points to a webpage where the disputed domain name is offered for sale.

Taking into account the fact that, based on the information of the Whois database, the Respondent is not commonly known by the disputed domain name, that no relationship exists between the Complainant and the Respondent, that the disputed domain name points to a webpage where the disputed domain name is offered for sale, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

- (i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or
- (ii) [the Respondent] [has] registered the [disputed] 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 [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

Taking into account that the disputed domain name is identical to the Complainant's trademark VIOOH (registered some years before the registration of the disputed domain name), and that the trademark VIOOH is registered in the Trade Mark Clearing House since April 12, 2018, well before the registration of the disputed domain name, the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the Complainant's trademark when registering the disputed domain name. Indeed, if the Respondent had carried out a search on the most common search engines, he would have found references to the Complainant.

Other panels considered that knowledge of a corresponding mark at the time of the domain name's registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100). The Panel shares this view.

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain name it would have filed a Response in this proceeding.

Furthermore, other panels considered that the general offer to sell the domain name constitutes bad faith use (see, for example, WIPO Case No. D2011-1981). In the circumstances of this case, the Panel shares this view.

The Panel, having taken into account the Respondent's knowledge of the Complainant's trademark "VIOOH" at the time of the disputed domain name registration, that no response to the complaint has been filed and the use of the disputed domain name in a webpage where the disputed domain name is offered for sale, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **VIOOH.XYZ**: Transferred

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION	2022-04-03
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Publish the Decision	
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