

Decision for dispute CAC-UDRP-104722

Case number	CAC-UDRP-104722
Time of filing	2022-07-12 09:39:07
Domain names	microsoft-surface-cd.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
--------------	--

Complainant

Organization	Microsoft Corporation
--------------	------------------------------

Complainant representative

Organization	Convey srl
--------------	-------------------

Respondent

Name	guo zhi jian
------	---------------------

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 MICROSOFT and SURFACE, such as:

- International Trademark no. 1318242 – MICROSOFT;
- International Trademark no. 1142097 – MICROSOFT;
- European Union Trademark no. 000330910 – MICROSOFT;
- European Union Trademark no. 000479956 – MICROSOFT;
- European Union Trademark no. 007138225 – MICROSOFT OFFICE;
- International Trademark no. 1321384 – SURFACE;
- International Trademark no. 1135373 – SURFACE; and
- European Union Trademark no. 005955018 – MICROSOFT SURFACE.

The Complainant is also the owner of the domain name <microsoft.com>.

FACTUAL BACKGROUND

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

The Complainant was founded on April 4, 1975. It develops, manufactures, licenses, supports, and sells computer software, consumer electronics, personal computers, and related services.

The Complainant was founded by Bill Gates and Paul Allen in order to produce software for the Altair 8800, an early personal computer. The company went on to license its MS-DOS operating system to IBM for its first personal computer, which debuted in 1981. Afterward, other computer companies started licensing MS-DOS, which had no graphical interface and required users to type in commands in order to open a program.

In 1985, the Complainant released a new operating system, Windows, with a graphical user interface that included drop-down menus, scroll bars and other features. In 1986, the Complainant moved its headquarter to Redmond, Washington, USA and became publicly listed. By the late 1980s, the Complainant had become the world's biggest personal-computer software company, based on sales.

The Complainant's product, Microsoft Office, which was introduced in 1990, bundled separate applications such as Microsoft Word and Microsoft Excel. A few years later, the Complainant began to expand its product line into computer networking and the World Wide Web releasing Windows 95 that included technologies for connecting to the internet, such as built-in support for dial-up networking, TCP/IP (Transmission Control Protocol/Internet Protocol), and the web browser Internet Explorer 1.0.

When Bill Gates stepped down as the Complainant's Chief Operating Officer in 2000, the Complainant entered the gaming and mobile phone market. The Windows Mobile OS is used by numerous sellers including HTC, LG, Samsung, LG. In 2002, the Complainant released the Xbox followed by Xbox Live. Both releases were very successful and placed the Complainant second in the video gaming market. The Xbox 360, released in 2005, became a very powerful gaming console.

In 2014, the Complainant shifted away from consumer tech and toward business services, particularly subscription - or advertising-based online services such as cloud computing. In 2016 the Complainant acquired the professional networking platform LinkedIn. Consequently, the Complainant has been reorganized into two main divisions: "Experiences & Devices" and "Cloud + AI."

Today, the Complainant is amongst the leading players in the world hi-tech, with about 120 subsidiaries and 160,000 employees worldwide. In 2021 the revenues were more than USD \$168 billion and its ranked number 21 in the 2021 Fortune 500 rankings of the largest United States corporations by total revenue.

The Complainant is considered one of the Big Five companies in the United States information technology industry, along with Google, Apple, Amazon and Facebook.

The trademarks MICROSOFT and SURFACE, registered and used for many years, are distinctive and well-known all around the world.

The Complainant has extensively used the MICROSOFT and SURFACE denominations on all internet environments including and not limited to the company's official website <microsoft.com>, and its official accounts on the major social networks such as LinkedIn, Instagram, Facebook, Twitter and blog.

The Respondent registered the disputed domain name <microsoft-surface-cd.com> on December 5, 2020.

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).

The Complainant contends that the disputed domain name is confusingly similar to its registered trademarks MICROSOFT and SURFACE, to which trademarks the Respondent has included in the disputed domain name in its entirety with the addition of the term “CD”, with each of the trademarks and terms separated by the hyphen “-“.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0902; *Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin*, WIPO Case No. D2003-003-0888; *Wal-Mart Stores, Inc. v. Henry Chan*, WIPO Case No. D2004-0056.

The Complainant contends that the addition of the term “CD” to the disputed domain name is not sufficient to negate confusing similarity between a trademark and a domain name, and in the present case can increase the confusing similarity. See *GA Mo S.A. v. Mark O'Flynn* Case No. D2000-1424.

The Panel considers that the trademarks MICROSOFT and SURFACE are well-known trademarks, and in this case incontestably the principal part of the disputed domain name. The addition of the term “CD” does not change the overall impression of the designation as being connected with the Complainant’s trademarks MICROSOFT and SURFACE. The use of the hyphen “-“ separating each of the terms, in the Panel’s view, increases the likelihood of confusion between the disputed domain name and the Complainant as the true owner of the trademarks, and the domain name associated with the Complainant and its business.

The Complainant further contends that the top level “.com” is merely instrumental to the use in Internet. See *The Forward Association, Inc., v. Enterprises Unlimited Forum* case FA0008000095491, October 3, 2000.

It is now a well-established principle in the domain name space that generic top-level domains such as “.com”, “.org” or “.net” do not affect the domain name for the purpose of determining whether it is identical or confusingly similar. See, for example, *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. D2006-0451.

The Panel considers that the addition of the generic top-Level domain suffix “.com” does not change the overall impression of the designation of the disputed domain name as being connected to the Complainant’s trademarks MICROSOFT and SURFACE.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark and that paragraph 4(a)(i) of the Policy is satisfied.

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).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd*, WIPO Case No. D2003-0455.

The mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name. See *Pharmacia & Upjohn Company v. Moreonline*, WIPO Case No. D2000-0134 and *National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net*, WIPO Case No. D2000-0118.

At the outset, the Panel notes that the disputed domain name was registered on December 5, 2020. There is no evidence to

show when the Complainant first knew of the disputed domain name other than from the period when the Complainant's agent sent a "cease and desist" letter to the Respondent on June 29, 2022.

If there was a delay in bringing proceedings, it is approximately 1½ years after the disputed domain name was registered by the Respondent. This fact raises the question whether the Respondent has accrued rights in the disputed domain name and consideration of paragraph 4(c)(i) of the Policy. While there is no time bar for claims under the UDRP, the burden of satisfying paragraphs 4(a)(ii) and 4(a)(iii) of the Policy remain.

The Complainant has not specifically responded to the length of delay in bringing the proceedings but it has adduced evidence of the strength of its trademarks MICROSOFT and SURFACE, and the global markets in which it operates.

Balancing all the extensive evidence and the notoriety of the trademarks, the Panel is satisfied that the delay is not fatal to the Complainant in circumstances where the evidence show the Respondent is prima facie seeking to unlawfully register the disputed domain name by incorporating the Complainant's well-known trademarks in order to use the disputed domain name for commercial gain without the permission or authority of the Complainant. See *Coles Pen Company Limited v Cole, Samantha/Coles of London*, FA1702001717458; *The Board of Regents of The University of Texas System v LLC Perfect Privacy*, FA1708001745104.

In support of this ground, the Complainant makes three contentions:

First, the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. The Respondent is also not authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name.

The Panel accepts this uncontradicted contention.

Secondly, the Complainant seeks to rely on information and belief that the Respondent is not commonly known by the disputed domain name, as individuals, business or organization and his family name does not correspond to MICROSOFT, SURFACE, or the disputed domain name. The Panel observes to merely rely on "information and belief" to support a contention is insufficient. It is not evidence.

However, in this case, it is abundantly clear from the materials adduced in evidence that the Complainant's contention is supported by evidence, especially when the Respondent is not identified in the WHOIS database as the disputed domain name.

Where information in the WHOIS database is not similar to the disputed domain name, a respondent is not commonly known by the disputed domain name. See, for example, *Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group*, Forum Case No. FA 1781783; *The Braun Corporation v. Wayne Loney*, Forum Case No. FA 699652.

The Panel, therefore, accepts this contention.

Thirdly, the Complainant contends that the Complainant has not provided the Complainant with any evidence of the 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 Complainant contends that the disputed domain name is being redirected by the Respondent to a website promoting pharmaceutical products and medical equipment. It contends that the Respondent is intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion. It further contends that an internet user could reasonably but at the same time wrongly assume that the website corresponding to the disputed domain name is sponsored by, affiliated with, or otherwise approved by the legitimate rights owner, namely the Complainant.

The Complainant's evidence shows that the disputed domain name resolves to a website that is in the Chinese language dealing with the products contended above.

The Respondent has not filed any administrative compliant response to the Amended Complaint. As such, the Complainant's evidence is uncontradicted.

The Panel accepts the Complainant's uncontradicted contentions and supporting evidence, and accordingly the Panel finds the Respondent has no right or legitimate interests in the disputed domain name.

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).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The evidence shows that the Complainant's trademarks MICROSOFT and SURFACE are well-known trademarks in the Information Technology sector. The Complainant has many subsidiaries worldwide including in China, where the Respondent is based. The evidence shows the Complainant's extensive reputation in its trademarks globally.

The Panel accepts and finds that the Complainant's trademarks are undoubtedly one of the most recognisable brands in the world. See UDRP decisions Microsoft Corporation v. StepWeb, WIPO Case No. D2000-1500; Microsoft Corporation v. Paul Horner, WIPO Case No. D2002-0029; Microsoft Corporation v. Webbangladesh.Com, WIPO Case No. D2002-0769; Microsoft Corporation v. Charilaos Chrisochou, WIPO Case No. D2004-0186.

The Complainant contends that the Respondent must have been aware of the Complainant's trademarks at the time the Respondent registered the disputed domain name.

The Panel considers that it is reasonable to infer that the Respondent knew of or should have known about the Complainant's rights, and therefore registered the disputed domain name with full knowledge of the Complainant's trademark. This is because of the manner in which the Respondent sought to use the Complainant's trademarks in the disputed domain name by accentuating each of the words MICROSOFT and SURFACE with the hyphen "-" joining the two trademarks and adding "-CD" to make up the disputed domain name. The strong inference here is that the Respondent intended to use the trademarks for its own commercial gain without lawful authority and thereby the Panel considers that such registration would be done in bad faith.

The Panel notes the past panel decision in Ferrari S.p.A. v. Allen Ginsberg, WIPO Case No. D2002-0033 where the respondent in that case registered the domain name <maserati.org> corresponding to the well-known or even famous trademark MASERATI which the panel found that he must have been aware of.

Accordingly, the Panel finds it is inconceivable that the Respondent would have registered the disputed domain name without being aware of the Complainant's legal rights.

Use in bad faith

The Panel has already referred to the uncontradicted facts set out in the Amended Complaint and accepts the evidence and contention that the disputed domain name resolves to a website promoting pharmaceutical products and medical equipment.

The strong inference is that the Respondent is intentionally attracting Internet users by creating likelihood of confusion with the Complainant's trademarks as to the source of the website and its products.

The fact that the Respondent has an active website suggest that it appears unabashed about using the disputed domain name incorporating the Complainant's trademarks for its own unauthorized commercial gain. This is a classic bad faith use. See First ScotRail Limited v. Mark Thomson, WIPO Case No. D2013-1623

The Complainant further contends that there is no disclaimer informing the internet users the absence of relationship between the Complainant and the Respondent. It is unnecessary for the Panel to make a finding on this contention as the Panel already considered that the registration is in bad faith. In any event, even if there was a disclaimer it does not absolve a respondent should there be a finding that registration was done in bad faith.

Further, the Complainant adduced evidence that on June 29, 2022 the Complainant's agent sent a "cease and desist" letter to the Respondent notifying it of the infringement of the Complainant's trademarks and requesting that it immediately cease any use, and transfer, of the disputed domain name to the Complainant.

The Czech Arbitration Court has also provided written notice of the Complaint to the Respondent in the Chinese language with no responses made in respect to any good faith use of the disputed domain name.

Despite written notices being given by the Complainant in the form of its "cease and desist" letter and CAC's two separate written notification (in the English and the Chinese languages) of the proceedings, the Respondent has not provided any administratively compliant response.

This conduct, the bona fides of which are clearly left unexplained by the Respondent, is in the Panel's view evidence of bad faith. See *StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC*, WIPO Case No. D2018-0497; *Citigroup Inc. v. Kevin Goodman*, Forum Case No. FA 1623939.

In the circumstances, the Panel finds it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be legitimate. See *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. D2007-0062.

The Panel, therefore, concludes that the Respondent's holding of the disputed domain name in this case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use were in bad faith.

PROCEDURAL FACTORS

Language of the proceedings

By its Amended Complaint, the Complainant requested that the proceedings be in English despite the language of the Registration Agreement providing that the language of the proceeding should be in Chinese.

On August 11, 2022, the Panel made the procedural orders to ensure there be fairness and justice pursuant to Rule 10 of the Rules accorded to the Respondent given that the initial written notice to the Respondent was in English and not in the Chinese language.

No administrative compliant response was received from the Respondent by the deadline of 2pm on Monday August 22, 2022.

Accordingly, the Panel confirms its preliminary indication of preparedness to accede to the Complainant's request that the language of the proceedings be in English and accordingly proceed to determine this proceeding in the English language.

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieved actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On August 3, 2022 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

- As far as the e-mail notice is concerned, the CAC received a confirmation that the e-mail sent to 8rja9tx9kzwizwey@gmail.com, postmaster@microsoft-surface-cd.com and trade@mehecointl.com.cn were returned back undelivered as the e-mail addresses had permanent fatal error.

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, the Panel is satisfied that CAC has discharged this responsibility.

On August 11, 2022 the CAC by its non-standard communication and pursuant to the Panel's procedural orders made on August 11, 2022 notified the Respondent in the Chinese language of the CAC proceedings, to which there was no response.

PRINCIPAL REASONS FOR THE DECISION

The Complainant owns the registered trademarks MICROSOFT and SURFACE and the domain name <microsoft.com> which is used in connection with its goods or services for a considerable time. The Complainant's trademarks are well-known globally.

The Respondent registered the disputed domain name on December 5, 2020. The disputed domain name has the addition of "CD" at the end of the Complainant's trademarks which is incorporated in its entirety separated by the use of the hyphen "-".

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent has failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is confusingly similar to the Complainant's well-known trademarks MICROSOFT and SURFACE.
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- (c) The disputed domain name has been registered and is being 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. **MICROSOFT-SURFACE-CD.COM**: Transferred

PANELLISTS

Name	Adjunct Prof William Lye, OAM QC
------	---

DATE OF PANEL DECISION	2022-08-29
------------------------	------------

Publish the Decision
