



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office) ADMINISTRATIVE PANEL DECISION

Case No. HK-1000320

Complainant: Inter Ikea System B.V., Delft, the Netherlands

Respondent: Isaac Goldstein, Hong Kong

1. The Parties and Contested Domain Name

The Complainant is Inter Ikea System B.V., Delft, the Netherlands.

The Respondent is Isaac Goldstein, Hong Kong.

The domain name at issue is <ikeaexp.com> (“the Disputed Domain Name”), registered by Respondent with Mynameonline.ca Inc., Ottawa, Canada.

2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the “ADNDRC”) on October 29, 2010. On November 2, 2010, the ADNDRC transmitted by email to Mynameonline.ca a request for registrar verification in connection with the Disputed Domain Name. On November 3, 2010, Mynameonline.ca transmitted by email to the ADNDRC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The ADNDRC verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the ADNDRC formally notified the Respondent of the Complaint, and the proceedings commenced on November 3, 2010. In accordance with the Rules, paragraph 5(a), the due date for Response was November 23, 2010. No Response was filed by the Respondent in the proceedings.

After consultation of the parties according to the Supplemental Rules, article 8 para. 5, the ADNDRC appointed Jacques de Werra as the sole panelist in this matter on November 29, 2010.

The Panel determines that the appointment was made in accordance with para. 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

3. Factual background

The Complainant is the owner of a unique concept for the sale of furniture and other home styling products, all marketed under the trademark IKEA (“the Trademark”), which is registered in Hong Kong and in many other countries. The Complainant owns approximately 1400 trademarks for the IKEA trademarks and variants thereof in more than 70 countries of the world. The business model of the Complainant is based on franchise and only approved and retailers who have entered into an agreement with the Complainant may use this concept, with the Trademark included. The trademark is notoriously famous both globally within the furniture and home styling market. The Trademark has acquired a high degree of public

recognition and distinctiveness as a symbol of the source of high quality goods and services offered by the Complainant and ranked Nr 28 in a global ranking of the best global brands.

The founder, Ingvar Kamprad, began using it in Sweden for the first time in 1943. Today there are more than 300 IKEA stores in more than 35 countries all over the world and the sales amount to 22,7 billion euros, in the financial year of 2009. The IKEA Catalogue is printed in almost 200 million copies every year and in 2009, the catalog was printed in 56 editions and 27 languages.

The Complainant has claimed protection of the Trademark in numerous UDRP proceedings. It is also the owner of various domain names for presenting its products and services (including at www.ikea.com).

The Disputed Domain Name was registered by the Respondent on June 14, 2010. It is presently used in the course of a parking program (via sponsored links) whereby certain websites are pointing to companies offering products which compete with those offered by Complainant.

A previous UDRP dispute about the Disputed Domain Name led to a decision dated July 9, 2010 which ordered its transfer to the Complainant (ADNDRC Case No.HK-1000287). However, the then registrar of the Disputed Domain Name released the Disputed Domain Name because the previous registrant had not paid the renewal fee which led to the registration of the Disputed Domain Name by the Respondent.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Complainant has built up a successful worldwide business based on the Trademark which is well-known and which is illegally used in the Disputed Domain Name, whereby the addition of the term "exp" does not exclude the confusing similarity between the Trademark and the Disputed Domain Name.
- ii. The Respondent has no right in the Disputed Domain Name and he is not authorized or licensed to use the Trademark, and he had knowledge about the Complainant and of the Trademark before registering the Disputed Domain Name, whereby it is impossible to conceive of any circumstances in which the Respondent could legitimately use the Disputed Domain Name without creating a false impression of association with the Complainant. The Complainant further sent a cease and desist letter to the Respondent on August 10, 2010 to which he did not answer.
- iii. The Respondent has registered and is using the Disputed Domain Name in bad faith by using the Disputed Domain Name in a parking system pointing (via sponsored links) to products competing with those of Complainant. The Respondent has also been involved as respondent in another UDRP proceeding in the past in which the transfer of the relevant domain name had been ordered.

B. Respondent

The Respondent did not file a response in these proceedings.

5. Findings

The Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

The Panel is satisfied that the Complainant has rights to the Trademark in Hong Kong (where the Respondent is based) as well as in many other countries.

A comparison between the Disputed Domain Name and the Trademark shows that the Disputed Domain Name is closely similar to the Complainant's Trademark. The only difference between the Disputed Domain Name and the Trademark is the addition of the descriptive term "exp" which is clearly insufficient to exclude the confusing similarity between them, given that the distinctive element of the Disputed Domain Name is "IKEA".

As a result, based on the rights of the Complainant in the Trademark and on the confusing similarity between the Trademark and the Disputed Domain Name, the Panel finds that the conditions of paragraph 4(a)(i) of the Policy are met.

B) Rights and Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

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

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, previous panels have consistently ruled that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the domain name, once the Complainant has made a *prima facie* showing. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

In the Panel's opinion, the Complainant has made a *prima facie* case against the Respondent. The Respondent indeed registered the Disputed Domain Name the key element of which corresponds to the famous Trademark owned by the Complainant.

The Complainant has also established that the Respondent has no right in the Disputed Domain Name, that he is not authorized or licensed to use the Trademark.

The Panel thus accepts the Complainant's *prima facie* showing and it is consequently up to the Respondent to come forward with evidence of a right to or legitimate interests in the Disputed Domain Name.

Given that the Respondent has not filed a response in these proceedings, the Panel finds that the Respondent has no right or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) circumstances indicating that the respondent 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;
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its website 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 website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

In this case, the Panel holds that the Respondent registered the Disputed Domain Name in bad faith because the Trademark is distinctively identifying the Complainant and the Respondent could not have failed to know of the Trademark before registering the Disputed Domain Name.

In the absence of any evidence provided by the Respondent legitimizing his use of the Disputed Domain Name and explaining in a convincing manner the choice of the Disputed Domain Name, the Panel cannot conclude otherwise than by stating that the registration and use of the Disputed Domain Name was made in bad faith. See *Aventis Pharmaceuticals Products Inc. v. PBS Publishing LLC*, WIPO Case No. D2003-0122.

Furthermore, based on the uncontradicted evidence filed by the Complainant, the Panel admits that the Respondent registered the Disputed Domain Name and uses it for the purposes of monetary gain by providing links to sites which are unrelated to the ones of the Complainant or are in some cases even competing with the products of the Complainant. Such use of the Disputed Domain Name can only be explained by the intent of the Respondent to attract Internet traffic by capitalizing on the Complainant's Trademark. This type of use of the Disputed Domain Name constitutes sufficient evidence of the bad faith of the Respondent under paragraph 4(b)(iv) of the Policy. See *Rhino Entertainment Company v. DomainSource.com, Inc.*, WIPO Case No. D2006-0968 and *Imperial Chemical Industries PLC v. RareNames*, WIPO Case No. D2006-0124.

On this basis, the Panel is convinced that the Respondent registered and used the Disputed Domain Name by intentionally attempting to attract users, for commercial gain, to its website by creating a likelihood of confusion with the Complainant's Trademark as the source, sponsorship, affiliation or endorsement of the Respondent's website.

For these reasons, the Panel considers that the Complainant has established that the Disputed Domain Name was registered and is being used in bad faith by the Respondent pursuant to paragraph 4(a)(iii) of the Policy.

6. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <ikeaexp.com> be transferred to the Complainant.

Jacques de Werra

Panelist

Dated: December 13, 2010