

## **ADMINISTRATIVE PANEL DECISION**

Desenio AB v. Alex Song  
Case No. D2022-3415

### **1. The Parties**

The Complainant is Desenio AB, Sweden, represented by Ports Group AB, Sweden.

The Respondent is Alex Song, United States of America (“United States”).

### **2. The Domain Name and Registrar**

The disputed domain name <deseniodecor.com> is registered with CloudFlare, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 14, 2022. On September 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 16, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 20, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on September 23, 2022.

The Center verified that the Complaint together with the amendment to 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 WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 19, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the parties that it would proceed to panel appointment on October 20, 2022.

The Center appointed Warwick Smith as the sole panelist in this matter on November 8, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is a Swedish company founded in 2010. It specializes in interior design, art and decorations. According to the Complaint, it has an online presence in 33 countries.

The Complainant is the registered proprietor of numerous DESENIO trade marks and service marks, including the following:

- United States word mark No. 5634989, registered on December 25, 2018, in International Classes 16, 20, 35, and 42;
- European Union word mark No. 016905507 registered on October 19, 2017, in International Classes 16, 20, 35, and 42;
- United Kingdom word mark No. UK 00916905507, registered on October 19, 2017, in International Classes 16, 20, 35, and 42.

In addition, the Complainant holds an International registration for its DESENIO word mark in the same classes. The International mark No. 1383099 registered on November 21, 2017, designates the following countries: Australia, China, Japan, Republic of Korea, and the United States.

The Complainant also owns the domain name <desenio.com>, which it uses to market its products. That domain name was registered on December 29, 2004.

The disputed domain name was registered on March 17, 2022. The Complainant produced a screen shot showing that the disputed domain name has resolved to an English language website (the Respondent's website) at which various products were marketed, including Christmas and Halloween lights. The Respondent's website also contained the click-on links "Canvas Art", "Gallery Wall", and "Tapestry".

The screen shot displayed the following statements:

"Welcome to Deseniodecor

It all started as a family business back in 2010. Since then we're so proud of how far Deseniodecor has come. Today, our incredible team has grown to nearly 100 and counting! With offices and warehouses across Europe and the US, our vision is still the same. We're focused on quality products . . . For us, it's more than just the lights, it's the feeling and the opportunity to transform any space. Transforming spaces is what we're all about, making a house a home . . .

#### Intellectual Property Rights

In the event of any concerns or complaints about possible violation of intellectual property rights please send us an email at [email address] identifying with specificity the rights alleged to be violated and the accused product(s). (This email address is just for intellectual property rights and legal issues. Other requests may not get [sic] response)."

On May 16, 2022, the Complainant's representatives sent a cease and desist letter to the Respondent via the Registrar, and to [...]@deseniodecor.com. The letter referred to the Complainant's reputation for its "stylish posters, prints, frames and other wall art" marketed under the DESENIO mark, and to a number of the Complainant's registrations of that mark. It demanded that the Respondent agree to an immediate transfer of the disputed domain name to the Complainant.

The Respondent did not reply to the cease and desist letter.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that it has rights in its DESENIO trade mark and service mark, and that the disputed domain name is confusingly similar to that mark.

It says that it has not licensed or otherwise allowed the Respondent to use its DESENIO mark, and there is no evidence to suggest that the Respondent has been commonly known by the names "Desenio" or "Deseniodecor". It says that the Respondent has not used, or prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services, or for any legitimate noncommercial or fair use. For those reasons, it says that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant next contends that the Respondent registered the disputed domain name in bad faith and has been using it in bad faith. It submits that its DESENIO mark was registered (in numerous jurisdictions) well before the disputed domain name was registered, and that the Respondent was well aware of the Complainant and its mark when he registered the disputed domain name. The Complainant alleges that the Respondent has been using the disputed domain name to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's DESENIO mark as to the source, sponsorship affiliation, or endorsement of the website or of a product or service on the website. The Respondent has been aiming to unlawfully profit through this use.

Alternatively, the Respondent's registration and use of the disputed domain name is alleged to reflect a deliberate intention to disturb and interrupt the Complainant's business.

The Complaint refers to the Respondent's use of a privacy service when registering the disputed domain name, as an additional factor justifying a finding of bad faith registration and use.

For the foregoing reasons, the Complainant says that it is entitled to an order transferring the disputed domain name to it.

### B. Respondent

The Respondent did not file any formal reply to the Complaint. However, the Respondent did send an email to the Center on September 30, 2022, containing the following:

“. . . Sorry for the late reply!  
We just found this email today, and we haven't found this problem before. The brand Desenio is for stylish wall art. But our store Deseniodecor is occasion clothing in the future. There is no competition between us, we will use this site in the clothing category.  
Thanks again for your (sic) understaing.  
Best regards, Alex Song:"

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to establish each of the following:

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

## A. Identical or Confusingly Similar

The Complainant is the registered proprietor of the DESENIO mark, in numerous jurisdictions. That is sufficient to establish that it has rights in the DESENIO mark for the purposes of paragraph 4(a)(i) of the Policy.

The only issue to be decided under paragraph 4(a)(i) is whether the “deseniodecor” part of the disputed domain name is confusingly similar to the Complainant’s DESENIO mark.

The first point to note on that issue is that the DESENIO mark is incorporated in full within the disputed domain name, with only the addition of the dictionary word “decor” and the “.com” suffix (which is not taken into account in the comparison required by paragraph 4(a)(i) of the Policy.<sup>1</sup>)

The consensus view of UDRP panels on the issue of confusing similarity where a complainant’s mark is incorporated within a disputed domain name, is described as follows in [WIPO Overview 3.0](#):<sup>2</sup>

“Where the relevant trade make is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.”

In this case the DESENIO mark *is* clearly recognizable within the disputed domain name, and the addition of the dictionary word “decor” is clearly insufficient to negate the confusing similarity caused by the use of the mark in the disputed domain name.

For the foregoing reasons, the Complainant has made out its case under paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy set out a number of circumstances which, without limitation, may be effective for the Respondent to demonstrate that it has rights to, or legitimate interests in, a domain name for the purposes of paragraph 4(a)(ii) of the Policy. The circumstances are –

- (i) Before any notice to [the Respondent] of the dispute, use by [the Respondent] 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) Where [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 trade mark or service mark rights; or
- (iii) Where [the Respondent is] making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly direct consumers or to tarnish the trade mark or service mark at issue.

[WIPO Overview 3.0](#) states the following on the burden of proof under paragraph 4(a)(ii) of the Policy:<sup>3</sup>

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<sup>1</sup> The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) notes at section 1.11 that the gTLD is a standard registration requirement, and as such is disregarded when applying the confusing similarity test under paragraph 4(a)(i) of the Policy.

<sup>2</sup> [WIPO Overview 3.0](#), section 1.8.

<sup>3</sup> [WIPO Overview 3.0](#), at section 2.1.

“While the overall burden of proof in UDRP proceedings is on the Complainant, panels have recognized that proving a Respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the Respondent. As such, 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.”

In this case, the disputed domain name is confusingly similar to the Complainant’s DESENIO mark, and the Complainant has not licensed or authorized the Respondent to use its DESENIO mark, whether in a domain name or otherwise. There is nothing to suggest that the Respondent (or any entity associated with him) is or has been commonly known by the disputed domain name, so there could be no claim to a right or legitimate interest under paragraph 4(c)(ii) of the Policy. Nor is there evidence that might establish a credible claim to a right or legitimate interest under paragraph 4(c)(i) or 4(c)(iii).

Looking first at paragraph 4(c)(i), certain features of the Respondent’s website (as shown in the screen shot produced by the Complainant) appear to have been calculated to make it appear as if the Respondent’s website is somehow affiliated or associated with the Complainant. For example, the Respondent’s website contained click-on links to product categories that included “Canvas Art”, “Gallery Wall”, and “Tapestry”. One or more of those categories might have featured wall art of the kind marketed by the Complainant. Also, the Respondent’s business was said to have been established in 2010 (the same year the Complainant was established), and the Respondent’s website referred to the Respondent having warehouses and offices “across Europe [where the Complainant is based] & the US”.

In his email to the Center, the Respondent did not deny that he was aware of the Complainant and its DESENIO mark when he registered the disputed domain name. He said that the Respondent’s website was intended to be used for marketing clothing (apparently at some time in the future), whereas the Complainant uses the DESENIO mark for “stylish wall art”. He contended that the parties would not be competing in the same market. The screen shot of the Respondent’s website which the Complainant has produced does not feature clothing at all, and the Panel has no evidence that the Respondent has made any demonstrable preparations to use the Respondent’s website as an online clothing store.

The “Intellectual Property Rights” statement on the Respondent’s website is unusual, in that it appears to anticipate that the use of the disputed domain name might give rise to intellectual property rights violation complaints. Again, that is consistent with the Respondent being aware of the Complainant’s rights in the DESENIO mark, and that he was alert to the possibility that his use of the disputed domain name might result in litigation.

On the limited available evidence, it appears that the Respondent probably chose the disputed domain name with the intention of trading off the Complainant’s reputation in its DESENIO mark, for commercial gain. That could never have been a *bona fide* use of the disputed domain name, and accordingly could never have provided a basis for any claim to a right or legitimate interest under paragraph 4(c)(i) of the Policy.

Turning to paragraph 4(c)(iii), the Respondent’s website appears to be commercial in nature, and at least without a sufficient explanation from the Respondent for his decision to incorporate “desenio” in the disputed domain name, which has not been provided, the Respondent’s use of the disputed domain name appears to have been neither “legitimate” nor “fair”.

The foregoing factors in combination are sufficient to establish a *prima facie* case under paragraph 4(a)(ii) of the Policy. The evidential burden of showing rights or legitimate interests in respect of the disputed domain name therefore moves to the Respondent. In the absence of any Response, the Respondent has failed to discharge that evidential burden, and the Complainant’s *prima facie* proof must prevail. The Complainant has accordingly made out its case under paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, the following circumstances, without limitation, are deemed (if found by the Panel to be present) to be evidence of the registration and use of a domain name in bad faith:

- (i) Circumstances indicating that the holder has registered or has 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 trade mark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) The holder has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
- (iii) The holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 holder's website or location or of a product or service on the holder's website or location.

The Complainant has also proved this element of the Complaint.

The screen shot from the Respondent's website that the Complainant produced shows that the Respondent has used the Respondent's website to market products in categories which are either the same as or similar to the Complainant's product range (e.g. "Gallery Wall" and "Tapestry" products). He has failed to explain his choice of "desenio" as the dominant part of the disputed domain name, in circumstances where that choice did call for an explanation: "desenio" does not appear to be a dictionary word in the English language, nor an expression that the Respondent would be likely to have thought of if he was not aware of the Complainant and its DESENIO products.

The screen shot of the Respondent's website appears to have been designed to create the impression that the Respondent had a substantial presence in Europe, where the Complainant is based, and it included a claim that the Respondent established his business in the same year (2010) the Complainant established its business.

Having regard to those factors, and the absence of any formal Response to the Complaint, the Panel concludes that the Respondent was probably aware of the Complainant and its DESENIO mark when he registered the disputed domain name. On the limited evidence that is available, the likelihood is that he chose to incorporate the expression "desenio" in the disputed domain name with the intention of misleading Internet users, being users who were familiar with the Complainant and its products, into believing that the website to be established at the disputed domain name was sponsored, affiliated, or endorsed by the Complainant.

The Respondent's email to the Center dated September 30, 2022 does not suggest any other conclusion. The email did not include any denial of knowledge of the Complainant's rights in its DESENIO mark, and it offered no explanation for the Respondent's choice of the expression "desenio" as the dominant part of the disputed domain name. The obvious inference is that the Respondent registered the disputed domain name intending to trade off the Complainant's reputation in its DESENIO mark. The Respondent's explanation that he intends in the future to use the disputed domain name to market clothing is unsupported by any corroborating evidence, and is inconsistent with his actual use of the disputed domain name (as established by the screen shot of the Respondent's website, where there is no reference to clothing).

The Panel is satisfied that the circumstances just described fall squarely within paragraph 4(b)(iv) of the Policy. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website at the disputed domain name, by creating a likelihood of confusion with the Complainant's DESENIO mark, as to the source, sponsorship, affiliation, or endorsement of the website the disputed domain name.

That finding is sufficient to dispose of the case in the Complainant's favor, and there will be an order for transfer accordingly.

## **7. Decision**

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

*/Warwick Smith/*

**Warwick Smith**

Sole Panelist

Date: November 15, 2022