

ADMINISTRATIVE PANEL DECISION

Alcon Inc. v. Metin Ekici

Case No. D2023-1525

1. The Parties

The Complainant is Alcon Inc., Switzerland, internally represented.

The Respondent is Metin Ekici, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <dailiestotal1.website> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2023. On April 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 2023, 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 (Redacted for Privacy / Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 12, 2023, 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 amended Complaint on April 13, 2023.

The Center verified that the Complaint, together with the amended 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 April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 9, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on May 19, 2023. 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 an international eye care device company with complementary businesses manufacturing eye care products and medical devices. It employs over 20,000 people from more than 90 countries and is physically present in over 70 countries on six continents and serves patients in over 140 countries each year. The Complainant was the number two company in the branded contact lens market in 2022. Its contact lens products are the Total line of lenses, including DAILIES TOTAL1, a daily contact lens which features the company's Water Gradient and SMARTEARS technologies which product it has marketed since 2012.

The Complainant owns registered trade mark rights for its DAILIES TOTAL1 mark, including United States logo mark registration number 6195323 registered on November 10, 2020 and International word mark registration 1003015 registered on April 29, 2009. The Complainant also owns the domain names <dailiestotal1.com> and <dailiestotalone.com>.

The disputed domain name was registered on February 17, 2023 and resolves to a website that features the Complainant's DAILIES TOTAL1 trade mark and photographs of the Complainant's product together with articles concerning the availability of this product and of competing products from various eyewear retailers.

5. Parties' Contentions

A. Complainant

The Complainant submits that it owns registered trade mark rights in the DAILIES TOTAL1 trade mark as set out above and that the disputed domain name wholly incorporates the Complainant's trade mark and as a result is confusingly similar to it. It says that the ".website" top level domain name has no distinguishing effect and does not prevent a finding of confusing similarity.

The Complainant asserts that it, or its corporate predecessors, have used the DAILIES TOTAL1 trade mark for more than 10 years prior to the Respondent's registration of the disputed domain name on February 17, 2023. It says that no relationship exists between the Respondent and the Complainant, or any of the Complainant's licensees, agents or affiliated companies that would give rise to any licence, permission, or authorisation by which the Respondent could own or use the disputed domain name, which incorporates and is confusingly similar to the DAILIES TOTAL1 mark. It also says that no Alcon entity has ever authorised the Respondent to use its trade marks in any way. The Complainant further submits that the Respondent is not commonly known by the disputed domain name and does not offer its own goods or services in connection with the disputed domain name. Rather, the Complainant says that the Respondent uses the Complainant's trade mark and the photos of the Complainant's product to drive traffic to its site and away from the Complainant's legitimate product websites and to induce a mistaken belief that the Respondent or its website is connected to the Complainant.

As far as registration and use in bad faith is concerned, the Complainant submits that the prior registration of the DAILIES TOTAL1 trade mark by the Complainant, the tremendous marketplace success of the DAILIES TOTAL1 products and the fact that the disputed domain name is so obviously connected with the Complainant's well-known mark, means that the Respondent's bad faith in registering the disputed domain name may be presumed by the Panel. The Complainant says that the Respondent explicitly targeted its business when purchasing the disputed domain name and it notes also that the trade mark DAILIES TOTAL1 is solely associated with the Complainant. In addition, says the Complainant, the use of its product photos demonstrates that the Respondent is aware of and had the Complainant's DAILIES TOTAL1 mark in mind when it registered the disputed domain name.

The Complainant also notes that the Respondent has included in the "terms of use" on its website various statements regarding the ownership of the intellectual property therein. It asserts that in circumstances that these terms of use state that "Other than the content [you choose to display on this Website], we and/or our licensors own all the intellectual property rights and materials contained in our website, unless...noted

differently". The Complainant says that considering its demonstrated ownership rights in the DAILIES TOTAL1 trade mark and in its corresponding product, the statement on the website at the disputed domain name is false.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns International word mark registration 1003015 registered on April 29, 2009 for the DAILIES TOTAL1 trade mark. The disputed domain name wholly incorporates the Complainant's trade mark and is therefore confusingly similar to it. The ".website" top level domain does not prevent a finding of confusing similarity, as it is a standard registration requirement. Accordingly, the Panel finds that the Complaint succeeds under the first element of the Policy.

B. Rights or Legitimate Interests

The Complainant has asserted that it, or its corporate predecessors, have used the DAILIES TOTAL1 trade mark for more than 10 years prior to the Respondent's registration of the disputed domain name. The Respondent has maintained that no relationship exists between the Respondent and the Complainant, or any of the Complainant's licensees, agents or affiliated companies that would give rise to any licence, permission, or authorisation by which the Respondent could own or use the disputed domain name, which incorporates and is confusingly similar to the DAILIES TOTAL1 mark. It has also said that no Complainant entity has ever authorised the Respondent to use its trade marks in any way. It has further submitted that the Respondent is not commonly known by the disputed domain name and does not offer its own goods or services in connection with the disputed domain name. Rather, the Complainant has alleged that the Respondent has used the Complainant's trade mark and the photos of the Complainant's product to drive traffic to its site and away from the Complainant's legitimate product websites and to induce a mistaken belief that the Respondent is connected to the Complainant.

In these circumstances the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond to or to rebut the Complainant's case or to explain its conduct and the Panel therefore finds that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The Complainant's International trade mark registration 1003015 was registered in April 2009 long before the registration of the disputed domain name in 2023. The DAILIES TOTAL1 trade mark is highly distinctive and it is apparent that through use over many years it has developed a considerable reputation in the marketplace in connection with the Complainant's products and as such, it is more than likely that the Complainant was well aware of it and of the Complainant's business upon the registration of the disputed domain name. Further, the fact that the disputed domain name resolves to a website that features representations of the Complainant's trade mark and images from its website, indicates that it is more than likely that the Complainant registered the disputed domain name with knowledge of the Complainant's mark and in bad faith.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

In this case the disputed domain name resolves to a website, which features the Complainant's DAILIES TOTAL1 trade mark and appears to include copied images from the Complainant's website and when visited by the Panel also featured articles in both English and in the German language which appear to be in relation to specific eyewear retailers and which review the Complainant's products and discuss certain competing products. It is apparent that the disputed domain name is being used to drive Internet users to the Respondent's website and to either confuse them into thinking that the website to which the disputed domain name resolves is owned by, affiliated with, or has some connection with the Complainant when it does not, or alternatively to promote to Internet users competing products to those offered by the Complainant. It is apparent that the Respondent is using the disputed domain name in this regard for commercial purposes and the Panel finds that such use fulfills the requirements of paragraph 4(b)(iv) which is evidence of registration and use in bad faith.

The Panel therefore finds that the disputed domain name has both been registered and used in bad faith and that the Complaint also succeeds under this element of the Policy.

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 <dailiestotal1.website> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: June 2, 2023