Decision for dispute CAC-UDRP-100331

Case number	CAC-UDRP-100331
Time of filing	2011-11-03 14:57:03
Domain names	ECCOSHOESOUTLET.ORG

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	ECCO Sko A/S

Complainant representative

Organization	Chas. Hude A/S

Respondent

Organization	li yi

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings with regard to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant relies on its ownership of the trademark ECCO registered in several jurisdictions worldwide, among others the following in classes that include leatherware or footware:

Community Trademark Reg. No. 001149871, reg. date 06/02/2003
Community Trademark Reg. No. 002967040, reg. date 02/05/2007
US Trademark Reg. No. 1935123, reg. date 14/11/1995
Canadian Trademark Reg. No. 280654, reg. date 26/03/1983
Australian Trademark reg. No. 375267, reg. date 10/05/1982
Chinese Trademark Reg. No. 208743, reg. date 30/05/1984.

In addition, Complainant has a large portfolio of domain names consisting of, or containing, ECCO, including ECCO.COM, ECCOSHOE.COM, ECCOSHOES.COM, ECCOSHOES.ASIA, ECCOBRANDSHOP.COM, ECCOSHOPS.COM, ECCOSHOPS.DK, ECCO-SHOP.DK and ECCOSHOPPING.NL.

FACTUAL BACKGROUND

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

The disputed domain name contains Complainant's trademark ECCO in full, together with some generic terms related to Complainant's business. Furthermore, the first part of the disputed domain name corresponds to "ECCO" in the company name of Complainant. Therefore, the disputed domain name is confusingly similar to Complainant's trademark (Policy, Par. 4 (a)(1)).

Respondent has no rights in the trademark ECCO and is not a reseller/licensee of Complainant, use of the trademark ECCO by Respondent has never been authorized by Complainant, and Respondent is using its website to promote the sale goods, which are very likely counterfeit. Accordingly, Respondent has no rights or legitimate interests in respect of the domain name (policy, Par. 4 (a)(11)).

The trademark ECCO constitutes the first and dominant element of the disputed domain name. Complainant’s logo and pictures taken from Complainant's website and catalogue are used by the Respondent, who is attempting to divert Internet users to his domain name by creating a likelihood of confusion with Complainant’s trademarks, company name and domain names. Respondent is exploiting the goodwill attached to Complainant's trademarks and company name for selling goods which are very likely counterfeit. Furthermore, Respondent is exploiting the trademark ECCO to sell goods bearing third parties’ trademarks. For all these reasons, Complainant concludes that the disputed domain name was registered and is used in bad faith (Policy, Par. 4(a)(iii)).

In all the aforementioned circumstances, Complainant submits that the disputed domain name has been registered and is used in bad faith.

CAC’s and WIPO’s decisions in the following complaint proceedings support the case:

CAC:
Case no. 100259, eccoshoesshop.com
Case no. 100278, eccoshoesuk.net
Case no. 100305, eccoonlinesale.com
Case no. 100312, eccosaleonline.com

WIPO:
Case no. D2010-2038, eccodiscount.com
(http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-2038)
Case no. D2010-1443, eccobrandshop.com, ecooshop.com
http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1443)
Case no. D2010-1113, 51ecco.com
(http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1113)
Case no. D2010-0650, eccoshoesoutlet.com, eccoshoesoutlets.com, eccoshoesoutlets.net
(http://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0650.html)

Language
Complainant asks that the language of the proceedings be English. The disputed domain name includes English terms, SHOES and OUTLET. The text on the homepage underlying the disputed domain name is in English. The goods offered on sale are referred to with English descriptive terms. Moreover, the goods sold on Respondent’s homepage are sold in different currencies, e.g. US Dollars, GB pounds, Canadian dollars, Australian dollars that show that Respondent is selling to English speaking countries and is able to offer his support to English speaking customers. All these circumstances show that the Registrant has a good command of the English language, notwithstanding the fact that he is apparently residing in China.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

Complainant has made out its assertion of its ownership of the mark ECCO with proof of a portfolio of trademarks registered in several countries, including China, that are mainly associated with its business of manufacturing and selling shoes. It has valuable goodwill worldwide in its mark as witnessed by a large commercial presence internationally. Complainant also has numerous domain name registrations bearing the name ECCO and variations of it; these are registered under different top-level domains.

By the same token, in relation to whether a domain name is identical or confusingly similar to a Complainant's mark, use of the .ORG top level domain by the Respondent cannot provide sufficient variation from the protected mark, as many previous arbitral decisions have held in similar circumstances. "ECCOSHOESOUTLET" itself plainly produces confusing similarity with the Complainant's name in its business setting while the first and predominant element in the disputed domain name is identical, so satisfying the first cumulative element the Complainant must show under the UDRP. The second element is satisfied by the absence of any evidence for Respondent having a countervailing right or legitimate interest in ECCO.

As to the third element, bad faith, content taken from Complainant's homepage and catalogue is displayed on Respondent's web site without Complainant's authorization. In addition to use of a protected name, this blatant lifting of content helps to create the false impression that the site is owned or approved by Complainant or that Respondent has some form of business relationship with Complainant, so potentially or actually deviating intenet users away from legitimate sites. Products displayed on the site bearing third parties' trademarks, such as Ralph Lauren, MBT, Franklin and Marshall might, furthermore, create the false impression among internet users that an association between rival firms existed to create a "shoes outlet" or other distribution channel, in clear disregard of Complainant's interests. As regards Complainant's reasons to believe ECCO goods displayed on Respondent's site to be counterfeit, Complainant notes that some of the shoes offered are not even an imitation of original ECCO shoes, despite the ECCO logo having been associated with them. This exacerbates the bad faith already proven.

In finding for Complainant and its requested remedy of transfer, it is hard to imagine a clearer example of abusive registration and use of a domain name. It is, in the absence of any response from Respondent, accordingly unnecessary to add further to the findings above as to substance.

The only remaining clarification concerns the procedural aspect of language. The Complainant requested the use of English; no objection was received from Respondent by the due date. Given this circumstance and the fact that Respondent is sufficiently conversant with English to construct and maintain a web site in this language, Complainant's request is accepted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ECCOSHOESOUTLET.ORG**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2011-12-18

Publish the Decision