

Decision for dispute CAC-UDRP-100357

Case number	CAC-UDRP-100357
Time of filing	2011-12-16 14:38:30
Domain names	ECCO-STOVLER.COM, ECCOUDSALG.NET

Case administrator

Name	Tereza Bartošková (Case admin)
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Complainant

Organization	ECCO Sko A/S
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Complainant representative

Organization	Chas. Hude A/S
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Respondent

Organization	linmaojian
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant has cited multiple trademark registrations for ECCO for use in connection with footwear, including Community Trademark Reg. Nos. 001149871 and 002967040; U.S. Reg. No. 1,935,123; Canadian Reg. No. 280654; Australian Reg. No. 375267; and Chinese Reg. No. 208743.

FACTUAL BACKGROUND

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

Language

Notwithstanding the fact that the Registration Agreement is very likely in Chinese, the Complainant respectfully requests that the language of the proceedings be English.

The FAQ page under the disputed domain names is in English and a part of the text of the website is in English – see e.g. annex 12. This circumstance shows that the Respondent has a good command of the English language and would not be disadvantaged if the proceedings were conducted in English.

Legal basis

The disputed domain names contain Complainant's trademark ECCO in full. The addition of the generic terms STOVLER (a misspelling of the Danish word "støvler", meaning "boots") and UDSALG (which means "sale / clearance sale") does not preclude but even enhance the risk of confusion / likelihood of association with the Complainant's trademark and company name. Therefore, the disputed domain names are 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. Accordingly, Respondent has no rights or legitimate interests in respect of the domain names (policy, Par. 4 (a)(11)).

The fact that the Complainant's trademark ECCO constitutes the dominant element of the disputed domain names, and that the Complainant's logo is used by the Respondent without the rightful owner's authorization constitute strong evidence of the fact that the Respondent is attempting to divert Internet users to his domain names by creating a likelihood of confusion with the Complainant's trademarks, company name and domain names.

Furthermore, the Respondent is exploiting the goodwill attached to Complainant's trademarks for selling goods which are very likely counterfeit as well as goods bearing third parties' trademarks.

Finally, the Complainant claims that the Respondent has provided false whois information.

For all these reasons, Complainant finds that the disputed domain name was registered and is used in bad faith (Policy, Par. 4(a)(iii)).

In all the aforementioned circumstances, Complainant argues that the disputed domain names have been registered and are being 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. 100311, UKECCOSHOES.NET
Case No. 100321, ECCOSKOUDSALG.COM
Case No. 100312, ECCOSALEONLINE.COM
Case No. 100305, ECCOONLINESALE.COM
Case No. 100327, ECCOONLINESALEUSA.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>)

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Names are 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 Names (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 Names have been registered and are 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.

Although the Complaint was filed in English and the registrar has stated that the language of the registration agreement is Chinese, the Panel exercises its authority pursuant to Paragraph 11(a) of the Rules, "having regard to the circumstances of the administrative proceeding," to allow these proceedings to occur in English. In this regard, the Panel notes that the Complainant has stated that "The FAQ page under the disputed domain names is in English and a part of the text of the website is in English.... This circumstance shows that the Respondent has a good command of the English language and would not be disadvantaged if the proceedings were conducted in English." Allowing this proceeding to occur in English is consistent with numerous decisions under the UDRP, including at least one decision brought by the same Complainant as in the instant case, before the same panel, ECCO SKO A/S v. linlin, CAC Case No. 100278 (transfer of <eccoshoesuk.net>). This Panel finds similar factual circumstances in this case.

PRINCIPAL REASONS FOR THE DECISION

Based on the multiple trademark registrations cited by Complainant (listed above), supported by copies of relevant certificates of registration, as well as previous relevant UDRP decisions in which the same trademark was at issue, the Panel is convinced that Complainant has rights in and to the trademark ECCO for use in connection with footwear. See, e.g., ECCO SKO A/S v. linlin, CAC Case No. 100278 (transfer of <eccoshoesuk.net>).

As to whether the disputed domain names are identical or confusingly similar to the ECCO trademark, the relevant comparison to be made is with the second-level portion of the domain names only (i.e., "ecco-stovler" and "eccoudsalg"), as it is well-established that the top-level domain names (i.e., ".com" and ".net") should be disregarded for this purpose.

Here, Complainant states (and Respondent does not dispute) that STOVLER is a misspelling of the Danish word "støvler", meaning "boots" and that UDSALG which means "sale / clearance sale." Accordingly, these words actually increase the confusing similarity between the Disputed Domain Names and Complainant's trademark. See, e.g., ECCO Sko A/S v. Jacklee, WIPO Case No. D2011-0800 (transfer of <eccoshoesaustralia.com>); Gateway Inc. v. Domaincar, WIPO Case No. D2006-0604 (finding the domain name <gatewaycomputers.com> confusingly similar to the trademark GATEWAY because the domain name contained "the central element of the Complainant's GATEWAY Marks, plus the descriptive word for the line of goods and services in which the Complainant conducts its business"); Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill, WIPO Case No. D2010-2124 (the addition of certain words can "exacerbate[] the confusing similarity between the [Complainant's] trademark and the Domain Name and increase[] the risk of confusion between the Domain Name and the... trademarks") (citing Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561 (citing Yellow Corporation v. MIC, WIPO Case No. D2003-0748 ("when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity"))).

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Complainant has stated that Respondent has no rights in the trademark ECCO and is not a reseller/licensee of Complainant, that use of the trademark ECCO by Respondent has never been authorized by Complainant, and that Respondent is using his website to promote the sale of third parties goods as well as goods, which are very likely counterfeit.

Under the UDRP, once a complainant has made out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Accordingly, as a result of Complainants' allegations and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainants have proven the second element of the UDRP.

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in the UDRP: (i) circumstances indicating that the registrant has registered or the registrant 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant'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 registrant's website or location or of a product or service on the registrant's website or location. Policy, paragraph 4(b).

In this case, Complainant appears to argue that bad faith exists pursuant to paragraph 4(b)(iv), given that the websites used by Respondent in connection with the disputed domain names allegedly offer for sale counterfeit ECOO products -- an allegation supported by printouts from Complainant's and Respondent's websites and not denied by Respondent. The sale of counterfeit products in such circumstances "is strong evidence of bad faith." Guccio Gucci S.p.A. v. Domain Administrator - Domain Administrator, WIPO Case No. D2010-1589. See also Cartier International, N.V. , Cartier International, B.V. v. David Lee, WIPO Case No. D2009-1758 (finding bad faith where "the domain name contains the Complainant's mark and the website offers to sell counterfeit imitations of the Complainant's products").

Accordingly, the Panel is satisfied that Complainant has proven the third element of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ECCO-STOVLER.COM**: Transferred
2. **ECCOUDSALG.NET**: Transferred

PANELLISTS

Name	Douglas M. Isenberg
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DATE OF PANEL DECISION 2012-01-30

Publish the Decision
