Decision for dispute CAC-UDRP-100389

Case number	CAC-UDRP-100389
Time of filing	2012-02-14 16:00:57
Domain names	ECCO-UDSALG.NET

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	ECCO Sko A/S

Complainant representative

Organization	Chas. Hude A/S

Respondent

Name	zhouyiming

OTHER LEGAL PROCEEDINGS

There are no other relevant legal proceedings of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various trade marks that comprise or incorporate the term "ECCO". These include:

(i) Community Trade mark Reg. No. 001149871, for the word mark "ECCO" in classes 3, 14, and 25 filed on 23 April 1999 and with a registration date of 6 February 2003; and

(ii) Chinese Trademark Reg. No. 208743 in class 25 filed on 30 May 1984.

FACTUAL BACKGROUND

1. The Complainant is a company based in Denmark that was founded in 1963. It manufactures shoes, bags, belts and shoe care products. The net turnover of the Complainant in 2010 was over DKK 6 million and it has a total workforce worldwide of approximately 17.500 employees.

2. In addition to various trade marks that comprise or incorporate the term "ECCO", it owns various domain names that incorporate that term. It operates a website from the domain name <ecco.com>.

3. There are three domain names in issue in these proceedings. These are <ecco-udsalg.net>, <eccoudsalg.com>, <eccoskoudsalg.net> (the "Domain Names"). According to the publicly available WhoIs details:

(i) <ecco-udsalg.net> was first registered on 31 December 2011. It is currently registered in the name of "zhouyiming" with the registrar BIZCN.COM, INC.
(ii) <eccoudsalg.com> was first registered on12 October 2011. It is currently registered in the name of "wangjujian" with the registrar Hang Zhou E-Business Services Co Ltd.
(iii) <eccoskoudsalg.net> was first registered on 6 January 2012. It is currently registered in the name of "linbingyou" Directi Internet Solutions Pvt. Ltd. D/B/A Publicdomainregistry.Com.

4. Each of the Domain Names have been used for websites predominantly but not exclusively in Danish that purport to sell "Ecco" branded products. In the case of the <eccoskoudsalg.net> Domain Name, the website also offers products in competition to those of the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT

1. The Complainant asserts that the domain names comprise its mark in various combinations with the Danish words "Udsalg" and "Sko", which translate as “sale / clearance sale” and “shoe(s)” respectively, and are therefore confusingly similar to the Complainant's marks.

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2. On the issue of rights or legitimate interests the Complainant maintains that the Respondents (which the Complainant contends are either the same or connected persons) have never been authorised to use the ECCO mark.

3. So far as bad faith is concerned, the Complainant contends that the nature of the Domain Names and the websites that are operating from the Domain Names make it clear that the Respondents are attempting to divert Internet users to these websites by creating a likelihood of confusion with the Complainant’s trade marks, company name and domain names. At one stage it claims that the ECCO products offered for sale on those websites are "very likely counterfeit". However, it is clear from other parts of the Complaint that the Complainant's case is somewhat more emphatic in this respect. In particular, it contends that at least some of the products on all three websites sell ECCO "Fussion" branded shoes that are different from the Complainant's "Fussion" products. The ECCO branded golf shoes on the website operating from the <eccoudsalg.com> Domain Name are different from those of the Complainant.

4. Procedurally, the Complainant also requests that although the Domain Names in this case are nominally registered in the name of three different respondents, that a single Panel can decide this case (referring to this as "consolidation"). It further requests that the language of this case be English. Theses issues are addressed in greater detail under the Procedural Factors segment of this decision.

RESPONDENT(S)

5. No Response has been filed by any Respondent in this case.

RIGHTS

1. The Complainant has, to the satisfaction of the Panel, shown that each of the Domain Names are confusingly similar to a trade mark in which the Complainant has rights. It accepts that each of the Domain Names are most sensibly read as the term "ECCO" in combination the Danish words for shoes and/or sales and the relevant ".com" and ".net" TLDs. The adding of these words does not distract from the ECCO term and/or change the meaning of the term so as to prevent a finding of "confusing similarity" as that phrase is understood under the Policy, In the circumstances, the Complainant has made out the requirements of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

NO RIGHTS OR LEGITIMATE INTERESTS

1. The Complainant has, to the satisfaction of the Panel, shown the Respondents to have no rights or legitimate interests in respect of the Domain Names. The primary reason for this, as is addressed in greater detail under the heading Bad Faith below, is that the Panel is persuaded that the Respondents have been engaged in the sale of counterfeit goods. There is obviously no legitimate interest in using a domain name confusingly similar to a mark for the purpose of the sale of counterfeit goods. Further such activity is positive evidence that no rights or legitimate interests exist.

2. Even if there were no sale of counterfeit goods, it is likely that the Panel would have reached a similar conclusion. This is a case where even if genuine goods were being sold, to claim a legitimate interest the Respondents would need to comply with the requirements set down in Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903. It is for a respondent to raise and substantiate an "Oki Data" argument (see AREVA v. Industrial Tests, Inc. WIPO Case No. D2009-1686). No respondent has done so in this case. In any event on the material that the Panel has seen, none of the websites operating from the Domain Names adequately distinguish themselves from the Complainant, and the Complainant has convinced the Panel that in at least one of the websites is being used to sell goods (whether genuine or not) that compete with those of the Complainant.

3. Further, even the Respondents were able to show that the "Oki Data" conditions apply, the nature of the Domain Name is such that for the reasons discussed in Research in Motion Limited v. One Star Global LLC, WIPO Case No. D2009-0227, the Complainant should still succeed.

4. In the circumstances, the Complainant has made out the requirements of paragraph 4(a)(ii) of the Policy.

BAD FAITH

1. The Complainant's case in relation to bad faith, although at one stage slightly equivocal, is nevertheless quite straight forward. It contends that the Domain Names are being used to promote the sales of counterfeit goods under the Complainant's mark.

2. The Panel is persuaded that this is so. This is not simply assertion on the part of the Complainant. The Complainant has explained how differences between the products sold by it and those sold on the websites operating from the Domain Names show that this is the case. That explanation is also supported by printouts from the relevant sites.

3. That conclusion is sufficient to justify a finding of bad faith registration and bad faith use in this case.

4. Further, regardless of the nature of the goods being sold on these sites, the Panel is likely to have reached a similar conclusion. This is because as far as the Panel can tell, none of the sites in question clearly identify the person or person that are responsible for running those sites. Further, the structure of the sites and the prominent use of Complainant's mark in each is clearly intended to give the visitor the impression that the sites are either the Complainant's or in some way connected with the Complainant. The Complainant, has made it clear that this is not the case. On this basis alone the Respondent's activities fall within the scope of paragraph 4(b)(iv) of the Policy.

5. In the circumstances, the Complainant has made out the requirements of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

1. There are a number of procedural complications in this case. They are as follows:

(i) The Complainant's Request to "Consolidate" proceedings;
(ii) The Complainant's Request that these proceedings be in English;
(iii) Issues of Registrar misconduct; and
(iv) The Panel decision on 14 March 2012 to certify that an additional fee was due from the Complainant.

2. The Panel will deal with each of these in turn.

REQUEST FOR "CONSOLIDATION"

3. The Complainant contends that its complaint in relation to all three Domain Names can be considered in a single set or proceedings. The reason given for this is that although the Domain Names are registered in three different names it "believes that the [Domain Names] are subject to the common ownership or control of the same person / company". It cites in support of this proposition Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons WIPO Case No. D2010-0281.

4. The circumstances in which a panel may decide to provide a decision in relation to multiple domain names in different names was also considered by this Panel at some length in RapidShare AG, Christian Schmid v. PrivacyAnywhere Software WIPO Case No. D2010-0894.

5. Although the terminology used in these and similar cases is is slight different, there is common ground that although ordinarily a single set of proceedings cannot be brought against different respondents, they can be where the different names are merely alter ego's of the same person or if the domain names are under the common control of the same person.

6. The reasons given by the Complainant in this case as to why the Panel should conclude that this is so, are as follows:

(i) The Domain Names all contain the Danish word UDSALG and that "it is very peculiar that 3 Chinese registrants (none of them residing in Denmark) use the same Danish words in 3 different domain names".
(ii) The Domain Names have been registered within less than 3 months (12 October 2011 - 6 January 2012).
(iii) The Domain Names are all being used in connection with the sale of counterfeit ECCO shoes.
(iv) Although each of the website look different they have a number of common features.

7. Ultimately, the Panel is persuaded on the balance of probabilities and in the absence of any evidence or argument to the contrary that the Domain Names in this case are under common control. It is factors (i) to (iii) above (and particularly item (i)) that are the most persuasive here. Although it is possible that three different Chinese entities have decided to sell counterfeit goods using the same sort of domain name at roughly the same time, it at first sight appears improbable. In the absence of any evidence or argument to the contrary, the Panel concludes that the Complainant is correct. Accordingly, the fact that there are three different named respondents in this case does not prevent the case proceeding as a single set of proceedings.

LANGUAGE OF PROCEEDINGS

8. The Complainant thought that the Registration Agreements in this case "are very likely in Chinese" but requested that the language of the proceedings be English.

9. Paragraph 11(a) of the Rules to the UDRP provides:

"Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

10. It is for that reason that ADR Providers under the Policy will include a question in their verification requests to registrars asking the registrar to confirm the language of the registration agreement that applies to the domain names claimed in a complaint. The Czech Arbitration Court ("ADR.eu") sent its verification request to each of the registrars on 14 February 2012.

11. In the case of the <ecco-udsalg.net> Domain Name, the registrar, BIZCN.COM, INC, provided a verification response, but did not directly answer the ADR.eu's question as to the language of the Registration Agreement. Instead it responded as follows:

"Answer: If possible, the respondent would like to opt for Chinese."

12. In the case of the <eccoudsalg.com> Domain Name, the registrar, Hang Zhou E-Business Services Co Ltd., failed to respond to ADR.eu's registration request.

13. Only in the case of the <eccoskoudsalg.net> Domain Name did the registrar, Directi Internet Solutions Pvt. Ltd. D/B/A Publicdomainregistry.Com fully answer the question put to it. Contrary to what the Complainant hought was likely to be the case, the registrar confirmed that the language of the agreement in this case was English.

14. In short, it is apparent that at least one of the three Domain Names in issue is subject to a registration agreement in the English language. It is simply unclear what the position is with the remaining two. Given the finding of the Panel that this is a case where the domain names are under the control of the same person, this is a case where the circumstances justify a decision on the part of the Panel that the case can continue in the English language. If a registrant decides to choose a registrar that does not properly reply to a UDRP Provider's registration request, and if it suffers prejudice by reason of that failure, then that is a matter for it to take up with its registrar.

15. There are also other (albeit less compelling) factors that point to the choice of English in this case. In particular, the Complainant points to small parts of the websites operating from the Domain Names that are in the English language and also suggest that the operators of those sites will accept payment in the currencies of at least four countries in which English is spoken. The Panel accepts that this does suggest some familiarity with the English language by the operators of those sites.

REGISTRAR MISCONDUCT

16. As has already been recorded, the registrar, Hang Zhou E-Business Services Co Ltd., failed to respond to ADR.eu's registration request. For reasons that were discussed by the Panel in KinderCare Learning Centers LLC v. PrivacyProtect.org WIPO Case No. D2011-1890, it is unacceptable for a registrar to ignore this sort of request. The Panel's understanding is that ADR.eu has already complained about this failure to ICANN. The Panel echos that complaint and ask that this be brought to ICANN's attention for ICANN to make such investigation and to take such steps as it considers appropriate in relation to the registrar's misconduct in this matter. That request is made in accordance with the procedure described in LEGO Juris A/S v. Whois Privacy Protection Service, Inc. / Domains Secured, LLC WIPO Case No. D2011-1857.

17. In the case of BIZCN.COM, INC, the registrar did at least respond. But that response is of itself concerning. In particular, the registrar did not answer the question put to it. Instead of identifying the applicable language of the relevant registration agreement it identified the language that the Respondent would like to "opt" for. Paragraph 11(a) of the rules does not offer any "option". The response also raises questions in its own right. How does it know what the Respondent wants to "opt" for? If the respondent and/or the registrar consider this to be an matter of "option" is that because there is no proper registration agreement in place in the first place.

18. Maybe so far as BIZCN.COM, INC, is concerned this is just an issue of language. However, the fact is that if the Policy is operate effectively, it is essentially that registrars understand their obligations under the Policy, that they comply with those obligations and that if they do not that there is some sanction for that failure. Once again the Panel, asks ADR.eu to bring BIZCN.COM, INC failure to ICANN's attention for ICANN to make such investigation and to take such steps as it considers appropriate in relation to the registrar's conduct.

ADDITIONAL FEE

19. Under the fee schedule that applies to disputes under the Policy in which ADR.eu is the dispute resolution provider and which is set out at Annex A of UDRP Supplemental Rules of the Czech Arbitration Court, the Complainant is required to pay an initial fee. In an case where no more than three domain names are in issue and a single person panel is chosen the fee is €500. Paragraph 1(a) of that Annex that a further fee of €800 will only be payable if the Respondent puts in a response. However paragraph 1(b) also provides that this additional fee is payable where:

"the Panel determines that it is appropriate for the Complainant to pay the Additional UDRP Fees, having regard to the complexity of the proceeding."

20. The Panel in this case made such a determination on 14 March 2012. There have been others in which panels have made similar decisions but as far as this Panel is aware there have been few, if any, cases in which the reasons for doing so have been explained in any detail. Ultimately, the question as to whether the circumstances and the complexity of a particular case require an additional payment is a matter for discretion for the Panel. Nevertheless, it is helpful if complainant's have some guidance as to in what circumstances an additional fee may be claimed. Further, it is of advantage to other panelists for these reasons to be made clear so that there is a greater likelihood of consistency between panelists on this issue.

21. In this instance case the legal questions raised by the substance of the Complaint were not particularly complex. Here the complexity arose out of the procedural complications already identified. These are the question of (i) a single set of proceedings against more than one respondent, (ii) the choice of language of the proceedings; and (iii) the conduct of two of the registrars.

22. In the the first two cases the Complainant was asking the Panel to do something that, although perfectly proper under the Policy, was different from the starting position (or in the case of language the Complainant considered to be the likely starting position) provided for by the Policy and its Rules. For a panel to make such a departure requires an explanation. As such, these requests carried with them an additional level of complexity that would not apply in an ordinary case.

23. The need to provide these explanations, particularly in relation to the request that a single set of proceedings deal with domain names registered in three different names, was sufficient to justify the Panel maknig a declaration under paragraph 1(b) of Annex A to the UDRP Supplemental Rules of the Czech Arbitration Court .

24. The questions of the conduct of two of the registrars in this case further complicated matters. To refer to ICANN the conduct of a registrar is (or at least should be) a serious matter. In order to do so the panel must provide a detailed description of the circumstances leading to that referral. It might be thought unfair that a complainant should bear that additional cost. Nevertheless, it is a cost it knows it might have had to bear in any event if a response had been filed. It certainly is the sort of factor that is likely to lead to an additional level of complexity that justifies the application of paragraph 1(b).

PRINCIPAL REASONS FOR THE DECISION

The Domain Names in this case comprised the Complainant's ECCO mark in combination with ordinary Danish words. In the circumstances paragraph 4(a)(i) of the Policy was made out by the Complainant.

The Panel was also persuaded that the Domain Names were being used for the purpose of selling counterfeit goods under the ECCO mark. In the circumstances, paragraph 4(a)(ii)and (iii) of the Policy were made out by the Complainant.

The complications in this case were procedural. The primary procedural issue was whether the Complainant could bring a single set of proceedings in respect of three domain names that prima facie were registered in different names. The Panel concluded on the balance of probabilities that the Domain Names were in fact under common control. In the circumstances, in accordance with the the decisions, inter alia, in Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons WIPO Case No. D2010-0281 and RapidShare AG, Christian Schmid v. PrivacyAnywhere Software WIPO Case No. D2010-0894, the Panel held that the proceedings could continue.

Further the Panel concluded that, inter alia, in the absence of a proper response from two of the registrars in respect of two of the Domain Names to ADR.eu's request (as part of its verification request) that the registrar identify the language of the registration agreement applicable to those Domain Names, the proceedings could continue in English.

Further, in accordance with the procedure described in LEGO Juris A/S v. Whois Privacy Protection Service, Inc. / Domains

Secured, LLC WIPO Case No. D2011-1857 the Panel asked ADR.eu to bring the failures by the two registrars to properly respond to the verification request to the attention of ICANN for ICANN to take such investigation and to take such steps to ensure compliance as it considered appropriate.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ECCO-UDSALG.NET**: Transferred
2. **ECCOUDSALG.COM**: Transferred
3. **ECCOSKOUDSALG.NET**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2012-03-25

Publish the Decision