Decision for dispute CAC-UDRP-101704

Case number	CAC-UDRP-101704
Time of filing	2017-10-24 09:32:09
Domain names	VilaClothing.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	VILA A/S

Respondent

Name	Maria Trudeau

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant, through its group company Aktieselskabet af 21. november 2001, is the owner, among others, of the following trademark registrations relating to the designation "VILA":

- VILA in Denmark (No. VR 1997 01726, registered on 18/04/1997)
- VILA in Norway (No. 216768, registered on 28/11/2002)
- VILA in Sweden (No. 357 360, registered on 26/07/2002)
- VILA in Bulgaria (No. 00053298, registered on 21/11/2005)
- VILA CLOTHES in the EU (No. 008291338, registered on 26/01/2010)
- VILA CLOTHES in Chile (No. 1130924, registered on 06/10/2014)
- VILA CLOTHES in India (No. 1647147, registered on 31/03/2010)
- VILA CLOTHES in Australia (No. 1611215, registered on 04/02/2016).

FACTUAL BACKGROUND

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

Identification of rights

VILA is a brand under VILA A/S, which is part of the BESTSELLER Group. All trademark registrations related to the brand VILA are owned by Aktieselskabet af 21. november 2001. Both VILA A/S and Aktieselskabet af 21. november 2001 are hereinafter collectively referred to as the “Complainant”. The trademarks VILA and VILA CLOTHES are registered in class 25 throughout the world.

Copies of the certificates of registration and excerpts from the official trademark databases have been attached to the

Complaint.

The Complainant also owns many domain names incorporating the VILA and VILA CLOTHES marks, including VILA.COM, VILA.DK, VILA.STORE, VILA-CLOTHES.COM, VILA-CLOTHES.NET, VILA-CLOTHES.DK, VILACLOTHES.COM and VILACLOTHES.NET.

Factual background

The BESTSELLER Group is a family-owned Danish fashion company selling and distributing clothing, shoes and accessories worldwide under a variety of trademarks such as VERO MODA, JACK & JONES, ONLY, VILA and VILA CLOTHES.

The disputed domain name <VILACLOTHING.COM>, was registered on 26 May 2017 whereas the Complainant's VILA and VILA CLOTHES trademarks were first registered on 18 April 1997. The disputed domain name is being used to sell unauthorized VILA CLOTHES clothing, appearing as an official VILA CLOTHES online store.

The Complainant furthermore sent a cease and desist letter to the registrant of <VILACLOTHING.COM> (hereinafter the "Respondent"), on 11 September 2017, notifying the Respondent of the Complainant's prior rights. The Respondent did not respond to the cease and desist letter.

The complaint

1. Trademark Infringement

The disputed domain name <VILACLOTHING.COM> (Hereinafter the "disputed domain name") only differs from the Complainant's VILA CLOTHES trademark, by the use of the word CLOTHING instead of CLOTHES. The word CLOTHING is synonymous with the word CLOTHES. Accordingly, VILA CLOTHES is visually and aurally very similar to, and conceptually identical to, the Complainant's VILA CLOTHES trademark.

Furthermore, the disputed domain name contains the Complainant's VILA trademark in its entirety and only differs from VILA with the additional word CLOTHING at the end of the domain name. The word CLOTHING is descriptive for the goods offered for sale on the website of the disputed domain name. VILACLOTHING is as such both visually, aurally and conceptually very similar to the Complainant's VILA trademark.

Regarding the similarity of goods, the goods for which the Complainant's trademarks have been registered, and for which the Complainant currently uses the trademarks VILA and VILA CLOTHES, are, among others, clothing, dresses, skirts and jackets and clothing of leather, which are identical to the goods offered for sale on the website of the disputed domain name.

As the disputed domain name is visually, aurally and conceptually very similar, or even conceptually identical, to the Complainant's VILA and VILA CLOTHES trademarks and as the goods offered for sale on the website of the disputed domain name are identical to the goods for which the Complainant's trademarks have been registered, the disputed domain name is confusingly similar to the Complainant's registered VILA and VILA CLOTHES trademarks.

Following the above, the disputed domain name is confusingly similar to the Complainant's VILA and VILA CLOTHES trademarks and is infringing the trademark rights of the Complainant, cf. paragraph 4(a)(i) of the ICANN Uniform disputed domain name Resolution Policy (Hereinafter the "Policy").

2. No Legitimate Rights in the Disputed Domain Name

The Complainant has neither authorized the Respondent to use the VILA or VILA CLOTHES trademarks nor to sell VILA CLOTHES goods. The Respondent is appearing as an official VILA CLOTHES online store, through the use of the Complainant's wholesale customer Zalando SE's copyright protected images on the website.

Furthermore, it appears that the Respondent is not able to deliver the goods which are marketed on the website. Accordingly, the Complainant has been contacted by a consumer who purchased goods from the website of the disputed domain name believing that it was an official VILA CLOTHES dealer, but received counterfeit goods.

The disputed domain name is therefore not being used in a legitimate non-commercial or fair manner and only intends to attract as many internet users as possible, pretending to sell the users VILA CLOTHES goods.

Furthermore, the Respondent has no trademark registrations on any part of the disputed domain name and there is nothing whatsoever, which indicates that the Respondent has any legitimate interests in the disputed domain.

Consequently, the Respondent does not have any rights or legitimate interests in the disputed domain name, cf. paragraph 4(a)(ii) of the Policy.

3. Bad Faith

The website of the disputed domain name is using, not only the Complainant's registered trademarks all over the website, but copyright protected images from the Complainant's wholesale customer as well. The website of the disputed domain name furthermore appears as an official VILA CLOTHES online store, selling the Complainant's VILA CLOTHES goods.

However, it seems as if the Respondent is only selling counterfeit goods, which substantiates that the disputed domain name has been registered in bad faith.

There can be no doubt, that the disputed domain name was not registered in, and is not currently being used in, good faith, when the Respondent is, and has been, intentionally using the Complainant's registered trademarks and the Complainant's wholesale customer's copyright protected images on the website, to appear as an official VILA CLOTHES online store authorized by the Complainant. Therefore, the Respondent has been intentionally attempting to attract internet users to the website for commercial gain, by creating a likelihood of confusion with the Complainant's VILA and VILA CLOTHES trademarks, attempting to show an affiliation with the website by the Complainant, cf. paragraph 4(b)(iv) of the Policy.

According to the reasons stated above, the disputed domain name has been registered in and is being used in bad faith by the Respondent, cf. paragraph 4(a)(iii) of the Policy.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

The Panel finds that the disputed domain name <vilaclothing.com> is confusingly similar to the Complainant's "VILA" trademarks since the disputed domain name incorporates the Complainant's "VILA" trademark in its entirety and the mere addition of the generic term „clothing" (which is even similar to the term „clothes" that forms part of a number of the Complainant's other trademarks) is not capable to dispel the confusing similarity arising from the Complainant's trademarks' incorporation in the disputed domain name.

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name, nor is the Respondent commonly known thereunder. In fact, the Complainant has evidenced that the disputed domain name is being used to resolve to a website at "www.vilaclothing.com" which has the look and feel of an official VILA website (which it is not), but rather apparently offers counterfeit products for online sale. Such making use of the disputed domain name neither qualifies as bona fide nor as a legitimate noncommercial or fair use under the UDRP. Also, there is no reason for the Panel to believe that the Respondent's name somehow corresponds with the disputed domain name and the Respondent does not appear to have any trademark rights associated with the "VILA" term. Accordingly, the Panel has no difficulty in finding that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Finally, the Panel holds that the disputed domain name was registered and is being used in bad faith. The fact that the disputed domain name resolves to a website that purports to be an official VILA CLOTHES online store not only by displaying the Complainant's "VILA" Trademark, but also by offering counterfeit clothing for online sale is a clear indication that the Respondent has been intentionally attempting to attract, for commercial gain, Internet users to said website, by creating a likelihood of confusion with the Complainant's "VILA" trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Such circumstances shall be evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VILACLOTHING.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2017-11-27

Publish the Decision