# Decision for dispute CAC-UDRP-101756

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| Case number | CAC-UDRP-101756 |
| Time of filing | 2017-12-12 08:55:04 |
| Domain names | VilaLeatherTrousers.com |

## Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |

## Complainant

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| Organization | Aktieselskabet af 21. november 2001 |

## Respondent

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| Name | Suzete Mazza |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided legal proceedings wich relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

All trademark registrations related to the VILA brand are owned by the Complainant. The trademarks VILA and VILA CLOTHES are registered for clothing (class 25 of the Nice Classification) in numerous jurisdiction throughout the world, including:

- 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 France (No. 4317729, registered on 21/07/2017)
- 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)

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

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

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 and VILA/VILA CLOTHES.

The disputed domain name <VILALEATHERTROUSERS.COM>, was registered on 29 December 2016 i.e. more than 9 years after the Complainant's first VILA trademark was registered on 18 April 1997.

The disputed domain name is being used to sell unauthorized VILA and VILA CLOTHES clothing and is being passed off as an official VILA and VILA CLOTHES online store through e.g. the use of original VILA and VILA CLOTHES campaign images.

The Complainant sent a cease and desist letter to the registrant of <VILALEATHERTROUSERS.COM> (hereinafter the "Respondent"), on 22 September 2017, notifying the Respondent of the Complainant's prior trademark rights to the VILA and VILA CLOTHES trademarks and copyright to the VILA and VILA CLOTHES campaign images. The Respondent did not respond to the Complainant's cease and desist letter.

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PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The complaint

1. Trademark Infringement

The disputed domain name <VILALEATHERTROUSERS.COM> coincides with the Complainant's VILA and VILA CLOTHES trademarks by the word "Vila", but differs by the use of the words "Leather Trousers" and the element ".com".

The element ".com" is a top-level extension, which is a technical necessity and a requirement for registration of a domain name. It is therefore disregarded. For the sake of completeness, it has also been well established in previous UDRP decisions that the omission of a gap or use of a hyphen between two or more words, such as Vila, Leather and Trousers, when compressed into a domain name, will not change the outcome of finding confusing similarity.

1.1. Comparison of the goods and services between the Complainant's registered VILA and VILA CLOTHES trademarks and the disputed domain name

The goods marketed for sale on the website of the Disputed Domain Name, i.e. clothing, are identical to the goods for which the Complainant's VILA and VILA CLOTHES trademarks have been registered, i.e. clothing.

1.2. Likelihood of confusion between the Disputed Domain Name and the Complainant's VILA trademark

Visually, the common element "Vila" is placed in the beginning of the Disputed Domain Name. The marks differ in the last elements of the Disputed Domain Name "Leather Trousers". The Disputed Domain Name consists of 3 words, whereas the Complainant's trademark only consists of 1 word.

Aurally, the meaningless word "Vila" coincides in both signs and the disputed domain name furthermore contains the additional words "Leather Trousers". The relevant public will therefore pronounce the word "Vila" identically, but the words "Leather Trousers" will be pronounced differently from the word "Vila". However, in accordance with the following cases from the General Court of the European Union T-206/12, LIBERTE, and the joined cases T-544/12, PENSA PHARMA, and T-546/12, the relevant public are not likely to pronounce words, such as "Leather Trousers", which are generic, descriptive and

superfluous, due to the nature of the goods offered for sale by the Respondent on the website of the disputed domain name.

Conceptually, the common word “Vila” is meaningless, and the only differing elements are the words “Leather Trousers”, which are English words for a specific type of clothing good. The English words “Leather Trousers” will be understood as such by the relevant public, as the language of the website is also English.

The common element “Vila” is a meaningless word, which will in no way be viewed as either descriptive or generic, but instead as a word capable of communicating origin of the goods concerned. The common element “Vila” is therefore inherently distinctive, whereas “Leather Trousers” are generic and descriptive words for the goods offered for sale by the Respondent on the website of the disputed domain name. As the common element “Vila” is the only distinctive part of the disputed domain name capable of communicating origin of the goods, it is clearly the dominant part of the disputed domain name. The additional words “Leather Trousers” will therefore not be likely to change the outcome of confusing similarity, when the remaining element of the disputed domain name coincides with the Complainant’s registered trademarks.

The fact that the disputed domain name incorporates the Complainant’s registered trademark VILA in its entirety is sufficient to establish identity or confusing similarity (see Six Continent Hotels, Inc. v. The Omnicorp, WIPO Case No. D2005-1249 and Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903).

The additional words “Leather Trousers”, which are descriptive for goods of clothing which are sold on the website of the Disputed Domain Name may serve to strengthen the connection with the Complainant’s VILA trademark, as the relevant public would connect the word VILA with goods of clothing, due to the fact that the Complainant uses the trademark extensively to sell such goods. The relevant consumers will therefore very likely search for the brand name VILA accompanied by the word for the specific goods they are looking to purchase, such as “VILA Leather Trousers”.

It has furthermore been well established that the addition of descriptive or generic words to the Complainant’s trademark will still lead to confusing similarity, when the Respondent’s domain name contains the entirety of the Complainant’s registered trademark (see Philip Morris Incorporated v. Eddy Fitch, WIPO Case No. D2002-0869 and Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc., WIPO Case No. D2002-0787). The addition of the words “Leather Trousers” to the Complainant’s VILA trademark, will therefore also lead to confusing similarity.

According to the reasons stated above, the disputed domain name is visually, aurally and conceptually very similar to the Complainant’s VILA trademark, and there is also identity between the goods offered for sale on the website of the disputed domain name and the goods for which the Complainant’s VILA trademark has been registered.

1.3. Likelihood of confusion between the Disputed Domain Name and the Complainant’s VILA CLOTHES trademark

Visually, the word “Vila” coincides as the first element in both the disputed domain name and the Complainant’s VILA CLOTHES trademark, and the marks differ in the last word elements “Leather Trousers” and “Clothes”. The words “Leather Trousers” replace the word “Clothes” at the end of the disputed domain name. The disputed domain name consists of 3 words, whereas the Complainant’s trademark consists of 2 words.

Aurally, the word “Vila” also coincides in both the signs, and will be pronounced identically by the relevant public, whereas the words “Leather Trousers” replaces the word “Clothes” in the Complainant’s trademark, which will be pronounced differently. However, as stated in section 1.2, generic, descriptive and superfluous words, such as the words “Leather Trousers” and “Clothes” are not likely to be pronounced by the relevant public, due to the nature of the goods.

Conceptually, the common word “Vila” remains meaningless, and the word “Clothes” is replaced by the English words “Leather Trousers”. The common word “Vila” is identical, and the English words “Leather Trousers” can be contained within the conceptual meaning of the English word “Clothes”.

The word “Vila” is a distinctive and the dominant part of the disputed domain name and the Complainant’s VILA CLOTHES trademark, whereas the remaining words “Leather Trousers” and “Clothes” are generic and descriptive for the goods offered

for sale by the Respondent.

When viewing the words “Leather Trousers” as a replacement of the word “Clothes”, the relevant public will naturally be able to make the connection between the disputed domain name and the Complainant’s trademark, as the word “Clothes” is also able to contain the words “Leather Trousers” within its meaning in the English language.

As the word VILA is both the distinctive and dominant part of the disputed domain dame, and as the words “Leather Trousers” are both unlikely to be pronounced by the relevant public and conceptually similar to the meaning of the word “Clothes”, the disputed domain name is visually, aurally and conceptually very similar to the Complainant’s VILA CLOTHES trademark. Accordingly, there is a high degree of visual, aural and conceptual similarity between the marks, including identity between the goods marketed for sale on the website of the disputed domain name and the goods for which the Complainant’s VILA CLOTHES trademark has been registered.

1.4. Confusing similarity between the Disputed Domain Name and the Complainant’s registered trademarks VILA and VILA CLOTHES.

The disputed domain name is confusingly similar to the Complainant’s VILA and VILA CLOTHES trademarks, according to paragraph 4(a)(i) of the ICANN Uniform Domain Name Dispute Resolution Policy (Hereinafter the “Policy”).

2. No Legitimate Rights in the Disputed Domain Name

The Complainant has neither authorized the Respondent to use its 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 own copyright protected images, as well as the Complainant’s wholesale customer ASOS.com Limited’s copyright protected images. 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. The consumer received different goods than the ones ordered and was unable to get in touch with the Respondent.

The Disputed Domain Name is therefore not being used in a legitimate non-commercial or fair manner and only intends to attract internet users, pretending to sell VILA CLOTHES goods.

Furthermore, the Respondent has no trademark registrations on any part of the Disputed Domain Name and the Complainant is not aware of any evidence, which indicates that the Respondent is commonly known by the Disputed Domain Name, according to paragraph 4(c)(ii) of the Policy.

Consequently, the Respondent does not have any rights or legitimate interests in the disputed domain name within the meaning of 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, but also the Complainant’s and the Complainant’s wholesale customer’s copyright protected images. Furthermore, the Respondent is pretending to sell VILA and VILA CLOTHES clothing.

The Respondent also never responded to the Complainant’s cease and desist letter. The lack of a reply from the Respondent to the cease and desist letter sent by the Complainant is further evidence of the Respondent’s bad faith (see The Great Eastern Life Assurance Company Limited v. Unasi, Inc., WIPO Case No. D2005-1218).

According to the above stated, it is obvious that 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 between the website and the Complainant, within the meaning of paragraph 4(b)(iv) of the Policy.

In conclusion the disputed domain name was registered in, and is being used in bad faith by the Respondent withing the meaning of paragraph 4(a)(iii) of the Policy.

RIGHTS

The VILA trademark is entirely reproduced in the Disputed Domain Name.

VILA is the only distinctive part of the Disputed Domain Name. The additional words "Leather Trousers" designate a certain type of trousers. It means that the VILA trademark is combined with generic terms designating specific clothes belonging to Class 25 for which the VILA trademark is protected.

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 Respondent did not contest the Complaint. It has no relation with the Comaplinant. The facts, as described by the Complainant show that the Respondent copies the Complainant's copyrighted pictures and that internet users who wanted to buy online did not get the ordered and paid clothes.

The Respondent has not been commonly known by the domain name, and did not make a legitimate non-commercial or fair use of the disputed domain name. On the contrary, it used the disputed domain name with intent for commercial gain to misleadingly divert consumers .

The Complainant has, to the satisfaction of the Panel, shown that the Respondent's behaviour meets the criteria set by paragraph 4(c)(i) and (iii) of the Policy.

Therefore the Panel is of the opinion that the Respondent has 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 Disputed Domain Name was obviously registered with the VILA trademarks in mind.

It was registered for the purpose of disrupting the Complainant's business.

By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location, within the meaning of paragraph 4(b)(iv) of the Policy.

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 Disputed Domain Name is composed with the VILA trademark, adding generic terms designating goods for which the VILA trademark is protected.

The Disputed Domain Name was obviously registered with the VILA trademarks in mind.

It was registered for the purpose of disrupting the Complainant's business.

The Disputed Domain Name was used for commercial gain to resolve to a website that copies copyrighted pictures belonging to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VILALEATHERTROUSERS.COM**: Transferred

## PANELLISTS

| Name | **Marie-Emmanuelle Haas, Avocat** |
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DATE OF PANEL DECISION 2018-01-22

Publish the Decision