Decision for dispute CAC-UDRP-101814

Case number	CAC-UDRP-101814
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Domain names	VeroModa-Jeans.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Aktieselskabet af 21. november 2001

Respondent

Name	Suzete mazza

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant adduced evidence of its following trademarks:

- VERO MODA in Denmark (No. VR 1989 01649, registered on 21 April 1989 under Class 25 in the Nice Classification System)
- VERO MODA in the EU (No. 001954353, registered on 20 August 2004)
- VERO MODA in the US (No. 3757629, registered on 9 March 2010)
- VERO MODA in China (No. 1132585, registered on 7 December 1997 and no. 11057621, registered on 7 July 2014).

The Complainant also adduced proof of its registration of domain names incorporating the VERO MODA trademark. These include VEROMODA.COM, VEROMODA.US, VEROMODA.CO, VERO-MODA.COM and VERO-MODA.NET.

The above trademarks and domain names relate to the VERO MODA brand employed by the Danish company BESTSELLER A/S. Both of the companies BESTSELLER A/S and Aktieselskabet af 21. november 2001 are members of the BESTSELLER Group. The Complainant thus identifies its interests with those of the group and has introduced its claim on this basis.

FACTUAL BACKGROUND

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

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 JACK & JONES, VILA, ONLY and VERO MODA.

The disputed domain name <VEROMODA-JEANS.COM> (hereinafter <VEROMODA-JEANS.COM>), was registered on 29

December 2016, i.e. more than 27 years after the Complainant's first VERO MODA trademark was registered on 21 April 1989.

The disputed domain name is being used to sell unauthorized VERO MODA clothing through the use of original VERO MODA marketing campaign images.

The Complainant sent a cease and desist letter to the registrant of <VEROMODA-JEANS.COM> (hereinafter the "Respondent"), on 12 December 2017, notifying the Respondent of the Complainant's prior trademark rights to the VERO MODA trademark and of its copyright in the VERO MODA marketing campaign images. The Respondent did not respond to the Complainant's cease and desist letter.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The disputed domain name website is being passed off by the Respondent as an official VERO MODA online store to sell VERO MODA branded clothing without authorization.

This conduct justifies transfer of the disputed domain name to the Complainant on the following grounds relative to the UDRP's criteria:

1 Confusing similarity between the Complainant's VERO MODA trademark and <VEROMODA-JEANS.COM>

The disputed domain name coincides with the Complainant's VERO MODA trademark by the words "Vero" and "Moda", and only differs through the use of the word "Jeans", a hyphen and the element ".com".

The element ".com" is a top-level domain, which is a technical necessity and a requirement for registration of a domain name. The top-level domain element ".com" of <VEROMODA-JEANS.COM> may therefore be disregarded entirely from the trademark infringement assessment, cf. Proactiva Medio Ambiente, S.A. v. Proactiva, WIPO Case No. D2012-0182. 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 Vero, Moda and Jeans, 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 VERO MODA trademark and <VEROMODA-JEANS.COM>

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 VERO MODA trademark has been registered, i.e. clothing, as demonstrated by evidence adduced by the Complainant.

1.2 Likelihood of confusion between <VEROMODA-JEANS.COM> and the Complainant's VERO MODA trademark

Visually, the common elements "Vero Moda" coincides in both marks, whereas the word "Jeans" in <VEROMODA-JEANS.COM> differs from the Complainant's VERO MODA trademark. The Complainant's VERO MODA trademark consists of 2 words, whereas <VEROMODA-JEANS.COM> consists of 3 words.

Aurally, the words "Vero" and "Moda" are identically represented in both <VEROMODA-JEANS.COM>and the Complainant's VERO MODA trademark and will therefore be pronounced identically by the relevant public. The word "Jeans" will be pronounced differently than the words "Vero Moda". 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 “Jeans”, which are generic, descriptive and superfluous, due to the nature of the goods offered for sale by the Respondent on the website of <VEROMODA-JEANS.COM>.

Conceptually, the common words “Vero Moda” are meaningless to the relevant public, as the language of the website is English, and the only differing element is the word “Jeans”, which will be understood by the relevant public as being an English word for a specific type of clothing good.

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

The fact that the disputed domain name incorporates the Complainant’s registered trademark VERO MODA in its entirety is sufficient to establish identity or confusing similarity, cf. 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 word “Jeans”, which is descriptive for goods of clothing, in <VEROMODA-JEANS.COM> may serve to strengthen the connection with the Complainant’s VERO MODA trademark, as the relevant public would connect the words VERO MODA with goods of clothing, due to the fact that the Complainant uses the trademark extensively to sell such goods. The relevant consumers will therefore be very likely to search for the brand name VERO MODA accompanied by the word for the specific goods they are looking to purchase, such as “VERO MODA Jeans”.

It has furthermore been well established that the addition of descriptive or generic words to a complainant’s trademark will still lead to confusing similarity, when the respondent’s domain name contains the entirety of the complainant’s registered trademark, cf. 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 word “Jeans” to the Complainant’s VERO MODA trademark, will therefore still 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 VERO MODA trademark. Furthermore, there is identity between the goods offered for sale on the website of <VEROMODA-JEANS.COM> and the goods for which the Complainant’s VERO MODA trademark has been registered, as noted in section 1.1.

Consequently the disputed domain name is confusingly similar to the complainant’s VERO MODA trademark, cf. paragraph 4(a)(i) of the ICANN Uniform Domain Name Dispute Resolution Policy.

2 No Legitimate Rights in <VEROMODA-JEANS.COM>

The Complainant has neither authorized the Respondent to use its VERO MODA trademark, nor to sell VERO MODA goods. The Respondent is appearing as an official VERO MODA online store, through the use of the Complainant’s copyright protected images, for which evidence was adduced, in like manner to the Complainant’s wholesale customer ASOS.com Limited’s copyright protected images which show VERO MODA goods.

The disputed domain name is therefore not being used in a legitimate non-commercial or fair manner but rather with the intention to attract internet users by pretending to sell VERO MODA goods.

Furthermore, the Respondent has no trademark registrations on any part of <VEROMODA-JEANS.COM> and the Complainant

is not aware of any evidence which indicates that the Respondent is commonly known by the disputed domain name with reference to paragraph 4(c)(ii) of the Policy.

Consequently, the Respondent does not have any rights or legitimate interests in <VEROMODA-JEANS.COM> in the sense of paragraph 4(a)(ii) of the Policy.

3 Bad Faith

TThe website of <VEROMODA-JEANS.COM> is using not only the Complainant's registered trademark but also the Complainant's and the Complainant's wholesale customer's copyright-protected VERO MODA images. Furthermore, the Respondent is pretending to sell VERO MODA clothing.

The Respondent 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.

Following the above, it is obvious that the Respondent is intentionally attempting to attract internet users to the website for commercial gain, by creating a likelihood of confusion with the Complainant's VERO MODA trademark and attempting to create the impression of an affiliation between the website and the Complainant for the purposes 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 in the sense of paragraph 4(a)(iii) of the Policy.

RESPONDENT:

None.

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

This is an uncontested case of active cybersquatting, consisting in creating the appearance of a legitimate online store bearing the Complainant's brand and marketing images yet without any authorization by the Complainant to do so. In this connection, ample evidence was provided by the Complainant of its trademarks and of its registration and use of other domain names that incorporate the VERO MODA brand.

The Panel in particular accepts the Complainant's contention that the criterion of confusing similarity stipulated in paragraph 4(a)(i) of the ICANN Uniform Domain Name Dispute Resolution Policy has been fulfilled notwithstanding addition of a hyphen and of the word "jeans" in the disputed domain name together with the Top Level Domain extension ".com". As numerous previous UDRP dispute resolution Panels have held, including in those decisions cited in argument by the Complainant, incorporation in its entirety of a party's protected name in another's domain name can give rise to confusing similarity. On the other hand, neither a punctuation mark such as a hyphen nor the addition of a generic descriptive word such as "jeans" -- to connote clothing that is moreover associated here with the Complainant's brand -- will dispel such confusing similarity.

As concerns the second UDRP criterion, that is, the absence of rights or of a legitimate interest on the part of the Respondent in the sense of paragraph 4(a)(ii) of the Policy, there is no circumstance disclosed from the case file to suggest the existence of such rights or of any legitimate interest possessed by the Respondent. To the contrary, the Complainant avers that the Respondent has infringed the Complainant's rights (and/or those of its wholesaler) since no authorization was given to the Respondent to sell the Complainant's branded products or use copyrighted marketing material. This is also a case far removed from a situation in which any fair or noncommercial use might be claimed. Moreover, the Respondent failed to respond to the Complainant's cease and desist letter or to its Complaint in the present proceeding by asserting any such rights or interest. The Panel is against this background obliged to conclude that this UDRP criterion too is fulfilled.

In relation to the final UDRP criterion, that of the presence of bad faith on the Respondent's part in the sense of paragraph 4(a)(iii) of the Policy, the Panel can detect from the facts before it no element that might counterweigh the compelling case presented by the Complainant of the Respondent's registration and use of a domain name in violation of the Complainant's rights in order to attract users for commercial gain. Such a design falls clearly within the meaning of bad faith contemplated by the UDRP.

The Panel hence finds that all three parts of the UDRP's cumulative test have been satisfied in this case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VEROMODA-JEANS.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2018-02-21

Publish the Decision