Decision for dispute CAC-UDRP-101901

Case number	CAC-UDRP-101901
Time of filing	2018-02-22 09:20:53
Domain names	hugo-bossoutlets.com , tophugobosssuits.com

Case administrator

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

Complainant

Organization	HUGO BOSS Trade Mark Management GmbH & Co
Organization	HUGO BOSS AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	Charles Carranza

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainants have trade mark registrations in several countries for the marks HUGO BOSS, alone or in combination with other words or device elements. The First Complainant, Hugo Boss Trademark Management GmbH & Co. KG, is the owner of a number of registrations for the trademark HUGO BOSS worldwide including the following:

Jurisdiction: European Union
Trademark No.: 000049254
Registration date: March 26, 2008

Jurisdiction: European Union
Trademark No.: 006645204
Registration date: November 26, 2012

Jurisdiction: International

Trademark No.: 430400
Registration date: June 3, 1977

Jurisdiction: International
Trademark No.: 513257
Registration date: April 10, 1987

Jurisdiction: International
Trademark No.: 637658
Registration date: May 31, 1995

Jurisdiction: China
Trademark No.: 9277541
Registration date: April 28, 2012

Jurisdiction: China
Trademark No.: 1960721
Registration date: September 14, 2002

Jurisdiction: China
Trademark No.: 949338
Registration date: February 21, 1997

Jurisdiction: China
Trademark No.: 253481
Registration date: June 30, 1986

Jurisdiction: Hong Kong China
Trademark No.: 1991B0042
Registration date: January 11, 1991

Jurisdiction: United States
Trademark No.: 73665342
Registration date: June 8, 1987

Jurisdiction: United States
Trademark No.: 75367506
Registration date: October 3, 1997

The Second Complainant, Hugo Boss AG, is the registrant of numerous domain names incorporating HUGO BOSS trademarks, including a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD"), for example, <hugoboss.com> (created on April 24, 1997), <hugoboss-shop.com> (created on June 14, 2004) and hugoboss.us (created on April 19, 2002).

FACTUAL BACKGROUND

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

In the case at hand there are two Complainants.

The first complainant HUGO BOSS Trade Mark Management GmbH & Co. KG (hereinafter "Complainant 1") and the second complainant HUGO BOSS AG (hereinafter "Complainant 2", collectively, “Complainants”), are part of the world-renowned HUGO BOSS Group.

Complainants are a well-known leading fashion company, founded in 1924 in Germany. It manufactures, markets and retails clothing, shoes and other accessories, as well as fragrances, skincare products, watches, eyewear and kidswear under various trademarks including HUGO BOSS, BOSS and HUGO. The Complainants employ almost 14,000 people worldwide and generated net sales of EUR 2.8 billion in fiscal year 2015.

The Disputed domain name <hugo-bossoutlets.com> is registered in the name Charles Carranza. The Disputed domain name <tophugobosssuits.com> is registered in the name William Tillery.

Complainants contend that the entities which control both domain names at issue are effectively controlled by the same person and/or entity.

Complainants provide the following support for consolidation for the domains <hugo-bossoutlets.com> and <tophugobosssuits.com>:

(i) There are similarities in the details under which the Disputed domain names are registered, both are US addresses and give the same details for the Registrant Name and Registrant Organisation;

(ii) The IP Location for both Domain Names is identical, namely California – Los Angeles – Psychz Networks and the IP Address is almost the same, with only one digit difference, respectively 45.35.198.201 and 45.35.198.200;

(iii) The domains were both registered on the same day, namely 27 April 2017 using the same Registrar “domain.com”;

(iv) The websites are both using the same server type, namely Apache/2.2.15;

(v) The content/ layout of the websites associated with the Disputed Domain Names share many common and identical elements, including that almost all the text within the sites are identical and there are identical customer registration forms;

(vi) The nature of the marks at issue – both domains are being used to promote an online store, claiming to sell discounted HUGO BOSS articles;

(vii) The owner of <hugo-bossoutlets.com> also has around 13 other domains featuring famous marks such as <prada-deutschlands.com>, <lacost-australias.com> and <juicy-couturessales.com>. Further, the official whois e-mail of the <tophugobosssuits.com> domain is linked to around 559 domains including others with famous brands such as <ferregamo-mexicos.com>, <guccis-deutschlands.com> and <newlvsale.com>. These similarities in the naming style using famous fashion brands and geographic terms with the addition of an “s” for other registrations associated with both domains are clearly beyond mere coincidence, and therefore also support a finding that the Disputed domain names are under common control; and

(viii) Both domains are in the English language, and roman script

Complainants have trade mark registrations in several countries for the marks HUGO BOSS, alone or in combination with other words or device elements. Complainant 1 is the owner of a substantial number of registrations for the trademark HUGO BOSS worldwide, the Complaint 2 is the registrant of numerous domain names incorporating HUGO BOSS trademarks, including a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD"), for example, <hugoboss.com> (created on April 24, 1997), <hugoboss-shop.com> (created on June 14, 2004) and hugoboss.us (created on April 19, 2002).

The Complainants states that in past disputes under the Policy panels held that the HUGO BOSS trademark was a well-known mark.

i) THE DOMAIN NAMES ARE CONFUSINGLY SIMILAR

The Complainants state that both Disputed domain names entirely incorporate Complainants' well-known, registered trademark HUGO BOSS with merely the addition of the highly relevant phrases "outlets" and "top suits". The addition of the generic Top-Level Domains (gTLD) ".com" does not in the view of the Complainants add any distinctiveness to the Disputed domain names. Furthermore, there have been many domain disputes involving a trademark and the words "outlet" and or "sale", where the panel has found such terms do not create distinctiveness.
The incorporation of the HUGO BOSS trademark into the Disputed domain names creates the impression that Respondents are somehow affiliated with Complainants, and Respondents are somehow doing business using Complainants` trademark. The top-level suffix in the Disputed domain names (".com") is to be disregarded under the confusing similarity test".

Complainants have not found that Respondents are commonly known by the Domain Names. The WHOIS information "Charles Carranza" and "William Tillery" is the only evidence in the WHOIS record, which relates Respondents to the Disputed domain names. Respondents have not by virtue of the content of the website, nor by its use of the Disputed domain names shown that they will be used in connection with a bona fide offering of goods or services. The Respondents could have easily perform a similar search before registering the Disputed domain names and would have quickly learnt that the trademarks are owned by Complainants and that the Complainants have been using their trademarks extensively in the United States and around the world.

There is also, in the view of the Complainants, no evidence that Respondent has a history of using or preparing to use the Disputed domain names in connection with a bona fide offering of goods and services.

At the time of filing this complaint, Respondents were using the Disputed domain names to attract internet users to its websites where Respondents states that it is "HUGO BOSS" including featuring a HUGO BOSS logotype prominently on the top left-hand side of the page. Respondents are not authorized to use the HUGO BOSS trademarks, nor is there any relationship between Complainants and Respondents.

Moreover, the use of the word HUGO BOSS (i) in the Disputed domain names and (ii) also on multiple occasions in the website text further created the impression that there is some official or authorized link with Complainants. As noted previously, the trademark HUGO BOSS is a well-known trademark around the world and given the references to this mark on the website and unauthorised use of a variation of the logotype, it is clear that Respondents know about it's existence.

In addition, the websites associated with the Disputed domain names invite visitors to contact Respondents via the "Contact Us" form accessible on the Contact Us pages. Respondents's attempt to "phish" for users' personal information is neither a bona fide offering of goods and services nor a legitimate non-commercial or fair use pursuant to Policy.

The use of a trademark as a domain name by an authorized or non-authorized third party is only to be regarded as a bona fide offering of goods or services within the meaning of paragraph 4(c) of the Policy if the following conditions are satisfied:
• the respondent must actually be offering the goods or services at issue;
• the respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods;
• the site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents;
• the respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

These conditions are in the view of the Complainats for the following reasons not satisfied :

Firstly, Respondents are unlikely to be offering the Complainants' products or services through the Disputed domain names, but rather appears to be offering similar products and possible fakes and counterfeits and claims to be a discount outlet, offering up 50% or more discounts;

Secondly, Respondents do not publish an adequate disclaimer on the challenged pages. On the websites connected to

Disputed domain names there is no statement disclaiming a relationship or association with Complainants but rather there are merely the statements “Copyright © 2018 hugo-bossoutlets.com. Powered by hugo-bossoutlets.com” and “Copyright © 2018 tophugobosssuits.com. Powered by tophugobosssuits.com”. Clearly such statements would only reinforce the impression that these are sites authorised by the Complainants;

Thirdly, Respondents are depriving the Complainants of reflecting their own mark in the Disputed domain names; and

Finally, Respondents present themselves as the trademark owner by using Complainants‘ HUGO BOSS trademark (word mark and logotype) on many occasions throughout the websites.

Respondents's use of the Disputed domain names creates an overall impression that they are the Complainants‘. In the present case, Respondents do not meet all the Oki Data criteria. It is in the view of the Complainants undeniable that Respondents were aware of Complainants’s marks prior to the acquisition of the Disputes domain names and establishment of Respondents’s websites. Respondents have made no claims to either having any relevant prior rights of its own, or to having become commonly known by the Disputed domain names. Clearly, Respondents are not known by the Disputed domain names, nor do Respondents claim to have made legitimate, non-commercial use of the Disputed domain names.

Respondents have been granted several opportunities to present some compelling arguments that it has rights in the Disputed domain names but have failed to do so. This behavior coupled with the use of the domain names cannot be considered as legitimate use of the Disputed domain names.

The Complainants state that the Disputed domain names were registered in bad faith, because Complainants’ numerous trademark registrations predate the registration of the Disputed domain names and Respondents have never been authorized by Complainants to register the Disputed domain names. Moreover, the active business presence, growth and success of Complainants worldwide in recent years shows that it inconcievable that Respondents were not aware of the unlawful registration of the Disputed domain names.

The Complainants tried to contact Respondents via the data centre Sayfa.net on July 20, 2017 through a cease and desist letter, sent to the official e-mail address provided. However no answer was received. This communication was simply disregarded. This is bad faith behaviour in Complainants view.

The Complainants have the view that Respondents tried to mislead Internet users and consumers, for commercial gain, into thinking that the website at the Disputed domain name is, in some way or another, connected to, sponsored by or affiliated with the Complainants and their business.

Furthermore, the fact that the Disputed domain names include the entire trademarks of the Complainants is a further factor supporting a conclusion of bad faith.

Respondents were taking advantage of the HUGO BOSS trademark by creating a likelihood of confusion with the Complainants’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s products, services, websites or location.

From the Complainants’s point of view, Respondent intentionally chose the Disputed domain names based on its registered and well-known trademark in order to generate more traffic to its own business. Nowhere do Respondents disclaim an association between itself and Complainants. The Disputed domain names are currently connected to a webside what appears to be an online shop, selling fashion clothing and accessories, consequently, Respondents are using the Disputed domain names to intentionally attempt to attract, for commercial gain, internet users to the website, by creating a likelihood of confusion with Complainants’s trademarks as to the source, sponsorship, affiliation or endorsement of its website.

Finally, the Complainants state, that Complainants’ trademark registrations predate Respondents’s domain names registrations.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainants have, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainants have, to the satisfaction of the Panel, shown the disputed 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.

PRINCIPAL REASONS FOR THE DECISION

The Complainants are the HUGO BOSS Trade Mark Management GmbH & Co. KG and the HUGO BOSS AG. The Complainants are a group of related entities that belong to the same company group.

I. Consolidated complaint

As stated in Section 4.16 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0), in order for multiple complainants to file a single complaint against multiple respondents, the complainants must accompany the complaint by a request for consolidation which establishes the following criteria:

"(i) the complainants either have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants' individual rights in a similar fashion;

(ii) it would be equitable and procedurally efficient to permit the consolidation; or in the case of complaints brought (whether or not filed by multiple complainants) against more than one respondent, where (i) the domain names or the websites to which they resolve are subject to common control, and (ii) the consolidation would be fair and equitable to all parties."

The Panel finds that consolidation in this case is proper.

The Complainants filed a joint complaint against the Respondents. First, the Complainants have a specific common grievance against the Respondents because the Complainants are entities of the same group.

Second, it would be equitable and procedurally efficient to permit the consolidation because the Disputed domain names are likely to be owned by the same person. The evidence on file shows that both Disputed domain names are registered on the same day using the same Registrar "domain.com" and US addresses, the IP Location for both Disputed domain names is identical, namely California – Los Angeles – Psychz Networks and the IP Address is almost the same, with only one digit difference, respectively 45.35.198.201 and 45.35.198.200, the websites are both using the same server type, namely Apache/2.2.15, the content/ layout of the websites associated with the Disputed domain names share many common and identical elements, including that almost all the text within the sites are identical and there are identical customer registration forms, the nature of the marks at issue – both domains are being used to promote an online store, claiming to

sell discounted HUGO BOSS articles and both domains are in the English language, and roman script.

It would be unjust to force the Complainants to incur additional costs by making them file a separate complaint. Thus, the consolidation is proper.

II. Rights

The Complainants have rights in the mark by virtue of its registered trademark "HUGO BOSS".

Many UDRP panels have found that a Disputed domain name is confusingly similar to a complainant's trademark where the Disputed domain name incorporates the complainant's trademark in its entirety (e.g.Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070 ; Chloé S.A.S. v. DVLPMNT Marketing, Inc., WIPO Case No. 2014-0039). The Panel shares this view in the case at issue where the Complainant's registered trademark "HUGO BOSS" is fully included in the Disputed domain names and combined with the addition of the generic terms like "OUTLETS", "TOP" and "SUITS" at the beginning and the end of the Disputed domain names, and the gTLD suffix ".com".

The Panel agrees with the Complainants that the addition of the generic terms "OUTLETS", "TOP" and "SUITS" at the beginning or end of the Disputed domain names and the gTLD ".com" are not sufficient to escape the finding that the Disputed domain names are confusingly similar to the Complainants trademark and does not change the overall impression of the designation as being connected to the trademark "HUGO BOSS", as the trademark "HUGO BOSS" is the only distinctive part of the Disputed domain names.

Therefore the Panel finds, that the Disputed domain names are confusingly similar to the Complainants trademark "HUGO BOSS".

III. The Respondents have no rights or legitimate interest in respect of the domain names

The Panel agrees with Complainants that the Respondents "Charles Carranza" and "William Tillery" are not commonly known by the Disputed domain names, because the Disputed domain name holders name or contact details contain no reference to "HUGO BOSS" or similar word or name. Respondents are not authorized to use the HUGO BOSS trademarks, nor is there any relationship between Complainants and Respondents.

The Panel agrees with Complainants that at the time of filing this complaint, Respondent were using the Disputed domain names and the "HUGO BOSS" trademark on the websites to attract internet users to its websites.

Moreover, the use of the word HUGO BOSS (i) in the Disputed domain names and (ii) also on multiple occasions in the website text further created the impression that there is some official or authorized link with Complainants.

Nevertheless, following Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903, the use of a trademark as a domain name by an authorized or non-authorized third party can be regarded as a bona fide offering of goods or services within the meaning of paragraph 4(c) of the Policy if the following conditions are satisfied:

• the respondent must actually be offering the goods or services at issue;
• the respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods;
• the site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents;
• the respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

Respondents fail this test, because Respondents do not publish an adequate disclaimer on the challenged pages. On the websites connected to Disputed domain names there is no statement disclaiming a relationship or association with

Complainants but rather there are merely the statements “Copyright © 2018 hugo-bossoutlets.com. Powered by hugo-bossoutlets.com” and “Copyright © 2018 tophugobosssuits.com. Powered by tophugobosssuits.com” and Respondents are depriving the Complainants of reflecting their own mark in the domain names; and, Respondent presents themselves as the trademark owner by using Complainants‘ HUGO BOSS trademark on many occasions throughout the websites.

The Panel notes that the In lack of any Response from the Respondents, or any other information indicating the contrary, the Panel concludes that the Respondents have no right or legitimate interests in respect of the Disputed domain names.

IV. The domain names were registered and are being used in bad faith

The Panel believes that Respondents registered the Disputed domain names with knowledge of Complainant's rights. First, Complainant obtained its first trademark registration decades before the Disputed domain names were registered and used it widely since than. Second, Respondents used the Disputed domain names to resolve to a website using Complainant's trademark, which is a clear indication that Respondent was aware of the trademarks of Complainant and demonstrates knowledge and targeting of Complainant and its trademark, i.e. registration in bad faith.

Furthermore, Respondents never replied to Complainants’ cease and desist letter, which can also, at the case at hand, be considered relevant in a finding of bad faith. (see e.g., News Group Newspapers Limited and News Network Limited v. Momm Amed Ia, WIPO Case No. D2000-1623; Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598; and America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460).

Based on the evidence provided by the Complainants, the Panel finds that the Respondents, by registering and using the Disputed domain names incorporating the Complainants' well-known trademark HUGO BOSS along with generic terms related to the Complainants business activity, tried to mislead Internet users and consumers, for commercial gain (for selling products), into thinking that the website at the Disputed domain names are, in some way or another, connected to, sponsored by or affiliated with the Complainants and their business, which the Panel finds is evidence of bad faith (see also Columbia Insurance Company v. Pampered Gourmet, WIPO Case No. D2004-0649). No disclaimer can be found on the website, to disclaim an association between Respondents and Complainants.

On these grounds, the Panel concludes that the Respondents have registered and are using the Disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HUGO-BOSSOUTLETS.COM** : Transferred
2. **TOPHUGOBOSSSUITS.COM**: Transferred

PANELLISTS

Name	**Jan Christian Schnedler, LL.M.**

DATE OF PANEL DECISION 2018-04-05

Publish the Decision