Decision for dispute CAC-UDRP-102087

Case number	CAC-UDRP-102087
Time of filing	2018-07-17 11:18:47
Domain names	DIADORASCARPE.COM

Case administrator

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

Complainant

Organization	DIADORA SPORT S.R.L.

Complainant representative

Organization	Convey srl

Respondent

Name	Gillian Grocott

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered holder of the following trademark consisting of the term "DIADORA":

(i) DIADORA (word), EU Trademark, priority date 15 July 1996, registration date 7 January 1999, trademark no. 339093, registered for goods and services in classes 18, 25 and 28.

In addition, the Complainant has registered various other trademarks consisting of the dominant part "DIADORA" in many jurisdictions as either international (WIPO) trademarks or national trademarks.

(referred to as "Complainant's trademark(s)").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "DIADORA".

FACTUAL BACKGROUND

The Complainant is an athletic footwear and apparel manufacturer and was founded in 1948 by Marcello Danieli. Its

products have been worn in connection with major sports events including by Gustavo Kuerten at the Roland-Garros international tennis championship and by the Italian Olympic team during the 2016 Olympic Games in Rio de Janeiro, Brazil. Therefore, the Claimant has spent considerable effort in promoting his products and Complainant's trademark.

The disputed domain name was registered on 24 January 2018 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) is used to (i) provide information on various products (shoes) sold under Hogan trademark (which is not in any way related to the Complainant) and encourages the visitors to purchase the same and (ii) links to such third party's websites offering for sale counterfeited Diadora products.

As soon as the Complainant became aware thereof it sent to the Respondent a cease and desist letter in order to notify it of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer of, the disputed domain name to the Complainant.

Since the letter was to no avail, the Complainant initiated this proceedings and seeks transfer of the disputed domain name to the Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains DIADORA part of Complainant's trademarks in its entirety;

- Addition of a generic and descriptive term „scarpa" (meaning „shoes" in English) is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark and it does not change the overall impression that the disputed domain name is connected to the Complainants' trademarks and its business;

- The generic Top-Level Domains (gTLD) ".com" does not add any distinctiveness to the disputed domain name;

- The Complainant refers to previous domain name decisions concerning such practice and assessing similarity in general.

Thus, according to the Complainant the confusing similarity between Complainant's trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name;

- The Complainant has not authorized, permitted or licensed the Respondent to use the Complainant's trademark in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name;

- No bona fide use of the disputed domain name has been established also because the above described use of the disputed domain name suggests that the Respondent intended to trade upon the Complainant's trademarks by intentionally

attempting to attract to its website users looking for the Complainant and its products, by misleading them as to the source or affiliation of its website.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademark predates the disputed domain name registration and such trademark is well-known in relevant business circles. The Respondent can be considered to be aware of the Complainant's trademark when registering the disputed domain name due to well-known character thereof;

- It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant's trademarks which enjoys strong reputation, plus other facts, such as above described no genuine use of the disputed domain name, are sufficient to establish bad faith under the 4(a)(iii) of the Policy;

- The Complainant refers to previous domain name decisions contending that (i) registering a domain name incorporating trademarks that enjoy high level of notoriety and well-known character and (ii) abusive use of such trademarks on the domain name website with an aim to mislead the public about origin of the website and services offered through it, both constitute prima facie registration and use in bad faith.

The Complainant presents the following evidence which has been assessed by the Panel:

- Copies of extracts from relevant databases concerning Complainant's Trademarks;
- Screenshots of websites <www.diadora.com> and <www.utilitydiadora.com> operated by the Complainant;
- Screenshots of the disputed domain name website;
- Copy of the cease and desist letter sent to the Respondent.

RESPONDENT:

The Respondent has not provided any response to the Complaint.

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

RIGHTS

Since the disputed domain name and the Complainant's trademarks are not identical the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term "DIADORA" accompanied by a suffix "SCARPE" is confusingly similar to the Complainant's trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of a dominant "DIADORA" element of Complainant's trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitutes confusing similarity between Complainant's trademark and such domain name. Addition of a non-distinctive element - suffix "SCARPE" (meaning "shoes") - to it cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the confusing similarity test as it is a necessary technical requirement of registration.

Therefore, since the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant's assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name.

Given the fact, that the Respondent, in particular (i) decided to use the disputed domain to present information about products of Complainant's competitors (i.e. shoes under brand Hogan), (ii) displays link to other websites offering counterfeited Complainant's products, and (iii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain name was intended to be used in connection with a bona fide offering of goods or services as required by the Policy.

As a result, the Respondent failed to provide any information and evidence that it has relevant 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's trademarks enjoy (at least in relevant business and customer circles) well-known status and high level of notoriety. As a result, there is only a remote chance that the Respondent has registered such complex domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business.

In addition, as described above, the Complainant has proven that the Respondent has used (at least for some time) the disputed domain name for purposes of presenting information about products of Complainant competitors, i.e. shoes under brand Hogan.

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain name just by a chance and without having any knowledge about the existence of the Complainant's rights and business (ii) the use of the dispute domain name is not compliant with fair business practices, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith, namely:

(i) in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name; and

(iii) by using the disputed domain name the Respondent intentionally attempted to attract, for commercial gain, Internet users to the disputed domain name website by creating a likelihood of confusion with the Complainant's trademark to the source, sponsorship, affiliation, or endorsement of the Respondent's website (or other location) or of a product or service on the Respondent's website (or other location).

Thus, the Panel has taken a view that 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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DIADORASCARPE.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2018-08-23

Publish the Decision