Decision for dispute CAC-UDRP-102233

Case number	CAC-UDRP-102233
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Domain names	geoxshop.com

Case administrator

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

Complainant

Organization	Geox S.p.a

Complainant representative

Organization	Brandstock Domains GmbH

Respondent

Name	Jeongyong Cho

OTHER LEGAL PROCEEDINGS

There are no other proceedings to the knowledge of the Panel.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of many national and regional trade marks worldwide for the word mark, GEOX, and various figurative marks, including many barely stylized logo marks with that as the word element.

Its extensive portfolio includes an EU Trade Mark, for the word mark, No. 003701059, filed on 8 March 2004 for classes 3, 9, 10, 14, 16, 18, 20, 21, 24, 25, 26, 28, 35 and the Complainant's International trade mark GEOX No. 837071, which designates some 31 countries, including South Korea, where the Respondent is located. That mark was applied for on 8 June 2004 and includes classes 03, 5, 9, 10, 12, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 38, 39, 41, 42.

The Complainant also has many other national marks around the world, some of the earliest dating from or about the mid-1990s.

The Complainant also relies on its fame and reputation and says it is a famous or well-known mark.

FACTUAL BACKGROUND

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

The Complainant is an Italian shoe and clothing manufacturer with particular expertise in waterproof and breathable fabrics. It was founded in 1995. The name and mark Geox, was created from the Greek word “geo” for earth, with an “x,” symbolizing technology. Its signature product, the “shoe that breathes”, was patented the same year. In less than 30 years, the Complainant grew to become an international leader in its field. Over 65% of its turnover is achieved by sales in over 110 countries worldwide. The Complainant’s products are sold through some 10,000 multi-brand retailers but also through its network of 1.157 own branded shops and it has more than 5,000 direct employees worldwide. The Complainant is listed on the Milan stock Exchange and its net sales figure in 2017 was 844 million euros.

See above as to its registered rights. The Complainant is the owner of the domain <geox.com>, and its website is ranked approximately 52,000 in Alexa’s Global Ranking. The Complainant has a Facebook page named Geox, with 1.4 million followers, a Twitter feed, followed by nearly 40,000 people, and an Instagram page followed by more than 197,000 users. The GEOX trademark is well-known worldwide. The Complainant submits that it enjoys a widespread reputation and goodwill through the continuous and long-standing use of the GEOX trade mark as a company name and a brand.

The Complainant submits that the disputed domain was registered on 30 May 2000 but changed hands in 2007 according to its evidence from DomainTools Whois History tool. 2007 was therefore the first time the Respondent was registered as the owner of the disputed domain name. The disputed domain name redirects to www.myboots.com, which displays a parking page with pay-per-click commercial links and a banner that states the disputed domain name is for sale. The disputed domain name is listed for sale on Sedo, the world’s largest domain name marketplace. That listing shows that many (more than 100) bids were placed on this domain name, none of which were accepted by the current owner.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

Language of proceedings

To the best of the Complainant’s knowledge, the language of the Registration Agreement is Korean. However, the Panel has authority to determine the language of proceedings. In many cases, UDRP Panels have adopted English as the language of proceedings, even if the Registration agreement of the registrar was exclusively in another language. In the absence of an agreement, the language of the registration agreement shall normally dictate the language of the proceedings. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel’s discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her ability to articulate the arguments for the case. This has been confirmed in WIPO Case no. D2014-1889, where the Panel also stated: “One important consideration is the issue of fairness to both parties in their abilities to prepare the necessary documents for this proceeding and also to respond adequately to these documents when they are served upon the parties.” English was also accepted as the language of proceedings at the Czech Arbitration Court (CAC), for example Case No. 101940 (<jimdo.top>), or Case No. 102076 (<perspire.xyz>).

The Complainant has undertaken a reverse WHOIS search for domain names owned by the Respondent and found a very large number of domain names containing English words. This must be seen as an indication that the Respondent is in position to understand the English language. The Complainant contends that the Respondent is able to undergo UDRP proceedings in English. Therefore, it would not be unfair to the Respondent to conduct these proceedings in English. The same was already decided in UDRP cases. For example, in WIPO Case No. D2015-1466, the Panel decided that “the Respondent's other domain name registrations contain generic English terms such as "outlet" and "replica". These circumstances lead the Panel to the belief that the Respondent would not be prejudiced if English is adopted as the language of the proceeding.” On the contrary, the Complainant is not able to communicate in Korean. Being an Italian entity,

the Complainant is not in position to conduct these proceedings in Korean without a great deal of additional expense and delay due to the need for translation of the Complaint. English is not the native language of the Complainant or its representative, therefore it would not give him unfair advantage over the Respondent. Paragraph 10 (c) of the UDRP Rules provides that the Panel shall ensure that the administrative proceeding takes place with due expedition. Conducting the proceedings in Korean would contravene this provision for the reasons stated above. Therefore, the Complainant kindly requests that the Panel agree to conduct these proceedings in English.

Rights

The Complainant submits that the disputed domain name is identical or similar, to the point of confusion, to the earlier trade marks of the Complainant. Indeed, the GEOX word mark is fully incorporated within the disputed domain name and followed by the generic English term “shop”. The word mark, GEOX, appears at the start of the domain name and the average and ordinarily cautious user will likely believe that the disputed domain name resolves or connects to an online store of Geox products. Panels widely accept that the addition of a generic term in general, and of the term “shop” in particular, to a brand, does not diminish the identity or similarity between a domain name and a trademark. See for example WIPO Case D2008-1191 where the Panel stated: “the additional word “shop” does not negate the confusing similarity between the domain name and the Complainant's trademarks. On the contrary, it does suggest that it is related to the Complainant's website.. which is likely to cause consumers' confusion.” Equally, the applicable Top Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is disregarded under the first element’s similarity test, as indicated by the WIPO Jurisprudential Overview 3.0. Therefore, the Complainant says the disputed domain name is identical or confusingly similar to the name and marks of the Complainant. The first element of the Policy is therefore deemed satisfied.

Legitimate interests

The Respondent in this administrative proceeding was confirmed as such by the relevant Registrar. The Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name. To the best of the Complainant’s knowledge, the Respondent is not commonly known by the disputed domain name and has acquired no trade mark or service mark rights in the word or term “GEOX.” Firstly, the Respondent is not commonly known by the disputed domain name. The Complainant has conducted trade mark searches and found no registered GEOX trade mark or right owned by the Respondent. Moreover, having made no use of the disputed domain name over the years, the Respondent cannot be seen as commonly known by the disputed domain name. Indeed, the disputed domain name redirects to www.myboots.com, which displays a parking page with pay-per-click commercial links. Secondly, the Respondent reproduces the Complainant’s word mark without any license or authorization from the Complainant, which is strong evidence of the lack of legitimate interest. The Complainant asserts that the Respondent is neither a contractor, authorized distributor, employee, licensee, dealer or other kind of business partner of the Complainant. The Complainant has no contractual or business relations with the Respondent. Thirdly, the Respondent’s has not used the disputed domain name nor made any preparation to use the disputed domain name in connection with a bona fide offering of goods or services. Indeed, as stated above, the disputed domain name has been redirected to a parking page of pay-per-click commercial links. Their ability to generate revenue depends in turn on the ability of the disputed domain name to attract users seeking information on the owner of the trade mark. As the disputed domain name comprises only the Complainant’s trade mark, it is very likely to attract Internet users. Fourthly, since the adoption and extensive use by the Complainant of the trade mark predates the registration in the name of the Respondent of the disputed domain name, the burden is on the Respondent to establish its rights or legitimate interests (if any) the Respondent may have in the disputed domain name. None of the circumstances by which a respondent can prove his rights or legitimate interests, are present in this case. In light of all the elements mentioned above, the Respondent should be considered to have no rights or legitimate interests in respect of the disputed domain name. Given that the Complainant has made a prima facie case that the Respondent lacks legitimate rights or interests in the disputed domain name, the burden of proof shifts to the Respondent to come forward with appropriate evidence demonstrating rights or legitimate interests in the domain name. The second condition under the Policy should be deemed satisfied.

Bad faith

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant submits that the domain was registered on 30 May 2000. However, the domain changed hands in 2007 according to the DomainTools Whois History tool. For the purpose of the proceedings, the Complainant will therefore consider that the domain was registered in 2007. Firstly, the GEOX trade marks have enjoyed wide-spread extensive use and are so widely well-known that it is inconceivable that the Respondent could have been ignorant of the Complainants' earlier rights at that date. The Respondent must have had the Complainant's trade marks in mind when registering the disputed domain name in his name in 2007. This cannot have been accidental and must have been influenced by the fame of the trade marks. Indeed, a simple search on an online search engine yields results only related to the Complainant. Consequently, it is asserted that the Respondent obviously knew of the earlier rights of the Complainant. The registration of a domain name reproducing the identical trade mark of the Complainant, clearly shows the Respondent had full knowledge of the earlier trade mark and registered the disputed domain name in that full knowledge and in contravention of the Complainant's rights. Moreover, the Complainant contends that this finding also applies should the registration date be set to 2000 for the purpose of the proceedings. Secondly, the term "geox" is an arbitrary term with no meaning whatsoever. See https://en.wikipedia.org/ Therefore the Complainant submits the Respondent registered the domain name with the GEOX trade mark in mind. Thirdly, the Complainant sees no possible way whatsoever that the Respondent would use the domain name in connection with a bona fide offer of products or services. Indeed, any use of the GEOX trade mark would amount to trade mark infringement and damage to the repute of the trademark. The retention of the disputed domain name by the Respondent, is an attempt to prevent the Complainant from reflecting its trademark in the disputed domain name, and is strong evidence of bad faith. Furthermore, any actual use of the disputed domain name by the Respondent would de facto amount to bad faith use. Fourthly, the Complainant submits that there is a pattern of registration of domain names containing third party trade marks by the Respondent and that it's email address is associated with the registrations of the domains amexsecurity.com, buyprovillus.com or cleanexcel.com which all reproduce trade marks of third parties. This shows that the Respondent acts in bad faith when registering and using the disputed domain names. Fifthly, the disputed domain name is listed for sale on Sedo, the world's largest domain names marketplace. It is shown that more than 100 bids were placed on this domain name, none of which was accepted by the current owner. The Respondent is clearly attempting to make a large amount of money from the domain with the Complainant's trade mark. This cannot be good faith. Sixthly, the Complainant's research shows several domain disputes involving the Respondent and ordering that the domains be transferred to the corresponding complainants:

- WIPO Case D2017-0769 against domain name solarsense.com
- WIPO Case D2013-1263 against domain name cicstart.com
- WIPO Case D2013-0066 against domain name primagas.com
- WIPO Case D2011-0155 against domain name xpole.com
- WIPO Case D2008-1407 against domain name capitoltokyu.com
- WIPO Case D2007-1582 against domain name nutergia.com

The above clearly show that the Respondent is engaged in a pattern of behaviour and is trying to take advantage of trade mark owners.

Finally, the panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith. Examples of cumulative circumstances may be found to be indicative of bad faith including a complainant having a well-known trade mark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether a domain name is used in bad faith given the circumstances surrounding registration, and vice versa. The issue is not limited to positive acts in bad faith but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive course of action in bad faith and acting in bad faith may be a fine distinction, but inaction is also within the concept. For the foregoing reasons, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The final limb of the Policy is fulfilled.

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 Respondent's contact details were verified by the Registrar and CAC confirmed that service of the Complaint by e-mail to gregorychoo@gmail.com was successfully delivered.

The Panel grants the request of the Complainant for the language of the proceedings to be English. Under paragraph 11(a) of the Rules, unless otherwise agreed, the language of the administrative proceeding should be the language of the Registration Agreement - which here is Korean. However, the Complainant produced a reverse WHOIS search of domain names owned by the Respondent which shows a very large number of its domain names contain English words. The word shop in the disputed domain name is also an English word. This may be taken as an indication that the Respondent is in position to understand English. Therefore, it would not be unfair to the Respondent to conduct these proceedings in English. A similar view has been taken in other UDRP cases. For example, in WIPO Case No. D2015-1466 the Panel decided that “the Respondent's other domain name registrations contain generic English terms such as "outlet" and "replica". These circumstances lead the Panel to the belief that the Respondent would not be prejudiced if English is adopted as the language of the proceeding.” See also the CAC Case No. 101940 (<jimdo.top>), or Case No. 102076 (<perspire.xyz>) (same). We also accept that it would not impact the fairness of the proceeding as English is not the Complainant's first language either. Both parties will therefore be in a similar position.

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 the Complainant has registered rights in the similar name and mark and that mark is a well-known mark. The applicable Top Level Domain (“TLD”), here.com, is disregarded under the first limb’s identity/similarity test. The leading authority is WIPO Case No. D2000-0429 re rollerblade.net. While the generic word ‘shop’ may be relevant in some cases to panel assessment of the second and third elements, it adds nothing to this limb and does not prevent the visual, aural or conceptual similarity. See for example WIPO Case D2008-1191 where the Panel stated: “the additional word “shop” does not negate the confusing similarity between the domain name and the Complainant's trademarks." The name and mark are not however identical, which is a strict test, see WIPO Case No. D2012-1862, <electrolux-vacuum.net>.

While the issue is highly fact-sensitive, the registration of a domain name identical or similar to a well-known or famous mark without legitimate right or interest in the name creates a strong presumption of bad faith (see Societe Air France v ibiz hosting, CAC 46465, <airfranceonline.eu>).

The disputed domain name however was first registered prior to the Complainant’s national Korean trade mark registration, as the Korean national mark was only protected from the application date in June 2004, whereas the disputed domain name was registered in 2000. It is possible therefore that the original registration of the disputed domain name was in good faith. The evidence is not sufficient to determine the point. The WIPO overview says: "Subject to scenarios described in 3.8.2 below, where a respondent registers a domain name before the complainant’s trademark rights accrue, panels will not normally find bad faith on the part of the respondent. (This would not however impact a panel’s assessment of a complainant’s standing under the first UDRP element.) Merely because a domain name is initially created by a registrant other than the respondent before a complainant’s trademark rights accrue does not however mean that a UDRP respondent

cannot be found to have registered the domain name in bad faith. Irrespective of the original creation date, if a respondent acquires a domain name after the complainant's trademark rights accrue, the panel will look to the circumstances at the date the UDRP respondent itself acquired the domain name."

Here, the disputed domain name apparently changed hands in 2007 according to the Complainant's DomainTools Whois History tool. The evidence submitted as to that point is not very clear to the Panel. The assertion is however uncontested. For the purpose of the proceedings, we will therefore consider that the disputed domain name was registered by the Respondent in 2007. By that date, the GEOX trade marks had enjoyed extensive use and were well-known. While it may have been purchased as part of a portfolio, it now resolves to a footwear related parking page. That suggests some knowledge and an attempt to leverage the reputation of the mark.

The Complainant says that none of the grounds under paragraph 4 (c) of the Policy are prima facie applicable and so it has discharged its burden under paragraph 4(a) of the Policy. The evidential burden then shifts to the Respondent (see WIPO Case D2004-0110 re belupo.com). The Respondent has not come forward, either to explain its rights or interests in the name and mark and why it has selected the disputed domain name, or at all. That does not mean there is a default decision.

However, here on the very face of it, the disputed domain name may have been registered for a bona fide offering or for a legitimate use as the disputed domain name includes the word 'shop.' The use of the generic word 'shop' adds nothing for the similarity analysis but is relevant to the other limbs of the UDRP Policy. It arguably operates as a kind of disclaimer. It means retailer. Branded goods are sold by many retailers other than wholly owned or authorised ones and the Complainant accepts its goods are sold in multi-brand outlets. Therefore even if there was knowledge, in theory there could be a bona fide or fair and legitimate use if the purpose was lawful resales. These are permitted under the Policy provided the OKI Data criteria are met. However, it is difficult to see that fair or legitimate use is made when there is no use in fact. Here we have only an inactive registration or passive holding.

That alone is not determinative and all circumstances are relevant. The disputed domain name was immediately parked and offered for sale. The WIPO overview at 3.3 states: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details, and (iv) the implausibility of any good faith use to which the domain name may be put." See also Telstra WIPO Case D2000 -0003, Telstra.org.

Further, while an offer for sale is not necessarily, without more, bad faith; here we do have very clear evidence of an offer from the Respondent, to sell the disputed domain name to the world on sedo.com. The Sedo offer is unsolicited (see WIPO case No. D2005-1109, marthastewartfoundation.com; "The Respondent's unsolicited offer to sell these domains to the Complainant on the very day the Respondent registered the marks… is compelling evidence of ..bad faith."). This offer squarely satisfies the most straightforward ground of paragraph 4(b) of the Policy.

In light of all of the factors above, we find the Complainant has discharged its burden.

We therefore do not need to look at the alternative ground of a pattern of abusive or bad faith registrations.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GEOXSHOP.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2019-01-02

Publish the Decision