Decision for dispute CAC-UDRP-102368

Case number	CAC-UDRP-102368
Time of filing	2019-04-08 00:00:00
Domain names	hugobossorangeoutlet.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

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

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Andrew Taylor

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings, either pending or decided, relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The First Complainant, HUGO BOSS Trade Mark Management GmbH & Co, is the holder of trademark rights for the word mark HUGO BOSS, registered in numerous jurisdictions, including the European Union (e.g. EUIPO registration No. 000049254 since March 26, 2008, duly renewed, and covering products in classes 3, 9, 10, 12, 14, 16, 18, 20, 24, 25, 27, 28, 29, 30, 31, 32, 35 and 42) and the UK (UKIPO registration No. UK00001298756 since March 10, 1989, duly renewed, and covering products in classes 9, 14 and 18).

The First Complainant is also the holder of trademark rights for the word mark BOSS ORANGE, registered in numerous jurisdictions, including the European Union (e.g. EUIPO registration No. 003400306 since May 3, 2007, duly renewed, and covering products in classes 3, 18, 24, 25 and 28).

The Second Complainant is an operational entity that belongs to the same group of companies as the First Complainant and that is allowed to use the First Complainant's trademarks, identified above.

FACTUAL BACKGROUND

The Complainants, HUGO BOSS Trade Mark Management GmbH & Co (First Complainant) and HUGO BOSS AG (Second Complainant), are both subsidiaries of the Hugo Boss Group. The First Complainant is the holder and manager of the global trademark portfolio and the Second Complainant is the operational entity of the Hugo Boss Group (hereinafter collectively referred to as the Complainants). The Hugo Boss Group is an international fashion company manufacturing and selling luxury retail products, such as clothing, shoes, accessories, watches, sunglasses, perfume, etc. The Hugo Boss Group was founded in 1924 and employs almost 15,000 in over 1,100 retail stores worldwide.

The First Complainant is the holder of the registered word marks HUGO BOSS and BOSS ORANGE in several classes in numerous countries and regions all over the world, including the UK and the EU.

The disputed domain name <hugobossorangeoutlet.com> has been registered on February 5, 2018, by the Respondent. The disputed domain name resolves to a website offering for sale various heavily discounted products carrying the HUGO BOSS brand. The website prominently displays the HUGO BOSS trademarks and logos and displays the text “Hugo Boss Authorized Genuine Shop” in the upper right corner of the page.

The Complainants tried to contact the Respondent through a cease and desist notice using the online communication form on the website connected to the disputed domain name. The Complainants did not receive a response to this communication.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANTS:

The Complainants consider the disputed domain name to be confusingly similar to trademarks in which they have rights. The Complainants claim that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainants, the Respondent does not use the disputed domain name in connection with any legitimate use. Also, according to the Complainants, the Respondent has not been commonly known by the disputed domain name. Finally, the Complainants consider that the disputed domain name was registered and is being used in bad faith, as the website connected to the disputed domain name offers for sale alleged HUGO BOSS goods that are likely counterfeit products and it unduly depicts copyrighted pictures taken from the Complainants’ official website.

RESPONDENT:

The Respondent did not reply to the Complainants’ contentions.

RIGHTS

The Complainants have, 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 Complainants have 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 name (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 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

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainants to make out their case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainants must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus, for the Complainants to succeed, they must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name; and

3. The disputed domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Confusing similarity of the Domain Name with existing rights

The Complainants must first establish that there is a trademark or service mark in which it has rights. Since the First Complainant is the holder of the registered HUGO BOSS and BOSS ORANGE trademark, which are used in connection with the Complainants' retail business, it is established that there is a trademark in which the Complainants have rights.

The disputed domain name <hugobossorangeoutlet.com> reproduces Complainants' HUGO BOSS and BOSS ORANGE trademarks in its entirety, with the addition of the non-distinctive suffix "outlet". Merely adding the generic term "outlet" as a suffix does not avoid confusing similarity between the disputed domain name and the Complainants' trademarks ((see Karen Millen Fashions Limited v. Akili Heidi, WIPO Case No. D2012-1395; Belstaff S.R.L. v. Jason Lau, Sharing, WIPO Case No. D2012 0783; Lime Wire LLC v. David Da Silva / Contactprivacy.com, WIPO Case No. D2007 1168).

Additionally, it is well established that the generic top level suffix ".com" may be disregarded when considering whether the disputed domain name is confusingly similar to the trademarks in which the Complainants have rights.

Therefore, the Panel finds that the disputed domain name <hugobossorangeoutlet.com> is confusingly similar to the Complainants' HUGO BOSS and BOSS ORANGE trademarks.
Accordingly, the Complainants have made out the first of the three elements that it must establish.

2. No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainants have the burden of establishing that Respondent has no rights or legitimate interests in respect of the disputed domain name.
It is established case law that it is sufficient for the Complainants to make a prima facie showing that Respondent has no right or legitimate interest in the Domain Name in order to shift the burden of proof to the Respondent (See Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. The WhoIs information connected to the disputed domain name indicates the Respondent's name is "Andrew Taylor". The Respondent's use and registration of the disputed domain name was not authorized by the Complainants. There are no indications that a connection between the Complainants and the Respondent existed.

In addition, despite advertising on the website connected to the disputed domain name that it is a "Hugo Boss Authorized Genuine Shop", the Respondent does not show to be an authorized reseller of the Complainants. Nevertheless, the Respondent uses the disputed domain name to refer to a website offering for sale various kinds of clothing, accessories and fragrances displaying the Complainants' HUGO BOSS trademark. The Panel suspects that the Respondent is offering counterfeit goods on the website or that the offer on the website is not genuine.

The Respondent did not reply. Based on the available record, the Panel finds that the Complainants have established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the Complainants have satisfied the second requirement that the Respondent has no rights or legitimate interests in the disputed domain name, under paragraph 4(a)(ii) of the Policy.

3. Bad faith

The Complainants must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempted to attract, for commercial gain, Internet users to a web site or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the web site or location or of a product or service on the web site or location.

According to the Panel, the awareness of a respondent of the complainants and/or the complainants' trademark rights at the time of registration can evidence bad faith (See Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070). In the instant case, the Panel finds that Respondent must have had knowledge of the Complainants' rights in the HUGO BOSS and BOSS ORANGE trademarks at the moment it registered the disputed domain name, since the Complainants' trademarks are widely known and the Respondent specifically uses the Complainants' trademarks, pictures, logos and products on its website connected to the disputed domain name.
In the instant case, the Respondent is using the Complainants' trademarks and copyright protected images without the Complainants' authorization and without disclosing its relationship with Complainants. Even more, the Respondent falsely claims to be a "Hugo Boss Authorized Genuine Shop". Doing so, consumers are likely misled into believing that the Respondent's website is operated by the Complainants themselves or a company affiliated to the Complainants. The likelihood of confusion with the Complainants' trademarks is clearly with the intention of attracting Internet users for commercial gain, since the purpose of the website is to sell various kinds of clothing, shoes and fashion accessories carrying the Complainants' HUGO BOSS trademarks, which are likely counterfeit products. Finally, the Respondent did not formally take part in the administrative proceedings. According to the Panel, this serves as an additional indication of the Respondent's bad faith.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HUGOBOSSORANGEOUTLET.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2019-05-16

Publish the Decision