Decision for dispute CAC-UDRP-102644

Case number	CAC-UDRP-102644
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Domain names	diadorathailand.com

Case administrator

Name	Lenka Náhlovská (Case admin)

Complainant

Organization	Diadora Sport Srl

Complainant representative

Organization	Convey srl

Respondent

Organization	Ronny INTER-TRADING Co., Ltd

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 Complainant, Diadora Sport Srl, is an athletic footwear and apparel manufacturer, registered in Italy. The Complainant is the holder of the trademark DIADORA with several international and national trademark registrations worldwide, including the following:

• INT. TM n° 682095A of July 31, 1997, in classes 3, 9, 12, 14, 16, 18, 25, and 28;
• INT. TM n° 682095 of July 31, 1997, in classes 3, 9, 12, 14, 16, 18, 25, and 28;
• INT. TM n° 753911 of February 07, 2001 in classes 18, 22 and 25;
• European Union TM. n° 000339093 of January 07, 1999, in classes 18, 22 and 25;
• Italian TM n° 0001288679 of May 26, 2010 in class 12;
• U.S.A. TM n° 2282558 of October 5, 1999 in classes 18 and 25;
• Thai TM n° 0142798 of June 5, 1981 in class 25;
• Thai TM n° 0142836 of June 5, 1981 in class 25; and
• Thai TM n° 05207 of August 4, 1983 in class 25.

FACTUAL BACKGROUND

The Respondent registered the disputed domain name “diadorathailand.com” (hereinafter, the “Disputed Domain Name”) on June 16, 2016. The Disputed Domain Name refers to a parking page, sponsored by GoDaddy.

On February 20, 2016, the Respondent submitted orders to purchase items via the Complainant’s B2B sales platform. Article 16 of the Complainant’s General Conditions of sale provide that buyers undertake “not to register domains containing the [Complainant’s] trademarks and in case of default and / or in case of prior registration, […] to freely transfer to the Seller the ownership of the registered domain, within thirty (30) days from the Seller's request” .

On September 3, 2016, the Complainant’s Export Area Manager sent an e-mail to the Respondent notifying that the registration of the Disputed Domain Name was abusive and informing that the Complainant’s Legal and Corporate Affairs Department would contact him to transfer the Disputed Domain Name. The Respondent did not proceed to transfer the Disputed Domain Name, and on July 24, 2017 the Complainant’s General Counsel sent to the Respondent a demand letter requesting to pay the outstanding invoices within 10 days from the receipt of the letter and informing that, in light of those serious breaches, the Complaint was “not interested in continuing any business relationship” and intended to cease negotiations regarding a distribution agreement. The Respondent did not reply to the demand letter.

On July 11, 2019, the Complainant’s Export Area Manager reminded the Respondent of the Complainant’s request for a transfer of the Disputed Domain Name. The Respondent replied: “Make me an offer”.

The Complainant then instructed its legal representative to serve the Respondent with a cease and desist letter in order to formally notify him of the infringement of the Complainant’s trademark rights, requesting the immediate cease of any use, and the transfer of, the Domain Name to the Complainant. The cease and desist letter was sent on July 24, 2019. The Respondent did not reply.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT:

The Complainant considers the Disputed Domain Name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent does not use the Disputed Domain Name in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been commonly known by the Disputed Domain Name. Finally, the Complainant considers that the disputed domain name was registered and is being used in bad faith. The Complainant argues that the Respondent wanted to capitalize on the reputation of Complainant and registered the Domain Name in breach of the agreement signed on February 2016 following the purchase of the Complainant’s apparel on the Complainant’s B2B platform. For the Complainant, it is clear that the Respondent’s purpose is to exploit the situation to sell the Disputed Domain Name to the Complainant for valuable consideration in excess of documented out-of-pocket costs.

RESPONDENT:

The Respondent did not reply to the Complainants’ contentions

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and 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 the Disputed Domain Names. As the proceedings are administrative, 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:

i. the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and

ii. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and

iii. the Disputed Domain Names have been registered and are being used in bad faith.

To prove the first element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are trademarks in which it has rights. The Complainant's DIADORA trademarks have been registered and used in connection to its athletic footwear and apparel products.

The Disputed Domain Name incorporates the Complainant's DIADORA trademark in its entirety, merely adding the suffix "thailand". It is well established that the addition of generic words to a trademark in domain names is insufficient in itself to negate confusing similarity between a trademark and a domain name. The Panel therefore concludes that the Domain Name is confusingly similar to the registered trademarks in which the Complainant has rights.
With respect to the second element, the Complainant has the burden under paragraph 4(a)(ii) of the Policy of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. As established by previous UDRP panels, it is sufficient for the Complainant to make a prima facie showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the WIPO Overview 3.0).

The Panel notes that the Respondent has not apparently been commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trademark or service mark rights. According to the WhoIs records connected to the Disputed Domain Names, the Respondent is Ronny INTER-TRADING Co., Ltd. The Respondent's use and registration of the Disputed Domain Names was not authorized by the Complainants. The Respondent is not a licensee or authorized dealer of the Complainant nor has been authorized by the Complainant to use the trademark DIADORA in the Disputed Domain Name.

The record before this Panel does not reflect the Respondent's use or demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services.

According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential

Overview 3.0"), the Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark. In light of the fact that the Complainant expressly prohibits buyers of its B2B platform to register domain names containing the trademark DIADORA, the Oki Data test does not apply in this case.

The Respondent had the opportunity to assert and explain its purported rights or legitimate interests but did not do so.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

Finally, the Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered and used in bad faith (see, e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

The Panel observes that the Complainant has extensively used its registered trademark DIADORA since 1948 in several countries. The Disputed Domain Name was registered in January 2018, years after the Complainant obtained its trademark registrations, including in Thailand, where the Respondent is located. The Respondent registered the Disputed Domain Name after it had ordered products on the Complainant's B2B platform. It is therefore inconceivable that the Respondent was unaware of the Complainants and their trademark rights when it registered the Disputed Domain Name. The Panel therefore finds that the Respondent's awareness of the Complainants' trademark rights at the time of registration suggests 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; BellSouth Intellectual Property Corporation v. Serena, Axel, WIPO Case No. D2006 0007).

As to the use of the Disputed Domain Name in bad faith, the Panel considers that "the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users" (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition). The Panel observes that the Disputed Domain Name redirects to a parking page with various sponsored links connected to the shoes sector, where the Complainant is active.

In addition, the Respondent's request for an offer from the Complainant to purchase the Disputed Domain Name may serve as an indication that the Respondent intended to sell the Disputed Domain Name to the Complainant for valuable consideration in excess of the documented out-of-pocket costs.

The Panel also notes that Respondent did not respond to Complainant's cease-and-desist letter and did not participate in the present proceedings. Therefore, the Panel considers that the inference of bad faith is strengthened, in light of the cumulative circumstances indicating bad faith (See Telstra Corporation Limited v. Nuclear Marshmallows, supra).

Therefore, the Panel finds that, on the balance of probabilities, it is shown that the Disputed Domain Name was registered and used in bad faith. Considering the above, the Complainant also succeeds on the third and last element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DIADORATHAILAND.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2019-10-15