Decision for dispute CAC-UDRP-102624

Case number	CAC-UDRP-102624
Time of filing	2019-08-14 11:39:41
Domain names	todsayakkabi.com, todsau.com

Case administrator

Name	Lenka Náhlovská (Case admin)

Complainant

Organization	TOD'S S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Organization	PrivacyGuardian.org

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

• in EU:

- No. 010158889 – TOD'S in Classes 3, 9. 14. 18, 25 and 35 with the priority date from 28/07/2011
- No. 000407031 TOD'S in Class 9 with the priority date from 14/11/1996.

• International Trademarks:

- No. 1006548 – TOD'S (word and design) in Class 14, with the priority date from 04/05/2009
- No. 858452 – TOD'S in Classes 3, 9, 18, 25, 35 designating also Turkey with the priority date from 08/04/2005

• Australian Trademark No. 1498996 – TOD'S (word and design) in Classes 3, 9, 25, 35 with the priority date from 02/04/2012
• United States Trademark No. 1459226 – TOD'S (word and design) in Classes 18, 25 with the priority date from 29/05/1986.

FACTUAL BACKGROUND

FACTUAL BACKGROUND

Preliminary Procedural Issue: CONSOLIDATION OF MULTIPLE RESPONDENTS IN A SINGLE PROCEEDING

The Complainant relates to two Domain Names which he wishes to have dealt within a single administrative proceeding.

Paragraph 10(e) of the Rules states that a Panel decides a request by a party to consolidate multiple domain name disputes in accordance with the Policy and the Rules. Paragraph 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0") states that in the case of complaints brought against more than one respondent, consolidation may be allowed 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 Complainant explains that it is appropriate to consolidate the two Domain Names disputes as one common proceeding appears to be more efficient and equitable to all parties, providing that the two disputed Domain Names:

- result in websites with the same lay-out of the website corresponding to the Complainant's domain name;
- have the same extension ".com";
- have one Registrar, i.e. NameSilo LLC;
- have the same hosting provider, i.e. Inter Connects Inc.
- share the same IP address 5.157.60.210;
- were registered on June 2018; and
- have the same identity shield: PrivacyGuardian.org

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

The Complainant is an Italian producer of luxury shoes and other leather products. Its origins remotes to the early 20th century, when the company was founded as a small family business. Nowadays, the Complainant's products are present worldwide.

No information is known about the Respondents who registered the Disputed Domain Names under a privacy statement.

The disputed Domain Names <todsayakkabi.com> and <todsau.com> were registered on 8 June, 2018 and on 11 June, 2018 respectively. Both Domain Names currently result in webpages in which the goods identified by the trademark TOD's, are offered for sale.
The first domain name: <todsayakkabi.com> is addressed to Turkish market while the second domain name <todsau.com> is addressed to the Australian market. Both websites' graphical layouts are very similar to the layout of the original Complainant's webpage.

According to the Complainant, the goods offered for sale on the websites to which the disputed Domain Names result, are published, distributed and sold without the Complainant's consent and are not in anyway connected with the owner of the trademarks "TOD'S". Therefore, the Complainant is of the opinion, that such products are to be considered as counterfeit goods.

In view of the above-mentioned, on 24 July 2018, the Complainant sent a cease and desist letter to the e-mail address which was known to him at that time as the Respondents' e-mail address. The Complainant has never received any response to the cease and desist letter.

PARTIES CONTENTIONS

COMPLAINANT' CONTENTIONS:

Identical or confusingly similar

The Complainant argues that the Domain Names <todsayakkabi.com> and <todsau.com> and the Complainant's registered trademarks TOD'S are confusingly similar.

The Complainant argues that its trademarks are fully contained within the disputed Domain Names and points out that the elements in which the signs vary, are generics and thus do not alter the overall confusion between the signs.

No rights or legitimate interests

The Complainant argues that there is no evidence at all that the Respondents are commonly known by the Domain Names or a name corresponding to the Domain Names, nor that the Respondents are making a bona fide offering of goods or services. Moreover, the Complainant states that the Respondents have not been licensed or otherwise authorized to use any of the Complainant's trademarks nor to apply for or use any domain name incorporating such trade marks.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant states due to its worldwide presence and considering that the Complainant's trademarks are well known marks, the Respondents could not be unaware of the Complainant rights over the name TOD'S at the time of the disputed domain names registration.

Finally, the Complainant underlines that the goods offered on the Respondents' webpages are not original goods, as their price is substantially lower than the price of the original products.

RESPONDENT'S CONTENTIONS:

The Respondent did not respond 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

Paragraph 15 of the Rules states that the Panel shall decide a 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 deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the

contentions made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidences provided in support of them.

1. The first issue in this case is whether the complaint can be consolidated against two Respondents, as requested by the Complainant.

The Complainant argues that the complaint should be consolidated on the basis that the disputed Domain Names are under the control of a single individual or entity or, at least, are under the common management of a group of individuals acting in concert.

Moreover, according to the Complainant, the following elements cumulatively demonstrate, on balance, that consolidation of all the disputed Domain Names is possible:

- same identity shield: PrivacyGuardian.org;
- same lay-out of the websites corresponding to the domain names;
- same extension of the domain names;
- same registrar, i.e. NameSilo LLC;
- same hosting provider, i.e. Inter Connects Inc.
- same IP address 5.157.60.210;
- month and year of the registrations: June 2018;
- the Name Servers: NS1.DNSOWL.COM/NS2.DNSOWL.COM/NS3.DNSOWL.COM

Despite that the two disputed Domain Names were registered with the same registrar, NameSilo LLC, and use the same top level domain, ".com", the Panel considers that situation as such does not establish a common control between those two Domain Names.

However, the Panel accepts the Complainant's arguments and agrees that the similarities between the two websites in question and the fact that the disputed Domain Names have the same IP address and were registered on almost the same date, are sufficient enough to establish, on the balance of probabilities, that those Domain Names are under the common control.

Therefore, the Panel finds that all the above-mentioned factors in their conjunction are sufficient to establish a common control between the Domain Names and that the consolidation represents procedurally more efficient solution of this case for both parties.

Based on the above mentioned, the Panel determines that the dispute in respect of the Domain Names <todsayakkabi.com> and <todsau.com> can be consolidated within this proceeding.

2. The Complainant is owner of a considerable number of trademarks whose common distinctive element is a particle "TOD'S", which does not have any known meaning. Besides the EU protection, the trademarks "TOD'S" have been registered by the Complainant in various non-EU countries, including Turkey and Australia.

The first disputed Domain Name <todsayakkabi.com> comprises of the distinctive element "TOD'S" which is followed by a Turkish word "-"ayakkabi" and the Top-Level domain ".com".
The word "ayakkabi" means "shoes", therefore represents a non-distinctive element with regard to the goods that are offered for sale on the Domain Name's website <todsayakkabi.com>.

The second disputed domain name <todsau.com> comprises of the distinctive element "TOD'S" which is followed by the country indicative "AU", referring to Australia, and the Top-Level domain ".com".

Since the Complainant's trademark "TOD'S" is fully comprised within the disputed Domain Names that the additional elements have lower degree of distinctiveness, the Panel considers that the Domain Names are confusingly similar to Complainant's previously registered trademarks.

The Panel accordingly concludes that paragraph 4(a)(i) of the Policy is satisfied.

3. The Respondents are not in anyway related to the Complainant's business, and are not the agents of the Complainant. The Respondents are not currently known and have never been known as "TOD'S", or any combination of this trademark.

The websites the Domain Names are currently associated with promote and offer for sale exactly the same goods as the Complainant's goods. However, the Complainant has not granted any license or authorization to any of the Respondents to make any use, or apply for registration of the trademarks "TOD'S" or to distribute its products. Therefore, such active use of the name "TOD'S" in connection with the Complainant's goods does not constitute a legitimate interest in the disputed Domain Names.

Consequently, and in the absence of a Response, the Panelist finds that the Respondents have no rights or legitimate interests in the disputed domain names, so that the requirements of paragraph 4(a)(ii) of the Policy are met.

4. As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant's trademarks with which the disputed Domain Names are confusingly similar, and due to the worldwide presence of the Complainant's business known under the name "TOD'S", the Respondent were more likely to be aware of the Complainant's trademarks at the time of the registration of the disputed Domain Names.

Furthermore, the Complainant notes that the disputed Domain Names result in the webpages in which the counterfeit goods are sold. It is, however, well established that the Panelist does not evaluate the content of the webpages to which the disputed Domain Names are connected, but rather assess whether the registration and use of them comply with the Policy and the Rules.

Bearing in mind these circumstances, the Respondents can be deemed to have registered the Domain Names for obtaining commercial gain without a just cause and to the detriment of the Complainant's Intellectual Property Rights.

Under such circumstances, the Panel finds that the disputed Domain Name was registered in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied 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. **TODSAYAKKABI.COM**: Transferred
2. **TODSAU.COM**: Transferred

PANELLISTS

Name	**JUDr. Hana Císlerová, LL.M.**

DATE OF PANEL DECISION 2019-10-28

Publish the Decision