Decision for dispute CAC-UDRP-102714

Case number	CAC-UDRP-102714
Time of filing	2019-10-16 10:15:49
Domain names	danielwellingtonthailand.com , danielwellingtonth.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Daniel Wellington AB

Complainant representative

Organization	SILKA Law AB

Respondent

Name	Manu Grover

OTHER LEGAL PROCEEDINGS

The Panel is not aware of and other legal proceedings pending or decided which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant is the owner of the registered trademark DANIEL WELLINGTON as a word mark in numerous countries all over the world including in Thailand where the Respondent originates from including the Thai trademark with registration no. 171104041 registered on February 9, 2017, Thai trademark with registration no. 161101797 registered on August 19, 2016 and Thai trademark with registration no. ค403284 registered on November 11, 2015. Complainant also holds the international trademark registration with registration no. 1135742 registered on July 3, 2012.

Overview of relevant trademark registrations

Trademark Registration number Country Date of Registration
DANIEL WELLINGTON 1135742 International July 3, 2012;
DANIEL WELLINGTON 171104041 Thailand February 9, 2017;
DANIEL WELLINGTON 161101797 Thailand August 19, 2016;
DANIEL WELLINGTON 1135742 Thailand November 11, 2015.

FACTUAL BACKGROUND

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

Daniel Wellington was founded in 2011 by Filip Tysander. Since its inception, Daniel Wellington has established itself as one of the fastest growing and most beloved brands in the industry and is known for its sleek and minimalistic design. The preppy stylish watches have become a huge success and the marketing is not made through traditional marketing, but only through social media and its brand ambassadors. Today the brand Daniel Wellington has an astonishing +4,6 million followers on Instagram. In Thailand (where the Respondent resides) Complainant operates under its localized website www.danielwellington.co.th. Daniel Wellington has also been recognized and awarded by World Trademark Review for its work on enforcing and protecting its trademark rights and won the Europe, Middle East and Africa Team of the Year.

Complainant has also significant presence on various social media platforms, such as Facebook, Youtube, Instagram, Snapchat, Pinterest and Twitter.

Overview of Social Media Channels

1.5 M followers
www.facebook.com/danielwellingtonofficial

4.6 M followers
www.instagram.com/danielwellington

+ 8K subscribers
www.youtube.com/channel/UCY_BDqPMGJaBrxiiazZlEHg

36.3 K followers
twitter.com/itisDW

+20 K followers
www.pinterest.se/itisDW/

Complainant has also registered several domain names under Top-Level Domains containing the term “danielwellington” see for example, <danielwellington.com> (created on February 16, 2011) and <danielwellington.co.th> (created on October 5, 2018), <danielwellington.asia> (created May 30, 2013). Complainant is using the domain names to connect to a website through which it informs potential customers about its mark and its products.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant’s contentions can be summarised as follows:

Identical or confusingly similar

The disputed domain names incorporate Complainant's trademark DANIEL WELLINGTON® in its entirety. The addition of the geographic terms "thailand" and ""th" are not sufficient to avoid the finding that the disputed domain names are confusingly similar to the trademark. See for instance CAC Case No. 102179 where the Panel held that:

"Moreover, the Panel agrees with the view of other panels which considered that a geographical term, like the term "americas", added to a domain name is usually considered a factor that is likely to lead to web users' confusion (see, for example, CAC Case No. 102166)."

The addition of the generic Top-Level Domain (gtld) ".com" does not add any distinctiveness to the disputed domain names. Based on the foregoing Complainant has demonstrated that the disputed domain names are confusingly similar to its trademark. This is sufficient for a finding of confusing similarity for the purposes of the Policy; see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "WIPO Overview 3.0") as well as CAC Case No. 102348 where this was reinforced.

Respondent has no rights or legitimate interests in respect of the disputed domain names;

First of all, there is no bona fide offering of goods or services when the domain names incorporate a trademark which is not owned by Respondent, nor is the Respondent known by the name "Daniel Wellington". The Respondent signed its termination notice of the distributor agreement on June 10, 2019. The distribution agreement between the Complainant and the Respondent included a clause limiting the right of the Respondent to use the name Daniel Wellington. The distribution agreement was entered into on March 1, 2014, a year before the disputed domain names were registered. Complainant has previously authorized Respondent to sell products bearing the trademark in the past by virtue of the distribution agreement but explicitly prohibited the use of the trademark in domain names. Compare with FORUM Claim Number: FA1903001834528 with similar circumstances where the Panel held that:

"The Panel agrees and notes that even an authorized distributor cannot use a mark in a domain name to make a bona fide offering of goods or services, or a legitimate noncommercial or fair use, if not authorized to do so. See Associated Materials, Inc. v. Perma Well, Inc., FA 154121 (Forum May 23, 2003) (finding that, although the respondent was a distributor of the complainant's product, the respondent did not have permission to use the complainant's mark in its registered domain name and, therefore, was not using the domain name as a bona fide offering of goods or services or a legitimate noncommercial or fair use)."

Therefore, the Respondent is neither entitled anymore to present the Complainant's products nor to represent the Complainant in any way (with the Domain Name and/or the Trademark) since he is no longer a distributor of the Complainant.

The disputed domain names induce consumers into visiting the related websites which redirects to <groovegroovy.com> a site operated by the Respondent. The Respondent offers accessories from various brands in competition with the Complainant. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

"… Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

(i) the respondent must actually be offering the goods or services at issue;

(ii) the respondent must use the site to sell only the trademarked goods or services;

(iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and

(iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

"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."

The Respondent is not commonly known by the disputed domain names or any similar name. While the registration details refer to the registrant as being "Manu Grover" the Respondent is doing business as Ronny-Inter Trading Co. Ltd. The Respondent's conduct in registering the disputed domain names when he was aware of the Complainant's rights and lacked rights or legitimate interests of its own amounts to registrations in bad faith. The terms of the distribution agreement clearly indicate that the registration of the disputed domain names to have been undertaken in bad faith.

The Respondent has continued to use the disputed domain names without the permission of Complainant. Given that the disputed domain names solely exists of the trademark and a country name, internet users are likely to believe that it is Complainant's official Thai website or that Respondent is still affiliated with Complainant. Furthermore, the evidence in the case demonstrates that the Respondent is not promoting Complainant's products, but merely promoting competitors' brands such CALVIN KLEIN, PAUL HEWITT, ZINVO etc. Despite receiving notice of the Complainant's rights on numerous of occasions the Respondent has continued to breach its obligations under the distribution agreement following its termination, and to flagrantly infringe the Complainant's intellectual property. The Complainant has contacted the Respondent since October 2018 to transfer ownership of both disputed domain names. The Respondent has not responded to phone calls, emails or SMS and hasn't even bothered to comment on the letters.

The websites to which the disputed domain names resolve following notice termination of the distribution agreement do not disclose the true relationship between the Respondent and the Complainant – namely, that the Respondent is not (any longer) an authorized distributor of the Complainant's products. The use of the disputed domain names following termination of the agreement is an attempt to attract, for commercial gain, internet users to its website by creating confusion in the minds of the public as to an association between the Respondent's website and the Complainant. The Respondent registered the disputed domain names with full knowledge of the Complainant's registered trademark rights in DANIEL WELLINGTON. The existence and subsequent termination of the agreement between the Parties, followed by the refusal to transfer the domain names is sufficient to establish bad faith. This was established in for instance Village Candle, Inc. v. Paul Dupre, Dupre Inc. WIPO Case No. D2018-0834.

To summarize, DANIEL WELLINGTON is a well-known trademark in the fashion industry including in Thailand. The Respondent bears no relationship to the trademark and the disputed domain names coupled with its content has no other meaning except for referring to Complainant's name and trademark and there is no way in which the disputed domain names could be used legitimately under the current circumstances. Consequently, Respondent should be considered to have registered and to be using the disputed domain names in bad faith.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have 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

The disputed domain names registered in 2015 are confusingly similar to the Complainant's DANIEL WELLINGTON trade mark first registered in 2012, adding only the geographical designations 'Thailand' or 'th' and the gTLD .com which do not prevent such confusing similarity.

The Respondent does not have any rights or legitimate interests in the disputed domain names having registered them in breach of its distributorship agreement with the Complainant which has in any event now expired and so the Respondent had no authorisation to register the disputed domain names even at the time of registration. Since the domain names are being used to redirect to a site selling competing watches the use is not a bona fide offering of goods or services or a legitimate noncommercial or fair use. It is registration and use in bad faith misleading and diverting Internet users for commercial gain and disrupting the business of a competitor.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DANIELWELLINGTONTHAILAND.COM** : Transferred
2. **DANIELWELLINGTONTH.COM**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2019-11-18

Publish the Decision