Decision for dispute CAC-UDRP-102784

Case number	CAC-UDRP-102784
Time of filing	2019-11-26 12:06:59
Domain names	bossclearanfactory.com, bossoutletusa.com, hugobossclearancesusa.com, hugobossfroutlet.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

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

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Gueijuan Xu

OTHER LEGAL PROCEEDINGS

The panel is not aware about any other pending or decided legal proceedings concerning the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns numerous trademark registrations for HUGO BOSS and BOSS (thereafter the “Complainant’s trademark”), such as but not limited to:

- Germany trademark HUGO BOSS No. 1056562, registered on August 3, 1983;
- International trademark BOSS No. 456092, registered on October 9, 1980;
- International trademark HUGO BOSS No. 482758 No. 348017, registered on February 2, 1984;
- International trademark BOSS HUGO BOSS No. 606620, registered in July 20, 1993, designating China;3
- China trademark HUGO BOSS No. 9277541, registered in April 28, 2012.

FACTUAL BACKGROUND

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

According to GoDaddy.com, LLC’s (the “Registrar”) WhoIs database, “Gueijuan Xu” (thereafter “the Respondent”) is the registrant of the domain names <bossclearanfactory.com>, <hugobossfroutlet.com>, <hugobossclearancesusa.com> and

<bossoutletusa.com>.

These websites have shared black, grey and white dominant color tones. They display products (clothing and fashion accessories) in a very similar way – in boxes surrounded by a grey border, including the title of the product with the corresponding price and the mention “add to cart”. The same websites have provided information in a similar way. They have had a contact form and a similar dark grey banner at the bottom of the website pages. In this banner, an address only mentioning “Hugo boss outlet” and an email address have been provided as contact information regarding the websites corresponding to the domain names <bossclearanfactory.com>, <hugobossfroutlet.com>, <bossoutletusa.com>. The email address displayed in the aforesaid banner is the same on the websites associated <bossoutletusa.com> and <hugobossfroutlet.com> (“service1@vinayotap.com”). Furthermore, all the websites associated with the Disputed Domain Names have feature an “Affiliate”. This link resolves to a page (except for <bossoutletusa.com>) with identical text regarding an affiliate program. In this text, only varies the name of the Affiliate program which corresponds to the Disputed Domain Name, such as the “Hugo boss clearance usa affiliate program” on the website associated with the domain name <hugobossclearancesusa.com>.
Furthermore, the domain names <bossclearanfactory.com>, <bossoutletusa.com>, <hugobossfroutlet.com> and <hugobossclearancesusa.com> have resolved to websites reproducing the Complainant’s HUGO BOSS trademark with highly similar content. The domain names <bossclearanfactory.com> and <hugobossfroutlet.com> still resolve to such websites. The domain names <hugobossfroutlet.com> and <hugobossclearancesusa.com> have stopped resolving to this type of similar websites from different dates: around the months of January 2019 regarding <hugobossclearancesusa.com> and August 2019 regarding <bossoutletusa.com>. The Complainant’s trademark has been reproduced on these highly similar websites associated with the Disputed Domain Names. Some of the Complainant’s figurative trademark have especially been reproduced in a similar manner, at the top left-hand side of these websites: the HUGO BOSS trademark on the website associated to <bossoutletusa.com> and the BOSS HUGO BOSS trademark on the website associated to <hugobossclearancesusa.com>, <bossclearanfactory.com> and <hugobossfroutlet.com>. Moreover, similar products have been offered for sale under the Complainant’s trademark with identical products description. For example, the dress “Wide-neck dress in colorful geometric pattern 50390314 Patterned” or the trench “Trench coat in stretch cotton with hardware details 50390293 Beige” are present on the website associated with the domain names <bossclearanfactory.com>, <hugobossclearancesusa.com> and <bossoutletusa.com> .

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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). The Complainant owns numerous trademarks regarding HUGO BOSS and BOSS registered long before the Disputed Domain Names.

The Disputed Domain Names <bossclearanfactory.com> and <bossoutletusa.com>, in its second-level portion, incorporates the Complainant’s trademark BOSS in its entirety with the addition of the English terms “clear” and “factory” or “outlet” and the country abbreviation “usa”.

The Disputed Domain Names, <hugobossfroutlet.com> and <hugobossclearancesusa.com>, in their second-level portion, incorporate the Complainant’s trademark HUGO BOSS in its entirety with the addition of the English terms “clearance”, “outlet” and country abbreviations “fr” and “usa”.

Previous UDRP Panels have constantly held that, in the disputed domain names comprising the Complainant’s trademark, the mere addition of other terms (such as descriptive or geographical terms) would not prevent a finding of confusing similarity to a trademark (see Intesa Sanpaolo S.p.A. v. Abayomi Ajileye, CAC Case No. 102396; Arcelormittal S.A v. James, CAC No. 102161; RWE Aktiengesellschaft v. RWE (UK) Heat Energy Technology Co. Ltd., CAC Case No. 102050).

Moreover, each of the Disputed Domain Names comprise, in its first-level portion, the generic Top-Level Domain ".com" which is a standard registration requirement and should be disregarded when assessing whether a domain name is confusingly similar to the trademark in which the Complainant has rights (see, Arcelormittal S.A v. James, supra and Credit Mutuel Arkea v. Domain Administration, CAC Case No. 102345).

The Disputed Domain Names are therefore confusingly similar to the Complainant's trademarks HUGO BOSS and BOSS.

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).
The Disputed Domain Names were registered between December 18, 2017 and May 31, 2019, many years after the registrations of the Complainant's HUGO BOSS and BOSS well-known trademarks.

The Complainant has not licensed or authorized the Respondent to register or use the Disputed Domain Names.

There is no evidence that the Respondent is known by the Disputed Domain Names or owns any corresponding registered trademark including the terms "bossclearanfactory.com", "bossclearanfactory", "bossoutletusa.com", "bossoutletusa", "hugobossfroutlet.com", "hugobossfroutlet", "hugobossclearancesusa.com" and "hugobossclearancesusa".

When searching for those terms in popular Internet search engines, the Disputed Domain Names and their corresponding websites but also the Complainant's official websites may appear as first hits. Moreover, some third-party websites reporting possible fraudulent activities appear among the first hits when looking for the terms "bossclearanfactory.com", "bossclearanfactory", "bossoutletusa.com", "bossoutletusa", "hugobossfroutlet.com", "hugobossfroutlet", "hugobossclearancesusa.com" and "hugobossclearancesusa". Furthermore, when conducting the aforesaid search in popular search engines, no relevant results appear regarding any brand or legitimate business run by the alleged Respondent "Gueijuan Xu". Moreover, none of the Disputed Domain Names match the alleged Respondent's name.

When conducting searches on online trademark databases, no information is found in relation with trademarks corresponding to "bossclearanfactory.com", "bossclearanfactory", "bossoutletusa.com", "bossoutletusa", "hugobossfroutlet.com", "hugobossfroutlet", "hugobossclearancesusa.com and "hugobossclearancesusa".

The Disputed Domain Names resolve (for <bossclearanfactory.com> and <hugobossfroutlet.com>) or have resolved (for <hugobossclearancesusa.com> and <bossoutletusa.com>) to websites reproducing the Complainant's trademark and mimicking the look and feel of the Complainant's website by using similar colors tones, displaying products sometimes bearing the Complainant's trademark in a similar way . These websites clearly refer or have referred to the Complainant, its trademarks and products. Moreover, the aforementioned websites offered clothing and fashion accessories for sale at an important discounted price and they all provide the option to buy those items by adding them to cart The Complainant did not authorize the creation of such websites. The inclusion of the Complainant's trademark with the descriptive terms related to clothing and shopping such as "factory", "outlet" or "cheap" in the second level portion of the Disputed Domain Names reflects the Respondent's intention to create an association, and a subsequent likelihood of confusion, with the Complainant and its trademark in Internet users' mind. In similar circumstances, previous UDRP Panels have held that "the adoption by the Respondent of domain names confusingly similar to the Complainant's well-known registered trademark EASTPAK, which the Panel considers, as asserted above by the Complainant, was not by mere chance but by design, inevitably leads to confusion on the part of Internet users and consumers seeking information about the Complainant and its products. Further, the Panel finds that the Respondent is consequentially trading unfairly on the Complainant's well-known registered trademark EASTPAK and also the valuable goodwill that the Complainant has established in this trademark through prior and lengthy commercial use, as evidenced above, without any right or legal justification for doing so" (see JanSport Apparel Corp v. Feng Qi, WIPO Case No. D2017-1486).

Moreover, the spelling of the Disputed Domain Names <bossclearanfactory.com>, <hugobossfroutlet.com>, <hugobossclearancesusa.com> and <bossoutletusa.com> combined with the content of the websites to which they resolve

or have resolved also aims at creating a likelihood of confusion on Internet users' mind as to the source of the Respondent's website or the products on the same. Such behavior cannot be considered as bona fide offering of goods and services nor constitute a noncommercial or fair use of the disputed domain names. In similar situation, previous UDRP Panel held that "it is reasonable to conclude that the Respondents deliberately chose to include the Complainant's […] trademark in the Disputed Domain Names for the purpose of achieving commercial advantage by misleadingly diverting consumers to the websites at the Disputed Domain Names […] and such use cannot be considered a legitimate noncommercial or fair use" (see Bottega Veneta SA v. Chen Kai a.k.a. Kai Chen/ WhoIs Agent, Domain WhoIs Protection Service, WIPO Case No. D2013-0436).

Moreover, the Disputed Domain Names <hugobossclearancesusa.com> and <bossoutletusa.com> are now inactive. The fact that the Disputed Domain Dames <hugobossclearancesusa.com> and <bossoutletusa.com> does not now resolve an active website, further shows that the Respondent has not been using the Disputed Domain Names in connection with bona fide offering of goods or services.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).
The Respondent registered the Disputed Domain Names many years after the registrations of the Complainant's trademarks. The HUGO BOSS and BOSS trademarks are a well-known trademarks, as previously held by UDRP Panels (see Hugo Boss Trade Mark Management GmbH & Co. KG, Hugo Boss AG v. cheng yong, WIPO Case No. D2015-1688; HUGO BOSS Trade Mark Management GmbH & Co. KG and HUGO BOSS AG v. Terry Dong, WIPO Case No. DCO2017-0033; HUGO BOSS Trade Mark Management GmbH & Co and HUGO BOSS AG v. Charles Carranza and William Tillery, CAC Case No. 101901; HUGO BOSS Trade Mark Management GmbH & Co. KG and HUGO BOSS AG v. zeng aiqin, WIPO Case No. D2016-2296), registered in many countries and the Complainant enjoys a strong online presence. The Complainant is also very active on social media (Twitter, Facebook, Instagram) to promote its mark, products and services. The Complainant is followed by 1.7 million on Instagram, 8,247,313 on Facebook, and 701,000 people on Twitter (Annex 8) (see, Laboratoires M&L v. Zhaoxingming, CAC Case No. 102277). By conducting a simple online search regarding the term "Hugo Boss" or "Boss", the Respondent would have inevitably learnt about the Complainant, its trademark and business (see Intesa Sanpaolo S.p.A. v. Abayomi Ajileye, CAC Case No. 102396). It therefore inconceivable that the Respondent was unaware of the existence of the Complainant when he registered the Disputed Domain Names.

Furthermore, the Disputed Domain Names alongside the Complainant's trademark include the English terms "factory", "outlet" or "cheap" which are a direct reference to the Complainant's field of activity in designing, manufacturing and selling fashion apparel. Moreover, the Disputed Domain Names <hugobossfroutlet.com>, <hugobossclearancesusa.com>, and <bossoutletusa.com> comprise the abbreviations "fr" and "usa". In light of the fact that the Complainant has a long and very strong commercial presence in France and the United States of America, two countries which are part of the Complainant's six core markets it is very likely that the Respondent registered the Disputed Domain Names having the Complainant in mind. The inclusion of the Complainant's trademark with the aforementioned descriptive or geographical terms in the second level portion of the Disputed Domain Names reflects the Respondent's clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users' mind.

The Disputed Domain Names <bossclearanfactory.com> and <hugobossfroutlet.com> resolve to a website reproducing the Complainant's trademark, mimicking the look and feel of the Complainant's website and offering clothing products. The Disputed Domain Names <hugobossclearancesusa.com> and <bossoutletusa.com> have also resolved to highly similar websites.
These references to the Complainant's trademark – in the Disputed Domain Names and in the associated websites – catch the Internet users' attention and infer that the website associated with the Disputed Domain Names are or were connected to, or managed, or authorized or sponsored by the Complainant. Such use of the Disputed Domain Names creates a likelihood of confusion in Internet users' mind and may lead them to buy products displayed on the websites currently associated with <bossclearanfactory.com> and <hugobossfroutlet.com>.

It is very likely that the Disputed Domain Names are owned by the same individual or organization "Gueijuan Xu". Moreover,

the Respondent is familiar of such conduct. In a similar case, UDRP Panels have held that the Respondent's conduct of using domain names to resolve to websites purporting to sell products under the complainant's trademark at substantial discounts, claiming to be an official online store amounts to bad faith registration and use (see for instance, Philipp Plein v. Gueijuan Xu, WIPO Case No. D2017-2535; Salvatore Ferragamo S.p.A. v. Gueijuan Xu, WIPO Case No. D2018-0572; Fendi S.r.l. v. Gueijuan Xu, WIPO Case No. D2018-0749; Philipp Plein v. Gueijuan xu, CAC Case No. 101584). The Respondent therefore appears to be engaged in a pattern of conduct, as on separate occasions it has registered trademark-abusive domain names (see WIPO Overview 3.0, section 3.1.2).

The disputed domain names <hugobossclearancesusa.com> and <bossoutletusa.com> resolved to the reproducing the Complainant's trademark, mimicking the look and feel of the Complainant's website and offering clothing products. They are now inactive. According to the screen captures saved by the search marchine Wayback Marchine, the Disputed Domain Name <hugobossclearancesusa.com> resolved to an active website until January 2019. Since proximately March 2019, it resolved to a page displaying the following message "Error. Page cannot be displayed. Please contact your service provider for more details. (31)". The Disputed Domain Name <bossoutletusa.com> resolved to an active website until the end of August 2019.

Previous UDRP Panels have held, under the doctrine of passive holding, that "the non-use of a domain would not prevent a finding of bad faith" (see "WIPO UDRP Questions, Third Edition", section 3.3). More precisely, "it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith." (see Telstra Corporation Limited v. Nuclear Marshmallows). The circumstances of the case may indeed be such that "it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law" (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

In the present case, several factual considerations are clear indicators of bad faith use under the passive holding doctrine.

- The disputed domain names <bossoutletusa.com> and <hugobossclearancesusa.com> are confusingly similar to the Complaint's well-known HUGO BOSS and BOSS trademarks. The Complainant's trademarks were registered and used for many years before the registration of the Disputed Domain Names (See Advance Magazine Publishers Inc. and Les Publications Condé Nast S.A. v. ChinaVogue.com, WIPO Case No. D2005-0615; Volkswagen AG v. Guy Buchet, WIPO Case No. D2016-0959).

- Moreover, the Respondent could not ignore the Complainant and its trademark when it registered the disputed domain names <bossoutletusa.com> and <hugobossclearancesusa.com>. The Complainant has an established commercial presence in China where it has offices and a strong online presence. The disputed domain names also incorporate the Complainant's trademark with the addition of terms "USA" – country where the Complainant has subsidiaries and has a strong commercial presence –, "outlet" and "clearance" – words that may refer to the fashion sales.

- Furthermore, the Disputed Domain Names <bossoutletusa.com> and <hugobossclearancesusa.com> do not currently resolve to any active website or online location that would testify of a legitimate or good faith use of the disputed domain names. This statement is reinforced by the fact that the Disputed Domain Names previously resolved to active websites whom the use was not legitimate nor in good faith. There is therefore no evidence of any actual or contemplated good-faith use of the Disputed Domain Names.

- The Respondent also chose not to reply to the cease and desist letter sent by the Complainant which infers bad faith (see Arla Foods Amba v. Mlanie Guerin, CAC case No. 101640; Medela AG v. Donna Lucius, CAC case No. 101808).

The overall described circumstances are clear demonstration of the implausibility of any good faith use of the Disputed Domain Names (see Alstom v. Itete Peru S.A., WIPO Case No. D2009-0877).

In view of the above, the Respondent's conduct falls 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 Respondent has no relationship whatsoever with the Complainant or its trademarks and is not commonly known by the Disputed Domain Names. The fact that the Respondent has been using or has used the Disputed Domain Names to resolve to a “look and feel” website, which most likely generate revenue, by capitalizing on the reputation of the Complainant’s trademark, does not constitute a legitimate noncommercial or fair use of the Disputed Domain Names. Hence, the Respondent has no rights or legitimate interest in respect of the Disputed Domain Names. The fact that the Disputed Domain Names <hugobossclearancesusa.com> and <bossoutletusa.com> do currently resolve to an active website, further shows that the Respondent has not been using the Disputed Domain Names in connection with bona fide offering of goods or services. (iii) The Respondent knew the Complainant’s well-known trademark when it registered the Disputed Domain Names. By using the Disputed Domain Names in order to resolve to “look and feel” websites, the Respondent also intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s trademark. The Respondent seems to be familiar of such conduct. Finally, the Disputed Domain Names <hugobossclearancesusa.com> and <bossoutletusa.com> are now passively held and, in light of the circumstances of the case, it is implausible that they could have been used in good faith. Consequently, the Respondent has registered and has been using the Disputed Domain Names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOSSCLEARANFACTORY.COM**: Transferred
2. **BOSSOUTLETUSA.COM**: Transferred
3. **HUGOBOSSCLEARANCESUSA.COM**: Transferred
4. **HUGOBOSSFROUTLET.COM**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2020-01-09

Publish the Decision