Decision for dispute CAC-UDRP-102831

Case number	**CAC-UDRP-102831**
Time of filing	**2020-01-03 15:41:45**
Domain names	**todsdanmark.com, todsshoesgreece.com, todsstorejapan.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**TOD'S S.p.A.**

Complainant representative

Organization	**Convey srl**

Respondent

Name	**Justin Youngblood**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademark registrations across various jurisdictions, inter alia European trademark registration no. 010158889 TOD'S, registered on December 29, 2011, for goods and services in classes 3, 9, 14, 18, 25, and 35, and US trademark registration no. 1459226 TOD'S & design, registered on September 29, 1987, for goods in classes 18 and 25 (hereinafter referred to as the "Trademarks").

FACTUAL BACKGROUND

The Complainant is the operating holding of a Group, which is, according to the Complainant's assertions, amongst the leading players in the world of luxury goods with the trademarks Tod's, Hogan, Fay, and Roger Vivier and with about 4.600 employees worldwide. The Complainant has numerous stores around the world, including showrooms and large flagship stores in Europe, the U.S., China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey, and Australia. 2018 Annual revenues of Tod’s Group were almost 950 million Euros of which 53% came from the trademark TOD’S.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to the Trademarks as they fully contain the trademarks and additional generic elements.

Furthermore, the Complainant contends that the Respondents have no rights or legitimate interests in the disputed domain names. In this regard, the Complainant states that the Respondents are not licensees or authorized agents of the Complainant or in any other way authorized to use Complainant's trademarks. The Complainant further states that the Respondents are not authorized resellers of the Complainant and have not been authorized to register and use the disputed domain names, that the Respondents are not commonly known by the disputed domain names and that the Respondents do not use the disputed domain names in connection with a bona fide offering of goods or services but to offer counterfeit goods.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. In this regard, the Complainant contends that the Trademarks enjoy worldwide reputation and that the Respondent is using the disputed domain names to offer counterfeit goods. The Complaint argues that the Respondents were fully aware of the Trademarks at the time of the registration of the disputed domain names and are using the disputed domain names in bad faith under paragraph 4(b)(iv) of the Policy.

RESPONDENT:

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).

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 are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The first issue to be dealt with is the fact, that the disputed domain names are registered in the name of different domain owners.

The Complainant, however, argues that the disputed domain names are under common control and requests that the disputed domain names and the named Respondents be consolidated in a single UDRP proceeding.

In this regard, the Complainant states that there are numerous similarities in relation to the domain names at issue, namely:

- same country of the registrants, i.e. U.S.A.;
- same extension of the domain names;
- same registrar, i.e. NameSilo LLC;
- same hosting provider, i.e. FIBERGRID;
- same year of the registrations: 2019;
- same name servers: NS1.DNSOWL.COM/NS2.DNSOWL.COM/NS3.DNSOWL.COM;

- same products offered for sale in the websites corresponding to the domain names;
- similar layout of the websites corresponding to the domain names; and
- identical favicons used at the websites available at the domain names <todsdanmark.com> and <todsstorejapan.com>.

In order to file a single complaint against multiple respondents, the complaint must meet the following criteria:

(i) the domain names or corresponding websites are subject to common control, and
(ii) the consolidation would be fair and equitable to all parties.

The Panel finds that the Complainant has not furnished any concrete evidence to establish that the disputed domain names are indeed subject to common control. Identity or near identity of websites does not, without more, prove that the websites belong to or are controlled by the same entity. Given the proliferation of clone sites and the ease of copying website contents, the Panel would be slow to draw such a conclusion without supporting evidence. In this regard, the Panel also noted that the websites, in fact, have different layout and content. First, the website all have different languages (following the geographical identifier in the respective domain name). Even if such difference might be part of a scheme, the websites have different graphic elements (frames, font size, placement of images, the content of headers and footers), which militate against the fact that the same person has created several websites for different markets in the same way. The fact, that all of the websites feature the same products and the Complainant's Trademarks is per se not sufficient to consolidate the proceedings as this only shows that the websites all target the Complainant in the same (and nowadays very common) way. On the contrary, un-rebutted surface evidence suggests that there are three separate registrants with different registrant information and contact details. On balance, the Complaint has failed to meet the first criteria.

Given the above reasons, the Panel rejects the Complainant's request to have the Complaint filed against multiple respondents. In the circumstances, with a view to expediting the administrative proceeding, the remainder of this decision shall, in the Panel's sole discretion, deal only with the disputed domain name <todsdanmark.com>. It is, of course, open to the Complainant to bring separate Complaints in respect of the domain names <todsshoesgreece.com> and <todsstorejapan.com> if it so desires.

Otherwise, 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

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

(i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1. The Panel accepts that the disputed domain name <todsdanmark.com> is confusingly similar to the Trademarks as it fully incorporates the Trademarks. It is a well-established principle is that the confusing similarity is given where a trademark is recognizable as such within the domain name. In the present case, the Internet user will clearly recognize the Trademarks. The additional word “Danmark” is merely descriptive as it is a geographical term and does not eliminate the similarity between the Complainant’s trademark and the disputed domain name.

2. The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent did not deny these assertions in any way and therefore failed to prove any rights or legitimate interests in the disputed domain name.

Based on the evidence before the Panel, the Panel cannot find any rights or legitimate interests of the Respondent either.

The Respondent is using the disputed domain name for a website offering products similar to the Complainant's products and using the Complainant's branding. There is no persuasive evidence on the record supporting that the goods offered at the disputed domain name are counterfeit as repeatedly stated by the Complainant (even if the prices of the products on the Respondent's website suggest such a conclusion). But even if such goods were genuine, the use of the disputed domain name would not be bona fide under the Policy. The Panel acknowledges that a reseller can make a bona fide offering of goods and services and thus have rights or legitimate interests in a domain name if the use fits certain requirements, with regard to the actual offering of goods, the use of the site to sell only the trademarked goods, and the site is accurately and prominently disclosing the registrant's relationship with the trademark holder (see Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903; section 2.8.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0")). According to the evidence on the record, however, the website at the disputed domain name does not visibly disclose the registrant's relationship with the trademark holder, therefore does not meet the Oki Data criteria, and cannot convey any rights or legitimate interests on the Respondent's use of the disputed domain name.

Accordingly, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

3.1 The Panel is also satisfied that the Respondent registered the disputed domain name with full knowledge of the Complainant and its rights in the Trademarks as the Respondent's website prominently features the Complainant's logo.

3.2 As to bad faith use, by fully incorporating the Trademarks into the disputed domain name and by using such domain name for a website advertising the Complainant's brand, the Respondent was, in all likelihood, trying to divert traffic intended for the Complainant's website to its own for commercial gain as set out under paragraph 4(b)(iv) of the Policy. The Panel is therefore satisfied that the Respondent also used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **TODSDANMARK.COM**: Transferred
2. **TODSSHOESGREECE.COM**: Remaining with the Respondent
3. **TODSSTOREJAPAN.COM**: Remaining with the Respondent

PANELLISTS

Name	**Peter Müller**

DATE OF PANEL DECISION 2020-02-21

Publish the Decision