Decision for dispute CAC-UDRP-102892

Case number	CAC-UDRP-102892
Time of filing	2020-02-05 09:54:29
Domain names	hogansito-ufficialeonline.com, hogansitoufficialeoutletonline.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	TOD'S S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Name	Athena Reynolds

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 the following trademark registrations for the sign HOGAN (the “HOGAN trademark”):

- the International trademark HOGAN with registration No. 1129649, registered on 23 March 2012 for goods in International Classes 3, 9, 18 and 25; and

- the European Union trademark HOGAN with registration No.005184536, registered on 20 January 2010 for goods and services in International Classes 3, 9, 18, 25 and 35.

FACTUAL BACKGROUND

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

The Complainant is an Italian producer of luxury goods under the trademarks Tod's, Hogan, Fay and Roger Vivier. It has

about 4,600 employees worldwide and operates stores in Europe, the United States, China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia. The annual revenues of the Complainant for 2018 amounted to EUR 950 million, of which 22% came from the sales of products under the HOGAN trademark.

The Complainant maintains official websites at the domain names <hogan.com>, <hogan.it>, <hogan.fr>, <hogan.eu> and <hogan.cn>.

The Respondents registered the disputed domain names on 26 January 2019. They resolve to similar websites where counterfeit products bearing the HOGAN trademark are offered for sale.

The Complainant sent a cease and desist letter to the Respondents on 17 December 2019. The Respondents did not respond, but the disputed domain names were redirected to parking webpages displaying various sponsored links.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain names are confusingly similar to the HOGAN trademark in which the Complainant has rights, because they incorporate the HOGAN trademark. The inclusion of the non-distinctive elements “sito” (Italian for “site”), “ufficiale” (Italian for “official”), “online” and “outlet” does not affect the confusing similarity. Rather, the combination of the HOGAN trademark with these terms suggests to consumers that the disputed domain names and the corresponding websites have been authorized by the Complainant.

According to the Complainant, the Respondents have no rights or legitimate interests in respect of the disputed domain names, because they are not authorized resellers of the Complainant and have not been authorized by the Complainant to use the HOGAN trademark, they are not related to the Complainant and the disputed domain names do not correspond to their names. The Complainant adds that the Respondents have not used the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute. Rather, the disputed domain names resolved to websites featuring the Complainant’s HOGAN trademark and offering counterfeit low-priced HOGAN branded products for sale without any disclaimer as to the Respondents’ lack of relationship with the Complainant.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. According to the Complainant, the HOGAN trademark is widely known around the world in connection with shoes and leather goods items, and the Respondents chose and registered the disputed domain names with knowledge of this trademark and in order to capitalize on its reputation by diverting Internet users seeking original products under the HOGAN trademark to their commercial websites. Before receiving the cease and desist letter, the Respondents offered for sale discounted price counterfeit replicas of the Complainant’s shoes and reproduced the HOGAN trademark in the websites at the disputed domain names. Following the cease and desist letters, the Respondents removed these commercial websites and redirected the disputed domain names to parking webpages containing sponsored links.

RESPONDENT:

The Respondents did not reply to the Complainant's contentions and did not submit any arguments or evidence in their defence.

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 Respondents 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 registrant of the disputed domain name <hogansito-ufficialeonline.com> is Athena Reynolds, United States, while the registrant of the disputed domain name <hogansitoufficialeoutletonline.com> is Timothy Igo, United States. The Complainant has named these two registrants as Respondents in this proceeding and requests that the two disputed domain names and the named Respondents be consolidated in a single UDRP proceeding. According to the Complainant, the disputed domain names are under common control or under the control of a group of individuals acting in concert, because they share the same date of registration, registrar, hosting provider, whois privacy shield and IP address and resolve to websites that offer the same products for sale.

Where a complaint is filed against multiple respondents, panels look at whether the disputed domain names or corresponding websites are subject to common control, and whether the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in the content or layout of the websites corresponding to the disputed domain names, and any naming patterns in the disputed domain names.

This Panel is satisfied that these factors are present in this proceeding. The websites to which the disputed domain names used to refer indeed look very similar, if not identical, and the two disputed domain names differ very little. It also appears that a consolidation of the proceedings in respect of the two disputed domain names would contribute to procedural efficiency, and neither of the Respondents has objected to the Complainant’s consolidation request. Therefore, the Panel decides to consolidate the proceedings in respect of the two disputed domain names <hogansito-ufficialeonline.com> and <hogansitoufficialeoutletonline.com> and their registrants Athena Reynolds and Timothy Igo, which will jointly be referred to in this decision as “the Respondents”.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

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

(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondents, and the Respondents were given a fair opportunity to present their case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

In this proceeding, the Respondents have not used the opportunity provided to them under the Rules and have not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the HOGAN trademark.
The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain name.

The relevant parts of the disputed domain names are therefore the sequences "hogansito-ufficialeonline" and "hogansitoufficialeoutletonline". As pointed out by the Complainant, these sequences reproduce the HOGAN trademark is its entirety in combination with the dictionary words "sito", "ufficiale" and "online", and the second disputed domain name also contains the dictionary word "outlet". The HOGAN trademark is easily recognized in each of the disputed domain names, and the addition of the dictionary terms mentioned above does not preclude a finding of confusing similarity between the HOGAN trademark and the disputed domain names.

Taking all the above into account, the Panel finds that the disputed domain names are confusingly similar to the HOGAN trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondents have no rights or legitimate interests in the disputed domain names, because they have not been authorized by the Complainant to use the HOGAN trademark and are not related to the Complainant, and the disputed domain name does not correspond to the names of the Respondents. According to the Complainant, the Respondents have not used the disputed domain names in connection with a bona fide offering of goods or services, but for websites featuring the Complainant's HOGAN trademark and offering counterfeit low-priced HOGAN branded products for sale without any disclaimer as to the Respondents' lack of relationship with the Complainant. Thus, the Complainant has established a prima facie case that the Respondents lack rights or legitimate interests in the disputed domain names.

The Respondents have not submitted a Response and have not alleged that they have rights and legitimate interests in the disputed domain names; they have not disputed the Complainant's allegations and evidence in this proceeding.

The disputed domain names are confusingly similar to the Complainant's HOGAN trademark and contains dictionary words which may mislead Internet users to believe that the disputed domain names refer to websites authorized by the Complainant. The Respondents have not provided any plausible explanation why they have chosen and registered the disputed domain names and have then associated them with websites that feature the HOGAN trademark and offer for sale heavily discounted products bearing the HOGAN trademark.

All the above leads the Panel to the conclusion that it is more likely than not that the Respondents, being aware of the goodwill of the Complainant an of the HOGAN trademark, have registered the disputed domain names in an attempt to exploit this trademark's goodwill for financial gain. In the Panel's view, such activity is not legitimate and does not give rise to rights and legitimate interests in the disputed domain names.

Therefore, the Panel finds that the Respondents do not have rights or legitimate interests in the disputed domain names.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

As discussed above, the disputed domain names are confusingly similar to the HOGAN trademark and have resolved to commercial websites that feature the HOGAN trademark and offer for sale heavily discounted (so possibly counterfeit) products bearing the HOGAN trademark, without disclosing the lack of relationship with the Complainant.

Taking the above into account, the Panel accepts that the Respondents have registered the disputed domain names with knowledge of the Complainant and targeting the HOGAN trademark in an attempt to extract commercial gain by misleading Internet users that these websites have been authorized by the Complainant and are sources of original goods bearing the HOGAN trademark. This satisfies the Panel that the Complainant has established that the Respondents have registered and used 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. **HOGANSITO-UFFICIALEONLINE.COM**: Transferred
2. **HOGANSITOUFFICIALEOUTLETONLINE.COM**: Transferred

PANELLISTS

Name	Assen Alexiev

DATE OF PANEL DECISION 2020-03-15

Publish the Decision