Decision for dispute CAC-UDRP-102869

Case number	CAC-UDRP-102869
Time of filing	2020-01-22 10:18:00
Domain names	hoganscarpe.com, hoganitalian.site, hogandisconto.site, hoganitalia.top

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	TOD'S S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Organization	

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant relies on the following international registrations of logos consisting essentially or predominantly of the word HOGAN:

No. 1014830 in classes 9, 18 and 25;
No. 1014831 in classes 9, 18 and 25;
No. 774193 in classes 3, 9, 18 and 25;
No. 1129649 in classes 3, 9, 18 and 25;

and on an EU registration of a logo consisting essentially of the word HOGAN under No. 005184536 in classes Cl. 3, 9, 18, 25 and 35.

FACTUAL BACKGROUND

The Complainant and its subsidiaries carry on a business of making and selling supplying luxury shoes and leather goods under brands which include HOGAN. It has registered logos consisting essentially or predominantly of the word HOGAN as international and EU marks as set out above. The Complainant's group operates a website at www.hogan.com promoting its

goods under the HOGAN brand. The group's 2018 turnover amounted to nearly 1 billion Euros, of which 22% was under the HOGAN mark.

The disputed domain names were registered by the Respondents between 2017 and 2019. There is evidence that the Respondents are connected, in that the disputed domain names were directed to a website or websites with the same content prior to cease and desist letters. This content promotes the sale of counterfeits of the Complainant's products as well as products of the Complainant's competitors. The content is in Italian.

The Respondents are not connected with the Complainant and have not been authorised to use the disputed domain names or any other names similar to the Complainant's HOGAN marks.

The Complainant's cease and desist letter of 17 December 2019 was not answered.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

It is clear that the Complainant has registered rights in marks consisting essentially or predominantly of the word HOGAN. Each of the disputed domain names is confusingly similar to these marks, since each domain name consists of the word HOGAN followed by a word that is descriptive in Italian (scarpe, meaning shoes; disconto, meaning discount; italia, meaning Italy) or English (Italian), and a generic top level domain suffix.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that 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

As noted above, the Respondents are not connected with the Complainant and have not been authorised by the Complainant to use the disputed domain names or any corresponding names.

The Panel is satisfied that the Respondents did not make or prepare to make any bona fide offering of goods or services under the disputed domain names or any corresponding name before notice of the dispute. On the undisputed evidence, the use made of the disputed domain names by the Respondents was in bad faith, intentionally diverting consumers seeking the Complainant's products through the confusing similarity of the disputed domain names to the Complainant's marks to the Respondents' website offering counterfeit products and products sold under competing brands.

It is clear that the Respondents are not commonly known by the disputed domain names.

Nor are the Respondents making legitimate non-commercial or fair use of the disputed domain names. On the contrary, they are making unfair commercial use by intentionally diverting consumers through confusion to the Respondents' website offering counterfeit products and products sold under competing brands.

In these circumstances, 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 Panel finds that the Respondents have used the disputed domain names intentionally to attract Internet users to their websites offering counterfeit and other competing products for commercial gain by creating a likelihood of confusion with the Complainant's marks as to the source of the Respondents' website and the products promoted on it.

In accordance with paragraph 4(b)(iv) of the UDRP this constitutes evidence of registration and use of the disputed domain

names in bad faith. There is no material on the file displacing this presumption.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that 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 language of the registration agreement is Chinese. The Complainant requested a determination that the language of the proceedings should be English. In support of this request, the Complainant noted that the Respondents' website content used Latin characters; the language used was Italian, but the Respondents were likely to have better knowledge of English, as a more international language, than Italian; and the complaint had already been prepared in English, and translating it would involve significant additional expense.

The Complainant referred to WIPO Case No. D2016-1763 Orlane SA v Yu Zhou He where the Panel determined that the language of the proceeding should be in English in somewhat similar circumstances.

Bearing in mind also that the Respondents have not responded to the Complaint or objected to the proceedings being in English, the Panel determined pursuant to paragraph 11(a) of the UDRP Rules that the language of the proceedings should be English

The Complainant also requested that the multiple disputes set out in the Complaint be consolidated on the grounds that the disputed domain names are under common control. On the basis of the evidence summarised above and in the absence of any dispute by the Respondents, the Panel is satisfied on the available information that the disputed domain names are under common control. The Panel accordingly consolidates the disputes in this proceeding under paragraph 10(e) of the UDRP Rules.

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

Disputes consolidated on undisputed evidence that the disputed domain names are in common control.

The domain names each consist of the principal feature of the Complainant's registered marks following by a descriptive word and a generic top level domain name suffix.

Respondents are not licensed or authorised by the Complainant or commonly known by the disputed domain names.

Domain names were directed to websites promoting counterfeits of the Complainant's products and other competing products. So not bona fide use, nor legitimate non-commercial or fair use, but bad faith use covered by para 4(b)(iv) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HOGANSCARPE.COM**: Transferred
2. **HOGANITALIAN.SITE**: Transferred
3. **HOGANDISCONTO.SITE**: Transferred
4. **HOGANITALIA.TOP**: Transferred

PANELLISTS

Name	**Jonathan Turner**

DATE OF PANEL DECISION 2020-03-06

Publish the Decision