Decision for dispute CAC-UDRP-103096

Case number	CAC-UDRP-103096
Time of filing	2020-06-02 10:39:11
Domain names	DANIELWELLINGTON.SHOP

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Daniel Wellington AB

Complainant representative

Organization	SILKA Law AB

Respondent

Name	Nguyen Duong Tung

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has been carrying out business with the corporate name DANIEL WELLINGTON since 2012 and is owner of:
- International trademark (word) DANIEL WELLINGTON no. 1135742, registered on 3 July 2012, in classes 9, 14, 35;
- International trademark (device) DW DANIEL WELLINGTON no. 1260501, registered on 11 March 2015, in classes 9, 14, 18, 25, 35.

The Complainant is also owner of several domain names, among which danielwellington.com registered on 16 February 2011 and used as the Complainant's main website.

Hereinafter above rights are referred to as DANIEL WELLINGTON Trademark.

FACTUAL BACKGROUND

The Complainant is a Swedish company, founded in 2011 by Filip Tysander. The Complainant uses minimalist designs and social media marketing to sell watches to a younger generation of consumers in several countries worldwide, among which

in Vietnam where the Respondent is located. Since its inception, Daniel Wellington has sold over 6 million watches; the company has gained this success through its digital strategy on social network.

The disputed domain name was registered on 29 August 2019 and resolves to a website, which is a copycat version of the Complainant's official website, displaying the Complainant's DANIEL WELLINGTON Trademark, images and products or services.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

THE PARTIES' CONTENTIONS:

Complainant:

The Complainant states that the disputed domain name is identical or confusingly similar to its DANIEL WELLINGTON Trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not have any relationship with the Respondent. The Respondent is not affiliated with nor authorized by the Complainant in any way to make any use of the Complainant’s mark or to register the disputed domain name.

Besides, the disputed domain name resolves to a replica of the Complainant’s genuine website, which is clearly not a bona fide offering of goods or services or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's DANIEL WELLINGTON Trademark.

The Complainant also contends that the registration of the disputed domain name identical or confusingly similar to the Complainant's DANIEL WELLINGTON Trademark, the obviously infringing content of the website and, thus, the constructive knowledge on behalf of the Respondent of the Complainant’s potential rights, as well as the use of the privacy registration service, clearly shows the Respondent’s bad faith in the registration and use of the disputed domain name.

The Complainant, therefore, requests the transfer of the disputed domain name.

Respondent:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 name (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 name has 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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:
(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; 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 by the Respondent in bad faith.

I. THE COMPLAINANT'S RIGHTS AND IDENTITY OR CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in the DANIEL WELLINGTON Trademark since 2012.

In assessing identity or confusing similarity the Panel finds that the disputed domain name incorporates the entirety of the dominant and distinctive element of Complainant's trademark, namely the wording DANIEL WELLINGTON, and differs from it by merely adding the TLD ".shop".

It is well established that the TLD is usually to be disregarded for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of the registration. The practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to new gTLDs); the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element. The meaning of such TLD may however be relevant to Panel assessment of the second and third elements (see 1.11 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP Panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see 2.1 WIPO Overview 3.0: "[...] 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 disputed domain name was registered with privacy registration service. The Respondent was identified by the registrar with the name Nguyen Duong Tung, an individual domiciled in Vietnam.

The Complainant has no relationship with the Respondent whatsoever.

The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's DANIEL WELLINGTON Trademark or to register the disputed domain name.

There is no evidence that the Respondent has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name directs to a website which is a copycat version of the Complainant main website, displaying the Complainant's DANIEL WELLINGTON Trademark, images and products or services. Such use of the domain name is clearly not a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to

tarnish the Complainant’s mark.

Moreover, considered that the TLD chosen by the Respondent (.shop) is descriptive of or relates to goods or services, or other term associated with the Complainant, the Respondent’s selection of such TLD tends to support the finding that the Respondent obtained the domain name to take advantage of the Complainant’s mark and as such that the Respondent lacks rights or legitimate interests in the domain name (see also 2.14 WIPO Overview 3.0).

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Complainant has sufficiently demonstrated to be owner of the DANIEL WELLINGTON Trademark, registered prior to the registration of the disputed domain name and valid also in the territory where the Respondent is located (Vietnam).

The Respondent registered the disputed domain name, incorporating in its entirety the dominant and distinctive element of the Complainant's mark (namely the wording DANIEL WELLINGTON). The addition of the TLD “.shop” (on one hand a technical requirement of the registration, on the other descriptive of or relates to the business of the Complainant) is not only insufficient to escape the finding of identity or confusing similarity between the disputed domain name and the Complainant’s mark, but, together with the website content, even enhances the risk of confusion.

Indeed, the domain name resolves to a website which is a copycat version of the Complainant's official site, displaying the Complainant's trademark, images, products or service. Thus, it is clear that the Respondent registered and has used the disputed domain name with actual knowledge of the Complainant, it business and its mark and the intention to exploit the good will built by the Complainant by diverting traffic away from the Complainant’s website.

Furthermore, the Respondent used a privacy service when registering the disputed domain name. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact a panel’s assessment of bad faith (see 3.6 WIPO Overview 3.0).

The Respondent has failed to submit a response or to provide any evidence of actual or contemplated good faith use.

Taken into account all circumstances of this case, the Panel finds that it is implausible that there is any legitimate purpose in the registration and use of the disputed domain names by the Respondent.

Thus, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

Consequently, the disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DANIELWELLINGTON.SHOP**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2020-06-29

Publish the Decision