

Decision for dispute CAC-UDRP-103100

Case number	CAC-UDRP-103100
Time of filing	2020-06-03 09:04:37
Domain names	danielwellingtonwatch.com, danieldwellington.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	Daniel Wellington AB
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Complainant representative

Organization	SILKA Law AB
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Respondent

Name	Samdy Chen
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain names.

IDENTIFICATION OF RIGHTS

In these proceedings, the Complainant relies on the following trademarks:

- DANIEL WELLINGTON (wordmark), International Registration No. 1135742, filed on July 3, 2012, in the name of Daniel Wellington AB (the Complainant);

- DW Daniel Wellington (stylized word logo), International Registration No. 1260501, filed on March 11, 2015, in the name of Daniel Wellington AB (the Complainant).

It is worth noting that, the Complainant owns many similar trademarks in various countries, which have not been cited in these proceedings.

FACTUAL BACKGROUND

The Complainant is a well-known modern Swedish manufacturer of watches and hand accessories (rings, bracelets and straps). It boasts a fast growing business all around the world, including in China (with 300 stores), where the Respondent is located. It counts millions of followers on social media, through which its marketing takes place.

The Complainant owns a fair-sized portfolio of trademarks mainly including the wording "DANIEL WELLINGTON", among which a Swedish registration dating back to 2011, when it was founded. It also owns a multitude of related domain names, like <danielwellington.com> since February 16, 2011 and <danielwellington.asia> since May 30, 2013.

The disputed domain names <danielwellingtonwatch.com> and <danieldwellington.com> were registered respectively on April 7, 2020, and on April 13, 2020, apparently by the Respondent (Fujian province, China). It is to be noted that the Complainant has not provided the Panel with evidence on this point and that the Panel had to confirm it on the ICANN Whois database, while comparing with the Registrar verification in the file.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that, despite the word "watch" in the first domain and the single letter "d" in the second domain, the disputed domain names are confusingly similar to its DANIEL WELLINGTON registered trademark, as they wholly incorporate such trademark (which is recognizable therein). This last element is sufficient to support the finding that the disputed domain names are confusingly similar to the Complainant's trademark. As to the gTLD ".com", the Complainant suggests that it should be disregarded, as per usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain names, because the Respondent is not known by the disputed domain names, the Complainant is neither affiliated with the Respondent, nor has it ever authorised the Respondent to register its trademark as a domain name, and the Complainant has no business with the Respondent. There is no intention for or proven bona fide offering of goods/services, whatsoever.

According to the Complainant, given the distinctiveness and worldwide reputation of the DANIEL WELLINGTON trademark, the Respondent registered the disputed domain names with full knowledge of the Complainant's trademark in an intentionally designed way, with the aim to create a likelihood of confusion with the Complainant's trademarks and domain names, and this is evidence of the fact that the disputed domain names were registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has held passively the disputed domain names as parking websites, and has tried to attract internet users by creating a likelihood of confusion with the Complainant, facts that – in combination with the incorporation of a famous trademark in a domain name – prove use in bad faith.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain names in bad faith.

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).

The disputed domain names consist of the Complainant's whole trademark (DANIEL WELLINGTON), accompanied by the word "watch" in the first domain – which increases the likelihood of confusion on the consumer side, as it is directly linked to the Complainant's industry – and by the single letter "d" between the two trademarked words above in the second domain. Thus, there is nothing in the domain names, sufficient to escape the finding that the disputed domain names are confusingly similar to

the registered trademark of the Complainant.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the complainant to establish a prima facie case that the respondent lacks rights or legitimate interests in the domain name to shift the burden of proof to the respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the DANIEL WELLINGTON trademark in a domain name.

Furthermore, the Respondent has not demonstrated any use of the disputed domain names in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain names.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the seniority and reputation of the Complainant's registered trademark and the fact that the disputed domain names fully incorporate this trademark, as well as the word "watch" in the first domain, it is evident that, at the time of the registration of the disputed domain names, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark, with full knowledge of the fact that the rights over this trademark belong to a third party, amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain names resolve to inactive, parking websites. This fact is to be combined with the full incorporation of the Complainant's reputable trademark in the disputed domain names. For this Panel, same as for many previous panels, such misleading behaviour clearly amounts to use in bad faith. Consequently, it is impossible to conceive any plausible active use of the disputed domain names that would be legitimate.

Therefore, the Panel finds it clear that the disputed domain names were used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain names wholly incorporate the Complainant's well-known registered trademark. The disputed domain names are therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain names. The Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain names with full knowledge of the Complainant's reputable trademark. His use of the disputed domain names is in bad faith, as there is no conceivable use of the disputed domain names that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. DANIELWELLINGTONWATCH.COM: Transferred
- 2. DANIELDWELLINGTON.COM: Transferred

PANELLISTS

Name	Sozos-Christos Theodoulou
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DATE OF PANEL DECISION	2020-07-06
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Publish the Decision