Decision for dispute CAC-UDRP-103097

Case number	CAC-UDRP-103097
Time of filing	2020-06-02 10:39:04
Domain names	Daniel-wellington.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Daniel Wellington AB

Complainant representative

Organization	SILKA Law AB

Respondent

Name	Mohamed Benlekbir

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 submitted evidence, which the Panel accepts, showing that it is the registered owner of the IR trademarks DANIEL WELLINGTON (Registration n°1135742, 1260501 and 010553345).

Moreover, the Complainant is also the owner of the domain names bearing the sign “DANIEL WELLINGTON” or its abbreviation “DW” such as <danielwellington.com> creation dated February 16, 2011, <danielwellington.asia> creation dated May 30, 2013, <dwwatch.shop> creation dated September 22, 2016 and <dwwatch.store> creation dated September 1, 2016.

The Complainant also has a significant presence on several social media platforms such as Facebook, Youtube, Instagram, Pinterest and Twitter.

FACTUAL BACKGROUND

The Complainant, Daniel Wellington AB, was founded in 2011 by Filip Tysander and Daniel Wellington is one of the fastest growing and most beloved brands in the fashion industry. Nowadays, the Complainant has a huge presence on various social media platforms and awarded by World Trademark Review for its work on enforcing and protecting its trademark

rights and won the Europe, Middle East and Africa Team of the Year.

The Complainant holds the international trademark registrations for “DANIEL WELLINGTON” (Registration n°1135742, 1260501 and 010553345) and the Complainant also holds domain names bearing “DANIEL WELLINGTON” or its abbreviation “DW” such as <danielwellington.com> creation dated February 16, 2011, <danielwellington.asia> creation dated May 30, 2013, <dwwatch.shop> creation dated September 22, 2016 and <dwwatch.store> creation dated September 1, 2016.

The Respondent registered the disputed domain name <daniel-wellington.com> and the domain name is currently inactive.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant, Daniel Wellington AB, was founded in 2011 by Filip Tysander and Daniel Wellington is one of the fastest growing and most beloved brands in the fashion industry.

The Complainant holds international trademark registrations for the trademark “DANIEL WELLINGTON” and also is the owner of the domain names bearing the sign “DANIEL WELLINGTON” such as <danielwellington.com> and <danielwellington.asia>.

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant alleges that the disputed domain name <daniel-wellington.com> is confusingly similar to the Complainant’s trademark “DANIEL WELLINGTON” as it bears the Complainant’s trademark as a whole.

The Complainant states that the addition of the hyphen is not sufficient to abolish the confusing similarity between the disputed domain name and the “DANIEL WELLINGTON” trademark.

The Complainant refers to CAC Case No. 102797 BNP PARIBAS v. Julio Jaime.

The Complainant also alleges that the addition of the gTLD “.COM” does not change the overall impression of the designation as being connected to the Complainant’s trademark “DANIEL WELLINGTON”.

The Complainant refers to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “WIPO Overview 3.0”) as well as CAC Case No. 102348 Manifattura Mario Colombo & C. Spa v. Convey srl.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant states that the Respondent has no rights on the disputed domain name as the Respondent is not known as the disputed domain name.

The Complainant argues that the disputed domain name is currently not active and states “this shop is unavailable”. Thus, the Complainant argues that the Respondent is using the disputed domain name in a way to create a perception on the visitors that the domain name was previously connected to an online shop.

The Complainant also argues that the disputed domain name is listed for sale via the auction site Afternic.com. Therefore,

the Complainant states that it is obvious that the Respondent is trying to earn money by using the Complainant's reputation.

Moreover, the Complainant states that neither license nor authorization has been granted to the Respondent to use the Complainant's trademark "DANIEL WELLINGTON" or to apply for registration of the disputed domain name.

The Complainant also argues that the Respondent has had the intention to run an online shop under the disputed domain name and it demonstrates the lack of rights or legitimate interests.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant states that the "DANIEL WELLINGTON" is a well-known trademark in the fashion industry.

The Complainant states that taking into account the distinctive character and the well-known status of the "DANIEL WELLINGTON" trademark; the Respondent was aware of such trademark while registering the disputed domain name.

The Complainant asserts that the disputed domain name is created by adding a hyphen to the well-known trademark "DANIEL WELLINGTON" which demonstrates the bad faith of the Respondent.

The Complainant alleges that the bad faith of the Respondent is supported within the fact that the disputed domain name is inactive.

The Complainant states that prior Panel decisions have accepted the bad faith of the Respondent in similar cases such as WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows ("The concept of a domain name 'being used in bad faith' is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.").

The Complainant refers to CAC Case No 101285 BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Huang ChaoQiong where the Panel held that "the offer for sale is already indicative of registration and use of the domain name in bad faith". The same principle applies to the present case.

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

A. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

B. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

C. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of the “DANIEL WELLINGTON” trademark.

The Panel finds that the disputed domain name contains the Complainant’s “DANIEL WELLINGTON” trademark as a whole and the hyphen included within the disputed domain name is not sufficient to vanish the similarity.

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is open to a Respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the Respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate

interest in the disputed domain name, the Complainant will have failed to discharge its burden of proof and the Complaint will fail. The burden is on the Complainant to demonstrate a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. Once the Complainant has made out a prima facie case, then the Respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complaint and any use of the trademark “DANIEL WELLINGTON” has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name. Finally, the disputed domain name is inactive.

In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant’s trademark in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain dame, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Panel concludes that the Complainant's “DANIEL WELLINGTON” trademark has a significant reputation and is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the “DANIEL WELLINGTON” trademark and the associated domain names, the Respondent, was aware of the Complainant and its trademark at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant’s trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover the link http://daniel-wellington.com/ is currently inactive and the disputed domain name is offered for sale via the auction site Afternic.com.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DANIEL-WELLINGTON.COM**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2020-07-13

Publish the Decision