Decision for dispute CAC-UDRP-103205

Case number	**CAC-UDRP-103205**
Time of filing	**2020-07-30 11:14:36**
Domain names	**Danielwellington.store**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Daniel Wellington AB**

Complainant representative

Organization	**SILKA Law AB**

Respondent

Name	**Nguyễn Thanh Dũng**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any proceedings, pending or decided, which relate to the disputed domain name. The Complainant has declared that there are no such proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of trade marks including the word mark 'DANIEL WELLINGTON', registered under the Madrid international system (1135742, 3 July 2012) on the basis of a European Union trade mark (010553345, 11 January 2012), in classes including class 14 (watches and jewellery) and 35 (retail services concerning same).

FACTUAL BACKGROUND

The Complainant, a limited company with its seat in Stockholm, Sweden, is a manufacturer and retailer of watches and other items. It was founded in 2011, and makes substantial use of online marketing (social media, in particular). It operates at a global scale, and has registered and makes use of various domain names of its own, e.g. <DANIELWELLINGTON.COM> (first registered 16 February 2011).

The Respondent, an individual with an address in Ho Chi Minh, Vietnam, registered the disputed domain name on 25 November 2019.

PARTIES CONTENTIONS

No administratively compliant response has been filed. The Provider is unaware of whether written notice of the Complaint has been received by the Respondent. One of the emails sent to the Respondent was successfully relayed; the Respondent never accessed the online platform.

The Complainant argues that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. It submits that the disputed domain name is confusingly similar to its mark, and that there are no relevant rights or legitimate interests on the part of the Respondent (noting, in particular, a lack of authorisation or bona fide offering of goods and services. Further, it contends that the Respondent would have had prior knowledge of the Complainant and its mark, that the Respondent had a primary motive of selling the disputed domain name, and that registration and use in bad faith is present (relying upon the principle in WIPO Case No. D2000-0003 Telstra Corporation Ltd v Nuclear Marshmallows).

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).

The only differences between the disputed domain name and the Complainant's trade mark are the replacement of a space with a hyphen, and the TLD 'store'. UDRP panels typically disregard the TLD for the purposes of paragraph 4(a)(i); see WIPO Jurisprudential Overview, version 3.0, paragraph 1.11; in the case of the present TLD (which arguably conveys meaning), the Panel can also find that confusing similarity is not dispelled in any way, and would consider any arguments in this regard under the second or third heading, below. As for the hyphen, the domain name system does not represent spaces between words, and so the replacement of a space with a hyphen is - at least - confusingly similar where there are no other differences between a mark and a domain name; see e.g. CAC Case No. 102797 BNP Paribas v Julio Jaime; CAC Case No. 101920 Aktieselskabet v Zhang Lixiang.

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).

The Respondent is known as 'Ông Nguyễn Thanh Dũng' and has provided no evidence of rights or legitimate interests in respect of its use of the disputed domain name. Furthermore, the Complainant has declared (without contradiction from the non-participating Respondent) that the Respondent is not affiliated with the Complainant in any way, and that the Respondent has not been authorised to use its mark or carry out any activities on its behalf.

The Complainant speculates that the Respondent has the intention to run an online store, since the Respondent has chosen the TLD 'STORE'. This must be treated with caution by the Panel, as in certain circumstances, an online store could be the basis for a finding of rights or legitimate interests under the Policy. (For instance, the many cases applying WIPO Case No. D2001-0903 Oki Data Americas v ASD). However, there is no evidence of such in the present case; in particular, an Oki Data analysis is impossible in the absence of at least some evidence of actual activity as, for instance, a reseller or repairer (before considering the conditions associated with such a finding e.g. no attempt to mislead). Again, the Respondent's failure to participate is to its detriment; moreover, the Panel notes the lack of an active website at the disputed domain name, or any other evidence that might challenge the Complainant's submission that neither rights nor legitimate interest are present.

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).

The Panel accepts that it is more likely than not that the Respondent had prior knowledge of the Complainant, in light of the evidence presented by the Complainant regarding its fame and reach. Although both words in the mark are (taken separately) personal names, there is no evidence available to the Panel that even begins to suggest that the Respondent had this or another meaning in mind.

The Complainant submits that 'the Respondent registered the Domain Name primarily to sell it which is evidently a factor of bad faith registration and use'. However, the Panel does not accept this contention, as there is nothing on the record which suggests a primary motive to sell, let alone any actual evidence of an offer to sell.

The Panel does however accept what the Complainant says regarding the relevance of the above-cited decision in Telstra, i.e. that this is a case of 'passive holding'. While a clearer analysis (by the Complainant) of the Telstra factors would have been more helpful to the Panel (rather than the unfounded statement regarding sale), the Panel is satisfied that the present dispute is within the scope of passive holding. Applying here the four factors set out in the WIPO Jurisprudential Overview, version 3.0, paragraph 3.3, the Panel notes that the Complainant's mark has a strong reputation, and agrees that good faith use is (reasonably) implausible. The Panel further notes that the Respondent has failed to submit a response (which could set out actual or contemplated good faith use), though there is limited evidence of a concealing of identity or use of false contact details.

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.

The Complainant requests that the language of the proceedings be changed, from Vietnamese to English. The UDRP Rules, paragraph 11, provide that the language of proceedings is, in the first instance, the language of the registration agreement (in this case, Vietnamese): "Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”

In support of its request, the Complainant notes that its mark is well known internationally, and that the TLD chosen by the Respondent is the English-language word 'store'; as such, it asks the Panel to find it more likely than not that the Respondent understands English. It also points to the expense and delay that would result from the present proceedings being conducted in Vietnamese.

As the Respondent has not participated in these proceedings, its view on the question of the language of proceedings - or indeed its competence in Vietnamese, English, or any other language - is not known.

The Panel finds that the Complainant's submission is well reasoned and so accepts the request to change the language of proceedings. In doing so, the Panel places emphasis on the common practice of assessing 'the credibility of any submissions by the parties and in particular those of the respondent (or lack of reaction after having been given a fair chance to comment)' on this matter: WIPO Jurisprudential Overview, version 3.0, paragraph 4.5.1.

PRINCIPAL REASONS FOR THE DECISION

The requirements for the acceptance of a Complaint under paragraph 4 of the Policy have been met. In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. On the other hand, it is clear that the Complainant has rights in respect of the trade mark DANIEL WELLINGTON, and that the disputed domain name is confusingly similar to this mark, differing only by the top-level domain '.STORE' and the replacement of a space with a hyphen. In light of the evidence presented by the Complainant, and its legal arguments (especially in respect of 'passive holding', as set out above), the Panel finds that the disputed domain name was registered and is being used in bad faith. The Panel accepted the Complainant's request that the language of proceedings be changed from Vietnamese to English.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DANIELWELLINGTON.STORE**: Transferred

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2020-09-07

Publish the Decision