Decision for dispute CAC-UDRP-103231

Case number	CAC-UDRP-103231
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Domain names	pandoraeu.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Pandora A/S

Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.

Respondent

Name	Wei Zhang

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceeding which relate to the disputed domain name

IDENTIFICATION OF RIGHTS

Pandora A/S is a Danish Company that has marketed and sold its products in more than 100 Countries through more than 7.700 points of sale. It has several PANDORA formative trademarks around the world. In this proceeding the Complainant has indicated the following trademark registrations:

EUTM No.3397858 in class 14 as of 18 April 2007 for PANDORA

EUTM 653519 in class 25 as of 17 April 2000 for the word mark PANDORA

EUIPO reg. no. 0979859 figurative mark for PANDORA with a crown above the letter "O". which was entered on register: 17 September 2008
UK00002576442 for the PANDORA word mark, entered into the register on 12 August 2011 in classes 9 and 14:

UK00002654960, the PANDORA word mark, entered into the register on 05 July 2013 for class 35 for Retail services, online retail services, wholesale services and sales promotion services all connected with jewellery, goods made of precious metals.

The Complainant has also registered the trademark PANDORA under several domain names worldwide, among these is <pandora.net> – which it has been the registrant of since 2010 .

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant requests that English be adopted as the language of the proceeding.
The domain in question is of the international .com TLD. The Registration Agreement by NameCheap is in English. Respondent, WhoisGuard.com, the Respondent's own website is in English, see http://www.whoisguard.com/contact-us.asp

Even in case the Registration Agreement applicable to this specific domain turns out not to be in English after all, previous UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement.

"Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, , (ii) the language/script of the domain name particularly where the same as that of the complainant's mark, (iii) any content on the webpage under the disputed domain name, [...] (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint [...]". Section 4.5.1, WIPO Overview 3.0.
Regarding factor (1), the WHOIS details of the Registrant are all in English. Moreover the Respondent has registered the Disputed Domain Name which contains the geographical indication 'eu', and which contain the Complainant's PANDORA Trademark, which in its turn is also in Latin characters (factor ii).

Regarding factor iii: the entire website of Respondent is in English. The currency indicated by default on the website is GBP, or Pound sterling, the official currency of the United Kingdom , where the de facto language is English. The Respondent's website order process is completed entirely in English. It is therefore obvious respondent is targeting United Kingdom consumers with counterfeit goods.

In case the first-named Respondent WhoisGuard, Inc. (as it is named in the WHOIS for the domain) would want to argue that it is not responsible or could not be named as a Respondent, Complainant refers to WIPO Case No. D2010-1945: Pandora Jewelry, LLC v. Whois Privacy Protection Service, Inc. / Lisa Xu): "In conclusion, as stated in […] which addresses the use of privacy or proxy services and the UDRP, the Panel considers by parity that the relevant domain names is in fact controlled by both persons, the privacy service as public registrant and the underlying registrant and that naming both entity as Respondents respects the UDRP rules (see, for example, […])."

In case the Respondent defaults, it has been given the opportunity to present any comments and/or objections in this case, including objection to the Complainant's language request, it did not do so. Forcing the Complainant to undertake the proceeding in the language of -for example- Spanish (the language of Panama where Respondent WhoisGuard, Inc. is established) or Chinese (the supposed return address of the counterfeit goods received after the test purchase, and where the order confirmation e-mail's domain name servicecentervip.com registrar is located) even though that service and the website operator both clearly know English since its name is in English, would serve no discernible purpose in the circumstances.

Complaint amended on 19 August 2020 after Registrar Verification:

Respondent appears to be a serial domain-squatter, who has also attempted to register domains for other well-known fashion brands, such as TimberlandEStores.com
(https://website.informer.com/email/YVETTELEVASSEUR990@OUTLOOK.COM: "timberlandestores.com as Wei Zhang YVETTELEVASSEUR990@OUTLOOK.COM since December, 2019") and BalenciagaEOutlets.com and BalenciagaEOutlets com.
And according to DomainIQ, Respondent registered the domain buypandoracharm.com, on 24 March 2017 (Complainant

attached an annex proving that Respondent knew Complainant's famous mark and registered the domain in bad faith in November 2019.

Serving as proof of Respondent's clear intent to sell fashion replicas (counterfeit goods), are his registrations for:
bestreplicasale.com,ZHANGXIAN108@163.COM,"WEI ZHANG",,UNITED-DOMAINS,2013-07-25,Shopping (row 34)
bestreplicaswatch.com,ZHANGXIAN108@163.COM,"WEI ZHANG",,UNITED-DOMAINS,2013-07-25,Shopping (row 35)
replica007.com,394738853@QQ.COM,"WEI ZHANG","ZHANG WEI","JIANGSU BANGNING",2019-12-02,Shopping (row 236)
replicaforsales.com,ZHANGXIAN108@163.COM,"WEI ZHANG",,UNITED-DOMAINS,2013-05-14,Shopping (row 237)
replicaonshop.com,ZHANGXIAN108@163.COM,"WEI ZHANG",,UNITED-DOMAINS,2013-07-22,Shopping (row 238)
replicasbrandswatch.com,ZHANGXIAN108@163.COM,"WEI ZHANG",,UNITED-DOMAINS,2013-02-27,Shopping (row 239)

PARTIES CONTENTIONS

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

The Complainant is a company incorporated in Denmark. It designs manufactures and markets hand-finished and contemporary jewellery. Its products have been marketed and sold under the “Pandora” name in more than 100 countries and through more than 7,700 points of sale. Total revenue in 2019 was 2,9 billion Euros , as a result Pandora enjoys a high degree of global recognition.

It is the registered owner of various trade marks, internationally well known. Furthermore Pandora A/S owns a series of PANDORA formative domain names amongst which PANDORA.net was registered since 2010.
The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that a complainant must prove each of the following to obtain transfer or cancellation of a domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant

has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

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

(1) TRADEMARK IDENTITY OR CONFUSINGLY SIMILARITY
The Complainant has demonstrated registered trade mark rights in the term “Pandora”. The Panel confirms that the only sensible reading of the Domain Name is as the term “Pandora” in combination with the geographical term “EU” and the “.com” generic Top-Level-Domain (“gTLD”). Given this, the trade mark is clearly recognisable in the Disputed Domain Name. It follows that the Domain Name is “confusingly similar” to a trade mark in which the Complainant has rights.

(2) LACK OF LEGITIMATE INTERESTS
The Respondent lacks rights or legitimate interests in the Disputed Domain Name

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

According to the Complainant, the Respondent has no rights in respect of the Disputed Domain Name, and any use of the trademark “PANDORA” has to be authorized by the Complainant. The Respondent has not been authorized or licensed by the above-mentioned banking group to use the Disputed Domain Name.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the Disputed Domain Name.

The Respondent has registered and used the disputed domain name for the purpose passing itself off as being connected with the Complainant using without authorization the word mark as well as the logo of the Danish Company shown in the Respondent’s internet pages at the top of any single page. The Respondent’s web site was involved in the sale of jewellery and this circumstance together with the abuse of the Pandora brands render the Respondent’s behavior without any legitimate right and of course in blatant bad faith.

From the documentary evidence field by the Complaint is absolute clear that the respondent has been using PANDORA marks in order to sale illegally counterfeit goods as shown by the originality tests carried out by the Complainant.

See: WIPO Case No. D2010-1353: Pandora Jewelry, LLC v. (FAST-12785240), anypandora.com: “This Panel agrees with the opinions expressed by other panels in other similar cases that there is no legitimate noncommercial or fair use of the disputed domain name because “[T]he Respondent is using the domain name to host an e-commerce operation that reproduces the Complainant's trademark and the look and feel of the Complainant's official website, selling jewelry under the Complainant's marks, without any authorization from the Complainant or from its affiliated companies”. See Pandora Jewelry, LLC v. David Lee, WIPO Case No. D2010-0582.”- the same applies to the domain name in question.

Regarding such passing off / imitation, see: WIPO Case No. D2015-1461 (Pandora A/S v. Whoisguard Protected, Whoisguard, Inc. / Sarah Mcmahon - pandorapolska.com):
“Previous UDRP panels have held that the imitation of the Complainant, by displaying the Complainant’s logo and trademark, with the intention of misleading the Complainant’s customers is not a bona fide offering of goods or services, thus, it is not a legitimate use of a disputed domain name (see (…)).”

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

(3) REGISTRATION AND USE IN BAD FAITH
The Disputed Domain Name has been registered and is being used in bad faith (Paragraph 4(a)(iii) of the Policy).

The Panel agrees with the Complainant that its PANDORA trademarks are distinctive and well known globally. The fact that the Respondent has registered a domain name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge (or should have known) of the Complainant's trademarks and that they had such knowledge prior to the registration and use of the Disputed Domain Name.

The counterfeit activity of the Respondent is blatant and proved by the Complainant's tests enclosed to the Complaint.

Complainant rightly refers, as precedents, to WIPO Case No. D2015-1462 Pandora A/S v. Cagir Aras, Alyanschi - pandorakiss.com: "the Respondent is using the disputed domain name in connection with a commercial website offering what appear to be counterfeited versions of the Complainant's products. In this respect, previous UDRP panels have concluded that a respondent's efforts to sell counterfeit products under the guise of a complainant's brand, trademarks, and/or logos do not amount to a bona fide offering of goods or services (see […])."
And also to WIPO Case No. D2010-1827 Pandora Jewelry, LLC v. WhoisGuard / Ke YingCase: "The registration and use of the disputed domain name for the blatant purpose of selling apparent counterfeit Pandora jewelry products cannot by any means constitute good faith use or registration."
Again: WhoisGuard is also the registrant in this case for pandoraeu.com

Complainant also refers to WIPO Case No. D2018-0586 (Pandora A/S v. Domain Admin, Privacy Protect LLC (PrivacyProtect.org) / Robin Puckett - pandorashine.com): "The Complainant's assertion that the Respondent's website has been used to sell counterfeit goods has not been refuted by the Respondent. The use of the disputed domain name for a website used for illegitimate or other fraudulent activities constitutes a real ongoing threat to the Complainant and as such, constitutes evidence of bad faith use."

In the present case, the Panel is of the opinion that the Complainant's trademarks are well known, which makes it difficult to conceive any plausible legitimate future use of the Disputed Domain Name by the Respondent.
The Disputed Domain Name is not used for any bone fide offerings. The Panel believes that it is likely that the Respondent has registered or acquired the Disputed Domain Name primarily for the purpose of selling counterfeit articles

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the Disputed Domain Name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PANDORAEU.COM**: Transferred

PANELLISTS

Name	**Massimo Cimoli**

DATE OF PANEL DECISION 2020-09-18

Publish the Decision