Decision for dispute CAC-UDRP-103259

Case number	CAC-UDRP-103259
Time of filing	2020-09-03 09:08:24
Domain names	JoyasPandora.net

Case administrator

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

Complainant

Organization	Pandora A/S

Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.

Respondent

Name	Larry Sack

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any proceedings that relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of the following rights:

- EU trademark no. 000653519 for the word mark PANDORA registered in Classes 22, 25 and 26 on April 17,2000 with filing date October 14, 1997;

- EU trademark no. 003397858 for the work mark PANDORA registered in Class 14 on April 18, 2007 with filing date October 9, 2003;

- International trademark no. 1004640 for the word mark PANDORA registered in Classes 3, 9, 14 and 35 on May 14, 2009 based on a filing dated February 20, 2009; and

- International trademark no. 0979859 for a logo consisting primarily of the word PANDORA registered in Classes 9, 14, 18 and 25 on September 17, 2008 based on a filing dated March 11, 2008.

FACTUAL BACKGROUND

The Complainant designs, manufactures and markets jewellery under the mark PANDORA. It has sold these products through more than 7700 points of sale in more than 100 countries, and its total revenue in 2019 was approximately 2.9 billion Euros.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Panel finds that the Complainant is the registered proprietor of EU and international trademarks for the word mark PANDORA as listed above. The Complainant is also the registered proprietor of an international registration of a logo consisted primarily of the word PANDORA.

The Panel is satisfied that each of the disputed domain names is confusingly similar to the Complainant's trademarks. Each of these domain names contains the word "Pandora" together with a descriptive term or terms and a generic top level domain suffix.

In the case of five of the disputed domain names, the descriptive term is the name of a country (Espana in two cases, Greece, Russia, Netherlands). In the case of another of the disputed domain names, the descriptive term is CZ, the commonly used abbreviation and ISO standard code for the Czech Republic.

In the disputed domain name <estorepandorait.com>, the prefix "e" is a common abbreviation for an electronic version of a physical facility, "store" refers to a sales outlet, and "IT" is the commonly used abbreviation and ISO standard code for Italy. Another disputed domain name consists of the word "Pandora" followed by "schmucksale"; "schmuck" means jewellery in German, although the Yiddish usage referring to a stupid person is also common. In the domain name <joyaspandora.net>, the descriptive term is "joyas", meaning "jewellery" in Spanish.

These descriptive terms do not provide a distinction that averts the likelihood of confusion from the incorporation of the entirety of the Complainant's trademark in the disputed domain names. On the contrary, the references to "sale" and "store" are generic; the references to countries would be taken to refer to outlets of the Complainant in those countries or websites directed to them; and the references to jewellery would be taken to refer to the Complainant's jewellery products, which (according to its undisputed evidence) it sells through more than 7700 points of sale in more than 100 countries, achieving annual sales of nearly 3 billion Euros.

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are identical or confusingly similar to trademarks in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that it has not authorised, licensed or permitted the Respondents to register or use any of the disputed domain names or its PANDORA mark which was registered long before the disputed domain names.

The disputed domain names are directed to websites offering for sale jewellery products at discounted prices. These websites do not state that they are not authorised by the Complainant. Even if they were selling genuine products of the Complainant, this use would not constitute a bona fide offering giving rise to a right or legitimate interest of the Respondents for the purposes of paragraph 4(a)(ii) of the Policy. It does not comply with the third condition set out in the decision in WIPO Case No. D2001-0903 Oki Data Americas, Inc v ASD, Inc., which has been widely followed in subsequent decisions under the UDRP.

In any event, the Complainant has provided undisputed evidence that the websites are not offering genuine products of the Complainant. In particular, when an attorney acting for the Complainant attempted several times to purchase products from one of the websites using different bankcards, payment was refused for security reasons.

The Panel is therefore satisfied that the Respondents have not used or prepared to use the disputed domain names for a bona fide offering of goods or services.

It is also evident that the Respondents are not commonly known by the disputed domain names or any corresponding names and that the Respondents are not making legitimate non-commercial or fair use of them.

In these circumstances, the Complainant has, to the satisfaction of the Panel, shown the Respondents 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).

BAD FAITH

The disputed domain names were registered at various dates between 2014 and 2020, long after the Complainant's mark PANDORA was registered as stated above and when the Complainant was well known in many countries for its jewellery products sold under this mark. As mentioned above, the disputed domain names, which are confusingly similar to this mark, are directed to websites offering for sale jewellery products at discounted prices, and the Complainant has provided undisputed evidence that these are not genuine products of the Complainant.

In these circumstances the Panel finds that the Respondents have intentionally attempted to attract Internet users for commercial gain to the websites located by the disputed domain names by creating a likelihood of confusion with the Complainant's mark as to the source of the products offered on these websites. In accordance with paragraph 4(b)(iv) of the Policy this constitutes evidence that the disputed domain names were registered and are being used in bad faith. There is no evidence contradicting this presumption. On the contrary, it is reinforced by the registration of all but one of the disputed domain names under privacy shields using false names, as described below.

The Panel accordingly concludes that the disputed domain names were registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

The disputed domain name <joyaspandora.net> was registered in the name of Larry Sack as registrant. The other disputed domain names were registered under privacy shields in the names of Larry Sack (<pandoracz.com>), Alice Ferri (<pandoranetherlands.com> and <estorepandorait.com>), Marion Blasi (<pandoraespana.com>), Sirkin Mosening (<pandorarussia.org>), Pier Meghan (<pandoragreece.com>), Monica Lugo (<pandoraespana.net>) and Tom Fargen (<pandoraschmucksale.com>) as registrants.

Although the disputed domain names are registered under these different names, the Complaint identifies a number of common factors:

• Each website uses WordPress with WooCommerce and Contact Form 7 plugins

• Each website offers for sale counterfeits of the Complainant's products

• Each website uses the same Wordpress WooCommerce code snippet <span class="onsale"['sale' in relevant language] " to signal that every product on the front page is on sale

• Each website uses the letter O with a crown taken from the Complainant's logo as its favicon. In the cases of <estorepandorait.com>, <pandoragreece.com>, <pandoraespana.com> and <pandoranetherlands.com>, the favicon has been incorrectly resized in the same way turning the circle into an oval with its longer axis horizontal

• Each website has the same "Pandora" logo in the same location at the top left, except <estorepandorait.com> (where it is missing) and <pandoracz.com> and <pandoraGreece.com> (where it is at the top in the centre).

• Each of the domain names is hosted with the same provider, Inter Connects

• <pandorascmucksale.com> was hosted on the same IP address (5.157.0.225) as <joyaspandora.net>. With two exceptions the other disputed domain names are hosted at IP addresses very close to this address, ranging from 5.157.0.216 - 5.157.0.226. The only other domain names on the subnet 5.157.0.x of the Inter Connects webhost are two domain names consisting of generic terms for jewellery which locate similar websites offering counterfeits of Pandora products. The remaining two disputed domain names are also hosted at Inter Connects at IP addresses 5.157.40.5 and 5.157.40.10.

The Complainant infers from these common factors that the disputed domain names are in fact under common control and that it is appropriate to consolidate the disputes in a single complaint in accordance with the principles set out in the decisions summarised in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3d Ed (WIPO Jurisprudential Overview 3.0).

According to these principles, disputes against differently named registrants may be consolidated where the disputed domain names or websites are under common control and consolidation is fair and equitable to all parties, taking into account procedural efficiency.

The Panel notes that these principles have been followed by Panels of the Czech Arbitration Court in disputes under the UDRP: see e.g. Case No. 101576 Roger Vivier SPA v Sun Cai Long, Case No. 102078 Mammut Sport Group AG v Xian Wei Fa, Case No. 101969 Under Armour Inc. v Fei Niu. This Panel considers that these principles are sound and should be followed also in the interest of consistency.

The Panel notes that none of the common factors identified in the Complaint nor the inference that the disputed domain names are under common control have been disputed. On the balance of probabilities, the Panel finds that this inference is well-founded and that the disputed domain names are under common control. The Panel is also satisfied that consolidation of these disputes is fair and equitable to all parties, and that they should be consolidated in the interest of procedural efficiency.

It might have been better if the Complaint had been amended to include as Respondents all of the names given for the registrants of the disputed domain names in their registrations. Nevertheless, the true Respondent is the common entity controlling the disputed domain names, and one of the names used by that entity is the name given for the Respondent in the Complaint. Indeed this is the name used for the registrant of the first of the disputed domain names to be registered, <joyaspandora.net>.

The Panel also notes that the Complaint was duly notified to the e-mail addresses provided for the registrant, administrative contact, technical contact and billing contact for each of the disputed domain names, as well as postmaster@ each of the domain names.

In these circumstances, the Panel considers that the proceedings are properly constituted and have been duly notified to the Respondent or Respondents in accordance with the paragraph 2 of the UDRP Rules.

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 consist of the Complainant’s registered trademark combined with descriptive or generic elements. They have been directed to websites offering for sale jewellery products at discounted prices. The evidence shows that these products are counterfeits of the Complainant’s products sold on a large scale around the word under its registered trademark. The disputed domain names were registered under different registrant names and in most cases behind privacy shields, but the evidence shows that they are under common control.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JOYASPANDORA.NET**: Transferred
2. **ESTOREPANDORAIT.COM**: Transferred
3. **PANDORASCHMUCKSALE.COM**: Transferred
4. **PANDORACZ.COM**: Transferred
5. **PANDORAESPANA.NET**: Transferred
6. **PANDORAGREECE.COM**: Transferred
7. **PANDORARUSSIA.ORG**: Transferred
8. **PANDORAESPANA.COM**: Transferred
9. **PANDORANETHERLANDS.COM**: Transferred

PANELLISTS

Name	**Jonathan Turner, Carrie Shang, Dinant T.L. Oosterbaan**

DATE OF PANEL DECISION 2020-10-10

Publish the Decision