Decision for dispute CAC-UDRP-103391

Case number	CAC-UDRP-103391
Time of filing	2020-11-04 09:29:55
Domain names	Daniel-wellington.store

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Daniel Wellington AB

Complainant representative

Organization	SILKA AB

Respondent

Name	Shvets Leonid

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

About Complainant's rights in the name DANIEL WELLINGTON
The Complainant is the owner of the registered trademark DANIEL WELLINGTON as a word mark in numerous countries all over the world. See for example the International Trademark registration with registration no. 1135742 registered on July 3, 2012. Complainant is also the owner of the International design mark with registration number 1260501 registered on March 3, 2015. These trademark registrations predate the Disputed Domain Name registration.

FACTUAL BACKGROUND

No business relationship exists between the parties.

Respondent does not have, and never has had, permission to use the Daniel Wellington trademark.

Daniel Wellington AB ("Daniel Wellington") was founded in 2011 by Filip Tysander. Since its inception, Daniel Wellington has established itself as one of the fastest growing and most beloved brands in the industry and is known for its sleek and minimalistic design. The preppy stylish watches have become a huge success and the marketing is not made through traditional marketing, but only through social media and its brand ambassadors. Today the brand Daniel Wellington has an

astonishing 4,9 million followers on Instagram.
Recently Daniel Wellington launched a new modern take on a classic design, the Iconic Link. The new Iconic collection by Daniel Wellington continues the brand's founding principles of creating timeless and elegant, yet expressive, pieces. Daniel Wellington has also been recognized 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.

Accordingly, a simple comparison of Complainant's Mark's and the Disputed Domain Name demonstrates that the two are confusingly similar. Therefore, Complainant has established the first element of the Policy under paragraph 4(a).

The Respondent does not use, and has not used, the Disputed Domain Name in connection with a bona fide offering of goods or services.

Respondent is not commonly known by the Disputed Domain Name.

There is no evidence that Respondent is commonly known by the Disputed Domain Name.

Respondent does not use the Disputed Domain Name for any legitimate or non-commercial fair use.

Respondent registered the Disputed Domain Name primarily for the purpose of disrupting Complainant's business.

First of all, there is no bona fide offering of goods or services since the Disputed Domain Name incorporates a trademark which is not owned by the Respondent. Nor is the Respondent known by the name "Daniel Wellington". The Respondent is currently masked. The purpose of the Disputed Domain Name is to induce consumers into visiting the website under the misapprehension that the website is endorsed by the Complainant, and/or where the Complainant itself would in the future offer its time pieces. The Respondent has used the URL associated with the Disputed Domain Name to resolve to a website that mimics the official website of the Complainant. The Respondent is not affiliated with the Complainant in any way. Respondent has not been authorized by the Complainant to register or use the Disputed Domain Name or to seek the registration of any domain name incorporating the DANIEL WELLINGTON mark. There is no evidence that the Respondent is commonly known by the Disputed Domain Name or any similar name or made demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services or for a legitimate, non-commercial use. In fact, it appears as if the Respondent has had the intention to run an online store since they have chosen the top-level domain name "store".

Respondent was or should have been aware of Complainant's rights in Complainant's marks and registered the Disputed Domain in bad faith.

To summarize, DANIEL WELLINGTON is a well-known trademark in the fashion industry. It is highly unlikely that Respondent was at the point of the Disputed Domain Name registration not aware of the rights the Complainant has in the trademark and the value of said trademark. The Respondent bears no relationship to the trademark and the Disputed Domain Name coupled with the gTLD "store" has no other meaning except for referring to Complainant's name and trademark and there is no way in which the Disputed Domain Name could be used legitimately under the current circumstances. Consequently, the Respondent should be considered to have registered and to be using the Disputed Domain Name in bad faith.

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).

The addition of annex "store" is not sufficient element to escape the finding that the Disputed Domain Name is confusingly

similar to the Complainant´s trademarks and domain names.

The Disputed Domain Name incorporates the DANIEL WELLINGTON mark in its entirety. The addition of a hyphen to the mark is insufficient to dispel the confusing similarity, see for instance CAC Case No. 102797 BNP PARIBAS v. Julio Jaime concerning the domain name bnp-paribas.pro where the Panel held that these additional elements are not enough to dispel a finding of confusing similarity between the disputed domain name and the trademark.

The addition of the generic Top-Level Domain (gtld) ".store" does not add any distinctiveness to the Disputed Domain Name. Based on the foregoing, Complainant has demonstrated that the Disputed Domain Name is confusingly similar to its trademark. This is sufficient for a finding of confusing similarity for the purposes of the Policy; see 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 where this was reinforced.

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 Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use the trademarks and/or domains "Daniel Wellington" as a domain or on a website. The Respondent does not carry out any activity for, nor has any business with the Respondent.

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).

Given the distinctiveness of the trademark and the content of its website, it is clear that the Respondent registered the Disputed Domain Name in knowledge of the Complainant and its trademark.

All these elements lead to the conclusion that the Respondent has intentionally attempted to attract Internet users to the Respondent´s website for commercial gain by creating a likelihood of confusion with the Complainant´s trademarks as to the source, sponsorship, affiliation, or endorsement of such websites.

Given the distinctive nature of the DANIEL WELLINTON mark, it is inconceivable that the Respondent registered the Disputed Domain Name without prior knowledge of the Complainant and the Complainant's mark. -The Respondent is not using the Disputed Domain Name in good faith– instead it has used the Disputed Domain Name to set up a fake website, mimicking the legitimate website of the Complainant. Registering and using the Disputed Domain Name to set up a website that copies the Complainant's website is a clear example of bad faith registration and use under 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.

The Parties should know that the Panellist is fluent in Russian language.
According to information provided by the Registrar the language of the Registration agreement is Russian.
The Panel agrees with the proposal of the Complainants request to change the language of proceeding to English. The main reason is that the Respondent would not be disadvantaged if the language of the proceeding is English, and is satisfied that using this language in this proceeding would be fair and efficient. Therefore, in exercise of its powers under paragraph 11 of the Rules, the Panel decides that the language of this administrative proceeding will be English. At the same time, the Panel will take into account the evidence in the case file that is in the Russian language.

PRINCIPAL REASONS FOR THE DECISION

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

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

ii. the Respondent has no rights or legitimate interests with respect to the disputed domain name; and

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

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain names, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant has clearly proven that it is a long standing and successful fashion industry company. It is clear that its trademarks and domain names “Daniel Wellington” are well-known.

The Complainant states that the Disputed Domain Name is confusingly similar to its trademark. Indeed, the trademark is incorporated in its entirety in the Disputed Domain Name.

The Disputed Domain Name is therefore deemed identical or confusingly similar.

b) It has to be stressed that it was proven that there are no fair rights of the Respondent to the Disputed Domain Name. The Respondent is not generally known by the disputed domain name and has not acquired any trademark or service mark rights in the name or mark.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the Disputed Domain Name.

c) The Disputed Domain Name was registered with an intention to attract customers of another well-known domain name/registered trademark holder. Therefore there cannot be seen any legitimate interest of the Respondent.

It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the Disputed Domain Name was registered and used. It is therefore concluded that the Disputed Domain Name was registered with an intention to attract customers of another well-known domain name/registered trademark holder.

The Panel therefore finds that the Disputed Domain Name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) 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.STORE**: Transferred

PANELLISTS

Name	**Dr. Vít Horáček**

DATE OF PANEL DECISION 2020-12-07

Publish the Decision