Decision for dispute CAC-UDRP-102054

Case number	CAC-UDRP-102054
Time of filing	2020-12-02 09:40:25
Domain names	todshopjp.com, todsclearanshop.com

Case administrator

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

Complainant

Organization	TOD'S S.P.A.

Complainant representative

Organization	Convey srl

Respondent

Name	shuo tina

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

TOD'S S.P.A. is the owner, among others, of the following trademark registrations related to "TOD'S" which enjoy protection in numerous countries and, inter alia, in China:

- Word mark "TOD'S", European Office for Intellectual Property (EUIPO), Registration No. 10158889, registered on December 29, 2012;

- Word mark "TOD'S", European Office for Intellectual Property (EUIPO), Registration No. 407031, registered on September 13, 2004 and duly renewed;

- Word-/design mark "TOD'S", World Intellectual Property Organization (WIPO), Registration No. 1006548, registered on June 1, 2009 and duly renewed;

- Word-/design mark "TOD'S", World Intellectual Property Organization (WIPO), Registration No. 858452, registered on May 20, 2005 and duly renewed; and

- Word-/design mark "TOD'S", Australian Trademark Office, Registration No. 1117869, registered on April 2, 2012.

FACTUAL BACKGROUND

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

1) TOD'S S.P.A. (hereinafter referred to as the Complainant) submits that despite some minor differences in the details provided in the official WHOIS records for the two domains included in the complaint, the domains should be considered to be under common control. This also in consideration of the fact that there are substantial commonalities in the web sites to whom the disputed domain names resolved.

2) The Complainant declares to be the operating holding of a Group, amongst the leading players in the world of luxury goods, with the trademarks Tod's, Hogan, Fay and Roger Vivier with about 4.600 employees worldwide. Furthermore, the Complainant informs to have numerous stores around the world, including showrooms and large flagship stores in Europe, the U.S., China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia.

3) According to the Complainant, the high standard of quality met by the products is guaranteed by the strong craftsmanship involved in every and each phase of the production: every product is handmade, crafted with techniques of the highest skilled handcraftsmanship. The Complainant also informs that the 2019 Annual revenues of Tod’s Group were almost 920 million of Euros of which 50% came from the trademark "TOD’S".

4) The Complainant has duly proved to be the owner of the registered well-known trademark "TOD'S" as a word and figure mark in several classes in numerous countries all over the word including in China, where the Respondent is located and that these trademark registrations long predate the registration of the disputed domain names (<todshopjp.com> on February 24, 2020 and <todsclearanshop.com> on March 9, 2020>).

5) The Complainant has registered a number of domain names containing the wording TOD'S (considering that due to technical limitations the apostrophe cannot be included in domain names), for example <tods.com>, <todsgroup.com> <tods.it>, <tods.net>, <tods.us>, <tods.cn>. Furthermore, the Complainant has, and extensively uses, official accounts on the major social networks such as Instagram, Facebook, YouTube, WeChat and Pinterest.

6) Before the commencement of this proceedings, on November 18, 2020, the Complainant made an attempt to contact the owners of the disputed domain names through a cease and desist letter sent to the domain name owners known e-mail addresses indicated at that time in the WhoIs records and in the websites; the addresses have simply disregarded said communication.

7) According to the Complainant, the domain names in dispute are similar to its "TOD'S" trademark. Actually, in both cases the domain names incorporate the Complainant’s "TOD’S" trademark in its entirety with the mere adding of non-distinctive elements such as the geographical indicator “jp” (for Japan), the words “shop” and “clearance”, and the generic Top Level Domains ".com".

8) The Complainant informs that the Respondent is not a licensee or an authorized agent of the Complainant and that it is not authorized to use the Complainant’s trademark. Furthermore, the Complainant has not found that the Respondent is commonly known by the disputed domain names or that it has any protectable interest over the domain names in dispute.

9) The Complainant argues that by virtue of its extensive worldwide use, the Complainant’s trademark "TOD’S" has become a well-known trademark in the sector of luxury goods. Therefore, it is clear, in the Complainant's view, that the Respondent was well aware of the trademark "TOD’S" and registered the disputed domain names with the intention to refer to the Complainant and its trademark "TOD'S".

10) According to the Complainant, the use of the disputed domain names in connection with commercial websites where the Complainant’s trademark is misappropriated and counterfeit "TOD’S" branded goods are offered for sale clearly indicates

that the Respondent purpose in registering the disputed domain names was to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking "TOD'S" products to their websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said websites.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

A. Consolidation of Respondents

According to Article 3(c) of Rules for Uniform Domain Name Dispute Resolution Policy ("Rules"), the Complaint may relate to more than one domain name, provided that the disputed domain names are registered by the same domain-name holder. According to Article 10(e) of Rules a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

The whois details for <todshopjp.com> domain are as follows:

Registrar: Dynadot
Registrant Name: shuo tina
E-mail address: saletoshop@163.com
Phone Number: 86.18606905216
Address Line 1: No. 28 Andingmen East Street
Address Line 2: Dongcheng District, Beijing
Registrant City: Bejing
Registrant State/Province: DongCheng
Registrant Postal Code: 100000

The whois details for <todsclearanshop.com> domain are as follows:

Registrar: Dynadot
Registrant Name: tina nono
E-mail address: servicestore@163.com

Phone Number: 376.18606905710
Address Line 1: No. 28 Andingmen East Street
Address Line 2: Dongcheng District, Beijing
Registrant City: Bejing
Registrant State/Province: DongCheng
Registrant Postal Code: 100000

Although the names of the disputed domain name registrants are different (even if they share the common female name Tina), the Panel is convinced that one single person controls both the disputed domain names since (i) the official address for both domains is identical, (ii) in both cases is used 163.com provider for the email addresses and (iii) considering that the websites connected to the domain names not only share the same objective (offering for sale alleged "TOD'S" goods) but also present identical layouts and graphic features.

The Panel therefore accepts the Complainant's request to address all the disputed domain names in one case under the Rules, paragraphs 10(e) and 3(c). Accordingly, the Respondents will be collectively referred to as the "Respondent" hereinafter.

The Panel outlines that in previous cases a similar decision was taken (please see Philip Morris USA Inc. v. Domain Administrator, Eastern Valley Limited / Domain Administrator, China Capital Investment Limited – WIPO Case No. D2017-1978, Cephalon Inc v. Alen Mironassyan, Vesju Pere, Michael Thornton, Mike Bento – CAC Case No. 100892, Pandora A/S v. Larry Sack and ot. - CAC Case No.103259, TOD'S S.p.A. v. Athena Reynolds – CAC Case No. 102892, TOD'S S.p.A. v. – CAC Case No.102869).

B. Material Requirements of the Policy

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

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

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

1a) <todshopjp.com>

The Complainant has demonstrated rights through registration and use on the "TOD'S" trademark. The Panel finds that the disputed domain name <todshopjp.com> is confusingly similar with the "TOD'S" trademark of the Complainant. Actually the disputed domain name incorporates the said trademark of the Complainant in its entirety (as correctly pointed out by the Complainant the omission of the apostrophe depends only to technical reasons due to the limited characters available in domain names). This is sufficient to establish confusing similarity (Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525). The word “shop” which is added in the disputed domain name does not avoid a finding of confusing similarity as it is a descriptive, non-distinctive term, denoting the operation of the website as an online shop (Accenture Global Services Limited v. Jean Jacque / Luck Loic, WIPO Case No. D2016-1315; Wragge Lawrence Graham & Co LLP v. Registration Private, Domains by Proxy LLC / Ian Piggin, WIPO Case No. D2015-0135). The fact that the first letter “s” of the “shop” part of the disputed domain name is also the last letter “s” of the “tods” part of the disputed domain name does not avoid a finding of confusing similarity either, as both wording “tods” and “shop” remain distinctly recognizable within the disputed domain name (Philip Morris Products S.A. v. Richard Chen, heatshop, WIPO Case No.

D2018-2537). The word “jp” which is added in the disputed domain name is disregarded as it is a geographic, non-distinctive term (BHP Billiton Innovation Pty Ltd v. Oloyi, WIPO Case No. D2017-0284, Accenture Global Services Limited v. Jean Jacque / Luck Loic, WIPO Case No. D2016-1315; Wragge Lawrence Graham & Co LLP v. Registration Private, Domains by Proxy LLC / Ian Piggin, WIPO Case No. D2015-0135). The generic Top-Level Domain (“gTLD”) “.com” is also disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons only (Rexel Developpements SAS v. Zhan Yequn, WIPO Case No. D2017-0275; Hay & Robertson InternationalLicensing AG v. C. J. Lovik, WIPO Case No. D2002-0122). Therefore, the Panel finds that the disputed domain name <todshopjp.com> is confusingly similar to the "TOD'S" trademark of the Complainant.

1b) <todsclearanshop.com>

As seen above, the Complainant has demonstrated rights through registration and use on the "TOD'S" trademark. The Panel finds that also the disputed domain name <todsclearanshop.com> is confusingly similar with the "TOD'S" trademark of the Complainant. Actually, even in this case, the disputed domain name incorporates the said trademark of the Complainant in its entirety and it is per se sufficient to establish confusing similarity. As seen above, the addition of the term “shop” does not prevent a finding of confusing similarity between the disputed domain name and the "TOD'S" trademark while, as a mere technical part of the disputed domain name, the gTLD “.com” may be disregarded in determining confusing similarity. The additional element "clearan", in the context of the disputed domain name clearly stands for "clearance". In this perspective it is important to consider that the addition of the above descriptive word does not serve in any way to distinguish the disputed domain name from the Complainant's trademark or lessen the likelihood that Internet users will be confused by the similarity. In fact because of the connotation associated with the word "clearance", implying the selling off of overstocked, old or otherwise unwanted inventory, the combination of the element "clearan" (especially because followed by the term "shop") with the Complainant's mark "TOD'S" increases the likelihood that Internet users will associate the disputed domain name with the Complainant's mark and therefore also increase confusing character of the disputed domain name (Swarovski Aktiengesellschaft v. swarovskiclearance.com swarovskiclearance.com, WIPO Case No. D2014-0857).

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights. The Complainant therefore succeds on the first element of the Policy.

2) The Complainant demonstrated that the websites to which the disputed domain names are linked allegedly offer for sale authentic merchandise bearing the "TOD'S" trademark. The Complainant clearly considers that Respondent has the hope and the expectation that Internet users looking for the brand "TOD'S" will be directed to the websites corresponding to the disputed domain names. The Panel finds that said activity, of course, does not provide a legitimate interest in the disputed domain names under the Policy. Furthermore, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain names as it is not commonly known under the disputed domain names and was never authorized to use the "TOD'S" trademark by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain names. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such

conduct; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Respondent registered the disputed domain names years after the use and registration of the "TOD'S" mark by the Complainant. In consideration of the reputation achieved by "TOD'S" it is clear that the Respondent was surely aware of the Complainant's trademark when he registered the domain names in dispute. Moreover, the Respondent appears to have attempted to benefit commercially from the appropriation of the "TOD'S" mark in the disputed domain names. The use of the famous mark "TOD'S", which is well-known worldwide in the fashion sector, for selling fashion items, clearly indicates that the disputed domain names were chosen by the Respondent to take advantage of the Complainant's mark reputation. This finding leads to the obvious conclusion that the disputed domain names have been registered in bad faith (Research In Motion Limited v. Privacy Locked LLC/Nat Collicot - WIPO Case No. D2009-0320; The Gap, Inc. v. Deng Youqian - WIPO Case No. D2009-0113; AXA S.A. v. P.A. van der Wees - WIPO Case No. D2009-0206; BHP Billiton Innovation v. Ravindra Bala - WIPO Case No. D2008-1059).

The Panel also finds that, by linking the disputed domain names to websites offering for sale alleged "TOD'S" items, the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain, by causing a likelihood of confusion with the trademark "TOD'S" as to the source, sponsorship, affiliation or endorsement of its websites and the products promoted therein.

Furthermore, the Respondent has ignored Complainant's attempt to resolve this dispute outside of this administrative proceeding by refusing to answer the cease and desist letters. Past UDRP panels have held that failure to respond to a cease and desist letter may properly be considered a factor in finding bad faith (see, for instance, Encyclopedia Britannica v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330 and RRI Financial, Inc., v. Chen, WIPO Case No. D2001-1242).

As the conduct described above clearly falls within paragraph 4(b)(iv) of the Policy (Triumph International Vietnam Ltd v. Tran Quoc Huy - WIPO Case No. D2017-0340), the Panel concludes that the Respondent registered and is using the disputed domain names in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TODSHOPJP.COM**: Transferred
2. **TODSCLEARANSHOP.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2021-01-07