

Decision for dispute CAC-UDRP-103636

Case number	CAC-UDRP-103636
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Time of filing	2021-03-04 00:00:00
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Domain names	danielwellington.top
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Daniel Wellington AB
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Complainant representative

Organization	SILKA AB
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Respondent

Name	QUYUJUN QUYUJUN
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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

The Complainant is the owner of the registered trademark DANIEL WELLINGTON as a word mark in numerous countries all over the world. For example the International Trademark registration with registration no. 1135742 registered on July 3, 2012. The 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 names registrations.

The Complainant has also registered several domain names, under various Top-Level Domains, containing the term “danielwellington”, for example, <danielwellington.com> (created on February 16, 2011) <danielwellington.asia> (created May 30, 2013).

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:**About Complainant**

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.

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. The 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 names registrations.

The Complainant has also significant presence on various social media platforms, such as Facebook, Youtube, Instagram, Pinterest and Twitter.

The Complainant has also registered several domain names, under various Top-Level Domains, containing the term "danielwellington" see for example, <danielwellington.com> (created on February 16, 2011) <danielwellington.asia> (created May 30, 2013).

A. Identical or confusingly similar

The disputed domain names incorporate the DANIEL WELLINGTON mark in its entirety. The addition of the generic words 'verify' and "acc" is insufficient to dispel the confusing similarity, 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 (gtlds) ".com" and ".top" does not add any distinctiveness to the disputed domain names. Based on the foregoing, the Complainant has demonstrated that the disputed domain names are 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.

B. Respondent has no rights or legitimate interests in respect of the disputed domain names (Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

First of all, there is no bona fide offering of goods or services since the disputed domain names incorporate a trademark which is not owned by the Respondent. Nor is the Respondent known by the name "Daniel Wellington". The Respondent is currently masked for the second domain name. The purpose of the disputed domain names is to induce consumers into visiting a website under the misapprehension that the website is endorsed by Complainant where Complainant's customer can enter serial number to verify their time pieces. Previously the websites had an identical layout but the <verifydanielwellington.com> domain name has changed into a Pay Per Click website. The Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the disputed domain names 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 names or any similar name or made demonstrable preparations to use the disputed domain names in connection with a bona fide offering of goods or services or for a legitimate, non-commercial use. In fact, on both websites the layout had the appearance of an official Daniel Wellington website whereby a customer could verify its serial number on the watch. The serial number is still requested on the ".top" website where the customer has to add the serial number to continue.

C. The disputed domain names were registered and are being used in bad faith

Registered in bad faith:

Given the distinctive nature of the DANIEL WELLINGTON mark, it is inconceivable that the Respondent registered the disputed domain names without prior knowledge of the Complainant and the Complainant's mark. Further, the Respondent could not have been unaware of the fact that it chose a domain name, which based on its composition could attract internet users in a manner that is likely to create confusion for such users. The Complainant has their own verification page under the official page <https://verify.danielwellington.com/>. It is evident that the disputed domain names are taking advantage of the official verification page.

As previously mentioned, the <verifydanielwellington.com> resolves to a Pay Per Click website at the moment with links to e.g. a competitor. There is nothing preventing the owner from re-activating the verify page at any time as the Respondent has ultimate control over the website.

To summarize, DANIEL WELLINGTON is a well-known trademark in the fashion industry. It is highly unlikely that Respondent was not at the point of the disputed domain names registrations 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 names coupled with the associated term 'verify' has no other meaning except for referring to Complainant's name and trademark and there is no way in which the disputed domain names could be used legitimately under the current circumstances. Consequently, the Respondent should be considered to have registered and to be using the disputed domain names 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).

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

Request for Consolidation:

Since the Complaint in the present case has been amended to include three distinct domain names, the Panel first moves to discuss the Complainant's consolidation request.

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. Therefore, the decision for the Panel to make is that whether the three disputed domain names in the present case are registered by the same holder. In the request to consolidate, the Complainant submits that evidence including "the registrants reside in China", "all three websites used to be identical in the layout", "registrants use a qq.com email address" and "registrants have email addresses consisting numeral numbers" to prove that the disputed domain names are held by the same party. The Panel disagrees. Records submitted by the three registrars show that registrants of <danielwellington.top>, <verifydanielwellington.com> and <danielwellinggacc.com> have distinct names, addresses, email addresses and phone numbers. There are no apparent connections among these identifiers. The disputed domain names were also registered on December 9, 2019, January 20, 2020 and March 17, 2020 separately. There is no

apparent connection among these registration dates that are apart from each other. Generally, qq.com emails are popular among Chinese speakers residing in China. Qq.com emails are by default based on QQ user IDs, which are distinct numeral numbers. These submitted evidence are not sufficient to allow a finding that the registrants of the three disputed domain names are the same. Therefore, the Panel denies the Complainant's Request for consolidation and this decision is issued regarding the complaint concerning <danielwellington.top> only.

Request for Change of Languages:

The Complainant requests that the language of this administrative proceeding be English pursuant to UDRP Rule 11(a): 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. Complainant makes this request in light of the potential Chinese language Registration Agreement of the disputed domain name involved at this Complaint.

Paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios were summarized into WIPO Jurisprudential Overview 3.0, 4.5.1. In this particular instance, the Complainant tried to request change of languages of proceedings in light of Chinese language Registration Agreement by showing that 1) disputed domain name <danielwellington.top> is formed in Latin characters and the Daniel Wellington trademark is a well-known international trademark; 2) the top-level domain name chosen ".top" targets non-Chinese speakers; 3) conducting the proceeding in languages other than Chinese would entail significant additional costs for the Complainant and unnecessarily burden the Complainant. Relevant decisions have been cited to support the Complainant's positions.

In light of the scenarios and equity, the Panel is of the view that conducting the proceeding in English is unlikely to heavily burden the Respondent, and it is likely that the Respondent can understand the English language based on a preponderance of evidence test. Without further objection from the Respondent on the issue, the Panel will proceed to issue the decision in English.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or confusingly similar

The Complainant contended that the disputed domain names <danielwellington.top> registered by QUYUJUN QUYUJUN are identical and or confusingly similar to its DANIEL WELLINGTON registered trademark. The Complainant Daniel Wellington AB was founded in 2011 and established itself as one of the fastest growing brands in the industry. Complainant is the owner of the registered trademark DANIEL WELLINGTON as a word mark in numerous countries all over the world.

The disputed domain name fully incorporates the Complainant's trademark. It is well established that the addition of a top-level domain would not change the determination that the dispute domain name is identical to the Complainant's trademark.

According to WIPO Overview 3.0 §1.11.1, "the applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".top") is viewed as a standard registration requirement and as such is disregarded under the first element confusion similarity test".

According to WIPO Overview 3.0 §1.11.2, "the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element." Here, the use of the new gTLD ".top" and the gTLD ".com" should not impact the assessment of the identity or confusing similarity within the meaning of paragraph 4(a)(i) of the Policy.

The Panel therefore concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the Respondent's contact details shown, there seems to be no evidence that Respondent is either commonly known by the names "DANIEL WELLINGTON" or in any way affiliated with Complainant. There is no evidence suggests that the Respondent is in any way associated with the name "danielwellington" and "danielwellingtontop". The Complainant also contended that it does not carry out any activity for, nor has any business with the Respondent. It has never licensed nor authorized the Respondent to make any use of the Complainant's trademark.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

There are a couple of instances cited by the Complainant that can be used to prove that the domain name is registered and used in bad faith.

As far as registration goes, UDRP Panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

“danielwellington” is associated with the Complainant’s distinctive and well-known brand and is not otherwise used commonly in the English language. A simple Google search reveals all results and references related to the Complainant’s brand. The fact that the Respondent has registered a domain name is registered long after the Complainant’s trademark became known.

In addition, the Respondent chose to register disputed domain names which resolves to a website that allows Daniel Wellington consumers to submit product serial numbers and safety codes for verification purposes, creating a confusion with the complainant’s brand. The Complainant has its own verification page under the official page <https://verify.danielwellington.com>. By creating a confusingly similar verification website under the <danielwellinton.top> and using it for non-legitimate business purposes, it might divert the Complainant’s existing consumers, tarnish the brand of the Complainant’s, and/or harm interests of Daniel Wellington consumers in other non-explicit ways.

In view of the above, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **DANIELWELLINGTON.TOP**: Transferred
2. **VERIFYDANIELWELLINGTON.COM**: Remaining with the Respondent
3. **DANIELWELLINGACC.COM**: Remaining with the Respondent

PANELLISTS

Name	Carrie Shang
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DATE OF PANEL DECISION	2021-04-20
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Publish the Decision
