

Decision for dispute CAC-UDRP-103837

Case number CAC-UDRP-103837

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Domain names danielwellington.online

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Daniel Wellington AB

Complainant representative

Organization SILKA AB

Respondent

Name Vu Duc Long

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of an international portfolio of trademark registrations including the following: International Trademark DANIEL WELLINGTON registration number 1135742 registered on July 3, 2012 for goods and services in international classes 9, 14 and 35, designating numerous jurisdictions under the Madrid Protocol including Vietnam where the registrant of the disputed domain name purports to have an address. International Trademark DANIEL WELLINGTON (figurative) registration number 1260501 registered on March 3, 2015 goods and services in international classes 9, 14, 18, 25, 35 also designating numerous jurisdictions under the Madrid Protocol including Vietnam where the registrant of the disputed domain name purports to have an address. Furthermore, the Complainant has rights established at common law by its extensive use of the mark in its international business manufacturing and selling watches including on the Internet.

FACTUAL BACKGROUND

The Complainant is a manufacturer of timepieces on which it uses the DANIEL WELLINGTON trademark and is the owner of the portfolio of trademark registrations identified above.

The Complainant also incorporates the DANIEL WELLINGTON mark as part of its company name and has an established

Internet presence using its domain names <danielwellington.com> (created on February 16, 2011), <danielwellington.vn> (created on July 2 2015), <danielwellington.asia> (created May 30, 2013), <dwwatch.shop> (created September 22, 2016). The disputed domain name <danielwellington.online> was registered on August 24, 2020 and resolves to a website that purports to offer watches for sale.

There is no information available about the Respondent except for that provided in the Complaint, the Registrar's WhoIs and information provided by the Registrar in response to the enquiry from the CAC seeking confirmation details of the registration of the disputed domain name for the purposes of this Complaint.

The Respondent is the registrant of the disputed domain name. The Respondent availed of a privacy service to conceal his/her/its name on the published WhoIs and the identity of the registrant was disclosed by the Registrar to the CAC in the course of this proceeding.

The only information available about the Respondent, is that which is provided in the Complaint, the Registrar's WhoIs, and the information provided by the Registrar in response to the request from the CAC for verification of the registration details of the disputed domain name. The Registrar's WhoIs confirms that the Respondent is the registrant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims rights in the DANIEL WELLINGTON mark established by its ownership of the trademark and service mark registrations set out below. In addition, the Complainant submits that it has established rights and goodwill in the mark through its use in its business since it was founded in 2011 becoming one of the fastest growing brands in the industry with 4,9 million followers on Instagram.

The Complainant alleges that the disputed domain <danielwellington.online> is identical to the Complainant's DANIEL WELLINGTON mark as it comprises the Complainant's trademark in its entirety with the mere addition of the generic Top-Level Domain (" gTLD ") extension <.online>.

The Complainant submits that the gTLD extension <.online> may be disregarded for the purposes of comparing the disputed domain name with the Complainant's mark, consistent with the practice of panels established under the Policy.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name because the disputed domain name incorporates a trademark which is not owned by the Respondent, nor is the Respondent known by the name "Daniel Wellington".

Additionally the Complainant argues that the Respondent is not using the disputed domain name to make any bona fide offering of goods or services .

Referring to a screenshot submitted in an annexe to the Complaint the Complainant submits that the purpose of the registration of the disputed domain name is to induce consumers into visiting the website to which it resolves creating the misapprehension that the website is endorsed by the Complainant and/or used by the Complainant to offers its watches for sale.

The Complainant argues that the screenshot shows that the disputed domain name resolves to a replica of the Complainant's genuine website at <www.danielwellington.com>. The Respondent's website not only incorporates elements of the Complainant's branding, i.e., the Complainant's trademark, but it also offers for sale goods which are highly similar to the products offered by the Complainant on its genuine website.

The Complainant contends that the Respondent is therefore using the disputed domain name with intent for commercial gain and misleadingly to divert consumers and such use is also intended to tarnish the trademark at hand.

The Complainant further submits that there is no evidence to suggest that Respondent bears any relationship to the trademark and argues that the disputed domain names coupled with their content of the website to which it resolves have no other meaning than as a reference to the Complainant's name and trademarks. There is no way in which the disputed domain names could be used legitimately under the current circumstances.

The Complainant also alleges that the disputed domain name was registered in bad faith arguing that the disputed domain name resolves to a website which flagrantly seeks to imitate that of the Complainant and therefore it is clear that the Respondent registered the disputed domain name with full knowledge of the Complainant's business. The active business presence of the Complainant in Vietnam, where the Respondent purports to be established with his website at

www.danielwellington.com, also makes it unlikely that the Respondent was unaware that the registration of the disputed domain name was unlawful. It is evident from the screen captures that have been adducing evidence that the Respondent registered the disputed domain name only due to the fame of the Complainant's DANIEL WELLINGTON mark.

The Complainant further contends that the behavior of the Respondent is disrupting the business of the Complainant adding that the Respondent is purporting to be the Complainant, while on its website it is purporting to sell DANIEL WELLINGTON branded products which are not authorized by the Complainant.

The Complainant adds that the disputed domain name is been used in bad faith because the evidence in the case demonstrates that the Respondent is not only using the Complainant's trademark on the website but also displays the same look and feel as that of the Complainant's website. The logotype, the pictures and the layout of the Respondent's website clearly resemble that of the Complainant's own main website.

Noting that the Respondent is using a privacy shield, the Complainant contends that although the use of a privacy or proxy registration service is not in itself an indication of bad faith, the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith. In this instance these are the proxy servers have increased the difficulties of the Complainant in identifying the Respondent, which does not reflect good faith.

RESPONDENT: 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 has provided clear, convincing and uncontested evidence that it has rights in the DANIEL WELLINGTON mark established by its ownership of the trademark and service mark registrations set out above. In addition, the Complainant has shown that it has established rights and goodwill in the mark through its extensive use in its watches business since it was founded in 2011 becoming one of the fastest growing brands in the industry with 4,9 million followers on Instagram.

The disputed domain name consists of only the Complainant's DANIEL WELLINGTON mark in combination with the gTLD <.online> extension.

The Complainant's DANIEL WELLINGTON mark is the only distinctive element in the disputed domain name as the gTLD <.online> extension may be ignored, because in the circumstances of this Complaint, on the balance of probabilities, it would be recognized as a technical necessity for a domain name and serves no other purpose or meaning in the context.

This Panel finds therefore that the disputed domain name is confusingly similar to the DANIEL WELLINGTON mark in which the Complainant has rights.

The Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i)

The Complainant has made out an uncontested prima facie case that Respondent has no rights or legitimate interests in the disputed domain name because

- the disputed domain name incorporates a trademark which is not owned by the Respondent;
- the Respondent known by the name "Daniel Wellington";
- the Respondent is not using the disputed domain name to make any bona fide offering of goods or services;
- the screen capture of the website to which the disputed domain name resolves which has been submitted in an annex to the Complaint shows that the purpose of the registration of the disputed domain name is to create the misapprehension that the website is endorsed by the Complainant and/or used by the Complainant to offers its watches for sale;
- the screen capture also shows that the disputed domain name resolves to a replica of the Complainant's genuine website at <www.danielwellington.com>;
- the Respondent's website incorporates elements of the Complainant's branding, i.e., the Complainant's trademark, and also offers for sale goods which Are highly similar to the products offered by the Complainant on its genuine website;
- the evidence shows therefore that the Respondent is using the disputed domain name with intent for commercial gain and misleadingly to divert consumers and such use is also intended to tarnish the trademark at hand;
- there is no evidence to suggest that Respondent bears any relationship to the trademark;
- the disputed domain name coupled with the content of the website to which it resolves have no other meaning than as a reference to the Complainant's name and trademarks; and
- there is no way in which the disputed domain name could be used legitimately under the current circumstances.

It is well established that, as in this case, once a complainant makes out a prima facie case that the respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts the respondent to prove such rights or interests.

The Respondent has failed to discharge the burden of production in this proceeding. This Panel must therefore find that on the balance of probabilities, the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

The Complainant has satisfied this Panel that on the balance of probabilities the disputed domain name was registered in bad faith because it is composed of the Complainant's distinctive trademark in its entirety, with no other elements. DANIEL WELLINGTON is a distinctive mark and while it is not impossible that there are people known by that name, the use to which the Respondent has put the disputed domain name is the address of a website offering watches for sale so that on the balance of probabilities the registrant of the disputed domain name was aware of the Complainant, its name, mark, reputation, goodwill, and website, and the disputed domain name was chosen and registered. Therefore, on the balance of probabilities, the disputed domain name was registered in bad faith with the Complainant's mark in mind with the intention of taking predatory advantage of the Complainant, and its goodwill.

Additionally, the Complainant has satisfied this Panel that on the balance of probabilities the disputed domain name is being used in bad faith because the uncontested evidence indicates that the disputed domain name is being used by the Respondent as the address of a website on which the Respondent is purporting to create impression that the website, is associated in some way with the Complainant.

The unauthorized use of the Complainant's mark in the disputed domain name itself and on the website to which it resolves, proves on the balance of probabilities that the Respondent is using the disputed domain name in bad faith by engaging in an intentional attempt to attract, for commercial gain, Internet users to his web site by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site.

As this Panel has found that on the balance of probabilities the disputed domain name was registered and is being used in bad faith. The Complainant has therefore succeeded in the third and final element of the test in Policy paragraph 4(a)(iii) and is entitled to succeed in its application for transfer of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. DANIELWELLINGTON.ONLINE: Transferred
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PANELLISTS

Name	Mr James Jude Bridgeman
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DATE OF PANEL DECISION 2021-06-27

Publish the Decision
