

Decision for dispute CAC-UDRP-103839

Case number CAC-UDRP-103839

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Domain names hoganscarpa.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 Wei Xifeng

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 has started its business since early 1900 in Italy and is the owner of the HOGAN trademark including but not limited to the followings:

- International Trademark n° 1014830 – HOGAN – Cl. 09, 18, 25
- International Trademark n° 1078778 – HOGAN REBEL - Cl. 09,18,25
- International Trademark n° 1014831 – HOGAN - Cl 09,18,25
- International Trademark n° 774193 – HOGAN - Cl. 3, 9, 18, 25
- International Trademark n° 1129649 – HOGAN - Cl. 3, 9, 18, 25
- European Union Trademark n° 005184536 – HOGAN - Cl. 3, 9, 18, 25, 35

Furthermore, the Complainant has been extensively using the “HOGAN” denomination on all internet environments including and not limited to Complainant's official website <https://www.hogan.com> – among which are <hogan.it>, <hogan.fr>, <hogan.eu>, <hogan.cn> - and its official accounts on the major social networks such as Instagram (more than 440,000 followers), Facebook (1.1 million of follows) , Youtube, WeChat and Pinterest.

FACTUAL BACKGROUND

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

The Complainant, Tod's SpA, is a company with headquarters in Sant'Elpidio al Mare, FM (ITALY). The Complainant has its roots in the early 1900. The company was renamed to J. P. Tod's in the late 70's and the J.P. was dropped in 1997. Tod's first success came with the Gommino driving shoe, which has gummy little rubber pebbles on the soles. In few years the production was expanded to the bags and in 1997 the D-Bag was launched becoming in few years an iconic model. Currently the company actively designs a wide range of luxury products such as shoes, bags and women accessories distributed all around the world via the official website and through more than 60 prestigious Boutiques. In 2018, the annual revenues of the Complainant were almost EUR 950 million of which 22% came from the trademark HOGAN.

The Complainant has 4,600 employees worldwide and 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. It has been listed in the Milan Stock Exchange since 2000.

The Complainant has served a Cease and Desist letter on April 23, 2021 to Respondent's known e-mail address indicated at that time in the website. The Respondent did not deem appropriate to answer.

The Registration Date of the disputed domain name is June 18, 2020.

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).

First, the Complainant claims rights in the HOGAN mark through its trademark registration. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

Second, the Complaint claims that the industrial related descriptive term “scarpa” (Italian translation for shoe) do not distinguish the disputed domain name from Complainant's HOGAN trademark. In addition, the “.com” generic top-level domain (“gTLD”) is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) (“The Panel finds that the

Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant claims that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name. In addition, the Complainant further claims that the Respondent is not commonly known by the disputed domain name as individuals, business or other organization and their family names do not correspond to HOGAN or the disputed domain name.

Second, the Complainant argues that Respondent is using the disputed domain name to pass off as Complainant in order to offer what appear to be counterfeits of Complainant's goods. Using a confusingly similar domain name to pass off as a complainant and offer counterfeit products evince a failure to make a bona fide offering of goods or services or a legitimate non-commercial or fair use. See *Philipp Plein v. Leno Trade Company*, 102184 (CAC 2018-11-19) and *ROGER VIVIER S.P.A. v. linannan*, 103788 (CAC 2021-06-08). Complainant has provided a screenshot of the resolving website, which displays the HOGAN mark and various images of shoes for sale. The Complainant also provides a screenshot of its own website for comparison purposes. The Complainant alleges that the goods offered on Respondent's website are counterfeit given the heavily discounted prices. Accordingly, the Panel finds that Respondent attempts to pass off as Complainant to offer counterfeit goods, failing to use the domain name in connection with a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant argues that Respondent had actual knowledge of Complainant's rights in the HOGAN mark at the time of registering the disputed domain name. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name evinces bad faith under paragraph 4(a)(iii) of the Policy. See *ARCELORMITTAL (SA) v. acero*, 102399 (CAC 2019-04-22). Complainant contends that Respondent's knowledge can be inferred given the HOGAN mark was promoted and publicized in China where the Respondent is domiciled, and as shown by Respondent's attempts to pass off as Complainant on the resolving website. The Panel also notes that the disputed domain name was registered almost 20 years after the registration of Complainant's HOGAN trademark. The Panel agrees with Complainant and finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration under Policy paragraph 4(a)(iii).

Second, the Complainant asserts that the Respondent disrupts Complainant's business by diverting potential customers to its site selling competing goods. Using a confusingly similar domain name in a manner disruptive of a complainant's business by trading upon the goodwill of a complainant for commercial gain evinces bad faith under paragraph 4(b)(iii) & (iv) of the Policy. See *Intesa Sanpaolo S.p.A. v. Abayomi Ajileye*, 102396 (CAC 2019-04-25) and *ROGER VIVIER S.P.A. v. linannan*, 103788 (CAC 2021-06-08). Complainant has provided a screenshot of the resolving website, which displays the HOGAN mark and various images of shoes for sale. Complainant also provides a screenshot of its own website for comparison purposes. Complainant alleges that the goods offered on Respondent's website are counterfeit given the heavily discounted prices. Accordingly, the Panel agrees that Respondent disrupts Complainant's business and attempted to commercially benefit off Complainant's mark in bad faith under paragraph 4(b)(iii) & (iv) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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.

PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreement is Chinese as confirmed by the Registrar. The official Complaint was submitted in English and no Response was received within the required period of time. Pursuant to paragraph 11 of the Rules, 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.

The Complainant requests to use English as the language of proceeding, with the arguments that the disputed domain name is registered in Latin characters, the website resolved by the disputed domain name was in Italian instead of Chinese language, and English is the primary language for business and international relationship.

The Panel is bilingual and is well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances, Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied, and decides that the language of proceeding to be English.

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. HOGANSCARPA.COM: Transferred
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PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION 2021-06-28

Publish the Decision
