

Decision for dispute CAC-UDRP-103884

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| Case number | CAC-UDRP-103884 |
| Time of filing | 2021-06-24 09:58:01 |
| Domain names | pandora-discount.com, sale-pandora.com, italia-pandora.com, outlet-jewelry-pandora.com, pandorajewelrycharm.com, pandora-sale-off.com, pandora-online.net, pandorashopsale.com, tiendapandoraonline.com, lessoldespandora.com, pandora-store-outlet.com, bijouxpandorafrance.com, pandorfrance.com, pandordisney.com, pansoldes.com, pandora-store-outlet.net, pandora-outlet-it.com, pandora-outlet-italian.com, pandora-it-outlet.com |

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

Organization **Pandora A/S**

Complainant representative

Organization **Coöperatieve Vereniging SNB-REACT U.A.**

Respondent

Name **"Wang" "Fei"**

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 several registered trademarks around the world.

In this proceeding the Complainant indicates the following trademark registrations:

- 1) EUTM No.3397858 in class 14 with priority date from 18 April 2007 for PANDORA (word mark).
- 2) EUTM No. 006646491 in classes 14, 18 and 25 with priority date from 21 January 2009 for PANDORA (word mark).
- 3) WIPO int. registration No. 0979859 in classes 9, 14, 18 and 25 with priority date from 17 September 2008 for PANDORA (figurative mark).
- 4) EUTM No. 0979859 in classes 9, 14, 18 and 25 with priority date from 17 September 2008 for PANDORA (figurative mark – designation of the WIPO int. registration No. 0979859).
- 5) WIPO int. registration No. 1004640 in classes 3, 9, 14 and 35 with priority date from 20 February 2009 for PANDORA (word

mark).

6) EUTM No. 1004640 in classes 3, 9, 14 and 35 with priority date from 20 February 2009 for PANDORA (word mark – designation of the WIPO int. registration No. 1004640).

The Complainant owns also several domain names worldwide, among these is <pandora.net> – which has been registered since 2010.

FACTUAL BACKGROUND

Preliminary Procedural Issue: CONSOLIDATION OF MULTIPLE DOMAIN NAMES IN A SINGLE PROCEEDING

The Complainant relates to 19 domain names which he wishes to have dealt within a single administrative proceeding.

Paragraph 10(e) of the Rules states that a Panel decides a request by a party to consolidate multiple domain name disputes in accordance with the Policy and the Rules. Paragraph 4.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) states that in the case of complaints brought against more than one domain name, consolidation may be allowed where (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

Moreover, where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

The Complainant explains that it is appropriate to consolidate the present dispute of the 19 domain names as one common proceeding appears to be more efficient and equitable to all parties, providing that all the disputed domain names:

- have one Registrar, i.e. Name.com, Inc.;
- use the same identity shield, i.e. Registrant Organization: Doman Protection Services, Inc.;
- have the same hosting provider, i.e. Inter Connects Inc.;
- are hosted in the IP addresses between 107.150.162.243 and 107.150.162.254;
- were registered within almost one year with the same Registrant country, i.e. China;
- resolve to a substantially similar webpages which are connected to the same web host Sayfa.net (Turkish webhost); and
- mostly follow the same naming patterns (reference to the Complainant’s business name and trademarks + generic or descriptive element).

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

The Complainant Pandora A/S is a Danish Company that has marketed and sold its jewelry products under its business name “PANDORA” in more than 100 countries through more than 7.700 points of sale. As a result of a widespread distribution and promotion of the products, its registered trademark PANDORA enjoys a high degree of global recognition for jewelry and was previously declared by this court as a well-known trademark (see CAC Case 103231 <PANDORAEU.com>)

No information is known about the Respondent who registered 19 domain names in question containing or referring to the name PANDORA.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Identical or confusingly similar

The Complainant argues that the disputed domain names and the Complainant's registered trademarks are confusingly similar.

The Complainant argues that 16 of them contain the word "PANDORA" together with a descriptive/generic term (or terms), and the generic top level domain suffix .com.

The other 3 domain names contain the dominant element of the trademark: <pandordisney.com>, <pandorfrance.com>, and <pansoldes.com>.

According to the Complainant, the confusing similarity is increased by the content of the Respondent's websites, which all bear the PANDORA visual mark at the top.

No rights or legitimate interests

The Complainant argues that there is no evidence at all that the Respondent is commonly known by the disputed domain names or a name corresponding to the disputed domain names, nor that the Respondent is making a bona fide offering of goods or services. Moreover, the Complainant states that the Respondent has not been licensed or otherwise authorized to use any of the Complainant's trademarks nor to apply for or use any domain name incorporating such trade marks.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant states that the Respondent has engaged in a pattern of conduct where it has registered the disputed domain names in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain names and that by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web sites by creating a likelihood of confusion with the Complainant's registered trademarks PANDORA.

Finally, the Complainant underlines due to its worldwide presence and considering that the Complainant's trademarks are famous marks, it is difficult to conceive of any plausible legitimate future use of the disputed domain names by the Respondent.

RESPONDENT:

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to trademarks 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 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

Paragraph 15 of the Rules states that the Panel decides a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidences provided in support of them.

1. CONSOLIDATION REQUEST

The first issue in this case is whether the complaint can be consolidated against 19 domain names, as requested by the Complainant.

The Complainant argues that the complaint should be consolidated on the basis that the disputed domain names are under the control of a single individual or entity or, at least, are under the common management of a group of individuals acting in concert.

Moreover, according to the Complainant, the following elements cumulatively demonstrate, on balance, that consolidation of all the disputed domain names is possible:

- same Registrar, i.e. Name.com, Inc.;
- same identity shield, i.e. Registrant Organization: Doman Protection Services, Inc.;
- same hosting provider, i.e. Inter Connects Inc.;
- related IP addresses between 107.150.162.243 and 107.150.162.254 on which the web sites of all the disputed domain names are hosted;
- registration made within a similar time period and with the same Registrant country, i.e. China;
- substantially similar webpages on which all 19 domain names redirects and which are connected to the same Turkish web host Sayfa.net; and
- use of the same naming patterns.

The Panel accepts the Complainant's arguments and agrees that the similarities between the domain names in question and the overall circumstances of the case pointed out by the Complainant are sufficient enough to establish, on the balance of probabilities, that all 19 domain names are under the common control.

Taking into consideration all the above-mentioned factors in their conjunction, the Panel consider that the consolidation represents procedurally more efficient solution of this case for both parties.

Based on the above mentioned, the Panel determines that the dispute in respect of the domain names:

pandora-discount.com
sale-pandora.com
italia-pandora.com
outlet-jewelry-pandora.com

pandorajewelrycharm.com
pandora-sale-off.com
pandora-online.net
pandorashopsale.com
tiendapandoraonline.com
lessoldespandora.com
pandora-store-outlet.com
bijouxpandorafrance.com
pandorfrance.com
pandordisney.com
pansoldes.com
pandora-store-outlet.net
pandora-outlet-it.com
pandora-outlet-italian.com
pandora-it-outlet.com

can be consolidated within this proceeding.

2. TRADEMARK IDENTITY OR CONFUSINGLY SIMILARITY

The Complainant is owner of a considerable number of trademarks whose common distinctive element is a particle "PANDORA", which refers to a human woman in the Greek mythology who was created on the instructions of Zeus and which is therefore an arbitrary name for the goods for which the Complainant's trademarks are registered and used in the market (namely jewelry).

Besides the EU protection, the trademarks "PANDORA" have been registered by the Complainant in various non-EU countries, including in the country declared as the Respondent's origin, China.

The Panel finds that 16 of the disputed domain names, namely:

pandora-discount.com
sale-pandora.com
italia-pandora.com
outlet-jewelry-pandora.com
pandorajewelrycharm.com
pandora-sale-off.com
pandora-online.net
pandorashopsale.com
tiendapandoraonline.com
lessoldespandora.com
pandora-store-outlet.com
bijouxpandorafrance.com
pandora-store-outlet.net
pandora-outlet-it.com
pandora-outlet-italian.com
pandora-it-outlet.com

use exactly the same naming patterns, i.e. comprise of the distinctive arbitrary element "PANDORA" accompanied by a non-distinctive element in different language variations (such as: "outlet, sale/soldes, jewelry/bijoux, store/tienda) and followed by the gTLD ".com" or ".net" which is often treated as an alternative to ".com".

Since the Complainant's trademarks "PANDORA" is fully comprised within these 16 disputed domain names and that the

additional elements have lower degree of distinctiveness, the Panel considers that the 16 disputed domain names are clearly confusingly similar to Complainant's previously registered trademarks.

With regard to the domain names <pandorfrance.com>, <pandordisney.com> and <pansoldes.com>, as stated by the Complainant and taking into consideration the overall factual background of the present dispute, those apparently refer to the Complainant's registered trademarks "PANDORA", though the full name is not included within the domain names.

Indeed, it appears that <pandorfrance.com> and <pansoldes.com> comprise a shorten version of the trademarks "PANDORA" which is followed by a descriptive element, while the domain name <pandordisney.com> makes a direct reference to a Complainant's famous Disney x Pandora collection (which can be seen on Internet, for example on the link provided by the Complainant <https://us.pandora.net/>).

As a result and bearing in the mind the high reputation and status of a well-known trademark which was previously declared by this court (CAC Case 103231 <PANDORAEU.com>) the Panel accordingly concludes that there are more similarities than differences between the disputed domain names and the registered trademarks "PANDORA" and that is more likely that the Internet users will be confused or misled when searching for the original PANDORA products.

It follows that the paragraph 4(a)(i) of the Policy is satisfied.

3. LACK OF LEGITIMATE INTERESTS

The Respondent is not in any way related to the Complainant's business and is not the agent of the Complainant. The Respondent is not currently known and have never been known as "PANDORA", or any combination of this trademark.

The websites the domain names are currently associated with promote and offer for sale exactly the same goods as the Complainant's goods. However, the Complainant has not granted any license or authorization to the Respondent to make any use, or apply for registration of the trademarks "PANDORA" or to distribute its products. Therefore, such active use of the name "PANDORA" in connection with the Complainant's goods does not constitute a legitimate interest in the disputed domain names.

Consequently, and in the absence of a Response, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names, so that the requirements of paragraph 4(a)(ii) of the Policy are met.

4. REGISTRATION AND USE IN BAD FAITH

As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant's trademarks with which the disputed domain names are confusingly similar, and due to the worldwide presence of the Complainant's business known under the name "PANDORA", the Respondent was more likely to be aware of the Complainant's trademarks at the time of the registration of the disputed domain names, which started from 4 January 2020 and ended on 22 February 2021.

Furthermore, the Complainant notes that the disputed domain names result in the webpages with a very similar layout and produces the same "look and feel" as the Complainant's original webpages.

Bearing in mind these circumstances, the Respondents can be deemed to have registered and used the disputed domain names for obtaining commercial gain without a just cause and to the detriment of the Complainant's Intellectual Property Rights.

Under such circumstances, the Panel finds that the disputed domain names were registered and used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PANDORA-DISCOUNT.COM**: Transferred
 2. **SALE-PANDORA.COM**: Transferred
 3. **ITALIA-PANDORA.COM**: Transferred
 4. **OUTLET-JEWELRY-PANDORA.COM**: Transferred
 5. **PANDORAJEWELRYCHARM.COM**: Transferred
 6. **PANDORA-SALE-OFF.COM**: Transferred
 7. **PANDORA-ONLINE.NET**: Transferred
 8. **PANDORASHOPSALE.COM**: Transferred
 9. **TIENDAPANDORAONLINE.COM**: Transferred
 10. **LESSOLDESPANDORA.COM**: Transferred
 11. **PANDORA-STORE-OUTLET.COM**: Transferred
 12. **BIJOUXPANDORAFRANCE.COM**: Transferred
 13. **PANDORFRANCE.COM**: Transferred
 14. **PANDORDISNEY.COM**: Transferred
 15. **PANSOLDES.COM**: Transferred
 16. **PANDORA-STORE-OUTLET.NET**: Transferred
 17. **PANDORA-OUTLET-IT.COM**: Transferred
 18. **PANDORA-OUTLET-ITALIAN.COM**: Transferred
 19. **PANDORA-IT-OUTLET.COM**: Transferred
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PANELLISTS

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| Name | JUDr. Hana Císlerová, LL.M. |
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| DATE OF PANEL DECISION | 2021-07-26 |
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Publish the Decision
