

Decision for dispute CAC-UDRP-103881

Case number	CAC-UDRP-103881
Time of filing	2021-06-24 09:57:20
Domain names	pandoragoldcharms.com, pandoraheartcharm.com, pandoraringsonsale.com, pandorajewelrynet.com, pandorashinecollections.com, pandoradisneycollections.com, pandorasalebracelet.com, pandoraringssale.com, pandoradiamondjewellery.com, pandorastorejewelry.com, pandorajewelryoffers.com, pandoraewelrycheap.com, pandorajewelryhandmade.com, salepandorabangle.com, ukpandorabangle.com, pandorajewelryretailers.com, pandoraofferte2020.com, rivenditoripandora.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Pandora A/S
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Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.
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Respondent

Name	"daihui" "wang"
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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 following trademarks:

- (a) European word trademark "PANDORA" reg. no. 003397858 registered on 18 April 2007, in class 14;
- (b) European word trademark "PANDORA" reg. no. 006646491, registered on 21 January 2009 in classes 14, 18, 25;
- (c) International work trademark "PANDORA" reg. no. 1004640, registered in several countries, including the EU on 14 May 2009, in classes 3, 9, 14, 35; and
- (d) International figurative trademark "PANDORA" reg. no. 0979859 registered in several countries, including the EU on 17

September 2008 in classes 9, 14, 18, 25.

("Complainant's Trademarks")

There are 44 disputed domain names which are shown in the operative part of this decision registered over the period of 2018-2020.

FACTUAL BACKGROUND

As the Respondent did not file any response to the Complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) The Complainant is a company incorporated in Denmark. It designs, manufactures and markets hand-finished and contemporary jewelry. Its products have been marketed and sold under the "Pandora" name in more than 100 countries and through more than 7,700 points of sale. Total revenue in the 2019 annual report was DKK 21.9 billion (approximately 2.9 billion Euros). As a result of all these matters, its mark PANDORA enjoys a high degree of global recognition for jewelry, and can be considered a famous mark.

(b) The Complainant is the owner of the Complainant's Trademarks.

(c) The Complainant has also registered the trademark PANDORA under several domain names worldwide, among these is <pandora.net> which has been registered in 2010.

(d) Previous UDRP Panels have found that the Complainant and its PANDORA trademark(s) are internationally well known (see CAC Case 103231 <PANDORAEU.com>, in particular in the specific field of jewelry (see WIPO Case No. D2010-0641, Pandora Jewelry, LLC v. Debbie Sanford <salepandora.com>).

(e) The disputed domain names were registered over the period of 2018-2020 and resolve to very similar websites which appear to be e-shops selling Pandora products with a heading "PANDORA OFFICIAL".

PARTIES CONTENTIONS

THE COMPLAINANT:

In addition to the above stated factual assertions, the Complainant also contends the following:

(i) The disputed domain names are confusingly similar to Complainant's Trademarks as addition of generic terms or descriptive terms such as "bracelet", "charms", "collections", "rings", "bangle", "jewelry", geographical indications ("Italia", "UK") or year denominations ("2020" or "2021") to the disputed domain names does not diminish confusing similarity of disputed domain names to Complainant's Trademarks.

(ii) The Complainant denies that the Respondent has any right or legitimate interest in registering the disputed domain names. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the disputed domain names or to use the Complainant's Trademarks. The Complainant has prior rights in the Complainant's Trademarks which precede the Respondent's registration of the disputed domain names.

(iii) The Respondent is taking unfair advantage from the distinctive character and reputation of the Complainant's Trademarks and unduly seeking to profit from the Complainant's goodwill for its own financial gain. The Respondent has registered and used the disputed domain names in bad faith, to intentionally attract for commercial gain, internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's official website, also creating the impression that the Respondent's website is sponsored/affiliated or endorsed by the Complainant. Also, the fact the goods on sale on websites under the disputed domain names are counterfeit which is a further evidence of bad faith use of the

disputed domain name.

THE RESPONDENT:

The Respondent did not provide any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain names are confusingly similar to Complainant's Trademarks within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy").

For details, please see "Principal Reasons for the Decision".

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.

For details, please see "Principal Reasons for the Decision".

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.

For details, please see "Principal Reasons for the Decision".

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.

The Complainant has requested that the proceedings concerning all disputed domain names are consolidated into single proceedings in accordance with paragraph 4(f) of the UDRP and paragraphs 3(c) and 10(e) of the UDRP Rules. The Complainant asserts that all disputed domain names are owned or under the effective control of a single person or entity, or a group of individuals acting in concert. In support of this assertion, the Complainant contends the following:

(a) 26 disputed domain names were registered with the registrar GoDaddy.com LLC out of which 8 are registered in the name of Donald Sandoz, residing at Scammon Bay, Alaska, USA (which appears to be a false identity taken from US trademark registration), 1 in the name of Guan Xuequan residing at Nanjing, Ahhui, China and 17 in the name of Daihui Wang, residing at Fuzhou City, Fuzhou, China.

(b) 18 disputed domain names were registered through the registrar 1API GmbH with the registrar all of the disputed domain names are held at the same registrar of Daihui Wang, residing at Fuzhou City, Fuzhou, China.

(c) All 18 disputed domain names registered through 1API GmbH are using the identical registration e-mail address 791778045@qq.com.

(d) Certain key elements of the websites operated under the disputed domain names are identical, in particular the e-shop like layout of the website with the heading "PANDORA OFFICIAL at the top;

(e) All of the websites all use the exact same template ("CSS stylesheet"), titled "musheji_mobile", as they all contain the same references to includes/templates/musheji_mobile/css/stylesheet.css" in the website HTML source code.

(f) The disputed domain names follow similar naming patterns since each of which incorporates Complainant's Trademark

in its entirety to which a non-distinctive, generic or geographical term is added.

The Panel concurs with past UDRP decisions that multiple domain names may be consolidated into a single case where they are all subject to common control and, having regard to all of the relevant circumstances, where consolidation would be procedurally efficient, fair and equitable to all parties, please see for example HUGO BOSS Trade Mark Management GmbH & Co v. Charles Carranza and William Tillery, Case No. 101901 (CAC, April 5, 2018) or PRADA S.A. v. xie xiaomei / zhang yuanyuan / zhou honghai / zhouhonghai / Zhou Hong Hai / Honghai Zhou / deng wen / xie peiyuan / Jianghong Wang / xie caida / liu min / du linmei, Case No. D2016-0799 (WIPO, June 22, 2016).

The Panel also concurs with the UDRP decision in CAC Case 101969 <UNDERARMOUROUTLETSTOREONSALE.COM> that although there may be no single factor which proves that all disputed domain names are under common ownership or control, it is sufficient when all relevant factors taken together lead to the reasonable conclusion that the disputed domain names are, in fact, commonly controlled and should be consolidated.

This is exactly the situation in the case at hand and therefore this Panel finds, on the balance of probabilities, that the disputed domain names are very likely under common ownership or control. Also, consolidation in this case is procedurally efficient, fair, and equitable to all parties and therefore is granted by the Panel.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

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

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

RIGHTS

The Panel concurs with the Complainant that the disputed domain names are confusingly similar to Complainant's Trademarks. Without exception, they contain the word "Pandora" together with a generic or descriptive term such as "bracelet", "charms", "collections", "rings", "bangle", "jewelry", sometimes in other languages than English such as "bracciali" or "offerte", sometimes geographical indications ("Italia", "UK") or year denominations ("2020" or "2021") are added.

The Panel fully concurs with the case law referred to by the Complainant that adding such generic or non-distinctive terms to Complainant's Trademarks cannot diminish confusing similarity of the disputed domain names to such trademarks.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

NO RIGHTS OR LEGITIMATE INTERESTS

The complainant is 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 UDRP (please see, for example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

As asserted by the Complainant (and unchallenged by the Respondent), the Respondent is not commonly known by the

disputed domain names. Neither is the Respondent in any way related to the Complainant or authorized to use Complainant's Trademarks. The Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a) (ii) of the Policy).

For the sake of completeness, the Panel also emphasizes that although the websites operated under disputed domain names appear to sell products of the Complainant, they do not meet the criteria to establish legitimate interest of a reseller or distributor to a domain name containing the trademark of a brand which is resold or distributed as set out by the so-called Oki Data test inferred from WIPO Case No. D2001-0903 Oki Data Americas, Inc. v. ASD, Inc., <okidataparts.com>:

- (i) the reseller must actually be offering the goods or services at issue;
- (ii) the reseller must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the reseller's relationship with the trademark holder; and
- (iv) the reseller must not try to "corner the market" in domain names that reflect the trademark.

Although the Complainant asserted that the websites operated under the disputed domain names sell counterfeit Pandora products, no evidence of such fact (such as an expert opinion on product purchased from such websites) was presented in these proceedings and therefore, the Panel could not take this assertion into account. It also does not appear that other brands are sold under the disputed domain names. On the other hand, there is an apparent failure of the Respondent to accurately and prominently disclose its relationship to the Complainant. Quite to the contrary, by using the title "Official" at the heading of each website, the Respondent deliberately attempts to mislead consumers as to operation of the website by the Complainant and/or authorization of the website operator by the Complainant to sell Complainant's products. Such conduct can hardly establish legitimate interest of the Respondent in the disputed domain names.

Therefore, the Panel found that the Respondent has no rights or legitimate interest in the disputed domain names.

BAD FAITH

The Panel also finds that the Respondent must have registered the disputed domain names in the full knowledge of Complainant's Trademarks, as the Respondent's websites appear to sell Complainant's products. Therefore, the Respondent also must have been aware of the fact that it is not authorized reseller of Pandora products. However, the Respondent failed to disclose such fact to consumers, instead it created a false impression that its conduct is "official" i.e. somehow authorized by the Complainant by using the word "official" in the headings of the websites and that the products sold at such websites come from the Complainant or its authorized distributors. Such conduct would be regarded as unfair competition (or passing off) in many jurisdictions and in the opinion of the Panel, it is also clearly evidencing bad faith of the Respondent upon registration and use of the disputed domain name, in particular given the pattern of Respondent's conduct in registering 44(!) such domain names with similar contents.

Therefore, the Panel has no doubt that the Respondent has registered and is using the disputed domain names in bad faith.

If also counterfeit products are sold at these websites, which unfortunately remains unproved by the Complainant, that would be another, even stronger argument to establish bad faith of the Respondent, as trademark infringement by selling counterfeit products constitutes criminal offense in most jurisdictions.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. PANDORAGOLDCHARMS.COM: Transferred
2. PANDORABRACCIALIRIGIDI.COM: Transferred

3. PANDORAHEARTCHARM.COM: Transferred
4. PANDORARINGSOBSALE.COM: Transferred
5. PANDORAJEWELRYNET.COM: Transferred
6. PANDORASHINECOLLECTIONS.COM: Transferred
7. PANDORADISNEYCOLLECTIONS.COM: Transferred
8. PANDORASALEBRACELET.COM: Transferred
9. PANDORARINGSOBSALE.COM: Transferred
10. PANDORADIAMONDJEWELLERY.COM: Transferred
11. PANDORASTOREJEWELRY.COM: Transferred
12. PANDORAJEWELRYOFFERS.COM: Transferred
13. PANDORAEWELRYCHEAP.COM: Transferred
14. PANDORAJEWELRYHANDMADE.COM: Transferred
15. SALEPANDORABANGLE.COM: Transferred
16. UKPANDORABANGLE.COM: Transferred
17. PANDORAJEWELRYRETAILERS.COM: Transferred
18. PANDORAOFFERTE2020.COM: Transferred
19. RIVENDITORIPANDORA.COM: Transferred
20. BRACCIALIPANDORAPROMO.COM: Transferred
21. ITALIAPANDORA2020.COM: Transferred
22. ITPANDORANET.COM: Transferred
23. PANDORACOLLANEGIFTS.COM: Transferred
24. BRACCIALEPANDORARIGIDO.COM: Transferred
25. PANDORAITALIASTORE.COM: Transferred
26. CHARMPANDORAIT2020.COM: Transferred
27. ITPANDORANET2020.COM: Transferred
28. PANDORAOFFERTE2021.COM: Transferred
29. SALEPANDORABANGLE2020.COM: Transferred
30. PANDORACHARMS2021.COM: Transferred
31. UKPANDORABRACELET2021.COM: Transferred
32. PANDORACHARMSCHEAP2020.COM: Transferred
33. PANDORACHEAPCHARM2020.COM: Transferred
34. PANDORACHEAP2021.COM: Transferred
35. HEARTSOFPANDORA2021.COM: Transferred
36. SALEPANDORA2020.COM: Transferred
37. UKPANDORACHARMS2020.COM: Transferred
38. NEWPANDORARINGS2020.COM: Transferred
39. BUYPANDORAJEWELRY2021.COM: Transferred
40. PANDORASILVER2021.COM: Transferred
41. PANDORABRACELETONLINE2020.COM: Transferred
42. DISCOUNTPANDORASHOP.COM: Transferred
43. SALEPANDORABANGLE2021.COM: Transferred
44. UKPANDORABANGLE2021.COM: Transferred

PANELLISTS

Name	Michal Matějka
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DATE OF PANEL DECISION 2021-08-02

Publish the Decision
