

Decision for dispute CAC-UDRP-103815

Case number **CAC-UDRP-103815**

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Domain names **hoganmalaysia.com , hogansingapore.com , hoganschoenen.com , hoganmexico.com , hoganpolska.com , hoganportugal.com , hogansko.com , hoganshoesau.com , hoganuksale.com , hoganindiasale.com , hogancipo.com , hoganenucuz.com, hoganinsaldo.com , hoganshopgr.com, hogansoldes.com, hoganbaratas.com, hogan-deutschland.com, hogantilbud.com, hoganoutletsuomi.com, hogankaufen.com**

Case administrator

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

Complainant

Organization **TOD'S S.p.A.**

Complainant representative

Organization **Convey srl**

Respondent

Organization **Web Commerce Communications Limited**

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 many trade marks for;

- HOGAN including, by way of example only, European Union trade mark registration number 005184536 in classes 3, 9, 18, 25 and 35 registered on January 20, 2010; and

- ROGER VIVIER, including, by way of example only, European Union trade mark, registration number 006349138 in classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 26, 34, 35 and 42, registered on October 17, 2008.

FACTUAL BACKGROUND**FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:**

The Complainant is a long-established company, with its headquarters in Italy, which manufactures and retails footwear and

other leather goods products. It has about 4,600 employees worldwide and operates around 403 mono-brand stores in addition to showrooms and other stores. Its revenues in 2020 were approximately EUR 650 million.

The Complainant sells its products under a number of brand names, including HOGAN and ROGER VIVIER, and it owns many trade marks to protect these trading styles, including the marks in respect of which full details are given above. The Complainant also owns many domain names which comprise or include its trade marks including <hogan.com>, and <rogervivier.com>, which resolve to websites promoting its products.

The disputed domain names were registered on various dates between June 23, 2021 and September 17, 2021. Save for the domain name <hogansinaldo.com>, which does not presently appear to resolve to an active website, all the disputed domain names resolve to websites which purport to be owned and/or operated by the Complainant and to offer its products for sale.

The disputed domain names are confusingly similar to the Complainant's HOGAN or ROGER VIVIER trade marks. Each disputed domain name incorporates the whole of either the Complainant's ROGER VIVIER or HOGAN trade marks and adds to it non-distinctive elements, such as "outlet" or the foreign language equivalent of words associated with the Complainant such as "shoes", "shop", "sales" and so on, and/or a geographical indicator such as "Singapore" or "Mexico". The addition of generic or geographical terms of this type does not prevent the disputed domain names from being found confusingly similar to the Complainant's mark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not in any way authorised to use the Complainant's marks nor has it been authorized to register or use the disputed domain names. The Respondent is not, to the Complainant's knowledge, known by the names HOGAN or ROGER VIVIER nor by any of the disputed domain names. There is no evidence of the Respondent's use of, or demonstrable preparations to use, any of the disputed domain names in connection with a bona fide offering of goods and services. The Respondent is using each of the disputed domain names to offer for sale counterfeit copies of the Complainant's products and such use cannot give rise to a legitimate interest in them.

The Respondent has registered and is using the disputed domain names in bad faith. The repute of the Complainant is such that, when registering the disputed domain names, the Respondent must have been aware of its marks. Indeed, the fact that the Respondent is offering for sale counterfeit copies of the Complainant's shoes, using its HOGAN and ROGER VIVIER trade marks, provides confirmation of this. Registration of a domain name with knowledge of a complainant's mark is evidence of bad faith. The low prices at which the Respondent's goods are offered for sale points to them being counterfeit. The Respondent is seeking to divert Internet users to its websites by creating a likelihood of confusion with the Complainant's products as to the source, sponsorship, affiliation or endorsement of its websites and/or the goods offered through them.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 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 name have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

Procedural Factors – Consolidation

The Complainant seeks to consolidate its claims against the registrant of the disputed domain name <rogervivieroutlets> and the registrant of the other disputed domain names, notwithstanding that the registrant details are different, on the grounds that this domain name and the other disputed domain names are subject to common control and that it is equitable and procedurally efficient to consolidate the proceedings. The Complainant relies on the following factors that all the disputed domain names have in common, namely that they each use the .com Top Level Domain extension, the same hosting provider, the same Autonomous System Number and the same registrar (more accurately, they each use registrars within the same corporate group). They all also incorporate either the Complainant's HOGAN or its ROGER VIVIER mark in its entirety and couple it with a geographical or descriptive term.

There are, in fact, some notable difference between <rogervivieroutlets> and the remaining disputed domain names. In particular, the stylisation of the website, to which this disputed domain name resolves, is more crude than the websites to which the other disputed domain names resolve, the brand which is being replicated is different and the identity and country location of the underlying registrant is different, albeit the Complainant says that the registrant details on the Whois record for <rogervivier.com> are incorrect.

Notwithstanding these differences, on balance, the Panel considers that <rogervivieroutlets.com> is under the same common control as the remaining disputed domain names. In addition to the points raised by the Complainant, the date of registration of this disputed domain name, June 23, 2021, is close in time to the registration of many of the other disputed domain names, nine, of which were also registered in late June 2021, and all the websites masquerade at websites of the Complainant and purport to sell the Complainant's footwear products. Moreover, the Respondents have had the opportunity to challenge in these proceedings the Complainant's assertions of common control but have chosen not to do so.

Consolidation of disputes involving domain names under common control would usually be ordered if, as here, it is both equitable and procedurally efficient to do so (see, for example, CAC Case No. 101576, ROGER VIVIER S.P.A. v Sun Cai Long, Liu You Quin) and the Panel therefore agrees to the Complainant's request for consolidation.

Procedural Factors – Language of the registration agreement

Paragraph 11 of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") UDRP Rules provides that unless otherwise agreed by the parties, the default language of the proceedings is the language of the registration agreement, subject to the authority of the panel to determine otherwise. The registration agreement in respect of the disputed domain name <rogervivieroutlets.com> is in the Chinese language. The Complainant maintains that, notwithstanding this, it is appropriate for the proceedings to be conducted in the English language. In support of this assertion, it points out that the website to which this disputed domain name resolves is in English and the disputed domain name contains Latin characters and a word which has a meaning in English. Additionally, it says that translation of the Complaint into Chinese would also cause additional expense and delay, making it unfair to proceed in Chinese, and that English is the primary language for business and international relations.

The Panel accepts these points. See also the decision of the panel in CAC Case No. 104156 Vivendi v Chen Jun. It accordingly directs that the language of the proceedings shall be English.

The Panel is accordingly satisfied that all procedural requirements under UDRP are met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain names are identical or confusingly similar to trade marks or service marks in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

Identical or confusingly similar

The Complainant's trade mark registrations for HOGAN and ROGER VIVIER, including those in respect of which full details are provided above, establish its rights in these marks.

For the purpose of comparing the disputed domain names with the Complainant's mark, it is established practice to disregard the Top-Level Domain, that is ".com" in the case of each disputed domain name, as this is a technical requirement of registration. The remaining elements of each disputed domain name comprise the Complainant's HOGAN or ROGER VIVIER trade mark, in full and without alteration, and combines it with either geographical terms and/or words apt to be associated with the Complainant's business, either in the English language or in the language with which the Respondent's website is likely to be associated having regard to the language of the associated descriptive term.

Where a domain name wholly incorporates a complainant's registered trade mark that is sufficient to establish confusing similarity for purposes of first element of the Policy; see, for example, CAC Case No. 102382, MAJE v enchong lin. The Complainant's mark is clearly recognizable within the disputed domain name and the additional elements do not serve to prevent the disputed domain name from being found confusingly similar to it. See, by way of example, CAC Case No. 103016, Novartis AG v unlocking guru; "An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion". The Panel accordingly finds that each of the disputed domain names is confusingly similar to a trade mark in which the Complainant has rights.

Rights and legitimate interests

Paragraph 4(c) of the Policy sets out circumstances, without limitation, by which a respondent might demonstrate that it has rights or a legitimate interest in a domain name. These are, summarised briefly: (i) if the respondent has been using the domain name in connection with a bona fide offering of goods and services; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate non-commercial or fair use of the domain name.

The only known use of the disputed domain name, has been to enable the Respondent to sell allegedly counterfeit copies of the Complainant's products. Whilst the Complainant has not provided direct evidence that the Respondent's products are counterfeits, it points to the greatly reduced prices at which the Respondent's products are sold, relative to the prices of the Complainant's products, which prior UDRP panels have accepted as amounting to evidence that they are unlikely to be genuine; see, for example Oakley, Inc. v. Victoriaclassic.Inc, WIPO Case No. D2012-1968. Indeed, the Respondent has not denied the Complainant's assertions of counterfeiting. As explained at section 2.13.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"); "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent". See also CAC Case No. 101969, Under Armour Inc. v Convey srl.

In these circumstances, the Respondent's activities cannot amount to a bona fide offering of goods and services. Furthermore, the current inactive use of the disputed domain name <hogansinaldo.com> does not amount to a bona fide offering of goods and services or provide the Respondent with a right or legitimate interest in it on any other basis.

There is no evidence that the Respondent has been commonly known by any of the disputed domain names, and the uses made of them are such that the Respondent's holding of them does not amount a legitimate non-commercial or fair use. Furthermore, as each of the disputed domain names, is confusingly similar to the Complainant's mark and any additional terms within each disputed domain name is apt to reinforce the association with the Complainant, they carry with them a risk of implied affiliation with the Complainant which prevents their use from being considered fair.

The Complainant having made out a prima facie case in relation to the second element, the burden of proof shifts to the Respondent to rebut it; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. In the absence of any response by it to the Complaint, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain

names.

Bad faith

The Panel accepts the Complainant's submission that the distinctive nature of the Complainant's mark and its reputation means that it is highly improbable that the Respondent registered the disputed domain names without an awareness of the Complainant and its trade mark rights. This is particularly the case when the only known use to which the disputed domain names have been put is to point to web pages purporting to offer for sale the Complainant's products, which points clearly to an awareness by the Respondent of the Complainant's HOGAN and ROGER VIVIER trade marks as at the date of registration of the disputed domain names. In these circumstances, the registration by the Respondent of the disputed domain names, leads to a presumption of bad faith; see, for example, CAC Case No. 101448, *Severina Kojić v Orbis d.o.o.* The Panel therefore finds that the disputed domain names were registered in bad faith.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy is if a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

The uses to which the Respondent has put the disputed domain names, namely to resolve to websites offering goods for sale which are, most likely, counterfeit copies of the Complainant's products fall precisely within these circumstances. The websites to which each disputed domain name resolves are clearly intended to deceive Internet users into believing that they are operated by the Complainant or with its authorisation. Such a belief will be reinforced because of the confusing similarity between the disputed domain names and the Complainant's HOGAN and ROGER VIVIER trade marks. The additional components to the disputed domain names, such as "uksale", "shopgr" ("gr" being a recognised abbreviation for Greece) and "outlets", accentuate the false impression of a connection with the Complainant's business and further increases the likelihood of confusion to Internet users. Moreover, there is no conceivable good faith use which the Respondent could make of the disputed domain names. Finally, the Respondent has not made any attempt to justify its conduct or to rebut the Complainant's assertions. The overall circumstances clearly point to bad faith registration and use; see, by way of similar example, the decision of the panel in CAC Case No. 101953, *G&P Net v zheng zhang*.

Finally, the present inactive status of the disputed domain name <hogansinaldo.com>, does not prevent a finding of bad faith registration and use under the doctrine of passive holding; see CAC Case No. 102333, *Amedei S.r.l. v sun xin*; the factors set out in that decision as indicating bad faith passive holding are fully present in the case of this disputed domain name.

The Panel accordingly finds that all the disputed domain names were both registered and are being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HOGANMALAYSIA.COM** : Transferred
2. **ROGERVIVIEROUTLETS.COM**: Transferred
3. **HOGANSINGAPORE.COM** : Transferred
4. **HOGANSCHOENEN.COM** : Transferred
5. **HOGANMEXICO.COM** : Transferred
6. **HOGANPOLSKA.COM** : Transferred
7. **HOGANPORTUGAL.COM** : Transferred
8. **HOGANSKO.COM** : Transferred
9. **HOGANSHOESAU.COM** : Transferred
10. **HOGANUKSALE.COM** : Transferred
11. **HOGANINDIASALE.COM** : Transferred
12. **HOGANCIPO.COM** : Transferred
13. **HOGANENUCUZ.COM**: Transferred

14. **HOGANINSALDO.COM** : Transferred
15. **HOGANSHOPGR.COM**: Transferred
16. **HOGANSOLDES.COM**: Transferred
17. **HOGANBARATAS.COM**: Transferred
18. **HOGAN-DEUTSCHLAND.COM**: Transferred
19. **HOGANTILBUD.COM**: Transferred
20. **HOGANOUTLETSUOMI.COM**: Transferred
21. **HOGANKAUFEN.COM**: Transferred

PANELLISTS

Name	Antony Gold
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DATE OF PANEL DECISION	2021-12-12
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Publish the Decision
