

Decision for dispute CAC-UDRP-104183

Case number CAC-UDRP-104183

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Domain names realhogan.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 Wang Lizhen

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 owner of several trademarks combining the term "HOGAN" with stylized elements, including:

- International Trademarks with registration numbers 1014830 and 1014831 for HOGAN, which were both registered on July 24, 2008 for goods in classes 9, 18, and 25;
- International Trademark with registration number 774193 for HOGAN, which was registered on January 18, 2001 for goods in classes 3, 9, 18, and 25; and
- European Union Trademark with registration number 005184536 for HOGAN, which was registered on January 20, 2010 for goods and services in classes 3, 9, 18, 25 and 35.
(the "HOGAN Trademark")

FACTUAL BACKGROUND

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

The Complainant is an Italian company which dates back to the early 1900 and currently designs a wide range of luxury products such as shoes, bags and women accessories distributed all around the world. The Complainant operates many

stores around the world, about 403 mono-brand stores, including showrooms and large flagship stores in Europe, the U.S., China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia. 2020 Annual revenues of the Complainant's Group were almost EUR 650 million of which 22% came from the HOGAN Trademark.

The disputed domain name was registered by the Respondent on March 7, 2021 without authorization of the Complainant, and has resolved to a website which offers counterfeit products of those of the Complainant for sale.

According to the Complainant the disputed domain name is confusingly similar to the HOGAN Trademark as the disputed domain name incorporates the HOGAN Trademark and the preceding element "real" is non-distinctive.

The Complainant also alleges that the Respondent is not a licensee or authorized agent of the Complainant, nor is the Respondent in any other way authorized to use the HOGAN Trademark or register the disputed domain name. Upon information and belief of the Complainant, the Respondent is not commonly known by the disputed domain name and has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute. In fact, the disputed domain name is redirected by the Respondent to a website where the HOGAN Trademark is published and counterfeit products are offered for sale for a price disproportionately below the market value, which demonstrates that Respondent is not intended to use the disputed domain name in connection with any legitimate purposes. The Complainant concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

According to the Complainant the actual knowledge of the HOGAN Trademark by the Respondent at the time of the registration of the disputed domain name is demonstrated by the fact that the Respondent has offered for sale replicas of the Complainant's shoes reproducing also the HOGAN Trademark in the website corresponding to the disputed domain name. Moreover, the Complainant alleges that the fact that replicas of HOGAN marked shoes are offered for sale on the websites corresponding to the disputed domain name indicates that the Respondent has been fully aware of the HOGAN Trademark and reputation and association with the Complainant and that his purpose in registering the disputed domain name was solely to capitalize on the reputation of the HOGAN Trademark by diverting Internet users seeking products under the HOGAN Trademark to its own commercial web sites.

Furthermore, the web site corresponding to the disputed domain name, there is no disclaimer informing the users as to the Respondent's lack of relationship with the Complainant and the Respondent. Consequently, the Complainant submits that the disputed domain name was registered and is being used in bad faith.

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).

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

In absence of arguments to the contrary and on the basis of the arguments and evidence submitted by the Complainant, the Panel established that the Complaint satisfied all three elements of paragraph 4(a) of the Policy for the following reasons:

1. The disputed domain name exists of the HOGAN Trademark in its entirety, preceded by word "real", which does not take away the similarity between the disputed domain name and the HOGAN Trademark. Consequently, the Panel finds that the disputed domain name is confusingly similar to the HOGAN Trademark.

2. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has no relationship with the Complainant and was not authorized by the Complainant to use the disputed domain name, and used the disputed domain name in the course of selling counterfeit products of the Complainant's genuine products under the HOGAN Trademark, which the Complainant demonstrated by referring to the fact that the products on the Respondent's website were offered significantly below the market value, which can never confer rights or legitimate interests on a respondent which did not use the disputed domain name (cf. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 2.13.1 and 2.13.2).

3. In view of the fact that the Respondent used the disputed domain name immediately upon registration to offer counterfeit products under the HOGAN Trademark for sale, the Panel infers that the Respondent must have had the HOGAN Trademark in mind when he registered the disputed domain name, which was therefore registered in bad faith. The Panel is also satisfied that the Respondent used the disputed domain name in bad faith by misleading attracting Internet users who believed that they were offered the Complainant's genuine products, which were actually counterfeit goods.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. REALHOGAN.COM: Transferred

PANELLISTS

Name	Alfred Meijboom
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DATE OF PANEL DECISION 2021-12-24

Publish the Decision