

Decision for dispute CAC-UDRP-104184

Case number	CAC-UDRP-104184
-------------	------------------------

Time of filing	2021-11-26 09:45:57
----------------	----------------------------

Domain names	todsshoesaus.com, todssingaporeoutlet.com, todsireland.com, todsus.com, todsonlineindia.com
--------------	--

Case administrator

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

Complainant

Organization	TOD'S S.p.A.
--------------	---------------------

Complainant representative

Organization	Convey srl
--------------	-------------------

Respondent

Organization	Whoisprotection.cc
--------------	---------------------------

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 submitted evidence that it is the registered owner of the following trademarks (hereafter: the "TOD'S trademark(s)"):

- EU trademark registration n. 010158889 "TOD'S" (word trademark), registered on 29 December 2011, valid for classes 3, 9, 14, 18, 25 and 35;
- EU trademark registration n. 000407031 "TOD'S" (word trademark), registered on 13 September 2004, valid for class 9;
- International trademark registration n. 1006548 "TOD'S" (figurative trademark), registered on 1 June 2009, valid for class 14;
- International trademark registration n. 858452 "TOD'S" (figurative trademark), registered on 20 May 2005, valid for class 14;
- US trademark registration n. 1459226 "TOD'S" (figurative trademark), registered on 29 September 1987, valid for classes 25.01.25 and 26.03.28; and
- Australian trademark registration n. 1498996 "TOD'S" (figurative trademark), registered on 12 November 2012, valid for class 3, 9, 25, and 35.

FACTUAL BACKGROUND

FACTUAL BACKGROUND

The Complainant is a well-known company that sells luxury goods (such as shoes and other footwear) for men and women, with headquarters in Italy. The Complainant is active in Europe, the U.S., China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia. The Complainant asserts to have about 4.600 employees worldwide, and to have generated almost 650 million euros in revenues in 2020, of which almost 47% came from the trademark TOD'S.

The Complainant has submitted evidence that it is the registered owner of several TOD's trademarks, mentioned above under "Identification of rights".

The Complainant has submitted evidence that it is the owner of the following domain names consisting of the TOD'S trademark(s):

- <www.todsgroup.com>, registered on 10 September 2000; and
- <www.tods.com>, registered on 15 May 2005.

The Complainant has submitted evidence that it exploits the TOD'S Trademark(s), inter alia, via social media platforms such as Instagram, Facebook, YouTube, and Pinterest.

The Complainant has submitted evidence that it has franchised stores in Malaysia, the home country of the Respondent, and TOD'S stores in Singapore.

The disputed domain names were registered on:

- 22 March 2021: todsshoesaus.com;
- 22 March 2021: todssingaporeoutlet.com;
- 24 March 2021: todsireland.com;
- 22 March 2021: todsus.com;
- 27 March 2021: todsoutletgreece.com; and
- 25 March 2021: todsonlineindia.com.

The Complainant has demonstrated evidence that, at the time of filing its complaint, the disputed domain names refer to websites that display the TOD'S Trademark(s), and that offer for sale products that are labelled with the TOD'S Trademark(s).

On 25 October 2021, the Complainant sent the Respondent a cease and desist message via the contact forms of the disputed domain names, to which the Respondent did not respond.

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

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.

In accordance with article 10 e) of the Rules and article 4.f. of the Policy, the Panel accepts the Complainant's request to consolidate the six domain name disputes. The Panel accepts the Complainant's request based on the following grounds. First, the disputed domain names all refer to webpages that look identical in terms of lay-out, and all display the Complainant's TOD'S trademark(s) in the same manner. Second, the disputed domain names all seem to have a similar purpose, namely selling (identical or at least similar) goods that look similar to the Complainant's products via an online shop. Third, the registration of the disputed domain names happened within a time span of only a couple of days, namely from 22 March 2021 to 27 March 2021. Fourth, the disputed domain names all consist of the Complainant's trademark with the addition of either (references to) geographical locations, or generic and descriptive terms. Fifth, the domain names all have the same hosting provider. Sixth, the domain names all have the same IP ASN. Lastly, aside from the disputed domain name <todsoutletgreece.com>, the disputed domain names have similar or identical WHOIS information, such as the registrant's address, the registrar, the registrar WHOIS Server, etc. The above mentioned grounds lead the panel to believe that the disputed domain names are indeed being exploited under common control.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or confusingly similar

The disputed domain names consist entirely of the Complainant's TOD's Trademark(s), with the addition of the terms "shoes" and "aus", "Singapore" and "outlet", "Ireland", "US", "outlet" and "Greece", and "online" and "India", respectively; and the ".com" suffix.

The Panel finds that the addition of the above-mentioned terms in the disputed domain names do not sufficiently change the overall impression of confusing similarity to the TOD'S Trademark(s). Indeed, these additional terms in the disputed domain names are either (references to) geographical locations, or generic and descriptive terms that refer directly or indirectly to the Complainant's core activities and/or its most popular products. There is also the addition of the ".com" suffix, which, in this case, can be disregarded when it comes to considering whether the disputed domain name is confusingly similar to a trademark to which the Complainant has rights.

The Respondent did not file an administratively complaint (or any) response.

The Panel concludes that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, the complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that:

(1) The Respondent is not a licensee or authorized agent of the Complainant, nor is it in any other way authorized to use the TOD'S Trademark(s). Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and / or use the disputed domain names. There is no disclaimer on the disputed domain names as to the Respondent's lack of relationship with the Complainant.

(2) The Respondent is not commonly known by the disputed domain names.

(3) The Respondent has not provided the Complainant with any evidence of the use of the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute, nor has it provided any evidence of demonstrable preparations for such use.

(4) The disputed domain names refer to webpages that display the Complainant's TOD'S Trademark(s), on which counterfeit products bearing the TOD'S Trademark(s) are offered for sale. Because of the low prices of the products offered for sale via the websites corresponding to the disputed domain names, these products are highly likely counterfeit products. Such use of the disputed domain names cannot be deemed a legitimate non-commercial or fair use without intent for commercial gain.

The contentions of the Complainant are not disputed by the Respondent, since the Respondent did not file a response.

The Panel finds that the Complainant has at least made a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain names.

This finding is based on a combination of the following facts and arguments:

(1) the Respondent does not seem to be related to the Complainant, and seems not to have received any license or authorization to use the TOD'S Trademark(s) or any variation thereof;

(2) the Respondent does not seem to be commonly known by the disputed domain names; and

(3) there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain names (or has any future plans to do so). On the contrary, it seems that the Respondent is using the disputed domain names to offer counterfeit products for sale that carry the TOD'S Trademark(s), and the disputed domain names display the TOD'S trademark(s), without authorization by the Complainant.

The Panel notes that the contentions of the Complainant are not contested by the Respondent. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain names (the Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but did not do so).

On the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain names within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith registration and use

The Complainant asserts that it has made worldwide intensive use of the TOD'S Trademarks for many years, that its TOD'S Trademarks are well-known, and that the Respondent could not possibly have been ignorant of the existence of the Complainant's TOD'S Trademarks. The Complainant contends that the Respondent has registered or acquired the disputed domain names primarily to create a likelihood of confusion with the TOD'S Trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and/or the goods offered or promoted through said websites.

The Complainant asserts that the TOD'S Trademarks enjoy a worldwide reputation in the sector of shoes and apparel goods. The disputed domain names were registered in 2021, many years after the Complainant obtained its trademark registrations. The Complainant contends that it is clear that the Respondent has registered the disputed domain names with full knowledge of the TOD'S Trademarks, to capitalize on the reputation of the Complainant's trademarks by diverting internet users seeking the Complainant's products to its own commercial sites. According to the Complainant, the knowledge of the TOD'S Trademarks by the Respondent at the time of the registration of the disputed domain names is demonstrated by the fact that the Respondent offers counterfeits of the Complainant's shoes which reproduce the TOD'S Trademarks for sale on the disputed domain names;

and that the disputed domain names are confusingly similar to the TOD'S Trademarks. The Complainant emphasises that the prices of the shoes are disproportionately below the usual market prices of the Complainant's products, which creates the impression that the Respondent either sells counterfeit goods or is attempting to obtain personal data or payments from the internet users. The Complainant points out that none of the disputed domain names contain a disclaimer informing the users of the Respondent's lack of relationship with the Complainant.

Lastly, the Complainant asserts that, on 25 October 2021, it sent the Respondent a cease and desist message via the contact forms displayed on the disputed domain names, to which the Respondent did not respond.

The Respondent did not file a response.

The Panel finds that, on the balance of probabilities, it can be accepted that the Respondent had actual knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's TOD'S Trademarks.

The Panel finds that the Respondent has registered or acquired the disputed domain names primarily to create a likelihood of confusion with the TOD'S Trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and/or the goods offered or promoted through said domain names.

It is highly unlikely that the Respondent would have registered these domain names (all containing the Complainant's word trademarks TOD'S), for the online sale of shoes (goods that are specifically covered by the Complainant's TOD'S Trademarks) without actual knowledge of the Complainant and its trademarks. The Panel also notes that the Respondent has used the Complainant's figurative trademarks on the websites available through these domain names. This only confirms the actual knowledge of the Respondent of the Complainant's TOD'S Trademarks.

The Panel believes that the disputed domain names selected by the Respondent were primarily selected for their similarity to the Complainant's registered TOD'S Trademarks. Indeed, the disputed domain names consist of the Complainant's TOD'S Trademarks, with the addition of the terms "shoes" and "aus", "Singapore" and "outlet", "Ireland", "US", "outlet" and "Greece", and "online" and "India", respectively. These additional terms in the disputed domain names are either (references to) geographical locations, or generic and descriptive terms that refer directly or indirectly to the Complainant's core activities or products.

In light of the above, it is highly unlikely that the Respondent would not have been aware of the unlawful character of the disputed domain names at the time of their registration and use.

In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the TOD'S Trademarks of the Complainant in mind when registering and subsequently using the disputed domain names.

For all of the reasons set out above, the Panel determines that the disputed domain names were registered and are being used in bad faith within the meaning of 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. **TODSSHOESAUS.COM**: Transferred
 2. **TODSOUTLETGREECE.COM**: Transferred
 3. **TODSSINGAPOREOUTLET.COM**: Transferred
 4. **TODSIRELAND.COM**: Transferred
 5. **TODSUS.COM**: Transferred
 6. **TODSONLINEINDIA.COM**: Transferred
-

PANELLISTS

Name	Bart Van Besien
------	------------------------

DATE OF PANEL DECISION	2022-01-04
------------------------	------------

Publish the Decision	
----------------------	--