

Decision for dispute CAC-UDRP-104314

Case number CAC-UDRP-104314

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Domain names golaireland.com , golaportugal.com , golaespana.com , golaaustralia.com , golacolombia.com

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization D. Jacobson & Sons Limited

Complainant representative

Organization TLT LLP

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registered trademarks (among others):

United Kingdom registered trademarks:

- GOLA, word mark, registered on May 22, 1905 under number 272980, for goods and services in Class 25;
- GOLA, word mark, registered on June 14, 1978 under number 1097140, for goods and services in Class 18;
- Wing Flash Logo, registered on November 25, 1975, under number 1055606, for goods and services in Class 25.

European Union registered trademarks:

- GOLA, word mark, registered on March 22, 2002 under number 1909936, for goods and services in Nice classes 18, 25 and

28;

- GOLA, word mark, registered on April 17, 2008 under number 003399681, for goods and services Nice classes 5, 10, 12, 35;

- GOLA, figurative mark registered on July 4, 2013 under number 011567625 for goods and services Nice classes 18, 25, 35.

FACTUAL BACKGROUND

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

The Complainant is a UK based designer, importer, seller and exporter of ladies', men's and children's footwear. In particular, the Complainant owns the internationally famous "GOLA" brand, which it has very successfully applied (amongst other things) to its range of footwear and bag designs. The Complainant's footwear and bag products are sold throughout the world, including through its various websites registered under domain names such as <gola.co.uk> and <golausa.com> (the Gola Domains). Customers in the UK, EU and US are able to purchase the Complainant's products through the Gola Domains.

The Complainant owns various trademark registrations pertaining to the "GOLA" brand, including the GOLA word mark, registered 117 years ago in the United Kingdom.

The disputed domain names were all registered in August 2021. None of the disputed domain names are in any way connected with or authorized by the Complainant.

The disputed domain names were registered by the same registrar. Of the five disputed domain names, three are websites which are accessible from the UK. The content of those websites all mirror each other either exactly or very similarly.

Also, the differences in the disputed domain names from the genuine Gola website are replicated in the accessible disputed domain names.

The disputed domain names make use of a mark which is identical or highly similar to the Complainant's Trade Marks without its authorisation or permission. The use of the above Trade Marks in the disputed domain names implies that there is a commercial relationship between the Complainant and the disputed domain names when there is none. This infringes the Complainant's rights in the Trade Marks.

The accessible disputed domain names have been set up by the Respondent to mirror the Complainant's websites, through use of domains which include the Complainant's Trade Marks, content from its website and prominently features the Trade Marks at the top of all pages of the (accessible) websites and in the product, advertising appearing on the website homepages and other pages throughout the websites.

The registration and use of the disputed domain names by the Respondent and the use of the Trade Marks within (at least) the UK are likely to mislead relevant members of the public who are attempting to purchase products through the disputed domain names into believing that they are doing so from the Complainant's genuine website or from a website that is in some way connected to or associated with the Complainant,

It is unlikely that at the time of registration, the Respondent did not know of the similarity between the disputed domain names and the Gola Domains and Trade Marks as the accessible disputed domain names are materially identical to the Trade Marks and the Gola Domains.

The Respondent purposefully used the Trade Marks fraudulently to deceive the public into a mistaken belief that the disputed domain names are owned by the Complainant, or are at least associated or connected with the Complainant.

Complainant has nothing to do with the disputed domain names or the Respondent. The Respondent has no legitimate interest in the Infringing Domains as they are most likely being used to defraud third parties.

The disputed domain names were registered in bad faith as the sole purpose for their registration was and is to impersonate the Complainant for fraudulent purposes. The Respondent's impersonation of the Complainant is designed to deceive third parties into believing that the disputed domain names are owned by the Complainant and are offering legitimate products, when in fact the Respondent is instead defrauding consumers.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLAINT 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 the trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy) mentioned hereabove under 'Identification of rights'.

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 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.

PRINCIPAL REASONS FOR THE DECISION

The Complainant demonstrated that it has various GOLA registered trademarks. The disputed domain names contain the Complainant's GOLA trademark in its entirety, together with the country names: "IRELAND", "PORTUGAL", "ESPANA", "AUSTRALIA" and "COLOMBIA". Complainant's GOLA mark is fully recognizable in all five disputed domain names. It is the first and dominant element in all disputed domain names. The generic Top-Level Domain in respect of the disputed domain names, in this case ".com". It is typically disregarded for the purposes of the comparison under the first element analysis of the Policy. Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainant's GOLA trademark.

The Complainant does not directly address the provisions of the Policy, in particular, paragraphs 4(c)(i), 4(c)(ii) and 4(c)(iii), regarding whether the Respondent has rights or legitimate interests in the disputed domain name. The Complainant notes that there is no commercial relationship between the Parties, that the Complainant has not authorized the Respondent to use its trademark in the disputed domain names and on the associated websites in the case of <golaportugal.com>, and <golaespana.com>. The Complainant noted that the content set out on these aforementioned websites operated under the disputed domain names replicate the Complainant's own website material without permission, evidencing this with a side-by-side screenshot comparison. A reverse image search has shown that five of the seven domain names use the same image, which is not featured on the genuine Gola websites. The Complainant suggests that the Respondent is merely collecting the Complainant's customers' data without permission. The Panel finds that these submissions are sufficient to constitute the requisite prima facie case that the Respondent has no rights and legitimate interests in the disputed domain names.

The Respondent has not rebutted the complaint, since it has not filed a Response in the administrative proceeding. The Panel has considered the possibility that the Respondent might be selling the Complainant's genuine goods under the Complainant's GOLA trademark. However, even if the Respondent had shown this, it would have been unable to establish all of the requirements of the well-known "OKI Data test" (see: Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-

0903). Notably, it would have had to establish that it was actually offering for sale only the trademarked goods and to show that its website accurately and prominently disclosed its (lack of) relationship with the Complainant. There is no evidence that the Respondent is selling genuine, or any, goods, and no such accurate and prominent disclosure is shown on the Complainant's screenshots of the website associated with the disputed domain names.

The Panel therefore considers that it is reasonable in all of the above the circumstances to find that that the Respondent has no rights or legitimate interests in the disputed domain names.

With regards to the question of bad faith in respect of the disputed domain names, the Complainant has made provided evidence that the websites associated with the disputed domain names of <golaportugal.com>, and <golaespana.com> contain content cloned from the Complainant's website. The said websites and the disputed domain names make prominent use of the Complainant's GOLA trademark and the Complainant's own website imagery. In these circumstances, the Respondent cannot have registered the disputed domains name other than in the full knowledge of the Complainant's trademark.

The Complainant noted that the Respondent registered and used the disputed domain names for fraudulent purposes and, in particular, to obtain personal data from the Complainant's customers by impersonating the Complainant, which has not been contested by the Respondent. In these circumstances, the Panel notes that Respondent has failed to advance any plausible good faith motivation for its registration and use of the disputed domain names.

In the absence of any relevant evidence or submissions from the Respondent to the contrary, the Panel considers it reasonable to infer from the facts and circumstances of this case that the Respondent had knowledge of the Complainant and its GOLA trademark when the Respondent registered the disputed domain names and, likewise, that it had the requisite intent to target such mark unfairly for its own commercial gain. The Panel finds that this constitutes registration in bad faith within the meaning of the Policy. The Panel also considers it reasonable to infer that, having registered the disputed domain names, the Respondent proceeded to use it in connection with cloned aspects of the Complainant's website in order to confuse consumers into giving up their valuable personal data. The Panel finds that this constitutes use in bad faith within the meaning of the Policy.

The Panel holds, that given the fact that the domain names <GOLAIRELAND.COM>, <GOLAAUSTRALIA.COM> and <GOLACOLOMBIA.COM> were registered also by the Respondent on the same dates as the afore-mentioned, August 11, 2021 and August 24, 2021, although inaccessible for the public. The Panel takes into account the combination of the simultaneous registration of the domain names <GOLAIRELAND.COM>, <GOLAAUSTRALIA.COM> and <GOLACOLOMBIA.COM> together with the accessible domain names <golaportugal.com>, and <golaespana.com> of which the Complainant has provided evidence that these are being used to sell GOLA branded products. The Panel, based on the combination of these facts, with the earlier complaint (case number 104197) decides that it is clear that the Respondent has registered all five domain names in bad faith, of which two (<golaportugal.com> and <golaespana.com>) are indeed being used in bad faith.

In the absence of any relevant evidence or submissions from the Respondent to the contrary, the Panel based on the facts and circumstances of this case, holds that the Respondent had knowledge of the Complainant and its GOLA trademark when the Respondent registered the disputed domain names and, likewise, that it had intent to target the GOLA trademark unfairly for its own commercial gain. The Panel finds that this constitutes registration in bad faith within the meaning of the Policy. The Panel also considers that, having registered the five disputed domain names, the Respondent proceeded to use it in connection with cloned aspects of the Complainant's website in order to confuse consumers. The Panel finds that this constitutes use in bad faith within the meaning of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. GOLAIRELAND.COM : Transferred
 2. GOLAPORTUGAL.COM : Transferred
 3. GOLAESPANA.COM : Transferred
 4. GOLAAUSTRALIA.COM : Transferred
 5. GOLACOLOMBIA.COM: Transferred
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PANELLISTS

Name **Mr. E.J.V.T. van den Broek**

DATE OF PANEL DECISION **2022-03-11**

Publish the Decision
