

Decision for dispute CAC-UDRP-104294

Case number	CAC-UDRP-104294
Time of filing	2022-04-28 10:17:49
Domain names	gola-outlet.com, golaphilippines.com , golapolska.com, golasporayakkabi.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	D. Jacobson & Sons Limited
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Complainant representative

Organization	TLT LLP
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Respondent

Organization	Web Commerce Communications Limited
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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 numerous trademarks worldwide consisting of the term "GOLA", including but not limited to:

- i) UK Trademark no. 00001097140 "GOLA", Cl: 18, Registration date: June 14, 1978;
- ii) UK Trademark no. 00000272980 "GOLA", Cl: 25, Registration date: May 22, 1905;
- iii) EU Trademark no. 001909936 "GOLA", Cl: 18, 25, 28, Registration date: October 4, 2000;
- iv) EU Trademark no. 003399681 "GOLA", Cl: 5, 10, 12, 35, Registration date: October 8, 2003; and
- v) EU Trademark no. 011567625 "GOLA" (stylised), Cl: 18, 25, 35, Registration date: February 12, 2013.

The Complainant is also the owner of several domain names, incorporating the trademark "GOLA", such as <gola.co.uk> registered on December 17, 1997 and <golausa.com> registered on February 13, 2002.

FACTUAL BACKGROUND

The Complainant is a UK based designer, importer, seller and exporter of ladies', men's and children's footwear. 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>. Customers in the UK, EU and US are able to purchase the Complainant's products through the Gola's domain names.

The Complainant owns different trademarks with the term "GOLA" brand, which it has applied (amongst other things) to its range of footwear and bag designs.

The Respondent registered the four disputed domain names as follows:

<gola-outlet.com> on August 11, 2021
<golaphilippines.com> on August 11, 2021
<golapolska.com> on August 28, 2021
<golasporayakkabi.com> on December 14, 2021

(hereinafter, the "Disputed Domain Names").

The Complainant argues that the Disputed Domain Names are being used fraudulently by the Respondent to obtain personal and financial information of the Complainant's customers. In this vein, the Complainant argues that the Disputed Domain Names are being used to offer for sale GOLA branded footwear and bags.

The above facts asserted by the Complainant are not contested by the Respondent.

According to the information on the case file, the Registrar confirmed that the Disputed Domain Names use the following registration information:

Domain holder. Organization: Web Commerce Communication Limited
E-mail: support@webnic.cc

The Complainant amended the Complaint accordingly and included Web Commerce Communication Limited as Respondent and owner of the Disputed Domain Names.

The language of the registration agreement is English.

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 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.

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a 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 are being used in bad faith.

The Panel has reviewed in detail the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of Complainant to demonstrate that the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of different trademarks registrations pertaining the term GOLA for different products, including bags, cases, articles of clothing, gymnastic and sporting articles, etc.

The Complainant's trademarks were registered prior to 2021, the year of the creation date of the Disputed Domain Names.

In the current case, the Disputed Domain Names are composed as follows:

1. <gola-outlet.com>: the trademark GOLA plus the generic word "Outlet";
2. <golaphilippines.com>: the trademark GOLA plus the country name "Philippines";
3. <golapolska.com>: the trademark GOLA plus the Polish word "Polska", which means Poland in English;
4. <golasporayakkabi.com>; the trademark GOLA plus the Turkish word "Sporayakkab", which means Sneakers in English.

In assessing confusing similarity, the Panel finds the Disputed Domain Names are confusingly similar to the Complainant's trademark, as it incorporates the entirety of the GOLA trademark plus generic terms such as Outlet and Sneakers as well as the name of countries such as Poland and Philippines. In this regard, UDRP panels agree that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 ("WIPO Jurisprudential Overview 3.0.).

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Names are confusingly similar to Complainant's GOLA mark.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAMES.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g.

WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this vein, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the disputed domain name on behalf of the Respondent such as:

- (i) before any notice to Respondent of the dispute, Respondent is using or provides with demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) The Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent did not reply to the Complaint despite the efforts made by this Center to notify the Complaint. In this regard, the Complainant has confirmed in the Complaint that the Disputed Domain Names are not connected with or authorized by the Complainant in any way.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the Disputed Domain Names.

The Respondent's name "Web Commerce Communication Limited" provided in the Registrar's verification dated April 29, 2022 is all what it links the Disputed Domain Names with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Names.

In terms of the evidence provided by the Complainant, the websites linked to the following three Disputed Domain Names have been used as follows:

1. <golaphilippines.com>: replicating Complainant's websites in English language using GOLA's trademarks;
2. <golapolska.com>: replicating Complainant's website in Polish language using GOLA's trademarks;
3. <golasporayakkabi.com>; replicating Complainant's website in Turkish language using GOLA's trademarks;

The Complainant presented a comparison between some parts of the Complainant's official website and those copied by the Respondent and it is clear that the Respondent set up the three websites to mirror the Complainant's genuine websites.

Furthermore, the Complainant indicated that the Disputed Domain Names are being used fraudulently by the Respondent to obtain the personal and financial information of the Complainant's customers, however, the Complainant did not submit any evidence to support this argument.

With respect to the disputed domain name <gola-outlet.com>, the Complainant did not provide with evidence about the use of the website and rather only provided with the who is record of the domain name. However, in the Complaint, the Complainant indicated that only three websites were accessible in the UK which means that the Complaint was not able to see the content of the domain name <gola-outlet.com>.

The Panel using its general Powers articulated in paragraphs 10 and 12 of the UDRP Rules visited the website linked to the domain name <gola-outlet.com> and realised that the website currently shows a message indicating the following "Access denied. You do not have access to gola-outlet.com".

From the evidence presented, it is then clear that the Respondent acquired and set up the three Disputed Domain Names with intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue and, therefore, the Panel neither finds a bona fide offering of goods and service nor legitimate non-commercial or fair use of the Disputed Domain Names.

In light of the reasons above mentioned, the Panel concludes that the Complainant has satisfied the second element of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Names in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four 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:

- (i) circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) The Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

For the current case, the evidence at hand confirms that Complainant's GOLA trademark is distinctive and it has a strong reputation in the footwear and bag industry. In addition, the Complainant's trademarks were registered long before the Disputed Domain Names were created. Based on those elements, the Panel is of the opinion that Respondent knew or should have known that its domain name registrations would be confusingly similar to the GOLA trademarks.

Furthermore, the Complainant provided with evidence showing that three of the four Disputed Domain Names were set up by the Respondent to mirror the Complainant's genuine websites with the purpose to mislead internet consumers 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. In this sense, the Complainant has confirmed that no authorization was granted to the Respondent to register them and no counterargument has been submitted by Respondent. This is a clear indication that the three Disputed Domain Names were set up with the only intention to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

The fourth domain name; i.e. gola-outlet.com, is currently used to host a website with a warning message. UDRP Panelist have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. In this regard, the Panel is convinced that the current use of the domain name gola-outlet.com cannot be considered in good faith due to the following aspects: i) distinctiveness of the GOLA's trademarks, ii) the lack of legitimate interest by the Respondent, iii) the lack of reply of this Complaint and, iv) the fact that the three additional Disputed Domain Names have been set up with the only purpose of mirroring the Complainant's official website. See paragraph 3.33 of WIPO Jurisprudential Overview 3.0.

The Complainant indicated that the Disputed Domain Names are linked to the UDRP Cases 1041970, 104197, 104314 and 104400 but did not provide with evidence (such as copies of the cases) supporting the involvement of the Respondent in those UDRP Disputes.

In terms of the current UDRP jurisprudence, it has been accepted that a Panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.

This may include visiting the website linked to the disputed domain name in order to obtain more information about the

respondent or its use of the domain name, consulting historical resources such as the Internet Archive in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopedias (e.g., Wikipedia), or accessing trademark registration databases.

See paragraph 4.8 of WIPO Jurisprudential Overview 3.0.

Since the Complaint was able to at least identify the UDRP case numbers, the Panel was able to research on the portal of this Arbitration Centre the following numbers linked to UDRP Disputes: 104197, 104314 and 104400. Those disputes were filed by Complainant against the current Respondent regarding different domain names with Complainant's GOLA trademark which is a confirmation of pattern of bad faith conduct on Respondent's side.

UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration.

This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner.

See paragraph 3.1.2. of WIPO Jurisprudential Overview 3.0.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Names and the Complainant's GOLA trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact that three of the Disputed Domain Names are being used to mirror the Complainant's genuine websites with the purpose to mislead internet consumers and the remaining one is on passive holding, d) The Respondent has been involved in at least three additional UDRP case, the Panel draws the inference that the Disputed Domain Names were 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. GOLA-OUTLET.COM: Transferred
2. GOLAPHILIPPINES.COM : Transferred
3. GOLAPOLSKA.COM: Transferred
4. GOLASPORAYAKKABI.COM: Transferred

PANELLISTS

Name **Victor Hugo Garcia Padilla, LL.M.**

DATE OF PANEL DECISION **2022-06-03**

Publish the Decision