Decision for dispute CAC-UDRP-100278

Case number	CAC-UDRP-100278
Time of filing	2011-06-28 09:19:39
Domain names	ECCOSHOESUK.NET

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	ECCO SKO A/S

Complainant representative

Organization	Chas. Hude A/S

Respondent

Organization	linlin

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant has cited multiple trademark registrations for ECCO for use in connection with footwear, including Community Trademarks Reg. Nos. 001149871 and 004568168; US Trademark Reg. Nos. 1935123 and 3187658; Canadian Trademark Reg. No. 280654; Australian Trademark reg. No. 375267A; and Chinese Trademark Reg. Nos. 208743.

FACTUAL BACKGROUND

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

The disputed domain name contains Complainant's trademark ECCO in full, together with some generic terms, which meaning is related to Complainant's business. Therefore, the disputed domain name is confusingly similar to Complainant's trademark (Policy, Par. 4 (a)(1)).

Respondent has no rights in the trademark ECCO and is not a reseller/licensee of Complainant, use of the trademark ECCO by Respondent has never been authorized by Complainant, and Respondent is using his website to promote the sale of third parties goods as well as goods, which are very likely counterfeit. Accordingly, Respondent has no rights or legitimate

interests in respect of the domain name (policy, Par. 4 (a)(11)).

ECCO constitute the first and dominant element of the disputed domain name. Complainant's logo and pictures taken from Complainant's website and catalogue are used by the Respondent, who is attempting to divert Internet users to his domain name by creating a likelihood of confusion. Respondent is exploiting the goodwill attached to Complainant's trademarks for selling goods which are very likely counterfeit. For all these reasons, Complainant finds that the disputed domain name was registered and is used in bad faith (Policy, Par. 4(a)(iii)).

In all the aforementioned circumstances, Complainant finds that the disputed domain name has been registered and is used in bad faith. WIPO's decisions in the following complaint proceedings support the case:

D2010-2038, eccodiscount.com
(http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-2038)
D2010-1443, eccobrandshop.com, ecooshop.com
http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1443)
D2010-1113, 51ecco.com
(http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1113)
D2010-0650, eccoshoesoutlet.com, eccoshoesoutlets.com, eccoshoesoutlets.net
(http://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0650.html)

Language
It has not been possible to obtain information on the language of the Registration Agreement. In any case, Complainant respectfully requests that the language of these proceedings be English.

Both the disputed domain name and the web site to which the domain name resolves are in English. Moreover, Respondent's e-mail addresses are also in English.

For all these reasons it must be assumed that Respondent has good command of the English language.

Moreover, Complainant would be unfairly disadvantaged if forced to translate the complaint to Chinese. WIPO's decision in the case D2010-1443, eccobrandshop.com, ecooshop.com (http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1443) supports the case.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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.

Although the Complaint was filed in English and the registrar has stated that the language of the registration agreement is Chinese, the Panel exercises its authority pursuant to Paragraph 11(a) of the Rules, "having regard to the circumstances of the administrative proceeding," to allow these proceedings to occur in English. In this regard, the Panel notes that the Complainant has stated that "[b]oth the disputed domain name and the web site to which the domain name resolves are in English. Moreover, Respondent's e-mail addresses are also in English... Complainant would be unfairly disadvantaged if forced to translate the complaint to Chinese." Allowing this proceeding to occur in English is consistent with numerous decisions under the UDRP, including at least one decision brought by the same Complainant as in the instant case, ECCO sko A/S v. Lin Ronghua / Mr. Lin, WIPO Case No. D2010-1443 (transfer of <eccobrandshop.com>), in which the panel found that "evidence has been adduced by the Complainant to suggest the likely possibility that the Respondent is conversant and proficient in the English language." This Panel finds similar factual circumstances in this case.

PRINCIPAL REASONS FOR THE DECISION

Based on the multiple trademark registrations cited by Complainant, supported by copies of relevant certificates of registration (including Community Trademarks Reg. Nos. 001149871 and 004568168; US Trademark Reg. Nos. 1935123 and 3187658; Canadian Trademark Reg. No. 280654; Australian Trademark reg. No. 375267A; and Chinese Trademark Reg. Nos. 208743), the Panel is convinced that Complainant has rights in and to the trademark ECOO for use in connection with footwear. This conclusion is consistent with previous UDRP decisions involving he same Complainant and trademark, e.g., ECCO Sko A/S v. Jacklee, WIPO Case No. D2011-0800 (transfer of <eccoshoesaustralia.com>).

As to whether the disputed domain name is identical or confusingly similar to the ECCO trademark, the relevant comparison to be made is with the second-level portion of the domain name only (i.e., "eccoshoesuk"), as it is well-established that the top-level domain name (i.e., ".net") should be disregarded for this purpose.

Here, because the word "shoes" is associated with the ECCO trademark, this word increases the confusing similarity between the Disputed Domain Name and Complainant's trademark -- as previous panels have held in cases involving the same Complainant and other domain names also containing the ECCO trademark and the word "shoes." ECCO Sko A/S v. Jacklee, WIPO Case No. D2011-0800 (transfer of <eccoshoesaustralia.com>) See also Gateway Inc. v. Domaincar, WIPO Case No. D2006-0604 (finding the domain name <gatewaycomputers.com> confusingly similar to the trademark GATEWAY because the domain name contained "the central element of the Complainant's GATEWAY Marks, plus the descriptive word for the line of goods and services in which the Complainant conducts its business"). See also Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill, WIPO Case No. D2010-2124 (the addition of certain words can "exacerbate[] the confusing similarity between the [Complainant's] trademark and the Domain Name and increase[] the risk of confusion between the Domain Name and the… trademarks") (citing Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561 (citing Yellow Corporation v. MIC, WIPO Case No. D2003-0748 ("when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity")).

Further, the addition of a geographic term to a domain name, as here (i.e., "uk"), does not diminish any confusing similarity, especially where, as here, Complainant has trademark rights in the indicated geographic region. See, e.g., ECCO Sko A/S v. Jacklee, WIPO Case No. D2011-0800 (transfer of <eccoshoesaustralia.com>) ("[i]t has been well established that the use of a geographic term in a domain name does not add distinctiveness"); and Six Continents Hotels, Inc. v. GBT - Domains For Sale and Lease, WIPO Case No. D2008-1309 (transfer of <holidayinnphiphi.com>) ("[t]his Panel further accepts the Complainant's submission that the combination of its trademark with the name of the Phi Phi Islands, where one of the Complainant's hotels is located, would serve to add to such confusion rather than distinguish the mark and the domain name").

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Complainant has stated that Respondent has no rights in the trademark ECCO and is not a reseller/licensee of Complainant, that use of the trademark ECCO by Respondent has never been authorized by Complainant, and that Respondent is using his website to promote the sale of third parties goods as well as goods, which are very likely counterfeit.

Under the UDRP, once a complainant has made out a prima facie case that the respondent lacks rights or legitimate interests, 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, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Accordingly, as a result of Complainants' allegations and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainants have proven the second element of the UDRP.

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has 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 registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location. Policy, paragraph 4(b).

In this case, Complainant appears to argue that bad faith exists pursuant to paragraph 4(b)(iv), given that the website used by Respondent in connection with the disputed domain name allegedly offers for sale counterfeit ECOO products -- an allegation supported by printouts from Complainant's and Respondent's websites and not denied by Respondent. The sale of counterfeit products in such circumstances "is strong evidence of bad faith." Guccio Gucci S.p.A. v. Domain Administrato - Domain Administrator, WIPO Case No. D2010-1589. See also Cartier International, N.V. , Cartier International, B.V. v. David Lee, WIPO Case No. D2009-1758 (finding bad faith where "the domain name contains the Complainant's mark and the website offers to sell counterfeit imitations of the Complainant's products").

Accordingly, the Panel is satisfied that Complainant has proven the third element of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ECCOSHOESUK.NET**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2011-08-04

Publish the Decision