Decision for dispute CAC-UDRP-100259

Case number	CAC-UDRP-100259
Time of filing	2011-06-17 15:30:08
Domain names	ECCOSHOESSHOP.COM

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	ECCO SKO A/S

Complainant representative

Organization	Chas. Hude A/S

Respondent

Name	Pin Shang

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings with regard to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies on the following trademark registrations for "ECCO" , all registered inter alia for " footwear": Community Trade Mark No. 001149871; US Trademark Reg. No. 1935123; Canadian Trademark Reg. No. 280654; Australian Trademark Reg. No. 375267A; and Chinese Trademark Reg. No. 208743.

FACTUAL BACKGROUND

The Complainant asserts the following facts:

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 constitutes the first and dominant element of the disputed domain name. Several pictures and logos 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 bearing third parties' trademarks. Respondent is using his website to sell goods, which Complainant strongly suspect to be 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
Notwithstanding the fact that the language of the Registration Agreement is Chinese, 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 that 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.

PRINCIPAL REASONS FOR THE DECISION

1.
ICANN approved the application of the CAC to become an international provider of UDRP services on 23 January 2008. As ICANN accredited UDRP provider the CAC can administer the present proceedings.

The legal basis for the Panel decision is built by the Uniform Domain Name Dispute Resolution Policy (UDRP), the Rules for Uniform Domain Name Dispute Resolution Policy (UDRP-Rules) and the CAC's UDRP Supplemental Rules of the Czech Arbitration Court (CAC Supplemental Rules).

The Panel concurs with the view that a respondent's default does not automatically result in a decision in favour of the complainant but that the complaint must build a case that the prerequisites for the requested transfer of the disputed domain name under the UDRP are fulfilled (c.f. e.g. CAC UDRP cases Nos. 100004 – novotelvietnam.com; 100095 – leros-boatyard.com; 100093 - asia-airfrance.com and WIPO cases Nos. D2002-1064 – vanguar.com; D2003-0465 – berlitzsucks.com; D2004-0383 – brookhogan.com).

2.
First, the Panel must determine the correct language of the proceedings.

2.1
Starting point is Paragraph 11(a) UDRP-Rules, stating that unless otherwise agreed by the Parties or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceedings.

2.2
The Complainant has not asserted that the Parties agreed to English as the language of the present proceedings. Consequently, the language of the proceedings must be determined with regard to the Registration Agreement (either because specific provisions are stipulated there or simply by looking at the language it is drafted in).

The Complainant himself asserts that the registration agreement for the domain name in question is made in Chinese.

2.3
The Complainant asserts that the case should nevertheless be decided in English. As far as the Complainant submits that he would be unfairly disadvantaged if forced to translate the complaint to Chinese, this argument has to be rejected.

The UDRP-proceedings completely rely on contractual provisions between private parties. It therefore complies with international comity, in lack of express agreements between the parties, to determine the language with regard to the language of the arbitration agreement. This rule also serves the interests of a domain name holder who, with the registration of the domain name, potentially faces UDRP-proceedings from all over the world. If the draftsmen of the UDRP and the UDRP-Rules would have thought that convenience should be the determining factor for the language of the proceedings the UDRP-Rules would expressly state so (cf. CAC UDRP case No. 100093 - asia-airfrance.com).

The Panel cannot agree with the Complainant that the requirement to translate the Complaint into Chinese would put a burden of further costs on the Complainant. The language requirements of the UDRP clearly protect the respondent party, who should be able to understand the allegations made in the complaint and should be able to properly defend itself. One can assume that the domain name owner would only use a registration agreement in a language it is proficient in. In case a complaint under the UDRP deviates from the language of the registration agreement, there is a danger that the defendant cannot understand the allegations and therefore would carry cost burden to have the complaint translated into a language he can properly understand and argue its case in. In the same way, the response would have to be translated, which would incur further costs. In the view of this Panel, the language regime of the UDRP is meant to protect the interests of the

respondent to a fair hearing and due process.

In the light of the above, the Panel is of the opinion that the discretion under Paragraph 11(a) UDRP-Rules should only be used in exceptional cases, when either the respondent does not need to be protected since the evidence shows that he is sufficiently proficient in the language requested by the complaint or if the choice of the language of the registration agreement is made in bad faith in order to incur costs for the complainant.

As far as the Complainant refers to WIPO's decision in the case D2010-1443, eccobrandshop.com, ecooshop.com in order to support its case, a detailed perusal of the reasons reveals that the panel mainly relied on the first exception accepted by this Panel: it held that the respondent had the proficiency to defend its case in English.

2.3
The fact that this Panel, in the end, decided to exercise its discretion and to conduct the proceedings in English has its reason solely in the fact that the Respondent in the present case is clearly not in the need of protection by the language regime of the UDRP. The Panel has the power to make own inquiries, particularly to visit the website under the domain name in question and take into consideration the content provided there (cf. e.g. CAC UDRP case No. 100093 - asia-airfrance.com). Since the language regime serves to protect the interests of the respondent, the Panel deems it necessary to undertake own inquiries rather than to rely on the assertions of the complainant. For this reason, this Panel is of the opinion that a complaint with a request of a change of the language of the proceedings cannot be decided in form of a "simplified decision".

The Panel has found that the online shoe shop operated under the domain name is held completely and exclusively in English, that the Respondent offers to sell its products for US dollars, Australian dollars, British pound and Canadian dollars, i.e. the currencies of countries with English as official language, that the privacy statements, condition of use, shipping and returns sections are all in English. Last and most importantly, the Respondent offers a "contact us" form in English language stating "Thank you for your letter.We will reply within 24 hours". In the view of the Panel this has to be understood as an offer to reply to English requests in English. This is, in the view of the Panel, sufficient evidence that the Respondent has sufficient proficiency to argue his case in English. Hence, there is no need to protect the Respondent under the UDRP language regime and to keep the Complainant to Chinese as the language of the proceedings.

3.
The Panel now turns to the substantive questions of the case. In order to succeed in its claim, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) UDRP have been satisfied: (i) The 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 with respect to the Domain Name; and (iii) The Domain Name has been registered and is being used in bad faith.

3.1
The Complainant has provided sufficient evidence that it is the owner of the "ECCO" trademarks for "footwear" identified above. These trademarks are confusingly similar to the domain name as required by Paragraph 4(a)(i) UDRP.

In the view of the Panel it is the uncontested position under the UDRP that the top level domain, such as ".com" in the present case, has to be exclude while comparing the trademark with the domain name (c.f. e.g. CAC UDRP cases Nos. 100004 – novotelvietnam.com; 100084 – paiement-cic.com; 100074 – michelintires.info; 100093 - asia-airfrance.com and WIPO cases Nos. D2000-1532 – brucespringsteen.com; D2002-0234 – herballife.net and DCC2003-0001 – officemax.cc).

Furthermore, the Panel concurs with the view of earlier decisions that a merely descriptive term, such as the portion "shoesshop" does not suffice to create a relevant distance between trademark and Domain Name since internet users (as "reasonable bystanders") will understand "shoesshop" as reference to an official website of the Complainant. Consequently, the Panel finds that the domain name and the Complainant's trademarks are confusingly similar.

3.2

In the view of the Panel the Respondent does not have rights or legitimate interests in respect of the Domain Name according to Paragraph 4(a)(ii) UDRP. Although the onus of proof for this second requirement under the UDRP rests with the Complainant, the Panel follows the view that it is impossible for a complainant to prove a “negative fact”, which would require information that is primarily within the knowledge of the respondent. Therefore, a complainant is required to make out prima-facie case that the respondent lacks rights or legitimate interests and the onus of proof then shifts to the respondent to rebuke the complainant’s prima-facie case (c.f. e.g. CAC UDRP cases Nos. 100053 – enterprisecarrentalonline.info; 100084 – paiement-cic.com; 100092 – lerosmarina.com; 100099 – sublimedirections.com; 100093 - asia-airfrance.com and WIPO cases Nos. D2003-0455 – croatiaairlines.com; D2004-0110 – belupo.com).

The Complaint has made out such a prima-facie case and stated, amongst others, that the Complainant is not aware of the fact that the Respondent is known by the term “ECCO” and that the Complainant has not licensed the right in the use of this designation to the Respondent. Paragraph 4(c)(iii) UDRP states that a use under legitimate interests would require that the Respondent makes a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue. Since the Respondent's website clearly serves as a commercial online shoe shop there is no non-commercial use. Since the Respondent - according to the Complaint and not disputed by the Respondent - sells counterfeited shoes under the Complainant's trademark, there is, in the view of the Panel, no fair use.

3.3
The Panel is, furthermore, of the opinion that the domain name has been registered and is being used in bad faith according to Paragraph 4(a)(iii) UDRP. As Paragraph 4(b) UDRP clearly states: for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
[...]
(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

This is the case here, since the Respondent uses the domain name to sell - as alleged by the Complainant and not rebuked by the Respondent - to sell counterfeited footwear under the trademark of the Complainant. Such behaviour amounts, in the view of the Panel, both, to a disruption of the business of a competitor and the the intentional attempt to attract users to the website of the Respondent for commercial gain.

4.
Since all three requirements under Paragraph 4(a) UDRP have been proven by the Complaint to the satisfaction of the Panel, the Complainant is entitled to a transfer of the Domain Name as requested in the Complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ECCOSHOESSHOP.COM**: Transferred

PANELLISTS

Name	**Dr. Uli Foerstl**

DATE OF PANEL DECISION 2011-08-08

Publish the Decision