Decision for dispute CAC-UDRP-100311

Case number	CAC-UDRP-100311
Time of filing	2011-08-31 10:13:41
Domain names	UKECCOSHOES.NET

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	ECCO SKO A/S

Complainant representative

Organization	Chas. Hude A/S

Respondent

Name	fuqingmaoyi

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided decision relating to the disputed domain name

IDENTIFICATION OF RIGHTS

The Complainant has shown that it ows registrations over the ECCO trademark in many countries worldwide in connection with, inter alia, footwear. Among the cited trademarks are Chinese Trademark Reg. Nos. 208743, Community Trademarks Reg. Nos. 001149871 and 004568168; US Trademark Reg. Nos. 1935123 and 3187658; Canadian Trademark Reg. No. 280654; Australian Trademark reg. No. 375267A

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 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)).

The disputed domain name is almost identical to ECCOSHOESUK.NET, which registration and use was found abusive (CAC decision no. 100278). Furthermore, ECCOSHOESUK.NET is now forwarding to the disputed domain name. It is Complainant's opinion that this constitutes a gross breach of the UDRP. Furthermore, it must be assumed that the two domain names have the same registrant.

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

CAC no. 100278, eccoshoesuk.net
CAC no. 100259, eccoshoesshop.com
WIPO no. D2010-2038, eccodiscount.com
WIPO no. D2010-1443, eccobrandshop.com, ecooshop.com
WIPO no. D2010-1113, 51ecco.com
WIPO no. D2010-0650, eccoshoesoutlet.com, eccoshoesoutlets.com, eccoshoesoutlets.net

Language
It has not been possible to contact the Registrar in order 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 is proficient in English.

CAC decisions in the cases no. 100278 eccoshoesuk.net and no. 100259 eccoshoesshop.com, and 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) support 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.

The only procedural issue that the Panel has been faced with is the language of the proceedings. The Complaint was filed in English but the registrar has stated that the language of the registration agreement is Chinese. When the Complainant first filed its complaint, the Complainant was unaware of the real name of the registrant as the Domain Name had been registered through a proxy holder. It is only when the Registrar replied to the request for Registrar verification that the Complainant became aware of the real identity of the Domain Name registrant.

The Complainant stated that "It has not been possible to contact the Registrar in order 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 is proficient in English". The Complainant cited a number of decisions that support the case, namely CAC decisions in the cases No. 100278 eccoshoesuk.net and No. 100259 eccoshoesshop.com, and WIPO's decision in the case D2010-1443, eccobrandshop.com, ecooshop.com.

Pursuant to Paragraph 11(a) of the Rules, the Panel exercises its authority , "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". The Complainant has enclosed pages of the website accessible through the Domain Name clearly showing that the language of the website is English.

Accordingly the Panel concludes that the it is not foreseeable that the Respondent will be prejudiced, should English be adopted as the language of the proceedings.

For all the reasons mentioned above, the Panel determines under paragraph 11(a) that English shall be the language of the proceedings (for a similar decision see WIPO Cases Nos. D2009-1572-1573-1584-1586-1620-1623-1624-1635-1639-1640-1658 -Farouk Systems, Inc. vs. several respondents).

PRINCIPAL REASONS FOR THE DECISION

The Panel is convinced that the Complainant enjoys trademark rights over the word ECCO in many countries worldwide, including in China, which is the place of origin of the Respondent. This circumstance has already been recognized by other Panels in prior cases (see for instance ECCO Sko A/S v. Jacklee, WIPO Case No. D2011-0800).

The Domain Name entirely includes the Complainant's trademark along with the prefix "UK" and the suffix "shoes". The Domain Name suffix simply describes the Complainant's activity, i.e., that of being a shoe manufacturer and seller. Thus, the addition of the term "shoe" to the Domain Name, rather than reducing the likelihood of confusion with the Complainant's trademark, increases it (see also ECCO Sko A/S v. Jacklee, WIPO Case No. D2011-0800 (transfer of <eccoshoesaustralia.com>), and ECCO Sko A/S v. linlin, CAC Case No. 100278 (transfer of <eccoshoesuk.net).
As to the addition of a geographic term to a domain name, (i.e., "uk"), it does not decrease the existing confusing similarity, as this term simply refers to the place where the Respondent's exercises its activity, or to the place of origin of the consumers of reference of the goods sold through the Domain Name website. Moreover, the Complainant is also active in the UK and enjoys trademark rights in this country.

Accordingly, the Panel finds that Complainant has successfuly proved 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).

As to the second element set forth by paragraph 4(a)(ii) of the Policy, i.e., that the Respondent has no rights or legitimate interests in respect of the Domain Name, the Panel notes that the 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 lies on the respondent. This is so because proving a negative fact is quite difficult, if not impossible. The Respondent has failed to demonstrate that it owns legitimate rights or interests.

The Complainant maintains that the goods offered for sale on the website acessible through the Domain Name are likely to be counterfeit goods. To substantiate this circumstance, the Complainant has enclosed a document containing a comparison between the shoes offered for sale on the Complainant's site and the corresponding shoes offered for sale on the site accessible through the Domain Name.

The Panel cannot ascertain beyond of any doubt that the Respondent is indeed selling counterfeit items on the website accessible through the Domain Name. However, Respondent's default in these proceedings, along with the evidence filed by the Complainant, support the inference that the goods sold on the website accessible through the Domain Name, or at least some of them, are probably counterfeit.

There can be no legitimate interest in the sale of counterfeits. Other prior decisions have come to the same conclusion whenever the disputed domain name leads to a website offering for sale counterfeit items (e.g. WIPO Case No. D2004-0750 - Lilly ICOS LLC v. Dan Eccles; WIPO Decision in Case No. D2005-0552, Wellquest International, Inc. v. Nicholas Clark).

Therefore the Panel is satisfied that also the second requirement set forth in the Policy is met.

As to the bad faith issue, according to the Policy, in order to satisfy the requirement under paragraph 4(a)(iii) of the Policy, the Complainant must prove that the domain name at stake was registered and used in bad faith.

The following circumstances are an indication of registration and use in bad faith according to the Policy: (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).

The Complainant has shown reputation of its trademark in many countries worldwide, and certainly in the UK, which is the territory were presumably the Respondent operates or where the consumers to which the Domain Name website is directed are located. Moreover, the kind of activity performed through the Domain Name website, and the fact that the Respondent has reproduced the Complainant's trademark and pictures of the Complainant's catalogue in the Domain Name website are clear indications that the Respondent knew the Complainant's trademark at the time of the registration of the Domain Name. Finally, the Respondent’s sale of presumably counterfeit goods on a website accessible through the Domain Name is evidence of bad faith. (see WIPO Case No. D2004-1019, Prada S.A. v. Domains for Life; WIPO Case D2005-0552, Wellquest International, Inc. v. Nicholas Clark). This conduct supports the inference that Respondent registered this Domain Name with

the bad faith intent to deceive consumers with its counterfeit products, and that it intentionally used the Domain Name to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and products, as set forth by para.4(b)(iv) of the Policy.

Accordingly, the Panel concludes that the Complainant has successfully proved that the Domain Name was registered an is 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. **UKECCOSHOES.NET**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2011-10-09

Publish the Decision