Decision for dispute CAC-UDRP-100406

Case number	CAC-UDRP-100406
Time of filing	2012-02-23 14:38:45
Domain names	ECCOSKOTILBUD.COM

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	ECCO Sko A/S

Complainant representative

Organization	Chas. Hude A/S

Respondent

Organization	xiaolansun

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided decision relating to the disputed domain name (hereinafter the "Domain Name")

IDENTIFICATION OF RIGHTS

The Complainant has shown that it owns many registrations over the ECCO trademark in numerous countries worldwide in connection with, inter alia, footwear. Among the cited trademarks are Chinese registration No. 208743 (registration date 30 May 1984) and Chinese registration No. G738941 (registration date 31 October 2005). Moreover, the Complainant owns two CTMs, namely registration No. 1149871 (registered on 6 February 2003), and registration No. 2967040 (registered on 2 May 2007), as well as two US registrations, respectively No. 1935123 (registered on 14 November 1995) and 3090429 (registered on 9 May 2006), and two Canadian registrations, No. TMA280654 (registered on 26 March 1983) and TMA752707 (registered on 10 November 2009) .

The Complainant also holds a large portfolio of domain names consisting of, or containing the name ECCO, including ECCO.CN (see Annex 4 to the Complaint)

FACTUAL BACKGROUND

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

Language
Notwithstanding the fact that the Registration Agreement is very likely in Chinese, for the following reasons the Complainant respectfully request that the language of the proceedings be English:

The text displayed on the adverse website is partly in Danish and partly in English. For what regards the Respondent's use of the Danish language, this text has probably been generated using some online translation tool (resulting in many errors and the general non-sense of much of the text provided in Danish on the website). Since the Complainant is a Danish-based company, we believe that the Respondent is aiming at enhancing the risk of consumer confusion by using some Danish texts on the website.

On the other hand, part of the text displayed is in English. Furthermore, the buyer of the Respondent's goods can pay in USD, CAD, GBP, which shows that the Respondent ships his goods to English-speaking countries and is able to provide customer support in English. Finally, it is apparently possible to choose the language of the Respondent's homepage, and one of the languages provided is English (this feature was not working when this Complaint was draft) (annex 7). Altogether, these circumstances show that the Respondent has a good command of the English language and would not be disadvantaged if the proceedings were conducted in English.

Legal basis
The Domain Name contains Complainant's trademark ECCO in full. The addition of the generic terms SKO and TILBUD does not preclude but even enhance the risk of confusion / likelihood of association with the Complainant's trademark and company name. Therefore, the 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. Accordingly, Respondent has no rights or legitimate interests in respect of the Domain Name (policy, Par. 4 (a)(11)).

The fact that the Complainant's trademark ECCO constitutes the dominant element of the Domain Name, and that the Complainant's logo and pictures are used by the Respondent without the rightful owner's authorization constitute strong evidence of the fact that the Respondent is attempting to divert Internet users to his Domain Name by creating a likelihood of confusion with the Complainant's trademarks, company name and domain names. The Respondent's use of the trademark ECCO to sell counterfeit/fake ECCO shoes is a further evidence of the abusive registration and use of the Domain Name.

For all these reasons, Complainant finds that the Domain Name was registered and is used in bad faith (Policy, Par. 4(a)(iii)).

The following decisions support the case:

CAC:
Case No. 100357, ECCO-STOVLER.COM
Case No. 100259, ECCOSHOESSHOP.COM
Case No. 100278, ECCOSHOESUK.NET
Case No. 100311, UKECCOSHOES.NET
Case No. 100321, ECCOSKOUDSALG.COM
Case No. 100312, ECCOSALEONLINE.COM
Case No. 100305, ECCOONLINESALE.COM
Case No. 100327, ECCOONLINESALEUSA.COM

WIPO:
Case No. D2010-2038, ECCODISCOUNT.COM
(http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-2038)
Case No. D2010-1443, ECCOBRANDSHOP.COM, ECOOSHOP.COM
http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1443)

Case No. D2010-1113, 51ECCO.COM
(http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1113)
Case No. D2010-0650, ECCOSHOESOUTLET.COM, ECCOSHOESOUTLETS.COM, ECCOSHOESOUTLETS.NET
(http://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0650.html)

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The case, 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 Panel first addresses the issue of the language of the proceedings, since, as the Complainant also pointed out, the language of the Registration Agreement is not English but probably Chinese.

Under Paragraph11(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), "[u]nless 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 proceeding".

Accordingly, the Panel has the authority to determine a different language of the administrative proceeding with respect to that of the Registration Agreement, when the circumstances of the case so require. Panels in earlier cases have found that, in certain situations, where the respondent can apparently understand the language of the complaint (or having been given a fair chance to object has not done so), and the complainant would be unfairly disadvantaged by being forced to translate, the Center as a provider may accept the language of the complaint, even if it is different from the language of the registration agreement. Such acceptance is subject to the panel's authority to determine the appropriate language of the proceeding on appointment. Likewise, in appropriate circumstances, a response in a language different from that of the complainant may be accepted.

In the instant case, the Complainant is fluent in English and Danish. The Complaint was filed in English and previous cases regarding the same Complainant were also decided in English. As far as the Respondent is concerned, he is apparently a Chinese citizen or company (the address provided at the time of the registration of the Domain Name indicates a city located in China). At the same time, however, the Domain Name resolves to an English and Danish website. While, as the Complainant points out, the Danish language used in the website contains several mistakes that entail that the website has been translated through an automatic tool, such as Google translator, the English website denotes a fairly good knowlege of English.

Accordingly, it is plausible that the Respondent is fluent in English, or at least that he understands English without difficulties. On the contrary, it is likely that the Complainant is not capable of speaking or reading Chinese. Filing the Complaint in Chinese would therefore place a too heavy burden on the Complainant in view of the circumstances of the case.

The Respondent had the possibility to object to the use of English had he filed a Response to the Complaint. However, the Respondent failed to file any Response and therefore implicitly accepted the use of English in the instant case.

For the aforementioned reasons, in accordance with Paragraph 11(a) of the Rules, the Panel determines that English shall be the language of this administrative proceeding.

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 consists of the Complainant's trademark ECCO followed by the term SKO, which is part of the Complainant's company name and means "shoe(s)" in Danish, and the word TILBUD, that in Danish means "special offer".

The most distinctive part of the Domain name is the term ECCO, which is identical to the Complainant's trademark. The additional term SKO, which is understandable by at least part of the Internet users, namely those fluent in Danish, designates the Complainant's activity, i.e., that of being a shoe manufacturer and seller. The same Internet users are also able to understand the remaining portion of the domain name, the term TIBUD meaning "special offer" in Danish.

Overall, the addition of the two terms SKO and TILBUD to a domain name consisting of the Complainant trademark is likely to increase, not to decrease, the initial likelihood of confusion. Potential consumers looking for special bargains of the ECCO products will certainly be attracted by the Respondent's website, since the Domain Name is likely to be perceived as originating from the Complainant and not from a third unrelated party.

Therefore, the Panel finds that the Complainant has successfully proved that the Domain Name is identical or confusingly similar to a trademark 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 can hardly be known under the name ECCO". Due to the Complainant long-standing use of the trademark ECCO for shoes, leather goods and other goods and services in many countries worldwide, the Respondent cannot have any legitimate rights in the Domain Name.

Although the Respondent is making a commercial use of the Domain Name, he does not belong to the Complainant's authorized dealers, nor has the ECCO trademark ever been licensed to the Respondent.

According to the Complainant, the goods offered for sale on the Respondent's website are counterfeit. To substantiate this issue the Complainant maintains that the models offered for sale on the Respondent's website and bearing the ECCO trademark do not correspond to any of the Complainant's official goods. This should be a blatant evidence of the fact that the Respondent is selling fake goods through the Domain Name.

The Panel cannot ascertain beyond 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 Complainant's claim, support the inference that the goods sold on the website accessible through the Domain Name, or at least some of them, are 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).

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.

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

Regarding the issue of bad faith, in order to satisfy the requirement of Paragraph 4(a) (iii) of the Policy, the Complainant must prove that the Domain Name was registered and is used in bad faith.

As far as registration in bad faith is concerned, 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 ownership of registered trademark rights over the term ECCO in many territories worldwide, including in China, which is where the Respondent is located, and in the US, Canada and the EU, which is where the Respondent operates through its website, as the acceptable currencies on the website include USD, CAD, Euro, GBP. Since the term ECCO is a fanciful term, it is quite likely that the Respondent was well aware of the Complainant's trademark at the time of the registration of the Domain Name. This assumption is reinforced by the fact that the Domain Name also consists of the term SKO, meaning "shoes" in Danish coinciding with the Complainant's field of activity.

As far as use in bad faith is concerned, the Domain Name leads to a website where goods probably counterfeit bearing the ECCO trademark are sold or offered for sale. The website prominently displays the ECCO trademark. The Respondent's sale and offer for sale of presumably counterfeit goods on a website accessible through the Domain Name is evidence of bad faith (see WIPO Case D2004-1019, Prada S.A. v. Domains for Life; WIPO Case D2005-0552, Wellquest International, Inc. v. Nicholas Clark). This conduct support the inference that the Respondent registered the 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. **ECCOSKOTILBUD.COM**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2012-04-03

Publish the Decision