

Decision for dispute CAC-UDRP-104197

Case number	CAC-UDRP-104197
-------------	------------------------

Time of filing	2022-01-13 15:11:36
----------------	----------------------------

Domain names	GOLA-UK.COM
--------------	--------------------

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
--------------	--

Complainant

Organization	D. Jacobson & Sons Limited
--------------	---------------------------------------

Complainant representative

Organization	TLT LLP
--------------	----------------

Respondent

Organization	Web Commerce Communications Limited
--------------	--

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registered trademarks (among others):

United Kingdom registered trademarks:

- GOLA, word mark, registered on May 22, 1905 under number 272980, for goods and services in Class 25;
- GOLA, word mark, registered on June 14, 1978 under number 1097140, for goods and services in Class 18.

European Union registered trademark:

- GOLA, word mark, registered on March 22, 2002 under number 1909936, for goods and services in Nice classes 18, 25 and 28.

FACTUAL BACKGROUND

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

The Complainant is a United Kingdom based designer, importer, seller and exporter of ladies', men's and children's footwear. The Complainant owns the internationally famous "GOLA" brand, which it has applied to its range of footwear and bag designs, among various items, for many years. The Complainant's footwear and bag products are sold throughout the world, including through its various websites using domain names such as <gola.co.uk> and <golausa.com>. Customers in the United Kingdom, European Union and United States of America are able to purchase the Complainant's products through such websites.

The Complainant owns various trademark registrations pertaining to the "GOLA" brand, including the GOLA word mark, registered in the United Kingdom since 1905.

The disputed domain name was registered on August 11, 2021 and is not connected with or authorized by the Complainant in any way. The associated website is being used to offer for sale GOLA branded footwear and bags. It is accessible to customers in the United Kingdom, allowing them to place an order and to register for an account. It constitutes passing off and unfair competition in the United Kingdom. It implies that there is a commercial relationship between the Complainant and the website associated with the disputed domain name when there is none. The disputed domain name is likely to mislead relevant members of the public, who are attempting to purchase products via the disputed domain name, 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, contrary to the fact.

On attempting to purchase a product from the website, users are prompted to enter their personal details. In September 2021 the Complainant attempted to make a purchase of product from said site. Although the funds were taken, no goods have ever been delivered.

It is inconceivable that at the time of registration, the Respondent did not know of the similarity between the disputed domain name and the Complainant's own domain names and the Complainant's trademarks. The disputed domain name is materially identical to the Complainant's trademarks and to its own domain names. The content set out on the website operated under the disputed domain name replicates the Complainant's own website content.

It is evident that the Respondent purposefully used the Complainants' trademarks fraudulently to deceive the public into a mistaken belief that the disputed domain name is owned by the Complainant, or is associated or connected with the Complainant. The Complainant has nothing to do with the disputed domain name or the Respondent. The Respondent has no legitimate interest in the disputed domain name as it is being used to defraud third parties.

The disputed domain name was registered in bad faith as the sole purpose for its registration was and is to impersonate the Complainant for fraudulent purposes. The Respondent's impersonation of the Complainant is designed to deceive third parties into believing that the disputed domain name is owned by the Complainant and is offering legitimate products, when in fact the Respondent is instead defrauding consumers. The disputed domain name should be transferred in order to protect such consumers.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

The Complainant has demonstrated that it has UDRP-relevant rights in its various GOLA registered trademarks. The second level of the disputed domain name contains the Complainant's GOLA trademark in its entirety, together with a dash or hyphen and the letters "UK". Neither the presence of the hyphen in the disputed domain name, nor the letters "UK", usually taken to be an abbreviation of the geographical designation "United Kingdom", alter the fact that the Complainant's GOLA mark is fully recognizable therein on a straightforward side-by-side comparison. It is the first and dominant element. The generic Top Level Domain in respect of the disputed domain name, in this case ".com", is typically disregarded for the purposes of the comparison under the first element analysis of the Policy. Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's GOLA trademark.

The Complainant does not directly address the provisions of the Policy, in particular, paragraphs 4(c)(i), 4(c)(ii) and 4(c)(iii), regarding whether the Respondent has rights or legitimate interests in the disputed domain name. However, the Complainant does note that there is no commercial relationship between the Parties, that the Complainant has not authorized the Respondent to use its trademark in the disputed domain name and on the associated website, and that the content set out on the website operated under the disputed domain name replicates the Complainant's own website material without permission, evidencing this with a side by side screenshot comparison. The Complainant also submits that, based on a test purchase, the Respondent is not supplying the Complainant's genuine product or, for that matter, any product. The Complainant suggests that the Respondent is merely collecting the Complainant's customers' data without permission. The Panel finds that these submissions are sufficient to constitute the requisite prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name.

The Respondent has failed to rebut the Complainant's said prima facie case in that it has not filed a Response in the administrative proceeding. The Panel has considered the possibility that the Respondent might be selling the Complainant's genuine goods under the Complainant's GOLA trademark. However, even if the Respondent had shown this, it would have been unable to establish all of the requirements of the well-known "OKI Data test" (see: *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903). Notably, it would have had to establish that it was actually offering for sale only the trademarked goods and to show that its website accurately and prominently disclosed its (lack of) relationship with the Complainant. There is no evidence that the Respondent is selling genuine, or any, goods, and no such accurate and prominent disclosure is shown on the Complainant's screenshots of the website associated with the disputed domain name.

The Panel therefore considers that it is reasonable in all of the above the circumstances to find that that the Respondent has no rights or legitimate interests in the disputed domain name.

Turning to the question of registration and use in bad faith in respect of the disputed domain name, the Complainant has made the unchallenged averment that the website associated with the disputed domain name contains content cloned from the Complainant's website. The said website and the disputed domain name make prominent use of the Complainant's GOLA trademark and the Complainant's own website imagery. In these circumstances, the Respondent cannot have registered the disputed domain name other than in the full knowledge of the Complainant's trademark.

The Complainant makes the uncontradicted submission that the Respondent registered and used the disputed domain name for fraudulent purposes and, in particular, to obtain personal data from the Complainant's customers by impersonating the Complainant. This submission is reinforced by the Complainant's assertion that the Respondent's website collects such personal data and that no goods were ever delivered following its test purchase, despite the price having been taken from the

purchasing party.

The allegations made by the Complainant of fraudulent activity on the Respondent's part are of a serious nature and call for an answer from the Respondent. No such answer has been forthcoming and the Respondent has simply maintained its silence. In these circumstances, the Panel notes that Respondent has failed to advance any plausible good faith motivation for its registration and use of the disputed domain name.

In the absence of any relevant evidence or submissions from the Respondent to the contrary, the Panel considers it reasonable to infer from the facts and circumstances of this case that the Respondent had knowledge of the Complainant and its GOLA trademark when the Respondent registered the disputed domain name and, likewise, that it had the requisite intent to target such mark unfairly for its own commercial gain. The Panel finds that this constitutes registration in bad faith within the meaning of the Policy. The Panel also considers it reasonable to infer that, having registered the disputed domain name, the Respondent proceeded to use it in connection with cloned aspects of the Complainant's website in order to confuse consumers into giving up their valuable personal data. The Panel finds that this constitutes use in bad faith within the meaning of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GOLA-UK.COM**: Transferred

PANELLISTS

Name	Andrew Lothian
------	-----------------------

DATE OF PANEL DECISION	2022-02-10
------------------------	------------

Publish the Decision