Decision for dispute CAC-UDRP-102849

Case number	CAC-UDRP-102849
Time of filing	2020-02-14 09:02:06
Domain names	shophugobossit.com

Case administrator

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

Complainant

Organization	HUGO BOSS Trade Mark Management GmbH & Co KG
Organization	HUGO BOSS AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	bai he

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has adduced evidence of its international trade mark "BOSS/HUGO BOSS" No. 754225 in Class 7 of the Nice Classification List and Class 4 of the Vienna Classification List for figurative marks. It added proof of several trade marks in the Hong Kong Special Administrative Region of China, in NCL Classes 24, 25, 35, 42 and 45. The international trade mark was registered on 8 February 2001 and indeed all of the trade marks presented were registered well before the date of the disputed domain name's registration. The Complainant further adduced evidence of its domain names registrations, notably <hugoboss.com>, which was registered in 1997, as well of this domain name's use, alongside other evidence of the Complainant's extensive and longstanding online presence.

The Respondent registered the disputed domain name <shophugobossit.com> on 18 June 2019.

FACTUAL BACKGROUND

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

The HUGO BOSS Group – to which the Complainant belongs – is a well-known, leading fashion group of companies founded in 1924 in Germany. It manufactures, markets and retails clothing, shoes, fashion accessories, fragrances as well as skincare products, under various trademarks including "HUGO BOSS" and "BOSS". The Complainant employs over 14,000 people worldwide and, in the fiscal year 2018, achieved sales of 2.8 billion euros. Hugo Boss' customers can currently purchase its products in 129 countries. 62 % of the group's sales are generated in Europe, 20 % in Americas and 13 % in Asia, including China and the Hong Kong SAR. The Complainant enjoys a high degree of renown around the world and has previously successfully challenged incorporation of its brand "HUGO BOSS" in several domain names through UDRP proceedings.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

A. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Domain Name <shophugobossit.com> incorporates the Complainant’s well-known, registered trademarks "HUGO BOSS" combined with a generic term “shop”, which is closely related to the Complaint’s business and the combination of letters “it” which may stand for Italy or stand for English “it”. The addition of the gTLD <.com> does not add any distinctiveness to the disputed domain name while addition of the descriptive term "shop” does not detract from the confusing similarity that is produced by incorporation of the Complainant's protected brand.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The disputed domain name was registered in June 2019, many years after the registration of the Complainant’s HUGO BOSS well-known trademarks.

The Complainant has never granted the Respondent any right to use its HUGO BOSS trademarks; nor is the Respondent affiliated to the Complainant in any manner.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademark including the terms “shophugobossit.com”.

To the contrary, online searches for the term “shophugobossit” entered in evidence in this proceeding show that the disputed domain name is classed as “untrustworthy” and a “fake on-line shop”. Similarly, searches made separately for “shop hugo boss it” point to the Complainant and its official websites.

Nor do searches on online trademark databases show any information for a trademark corresponding to <shophugobossit.com>.

Instead, the disputed domain name resolves to an active website reproducing the Complainant’s trademark and mimicking the look and feel of the Complainant’s website. It furthermore displays products bearing the Complainant’s trademarks, with

clothing and fashion accessories on the website offered at significantly discounted prices for purchase via the site itself.

The unauthorized inclusion of the Complainant's trademark with the descriptive term "shop" in the disputed domain name reflects the Respondent's intention to create an association, and subsequent likelihood of confusion, with the Complainant and its trademarks in internet users' minds. Previous panels have concluded in similar circumstances that such conduct amounts to trading unfairly on the Complainant's well-known registered trademark and on its valuable goodwill.

Moreover, the spelling of the disputed domain name <shophugobossit.com> combined with the content of the website to which it resolves also aims at creating a likelihood of confusion in Internet users' mind as to the source of the Respondent's website or the products offered on the same, which is behaviour that cannot be considered consistent with a bona fide offering of goods and services or constitute a non-commercial or fair use of the disputed domain name.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

By conducting a simple online search for "Hugo Boss", the Respondent would inevitably have learnt about the Complainant, its trademark and its business. It is therefore inconceivable that the Respondent was unaware of the existence of the Complainant when he registered the disputed domain name.

It is obvious that the Respondent had the Complainant and its trademarks in mind when registering the disputed domain name and that he registered it only for the purpose of misleading internet users.

ii. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

The disputed domain name resolves to an active website reproducing the Complainant's trademark and mimicking the look and feel of the Complainant's website, displaying products bearing the Complainant's trademarks. The disputed domain name clearly refers to the Complainant, its trademarks and products. The Respondent also uses copyrighted images copied from the Hugo Boss official website, to enhance the overall look-and-feel of the website associated with the disputed domain name so as to confuse internet users into believing that the site is official/authorized.

Obviously, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the Complainant and its trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

The Complainant tried to contact the Respondent but received a response suggesting that false contact details are being used. The Complainant relies on the views of previous panels as to the relevance of failure to respond to a cease-and-desist letter.

Furthermore, the Respondent has also registered a domain name, <tindercom.us>, that is, incorporating a well-known trademark associated with the dating application "Tinder", and using the same registrant's e-mail address as in the present proceeding. A search made for domain name registrations under the Respondent's name "bai hei" yields 397 domain names

registered, including those incorporating other well-known brands such “Pandora” and most likely others. Such a pattern of abusive conduct constitutes evidence of bad faith according to Paragraph (6) (ii) of the Policy.

Consequently, the Respondent should be considered to have registered and to be using the disputed domain name in bad faith. The Complainant therefore requests transfer to it of the disputed domain name.

RESPONDENT:

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.

The Panel takes note that the Complainant included a language of proceedings request asking for the proceeding to take place in English.

The Panel finds that this request was unnecessary since the language of the registration agreement is English and thus under the Rules that language should normally govern the proceeding. The Panel also points out in regard to other arguments related to Hong Kong made by the Complainant that English is an official language in Hong Kong.

The Panel also takes note of the Complainant’s request to consolidate Complainants. In this respect, the Panel draws attention to the UDRP Rules, which refer in Paragraph 3(a) to the Complainant in the broadest terms, namely as being “Any person or entity“. The Panel hence finds that this request too was unnecessary in this case, since the Hugo Boss group including its nominated component for this proceeding can be regarded functionally as a coherent "entity" for domain name administrative proceeding purposes. The position would, however, be different if distinct ownership and market undertakings were to join forces in a single administrative proceeding.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the Complainant has made out its case compellingly under the UDRP three-part cumulative test, in a case in which the Respondent has not responded to well-demonstrated allegations of calculated domain name abuse for commercial gain.

The Panel in particular finds that:

(i) the Complainant has shown its own longstanding rights in its brand and the confusing similarity of the disputed domain name with it. The Panel concludes in this regard that the use of the generic word “shop” in the name is merely a call to action to internet users to buy what they may mistakenly believe are the Complainant’s products. Addition of the semantic element “it” in the disputed domain name’s stem may simply augment the word “shop” or it may also connote “Italy” in the sense of the ISO 3166 Alpha-3 Top Level Domain code for that country, especially given evidence that the Complainant adduced to show that the website associated with the disputed domain name is available in Italian. But, either way, that addition does nothing cognitively to reduce the disputed domain name's confusing similarity to the Complainant’s brand;

(ii) far from there being any question of the Respondent having a right or legitimate interest behind the disputed domain name, the evidence the Complainant submitted of hundreds of registrations by the Respondent – from anonymous ones such as <925598.com> to <tindercom.us> and ten variants of <sunbet.us> -- instead suggest an illegitimate interest; and

(iii) evidence of bad faith abounds and is irresistible. The Respondent without authorization employed on his website logos and images belonging to the Complainant together with product offerings that he related to the Complainant's in the manner of an authorized outlet of the Complainant -- and indeed made that very claim in the contact details given on the website. The website is moreover a functional electronic commerce site with a catalogue structure and payment facilities, which demonstrate undeniable intent to make commercial gain. The conception and registration of a domain name incorporating the Complainant’s brand along with a call to action to internet users, combined with such a plain example of unauthorized online trading on the reputation of another, admits no explanation in terms of the UDRP other than registration and use in bad faith.

The Panel therefore has no hesitation in ordering the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SHOPHUGOBOSSIT.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2020-03-29

Publish the Decision