Decision for dispute CAC-UDRP-102841

Case number	CAC-UDRP-102841
Time of filing	2020-01-08 11:56:44
Domain names	austoretod.com, cheaptodsonlinestore.com, todssalenederland.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	TOD'S S.p.A.

Complainant representative

Organization	Convey srl

Respondent

Name	Gerald Penkler

OTHER LEGAL PROCEEDINGS

Ther is no other legal proceedings the Panel is aware of which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Tod's is the owner of various trademark registrations, such as:

• European Trademark n° 010158889 – TOD'S – registered on December 29, 2011 in classes 3, 9. 14. 18, 25, 35
• European Trademark n° 000407031 - TOD's - registered on September 13, 2004 in class 9;
• International Trademark n° 1006548- TOD'S – registered on June 1, 2009 in class 14 ;
• International Trademark n° 858452 – TOD'S – registered on May 20, 2005 in classes 3, 9, 18, 25, 35 designating also Turkey ;
• United States Trademark n° 1459226 - TOD'S – registered on September 29, 1987 in classes 18, 25;
• Australian Trademark n° 1498996 – TOD'S – registered on April 2, 2012 in classes 3, 9, 25, 35.

The disputed domain names are:

- <austoretod.com> created on October 10, 2019
- <cheaptodsonlinestore.com> created on June 11, 2019

- <todsshoesondiscount.com> created on June 4, 2019
- <todsturkeyoutlet.com> created on June 4, 2019
- <todssalenederland.com> created on December 10, 2018
The Complainant contends that the disputed domain names redirect to websites publishing TOD'S trademarks and fake TOD'S branded products offered for sale.

FACTUAL BACKGROUND

Tod's SpA (the Complainant) is a company specialized in the creation of shoes, bags, ready-to-wear apparels and fashion accessories. It's the operating holding of a Group, amongst the leading players in the world of luxury goods. Its headquarters are based in Sant'Elpidio al Mare, FM (Italy).

Founded in the early '900, the Complainant knew its first success in the 90's with the Gommino driving shoe, which has gummy little rubber pebbles on the soles. The production then was expanded to the bags and to ready-to-wear apparels and was promoted with celebrities such as Katie Holmes, Jessica Alba or Gwyneth Paltrow.

Today it has numerous stores around the world , including showrooms and large flagship stores in Europe, the US, China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia.

In 2018, Tod's Group annual revenues were almost 950 million of Euros of which 53% came from the trademark TOD'S.

All the trademarks owned by TOD'S are registered since many years and are well known around the world.

The Complainant has been expansively using the TOD'S denomination on its websites such as www.tods.com, www.todsgroup.com, www.tods.it, www.tods.net, www.tods.cn, www.tods.us, and on its social networks such has Instagram where it has 1.5 million followers, Facebook with 1.2 million of follows, YouTube, WeChat and Pinterest.

The disputed domain names were registered between December 2018 and October 2019. Considering them confusingly similar to its registered and well-known TOD'S trademarks, the Complainant instructed its representative to send cease and desist letters requesting the immediate cease of any use, and the transfer of the disputed domain names to the Complainant.
These cease and desist letters were sent on December 20, 2019 to the respective domain name owner's email addresses indicated at that time in the Whois records, but no answer was given.

The Complainant thus instructed its representative to file a complaint in order to obtain the transfer of the disputed domain names to its benefit.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

The Complainant submits that the disputed domain names <austoretod.com>, <cheaptodsonlinestore.com>, <todsshoesondiscount.com>, <todsturkeyoutlet.com>, <todssalenederland.com> are confusingly similar to its TOD'S trademark.

The disputed domain names incorporate the whole of the Complainant's TOD'S trademark. The Complainant explains that this similarity is neither affected by the extension ".com" which is merely instrumental to the use in Internet, nor by the adjunction of the non-distinctive elements such as the geographical indicators "au", "turkey", "Nederland", the generic terms

“store”, “cheap”, “online”, “shoes”, “on”, “discount”, “outlet” and “sale”. The combination of the TOD’S trademark with these generic terms could suggest improperly to consumers that the disputed domain names and corresponding websites might be controlled by the Complainant or under its authorization.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

It contends that no authorization or license were granted to the Respondent to register a domain name incorporating its TOD’S trademark. Specifically, the Respondents are not authorized resellers of the Complainant and have not been authorized to register and use the disputed Domain Names. It contends that the Respondents are neither commonly known by the Domain Names as individuals, business or other organization.

Furthermore, the Complainant affirms that no evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before the notice of the dispute was provided by the Respondents.

It submits that no disclaimer as to the Respondents lack of relationship with the Complainant was provided while the disputed domain names redirect to websites publishing TOD’S trademarks and counterfeited TOD’S branded products offered for sale.

Regarding the low prices of the shoes offered for sale on the website corresponding to the disputed domain names, the Complainant contends that the Respondents are undoubtedly attempting to gain from the sales of counterfeit products and it is clear that the Respondents intention is to benefit from the Complainant’s trademarks reputation to disrupt the Complainant’s business and to illegitimately trade on the Complainant’s fame for commercial gain.

It affirms that this behavior clearly demonstrates that the Respondents did not intend to use the disputed domain names in connection with any legitimate purpose.

The Complainant asserts that the Respondents registered and is using the disputed domain names in bad faith.

Since the TOD’S trademarks are intensively used since 1997 on advertising and sales worldwide, and enjoy a worldwide reputation in the sector of luxury goods, the Complainants contends that the Respondents could not have possibly ignored the existence of the Complainant’s trademark, registering the domain names years after the Complainant obtained its trademark registrations. The knowledge of the Complainant’s trademarks is demonstrated by the facts that the Respondents offer for sale replicas of Complainant’s shoes, reproduces the TOD’S trademarks, and that the websites corresponding to the disputed domain names have a lay-out similar to the Complainant’s websites.

Furthermore, the Complainant submits that in light of the high discounts (more than 70%) proposed to the internet users and of low prices of the shoes sold via the websites corresponding to the disputed domain names, prima facie the Respondent sells counterfeit goods or uses it as bait to obtain personal data or payments by the internet users without selling the goods.

The Complainant asserts that the use of the disputed domain names in connection with a commercial website where the Complainant’s TOD’S trademark is misappropriated and where fake TOD’S branded shoes are offered for sale, clearly indicates that the Respondents’ purpose in registering the Domain Names was to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking TOD’S products to their websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites. This statement is accentuated with the fact that there is no disclaimer informing the users as to the Respondent’ lack of relationship with the Complainant and the Respondent while there is no authorization, approval or license of the Complainant for such use.

As hereunder discussed, the Complainant requests the consolidation of the proceedings.

RESPONDENT:
There was only one response to the Complaint, submitted by Mr. G. P. identified as the registrant of the domain name <cheaptodsonlinestore.com>. He claimed that he is the victim of an identity theft.
Anyhow, given the fact that the consolidation of the Complaint does not include this domain name, this response shall not be taken into account.

RIGHTS

PRELIMINARY ISSUE ON CONSOLIDATION OF THE COMPLAINT

Paragraph 4(f) of the Policy allows a Panel to consolidate multiple disputes between parties at its sole discretion and paragraph 10 (e) of the Rules empowers a panel to consolidate multiple domain name disputes in accordance with the Policy and rules.

Paragraph 3 (c) of the Rules provides that “a complaint may relate to more than one domain name provided that the domain names are registered by the same domain name holder”.

“Panels are empowered under paragraph 10(e) of the Rules to consolidate multiple domain name disputes, and consolidation under paragraph 10(e) may be appropriate when doing so promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, reduces the potential for conflicting or inconsistent results arising from multiple proceedings, and generally furthers the fundamental objectives of the Policy” (Speedo Holdings BV v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons, WIPO Case No. D2010-0281).

At the same time, this panel further explains “ Consolidation of multiples registrants as respondents in a single administrative proceeding may in certain circumstances be appropriate under paragraphs 3(c) or 10(e) of the Rules provided the complainant can demonstrate that the disputed domain names or the websites to which they resolve are subject to common control, and the panel having regard to all of the relevant circumstances, determines that consolidation would be procedurally efficient and fair and equitable to all parties”.

In the present case, the Complainant contends similarities regarding the hosting providers, the use of a Whois privacy shield, the connection to China and mainly the identical lay-out of the websites.
The available data concerning the three disputed domain names are separately analyzed:
- <austoretod.com> created on October 10, 2019;

- <cheaptodsonlinestore.com> created on June 11, 2019;

- <todssalenederland.com> created on December 10, 2018.

The only common data are the Registrar and the name server. It’s true that the website has the same lay-out and offer fake TOD’S branded shoes.

Applying the principles to the facts in this case, the Panel finds that the evidences are not sufficient to prove a common control between the 5 disputed domain names, the similarities being scattered and not constitutive of a pattern demonstrating clearly a common control.
The alleged common connection to China is neither clearly established, nor relevant.

However, the Panel finds that the Complainant has established a common ownership or control of the same person or company between two of the disputed domain names, namely <todsshoesondiscount.com> and < todsturkeyoutlet.com>.

These both domain names have been registered using the same privacy shield service, with the same Registrar “WEBCC”, on the very same day and the same time, on June 4, 2019 with 7 minutes apart. They have the same name server and resolve to

the same website. The Panel finds such common control to justify consolidation of the Complainant's claims against the registrants of these two Domain Names in this proceeding. The Panel further concludes in the circumstances of this case that consolidation would be fair and equitable to all parties and procedurally efficient, and therefore will allow the consolidation for only 2 of the disputed domain names, namely <todsshoesondiscount.com> and < todsturkeyoutlet.com> pursuant to paragraphs 3 and 10 (e) of the Rules.

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.
The Complainant has submitted evidence of its prior registered TOD'S trademarks which are protected in France and in other countries.

The disputed domain names entirely incorporate the Complainant's TOD'S trademark.

In the <todsshoesondiscount.com> domain name, the generic terms "shoes", "on" and "discount" were added to the TOD'S trademark. These terms explicitly indicate the Respondent's aim to take advantage of the Complainant's business. It does not exclude the confusingly similarity between the TOD'S trademark and the disputed domain names.

The same applies to the disputed domain name <todsturkeyoutlet.com> which is composed with the TOD'S trademark with the addition of the generic term "outlet". Furthermore, the addition of the geographical term "Turkey" does not exclude confusingly similarity between the TOD'S trademark.

The confusing similarity is not affected either by the extension ".com" since it is a technical necessity in the use of Internet.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Respondent did not respond to the Complaint. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain name.

The Respondent is not commonly known under the disputed domain names and has not been licensed or authorized to use the well-known TOD'S trademark or to register the disputed domain name.

The Respondent is using the domain names at issue to resolve to websites reproducing the logo and the website' lay-out of the Complainant and offering the same products with a lower price.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of a domain name. It provides that:

“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:
(i) circumstances indicating that the Respondent has registered or the respondent 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 respondent’s documented out-of-pocket costs directly related to the domain name; or
(ii) the Respondent 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 respondent has engaged in a pattern of such conduct; or
(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website 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 the respondent’s website or location or of a product or service on the respondent’s website or location.”

Given the well-known character of the TOD’S trademarks, the Panel finds that the Respondent could not ignore the Complainant’s rights in the TOD’S trademark when it registered the disputed domain names.

In this regard, the entire reproduction of the Complainant's TOD’S trademark with the addition of merely generic terms, the sale of replicas, and the use of a similar lay-out of the Complainant’s website prove that the Respondent targeted the Complainant when it registered the disputed domain name.

Therefore the Panel finds that the disputed domain name was registered in bad faith with the Complainant in mind, to disrupt the Complainant’s activities, by creating a likelihood of confusion with the Complainant’s TOD’S trademark.

Given the foregoing, the Panel determines that, according to paragraph 4(b)(iv) of the Policy, by using the 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 Complainants’ trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website.

Therefore, the Panel finds that the disputed domain name was used in 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 consolidation of the proceedings was accepted for two of the five disputed domain names, base on the common data on the Whois of these both domain names and on the fact that they were registered at the same time, only a few minutes apart.
The dispuetd domain names incorporate the well-known TOD'S trademark with the addition of generic terms. They resolve to websites offering TOD'S branded shoes for very low prices. The Complainant contends that they are fake.
In the absence of any authorization, the absnece of legitimate right or interest is characterized.

Given the well-known character of the TOD's trademark and the litigious use of the disputed domain names, the Panel finds that they have been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **AUSTORETOD.COM**: Remaining with the Respondent
2. **TODSSHOESONDISCOUNT.COM**: Transferred
3. **CHEAPTODSONLINESTORE.COM**: Remaining with the Respondent
4. **TODSSALENEDERLAND.COM**: Remaining with the Respondent
5. **TODSTURKEYOUTLET.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2020-02-06

Publish the Decision