Decision for dispute CAC-UDRP-102867

Case number	CAC-UDRP-102867
Time of filing	2020-01-31 10:56:41
Domain names	HugobossNederland.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	HUGO BOSS Trade Mark Management GmbH & Co. KG

Complainant representative

Organization	HSS IPM GmbH

Respondent

Name	jack woen

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 part of the Hugo Boss Group based in Germany with a presence in around 80 countries worldwide including in China. It employs more than 14,000 people and recorded revenue of €2.8 billion in 2018. The Complainant is the registered owner of numerous registered trade marks for its HUGO BOSS mark including German trade mark No. 1007460 registered on 7 December 1979 and an International Registration designating China for a logo mark incorporating the word mark HUGO BOSS under trade mark No 550975 registered on 23 March 1990.

FACTUAL BACKGROUND

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

The Complainant owns a number of websites that incorporate the term HUGO BOSS and in particular it owns the website at <www.hugoboss.com> and has owned this website since 24 April 1997.

The Respondent is Jack Woen of of Hunanlu 340023 Hehui, Hunan, China. He is the registered owner of the disputed domain

name hugobossnederland.com. The identity of the registered owner of the disputed domain name hugoboss-nederland.com is not disclosed on Whois. The disputed domain names were both registered on 25 June 2019.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant asserts it owns registered rights in various jurisdictions for the HUGO BOSS word mark. It submits that the disputed domain names are identical or confusingly similar to its trade marks.

The Complainant asserts that it has reason to believe that the disputed domain names may be subject to common control with respect to the Respondent.

The Complainant notes that the only difference between the disputed domain names is the addition of a hyphen. The disputed domain names were registered with the same Domain Name Servers; freedns1.registrar-servers.com and freedns2.registrar-servers.com.The Complainant notes that the disputed domain name hugoboss-nederland.com was previously redirected to hugobossnederland.com.

The Complainant confirms that the disputed domain names previously shared the same IP Address; i.e. 23.228.208.104 from 19 June 2019 until 20 December 2019.

The Complainant submits that it has filed several takedown requests with Psychz Networks, the company in charge of the IP Address 23.228.208.104. The Respondent took down the infringing content, however after some time the Respondent has uploaded the content again.

Accordingly, the Complainant states that a complex and sophisticated web of contacts and connections has been involved in the registration and use of the disputed domain names which leads the Complainant to conclude that they are subject to common control.

The Complainant requests that the Panel consolidate the Complaint.

The Complainant submits that each of the disputed domain names wholly incorporate its trade marks for HUGO BOSS. In addition, both the disputed domain names include the name “nederland” being the Dutch name for “Netherlands”. The Complainant says that the inclusion of these references gives the impression that the Respondent is affiliated with the Complainant and is carrying out business using the Complainant’s trade mark.

The Complainant notes that prior panels have found that the addition of the top-level suffix in the domain name is to be disregarded under the confusing similarity test.

It follows the Complainant contends, that the disputed domain names are confusingly similar.

The Complainant claims that the Respondent has no rights or legitimate interest in each of the disputed domain names. The Complainant submits that the Respondent is not commonly known by either of the disputed domain names and has not used either of the disputed domain names for any purpose that might explain its choice in a manner that is consistent with it having rights or legitimate interest in the “Hugo Boss” name.

The Complainant notes that when it entered the term HUGO BOSS and China into Google’s search engine most of the results related to the Complainant’s business. According to the Complainant, if the Respondent had carried out such a search before it registered the disputed domain names it would have discovered that the Complainant owns trade marks for HUGO BOSS and that these trade marks are used in China.

The Complainant asserts that there is no evidence that shows that the Respondent has a history of using, or preparing to use, the disputed domain names in connection with a bona fide offering of goods and services. The Complainant states that it is clear that the Respondent intended to use the disputed domain names to take advantage of the reputation that the Complainant has built up in China.

The Complainant confirms that its trade marks predate registration of the disputed domain names. On the basis of its registered rights and use in China and renown worldwide, the Complainant suggests that the Respondent must have been aware that it was infringing the Complainant's rights by registering the disputed domain names.

The Complainant notes that the disputed domain names are now inactive. The Complainant further notes that the disputed domain names previously re-directed to an infringing website which was similar to the Complainant's website at <www.hugoboss.com> and contained the Complainant's trade marks. The Complainant explains that it filed several takedown notices in relation to the infringing content uploaded to the disputed domain names. Moreover, the Complainant confirms that the Respondent had not been granted any right to use its trade mark or content therefore the Complainant states that use of the disputed domain names could not be considered legitimate use.

As a result, the Complainant asserts that the Respondent lacks any rights or legitimate interest in the disputed domain names.

The Complainant submits that the Respondent has registered and uses the disputed domain names in bad faith.
The Complainant notes that Respondent has used an identity protection service to hide his identity. This means that it is impossible to contact the Respondent and this behaviour has been found by previous panels as evidence in support of a bad faith registration.

The Complainant further submits that the disputed domain names are inactive and do not resolve to active websites. The Complainant notes that previous panels have found that passive holding may apply even in the event of sporadic use, or "parking" in relation to a disputed domain name. Previous panels have also found that the registration and passive holding of a domain name which has no other legitimate use and clearly references a complainant's trade mark may amount to registration and use in bad faith. The Complainant asserts that in this case it is clear that the Respondent has registered the disputed domain names in bad faith by intentionally using the Complainant's well-known trade mark and by uploading infringing content to the website.

The Complainant notes that its trade marks predate registration of the disputed domain names. This fact and the fact that the Respondent continuously uploaded infringing content demonstrate that the Respondent has registered and is using the disputed domain names in bad faith. The Complainant explains that when the disputed domain names were active they were used to show a website that was similar to its website www.hugoboss.com. The Complainant claims that the Respondent intentionally used the Complainant's trade marks to attract, for commercial gain, internet users to the website, by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website. Moreover, there was no notice on the websites by the Respondent that disclaimed association between the Respondent and the Complainant.

The Complainant alleges that the Respondent has changed the IP addresses linked to the website a number of times in order to avoid complying with Complainant's takedown requests. The Complainant further notes that the IP address linked to Respondent's disputed domain names currently host a number of other domain name addresses of very well known brands, including Celine, Gucci and YSL.

Therefore, the Complainant submits that the Respondent has registered and is using the disputed domain names in bad faith.

RESPONDENT:

The Respondent did not submit an administratively compliant response.

RIGHTS

The Complainant has established that it owns the German trade mark registration for HUGO BOSS word mark registered under number 1007460 on 7 December 1979. It also owns the International trade mark number 550975 registered on 23 March 1990 and designated in China, for the HUGO BOSS logo, incorporating the word mark.

Each of the disputed domain names incorporate the HUGO BOSS word mark in its entirety. This is sufficient to render them confusingly similar to the Complainant's German trade mark registration. Inclusion of "nederland", and in one disputed domain name, a hyphen does not change the overall impression given by each disputed domain names. Accordingly, the Panel finds that each of the disputed domain names are confusingly similar to the Complainant's registered German trade mark for HUGO BOSS and the Complainant succeeds under this element of the Policy.

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

The Complainant says that it has not granted any rights to the Respondent to use its trade marks or its content. It also submits that the Respondent is not commonly known by the disputed domain names.

The Complainant's HUGO BOSS mark is distinctive and enjoys a very considerable degree of reputation and goodwill in connection with the Complainant's fashion products. The Respondent has failed to provide any explanation for its registration of the disputed domain names incorporating the HUGO BOSS mark.

The Complainant has provided evidence that each of the disputed domain names initially re-directed to a website featuring the Complainant's products and using the Complainant's trade marks without authority. Following takedown the disputed domain names re-direct to inactive websites. Meanwhile, there is evidence as noted under "Bad Faith" below, that the Respondent has registered other domain names containing a range of well-known brand names and this is in addition to evidence that it has changed IP addresses for the disputed domain names and sought to mask its identity using a privacy service. None of this is consistent with the Respondent having rights or legitimate interests in each of the disputed domain names.

For these reasons the Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in each of the disputed domain names. The Respondent has failed to respond or to rebut this case, therefore and also for the reasons set out below under "Bad Faith" the Panel finds that the Complainant succeeds under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant's trade marks were registered as early as 1979 and the disputed domain names were only registered on 25 June 2019, very many years after that date. The Complainant asserts that the Respondent was, or should have been, aware of the Complainant's registered rights on the basis that the HUGO BOSS mark had been substantially used and by 2019 was extremely well reputed worldwide and would have shown up in any event on a simple internet search in China. The Panel finds that, based on the evidence on record, the Complainant enjoys considerable renown attaching to its HUGO BOSS trade marks, that it is most likely that the Respondent was well aware of the Complainant's marks when it registered the disputed domain names and that it registered it on purpose with a view to taking advantage of the goodwill attaching to the Complainant's marks.

The Complainant has provided evidence that the Respondent was using the disputed domain names to resolve to a website that used the Complainant's trade marks without authority. Evidence was also provided that the Respondent had uploaded images of the Complainant's content. It is clear that by using the disputed domain names and advertising the Complainant's products, the Respondent was trying to either masquerade as the Complainant, or as having an association with the Complainant. This conduct amounts to intentionally attempting to attract, for commercial gain, Internet users to its website,

by creating a likelihood of confusion with the Complainant's mark under paragraph 4(b)(iv) of the Policy.

The Respondent did take down the infringing content on receipt of takedown notices from the Complainant, however later the Respondent uploaded the infringing content again. This repeated infringement is additional evidence of the Respondent using the disputed domain names in bad faith.

There is also on the record evidence of a pattern of bad faith conduct under 4(b)(ii) of the Policy. The Complainant has provided various examples of other domain names in which the Respondent has registered domain names incorporating well known brands. The Panel considers it extremely unlikely that these domain names were registered with the consent of the relevant brand owner. In these circumstances the Panel finds that the Respondent has both registered and used the disputed domain names in bad faith and the Complaint also succeeds under this element of the Policy.

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names has have been registered and are 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.
Consolidation

The Complainant has sought to consolidate the disputed domain names on the basis of common ownership. The burden of proof falls to the Complainant as the party seeking consolidation to provide evidence in support of its request. Paragraph 4.11.2 of WIPO Jurisprudential Overview 3.0 notes that in assessing whether to consolidate a complaint against multiple respondents previous panels have examined whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties.

The Complainant has provided evidence that there is a strong likelihood that there is a connection between the disputed domain names. The Complainant provided evidence that the disputed domain names previously shared the same IP address. The Complainant also showed that the disputed domain names were registered with the same Domain Name Servers, i.e. freedns1.registrar-servers.com & freedns2.registrar-servers.com. The Panel finds the fact that the disputed domain name hugoboss-nederland.com was previously redirected to hugobossnederland.com particularly persuasive in this regard.

It follows that the Panel finds that the Complainant has established that the disputed domain names are for the purposes of the Policy, more likely than not subject to common ownership or control. The Panel therefore finds 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 as requested by the Complainant pursuant to paragraph 10(e) of the Rules.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has established that there is a strong likelihood that the disputed domain names are subject to common ownership, in particular, as a consequence of the fact that that one of the disputed domain names previously redirected to the other disputed domain name cited.

The Complainant has established that it owns registered HUGO BOSS trade marks. The disputed domain names wholly incorporate the HUGO BOSS mark and as a result the disputed domain names are confusingly similar to the Complainant's trade marks.

There is evidence that the disputed domain names re-direct to a website that displays the Complainant's trade marks without permission. There is no evidence that the Respondent was permitted to use the Complainant's trade marks and no evidence that it was making a bona fide or non-commercial use of the disputed domain names.

The German HUGO BOSS trade mark was registered in 1979, and the HUGO BOSS brand enjoys an established worldwide reputation. As a result, it is likely that the disputed domain names were registered with prior knowledge of the Complainant's trade marks.

There is also evidence that the Respondent was using the disputed domain names to resolve to a website that used the Complainant's trade marks and the Complainant's content without permission.

In addition there was evidence that the Respondent had engaged in a pattern of conduct of registering disputed domain names that incorporated a range of well know trade marks, which is additional evidence of bad faith.

Although the disputed domain names do not now re-direct to an active website, the circumstances of this case, including the considerable reputation attaching to the HUGO BOSS mark and the fact that the Respondent persistently infringed the Complainant's trade marks and used the Complainant's content on its website to which the disputed domain names redirect, amounts to registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HUGOBOSSNEDERLAND.COM**: Transferred
2. **HUGOBOSS-NEDERLAND.COM**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2020-03-16

Publish the Decision