

Decision for dispute CAC-UDRP-104850

Case number CAC-UDRP-104850

Time of filing 2022-10-13 10:18:42

Domain names ONEILLSHOPS.COM

Case administrator

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

Complainant

Organization Sisco Textiles N.V.

Complainant representative

Organization O'Neill Brand S.à r.l

Respondent

Name Xiufang Jiang

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 a recognized Netherlands Antillean company, worldwide known surf, ski and casual brand that has been designing, manufacturing, marketing, and selling quality apparels, accessories, and performance wear goods since 1952.

The Complainant owns the following Trademarks:

- US Trademark, O'NEILL, Reg. No. 1069298, filed on May 23, 1975, granted on July 12, 1977 and in force until July 12, 2026; in connection with classes 9 and 25;
- International Trademark, O'NEILL, Reg. No. 1014984, granted on June 3, 2009 and in force until June 3, 2029, in connection with classes 3, 9, 14, 16, 18, 22, 25, 28 and 35.;
- International Trademark, O'NEILL + WAVE (logo), Reg. No. 1061053, granted on February 19, 2010, and in force until February 10, 2030, in connection with classes 3, 9, 14, 16, 18, 25, 28 and 35;
- EUIPO Trademark, O'NEILL, Reg. No. 008499782, granted on May 17, 2010, and in force until August 20, 2029, in connection with classes 3, 9, 14, 16, 18, 25, 28 and 35;
- EUIPO Trademark, O'NEILL + WAVE (logo), Reg. No. 008501141, granted on June 8, 2010, and in force until August 20, 2029, in connection with classes 3, 9, 14, 16, 18, 25, 28 and 35.

FACTUAL BACKGROUND

The Complainant is a recognized Netherlands Antillean company, worldwide known surf, ski and casual brand that has been designing, manufacturing, marketing, and selling quality apparels, accessories, and performance wear goods since 1952.

The Complainant is the exclusive owner of the O'NEILL's Trademarks registered throughout the world notably for clothing and accessories.

The Complainant owns numerous physical stores arounds the world, and the following domain names <oneill.com>, <eu.oneill.com>, <us.oneill.com>, <au.oneill.com> from which customers can purchase its products (through its licensees).

The disputed domain name <oneillshops.com> was registered on **May 18, 2022** and resolves to an online store based on Complainant's Trademarks O'NEILL.

By the time of this Decision, the disputed domain name and the website are active.

PARTIES CONTENTIONS

Complainant

Complainant Contentions:

1. The Complainant states that the disputed domain name comprises (a) an exact reproduction of the O'NEILL trademark; (b) a non-distinctive additional element: "shops" and (c) a top-level domain suffixes such as ".com". The most prominent and distinctive part of the disputed domain name is the word "O'NEILL" which is identical to the Complainant's registered trademark. Furthermore, that the addition of descriptive and non-distinctive terms such as "outlet", "online/s", "news", "shoes", "shop", "sale" do not provide additional specification or sufficient distinction from the Complainant or its O'NEILL trademarks; that in contrary the addition of such descriptive and non-distinctive terms has the effect of the confusing similarities and inducing Internet Users to believe that there is an association between the disputed domain name and the Complainant. In addition, the Complainant underlines that the considerable reputation of the trademark; the distinctive character of its O'NEILL's trademarks and the dominant component of the disputed domain name, make undoubtful that the disputed domain name is confusingly similar to O'NEILL trademarks in which the Complainant has rights.
2. That the Respondent knew of the Complainant's Trademarks at the time of registering the disputed domain name as such trademarks are well-known throughout the world and subject of a large number of trademark registrations.
3. That the Respondent has no rights or legitimate interests over the disputed domain name, due to there is no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the O'NEILL's Trademarks. Furthermore, there is no evidence that "oneillshops" is the name of the Respondent's corporate entity or a fair use of the Complainant's Trademark. Neither, that the Respondent is using, or plans to use, the O'NEILL Trademarks or WAVE logo trademark or the disputed domain name for a bona fide offering of goods or services. To the contrary, the disputed domain name resolves to a website on which the Respondent has made unauthorized use of the O'NEILL's Trademarks.
4. That the disputed domain name leads to clone of the Complainant website where the Complainant's Trademark and logo are reproduced. The website offers what appear to be genuine O'NEILL branded products but are counterfeited goods. The website is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorses its commercial activities, when in fact, no such relationship exists.
5. That the Respondent has registered the disputed domain name to intentionally attempts to attract, for commercial gain, Internet Users to the website by creating a likelihood of confusion with O'NEILL's Trademarks; that, the sole purpose of the inclusion of the O'NEILL Trademarks in the disputed domain name is to attract Internet Users in order to generate revenue and take unfair advantage from the O'NEILL's Trademarks reputation.
6. That on June 27, 2022, the Complainant sent a Cease and Desist Letter to the Respondent, through the concerned Registrar, which remained unanswered.

Response

The Respondent did not reply to any of the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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

First UDRP Element

The Complainant has sufficiently proved before the Panel, that owns Trademark Rights over the word O'NEILL since at least July 12, 1977, according to its US Trademark Reg. No. 1069298. In addition, the Complainant owns Trademark Rights at International and European level.

The disputed domain name <oneillshops.com> registered on May 18, 2022, reproduces the Trademark O'NEILL, plus the descriptive term "shops", addition that doesn't prevent a finding of confusing similarity (see point 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0")).

It is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLD ".com", is considered "as a standard registration requirement and as such is disregarded under the first element confusing similarity test" (see point 1.11.1 of the WIPO Jurisprudential Overview 3.0).

Therefore, the disputed domain name <oneillshops.com> is confusingly similar to Complainant's Trademarks O'NEILL.

Second UDRP Element

In relation to the Second UDRP Element, it is well established that "a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response (...) that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent" (see point 2.1 of the WIPO Jurisprudential Overview 3.0). In the present case, this Panel finds that:

- (1) the Respondent is not associated or affiliated or hasn't been authorized or licensed by the Complainant to use its Trademarks O'NEILL.
- (2) there is no evidence in Respondent's favor that could possibly justify the selection of such a recognized Trademark as O'NEILL in addition of a descriptive term as "shops", which is intrinsically related to Complainant's online business, to be registered as a domain name.
- (3) there is no evidence that the Respondent corresponds or has become commonly known by the term <oneillshops.com>.
- (4) the Respondent registered the disputed domain name on May 18, 2022, meaning at least 45 years after the Complainant's acquired its Trademark Rights over the word O'NEILL on July 12, 1977 (US TM Reg. No. 1069298).
- (5) the Respondent is not making a bona fide offering of services, or a legitimate non-commercial or fair use of the disputed domain name, since it resolves to an unauthorized website based on the Complainant's Trademarks O'NEILL for selling and identifying - potential fake- products, being strong evidence of its lack of rights or legitimate interests over the disputed domain name.

Therefore, to the satisfaction of the Panel, the Complainant has made out its prima facie case. No Response has been submitted. In the absence of a Response, this Panel accepts Complainant's undisputed factual averments as true. This Panel concludes that the Respondent to have no rights or legitimate interests in respect of the disputed domain name (see ATOMIC Austria GmbH vs. Xuhe Huang, CAC-UDRP Case No. 104648).

Third UDRP Element

In relation to the Third UDRP Element, this Panel finds that:

Bad Faith Registration:

The Complainant acquired its Trademark Rights at least since July 12, 1977, meaning 45 years before the Respondent registered the disputed domain name on May 18, 2022. The Respondent reproduces Complainant's Trademarks O'NEILL in the disputed domain name plus a descriptive term as "shops", intrinsically related to Complainant's additional line of business, and builds a website based on Complainant's Trademarks to sell and identify -potential fake- products, showing Respondent's consistent knowledge of Complainant's business, trademark value and reputation at the time of the registration of the disputed domain name (see point 3.2.2 of the WIPO Jurisprudential Overview).

Therefore, this Panel concludes that the disputed domain name was registered in bad faith.

Bad Faith Use:

According to the evidence submitted before the Panel, the disputed domain name is being used to sell and identify products with Complainant's Trademarks O'NEILL, all of it, on a potential attempt to defraud customers.

Paragraph 4(b)(iv) of the Policy states as evidence of registration and use of a domain name in bad faith:

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

In this case, and as described above, the Respondent is using the disputed domain name to intentionally attract Internet Users, for commercial gain, by creating a likelihood of confusion with the Complainant's Trademarks as to the source, sponsorship, or affiliation, falling into Paragraph 4(b)(iv) of the Policy. Therefore, this Panel concludes that, the disputed domain name is being used in bad faith as well.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ONEILLSHOPS.COM: Cancelled**

PANELLISTS

Name	María Alejandra López García
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DATE OF PANEL DECISION 2022-11-08

Publish the Decision
