

Decision for dispute CAC-UDRP-104847

Case number	CAC-UDRP-104847
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Time of filing	2022-10-13 10:04:59
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Domain names	ONEILLSOLDES.COM
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Sisco Textiles N.V.
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Complainant representative

Organization	O'Neill Brand S.à r.l
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Respondent

Name	Lizhong456 Wang
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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 proprietor of the mark 'O'NEILL' (1014984, 3 June 2009 and duly renewed) under the Madrid international system (designated in various territories including China). It is also the proprietor of logo marks, and of further marks in respect of the string 'O'NEILL - US mark 1069298 (12 July 1977) and EUTM 008499782 (8 June 2010). These marks subsist in a number of classes in respect of clothing, sporting goods, and retail.

FACTUAL BACKGROUND

The Complainant, a company with its seat in Willemstad, Curaçao, is the exclusive owner of the O'Neill trade marks registered throughout the world in respect of, amongst other things, clothing and accessories. O'Neill is a surf, ski and casual brand that that been utilised in this context for 70 years. The Complainant has licensed the trademarks, copyright and other rights and assets to another party, O'Neill Brand S.à r.l, in respect of these activities, on an exclusive basis, with evidence of such supplied as an annex to the Complaint. On this basis, a number of licencees operate various websites (e.g. <ONEILL.COM>) and physical retail stores around the world.

The Respondent, an individual with an address in Guangdong, China, registered the dispute domain name on 20 May 2022.

PARTIES CONTENTIONS

No administratively compliant Response has been filed. Neither written notice of the Complaint nor the advice of delivery thereof was returned to the Provider. One email notice was sent (without any proof of delivery or non-delivery being received), and another email was returned as undeliverable. The Respondent never accessed the online platform.

The Complainant submits that the Respondent is engaged in unlawful activity through the sale of counterfeit goods on its website, which has utilised the Complainant's mark to deceive Internet users and take advantage of the well known nature of its mark. It contends that all aspects of the Policy have been fulfilled and that the disputed domain name should be revoked. The Complainant also states, supported by evidence, that it issued a 'cease and desist' letter to the Respondent, through the domain name Registrar with which the disputed domain name was registered, on 27 June 2022, and that no response to said letter has been received.

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).

The disputed domain name incorporates in full the Complainant's mark O'NEILL (with the exception of the apostrophe, on account of the technical limitations of the original domain name system). The only other difference between the mark and the disputed domain name, apart from the generic TLD .com which is disregarded in accordance with established practice under the Policy, is the presence of the text SOLDES in the disputed domain name. As this is the French word for 'sales', the Panel can safely find that confusing similarity is present, on the grounds that a generic term has been added to a mark, or in the alternative that it is a descriptive term associated with the Complainant's activity (through its licencees) in respect of physical and online retail of goods (see further WIPO Jurisprudential Overview, version 3.0, para 1.8)

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).

The Complainant has stated, without contradiction from the Respondent, that it has not issued any licence or consent to the Respondent in respect of any of its marks. The Respondent is not known as 'O'Neill' or 'O'Neill Soldes', but as 'Lizhong456 Wang'.

The Panel takes account of the prima facie case made out by the Complainant - that there is no bona fide offering of goods and services. Indeed, as the Complainant points out through its Complaint and comprehensive Annexes, and as the Panel can accept on the basis of the evidence available to it, the marks and logos of the Complainant are reproduced on the Respondent's website. There is nothing on the website to suggest that clarity has been provided regarding the lack of any relationship between the Complainant and the Respondent. It is of course open to a Respondent to address this, whether through text on its website or even in submitting a compliant Response in the context of the present proceedings. The absence of any of this allows the Panel to draw all reasonable inferences from the information available to it, and to accept that no rights or legitimate interests are present. The Panel has taken care to consider whether this could be a case of the legitimate resale of goods through a website, but does not have sufficient evidence to take this hypothesis any further. In reaching this conclusion, due regard has been given to similar cases cited by the Complainant (WIPO Case D2022-2325, volcosoldes.com), to the advice in the WIPO Jurisprudential Overview, version 3.0, para 2.13.2 in respect of circumstantial evidence of unlawful use and para 2.8 in respect of nominative use by resellers or distributors, and to the Complainant's uncontradicted assertion that the goods offered for sale are in fact counterfeit goods.

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).

The Complainant submits in this regard that its marks and business are well known and that the Respondent is likely to have known of the Complainant when choosing to incorporate its mark into the disputed domain name. The Complainant further submits that the sole purpose of the inclusion of its marks in the disputed domain name is to attract Internet users in order to generate revenue and take unfair advantage from the reputation associated with those marks.

The Panel accepts that the disputed domain name was registered in bad faith, drawing appropriate inferences from the Respondent's lack of participation (and lack of response to the earlier cease and desist letter), and the likelihood that the Respondent was aware of and had in mind the Complainant at the point of registration.

The Panel also accepts that the disputed domain name is being used in bad faith, recalling the discussion of the evidence under

paragraph 4(a)(ii) (above) and applying, in particular, the provisions of paragraph 4(b)(iv) of the Policy - that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of that website and of the products offered for sale on that website. Again, there are a number of scenarios where a Respondent could have sought to rebut this contention, or point the Panel to evidence of activities that are associated with good faith, but has failed through non-participation to do so. The Panel again notes that a detailed letter from the Complainant to the Respondent identified the similarities between its website and that of the Respondent, requesting that the said course of conduct be discontinued, but received neither response nor amendment.

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 issued a procedural order within the terms of rules 10 and 12 of the UDRP Rules, in its sole discretion and in the interests of fairness and due expediency. This was for the purpose of inviting additional submissions on the appropriate remedy, as it was unclear whether the Complainant was requesting the cancellation of a domain name or its transfer from the Respondent to the Complainant, in the terms set out in para 4(i) of the Policy. The Complainant supplied a response within the time set for such (advising that it requested cancellation of the disputed domain name); the Respondent, who had not addressed the matter at all in the first instance through its non-participation, did not make any further observations on this point. The Panel therefore proceeded to make its decision in light of the Complaint and the additional submission.

PRINCIPAL REASONS FOR THE DECISION

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. On the other hand, it is clear that the Complainant has rights in respect of the trade mark O'NEILL, and that the addition of the text SOLDES ('sales', in French) does not prevent a finding of confusing similarity with the Complainant's marks. It is likely, in light of the nature of the Complainant's mark and activities, and the degree to which the disputed domain name departs from the Complainant's mark, that the Respondent would have been aware of the Complainant and its particular activities (through licencees) in respect of the retail of clothing and sporting goods, and that the Respondent is intentionally using the disputed domain name to attract Internet users to its page purporting to sell authentic goods authorised by the Complainant, an established form of bad faith use under the Policy. The Panel takes into account the detailed evidence supplied by the Complainant including in respect of the content of the Respondent's website and the similarities between it and the legitimate website it has authorised for the online retail of goods bearing its marks. The Panel can find for these reasons that the disputed domain name was registered and is being operated in bad faith, and that the Respondent, through its failure to participate, has not pointed to any rights, legitimate interests, or the absence of bad faith registration or use. The requirements for the acceptance of a Complaint under paragraph 4 of the Policy have therefore been met, and the Panel ordered that the disputed domain name be cancelled, taking into account the Complainant's response to a Panel request for clarification in respect of remedy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ONEILLSOLDES.COM**: Cancelled

PANELLISTS

Name	Daithi Mac Sithigh
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DATE OF PANEL DECISION 2022-11-15

Publish the Decision
