

Decision for dispute CAC-UDRP-105027

Case number	CAC-UDRP-105027
Time of filing	2022-12-02 11:16:44
Domain names	sofia-milani.com, sofia-milansoldes.com

Case administrator

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

Complainant

Organization	Brands United 360 GmbH
--------------	-------------------------------

Complainant representative

Organization	Grünecker Patent und Rechtsanwälte PartG mbB
--------------	---

RESPONDENTS

Name	Yu Guo
Name	homgyan34 li

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademark and service mark registrations:

European Union Trademark Registration SOFIA MILANI, registration number, 018185719, registered on May 22, 2020 for goods and services in classes 14 and 35;

German registered trademark and service mark, SOFIA MILANI, registration number 302017231558, registered on march 6, 2018 for goods and services in classes 14, 35 and 42.

The Complainant has an established Internet presence and maintains a website at www-sofiamilani.com.

FACTUAL BACKGROUND

The Complainant is a retailer of jewellery which it markets using the SOFIA MILANI mark, and is the owner of the trademark and service mark registrations described above.

The disputed domain name <sofia-milani.com> created on June 16, 2022, is registered in the name of Yu Guo.

The disputed domain name <sofia-milansoldes.com> was created on June 22, 2022, and is registered in the name of “lihomgyan34 Li” (sic).

Each of the disputed domain names resolves to an almost identical website, albeit in different languages, but with certain identical images, and the same overall appearance, which purports to impersonate the Complainant and offer the Complainant's branded goods to the public at greatly discounted prices.

There is no information available about the Respondents except for that provided in the Complaint, the Registrar's WHOIS and the information provided by the Registrar in response to the request by the Centre details of the registration of the disputed domain names.

While the names of the registrants of each of the disputed domain names, which have been disclosed by the Registrar in the course of this proceeding, are different, on the balance of probabilities the registrants are the same person or acting in concert.

For this reason, this Panel has decided to permit the consolidation of two complaints as discussed below, but continues to refer to the Respondents as being two different persons, albeit acting in concert.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims rights in the SOFIA MILANI trademark and service mark established by its ownership of the EUTM and German trademark and service mark registrations described above as well as extensive use of the mark in its retail business, including on its website at www-sofiamilani.com, a copy of which has been provided in evidence in an annex to the Complaint.

Further, the Complainant asserts that it is the rights-owner to the company name “Sofia Milani Jewels” as well as the “Sofia Milani Jewels” logo which is also displayed in an annex to the Complaint, and these claims have not been contested.

The Complainant alleges that the disputed domain names are confusingly similar to the Complainant's SOFIA MILANI trademark and service mark, arguing that the reference to the Complainant's mark within each of the disputed domain names is clear.

The Complainant submits that the disputed domain name <sofia-milani.com> fully incorporates the Complainant's SOFIA MILANI mark, adding only a hyphen between the elements “sofia” and “milani” and the generic Top-Level Domain (“gTLD”) <.com> extension. The Complainant contends that the hyphen is not of significance.

The Complainant also submits that the disputed domain name <sofia-milansoldes.com> almost fully incorporates the Complainant's SOFIA MILANI mark as its coining element, only leaving out the last letter “i” and adding the non-distinctive term “soldes” (i.e. “sale”) with the gTLD extension <.com>. The reference to the Complainant's mark within this disputed domain name is clear.

The Complainant argues that the incorporation of a complainant's mark in its entirety, will normally be considered sufficient to make a finding of confusing similarity for the purposes of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) paragraph 1.7. “While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain names, arguing that to satisfy the requirement of a bona fide and legitimate offer of services, according to Policy Paragraph 4(c)(i), the websites to which the disputed domain names resolve, must accurately disclose the Respondent's relationship with the Complainant, and may not, for example, falsely suggest that it is operated by the Complainant or that the website is the Complainant's official site but in the case at hand, the Respondent is making no effort to dissociate itself from the Complainant.

There is also no use, nor any demonstrable preparations to use, the disputed domain names with respect to a bona fide and legitimate offering of goods or services, according to Policy paragraph 4(c)(i).

The screen captures of the websites to which the disputed domain names resolve show that the Respondent is using the disputed domain names to create the false impression of being affiliated with the Complainant by using the Complainant's distinctive SOFIA MILANI mark, company name, company keyword and logo on the websites.

Additionally, the Respondent uses company names “Sconto Sofia Milani in Italia” and “Sofia Milani Soldes Magasin LLC”, as well as offering jewellery products which are identical to those offered by the Complainant.

Moreover, the Complainant argues that product photographs and crossed-out prices displayed on the Respondent's websites and shown in the exhibited screen captures, are taken from the Complainant's website without authorization. To give one of numerous examples, the Complainant's offering of “anchor” shaped earrings corresponds with purported identical offerings on the Respondent's

the websites as shown in the screen captures which are exhibited in an annex to the Complaint.

Therefore, instead of setting itself apart from the Complainant, the Respondent is deliberately trying to create the false impression of being affiliated with or endorsed by the Complainant.

The Complainant next alleges that the disputed domain names have been registered and are being used in bad faith, arguing that the Whols information exhibited in an annex to the Complaint shows that the disputed domain names were registered by the Respondent with a time difference of only five days and using the same privacy service in order to hide the identity of the Respondent which shows that they were registered with the clear intention of using them to conduct fraudulent activities.

In this regard the Complainant again refers to the exhibited screen captures of the websites to which the disputed domain names resolve and argues that they illustrate that the disputed domain names are being used by the Respondent to create the false impression that the websites are affiliated with, or endorsed by, the Complainant in order to facilitate fraudulent activities.

The Complainant contends that by operating the websites to which the disputed domain names resolve, for its own commercial gain, the Respondent is taking unfair advantage of the Complainant's distinctive SOFIA MILANI marks, company name, company keyword, logo and product photographs inferring that there is an affiliation with or endorsement of the websites by the Complaint and a trustworthy and reliable origin of services in the jewellery sector.

Moreover, the Complainant refers to a copy of a redacted e-mail which is also exhibited in an annex to the Complaint, and submits that it shows that a customer known to the Complainant had an inconvenient experience with the website to which the disputed domain name <sofia-milansoldes.com> resolves. On October 21, 2022, the Complainant received the following e-mailed message from the customer asking if the aforementioned site was the Complainant's authentic website: "Hello, I was wondering if you could tell me if this site is yours or associated with you <https://www.sofia-milansoldes>. Please let me know if it's associated with you and if you need any more data or help I will be happy to collaborate. Kind regards"

The Complainant submits that the evidence shows that by using the disputed domain names, the Respondent intentionally attempts to attract, for commercial gain, Internet users to the websites under the disputed domain names, by creating a likelihood of confusion with the Complainant's SOFIA MILANI mark as to the source, sponsorship, affiliation, or endorsement of the website and services offered on the website.

The Complainant contends that the behaviour described above is fraudulent and constitutes a classic case of use of the domain names in bad faith in accordance with Policy paragraph 4(b)(iv).

The Complainant next alleges that the disputed domain names were registered and are being used in bad faith arguing that it has not authorised the Respondent to use its SOFIA MILANI mark but nonetheless the Respondent is using the disputed domain names as the addresses websites on which the Respondent is offering jewellery which is identical to the Complainant's goods under the Complainant's distinctive SOFIA MILANI marks, company name, company keyword and logo, which constitutes use of the disputed domain names in bad faith.

Additionally, the Complainant argues that the Respondent is allegedly offering shipment to several EU countries, including Germany, and therefore targeting the same regions as the Complainant, who acquired the SOFIA MILANI trademarks for these regions.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

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 has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (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 names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Preliminary Issue Consolidation of Proceedings

Notwithstanding that the Whois information records that the disputed domain names are each registered by differently named persons, the Complainant requests that this Panel issue a decision on both disputed domain names in one proceeding, by consolidating the disputes in accordance with Paragraph 4(f) Policy in conjunction with Paragraphs 10(e) and 3(c) Rules.

The Complainant submits that multiple domain disputes may be consolidated into one proceeding when the domain names at issue or corresponding websites are subject to common control and a consolidation of proceedings would be fair and equitable to all parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) at paragraph 4.11.2 (“Where a complaint is filed against multiple respondents, panels look at 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. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.”).

The Complainant argues that even despite nominally different domain name registrants, previous panels established under the Policy, have accepted common control where the disputed domain names were registered within a short period of time, used the same privacy service, all incorporated the same trademarks in similar configuration and resolved to similar websites, promoting similar or identical products, sharing the same layout and displaying some identical content (see *Virgin Enterprises Limited v. Guman Sulaen et al.*, WIPO Case No. D2021-2689).

The Complainant submits that in the present Complaint, it is obvious that the same party is involved behind both disputed domain names and that the websites to which they resolve are subject to common control, because in each case the disputed domain names:

- were registered with a time difference of only five days, with the disputed domain name <sofia-milani.com> registered on June 16, 2022 and the disputed domain name <sofia-milansoldes.com> registered on June 21, 2022;
- have the same Registrar;
- are registered using the same privacy service, namely Cloudflare Inc.;
- incorporate the Complainant’s SOFIA MILANI mark and company keyword as their main element; and
- resolve to almost identically designed websites that both promote identical jewellery offerings under prominent use of the Sofia Milani Marks, company name, company keyword and logo.

Moreover, according to the terms and conditions sections of both websites, the alleged operators of the websites are the entities “Sconto Sofia Milani in Italia” (with regard to <sofia-milani.com>) and “Sofia Milani Soldes Magasin LLC” (with regard to <sofia-milansoldes.com>). Both terms, “sconto” in Italian and “soldes” in French, mean “sale” in the context of a discount promotion. It is rather unusual to integrate the term “sale” in the sense of “discount” into a company name for a company that is not specifically known as a discounter, and yet this is the case for both alleged operators of the websites under the disputed domain names.

Furthermore, despite the websites being available only in Italian and French, the terms and conditions of both websites are not provided in the respective languages but only in English.

The consistency in rather unusual choices for the company names, and the language of the terms and conditions, make clear that one and the same party is operating both websites under the disputed domain names.

The Complainant argues that against the above background, a consolidation of proceedings would be fair and equitable to all parties and would benefit procedural efficiency. Therefore, in the following both registrants are together referred to as the “Respondent”.

This Panel accepts that it is appropriate to consolidate the complaints against the two named registrants as requested, and for the reasons advanced by the Complainant. The registrants of the two disputed domain names are either the same person or acting in concert.

While this Panel notes that the Complaint treats both registrant as the same person, this Panel follows the information on the Whois and treats the registrations as being made by separate registrants acting in concert.

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

Complainant has provided convincing, uncontested evidence that it has rights in the SOFIA MILANI mark, established by the ownership of the portfolio of trademark registrations described above and its use of the mark to distinguish its products and services in its business

The disputed domain name <sofia-milani.com> consists of the Complainant’s SOFIA MILANI mark in its entirety, albeit with a hyphen separating to two elements “sofia” and “milani” and the generic Top Level Domain (“gTLD”) extension <.com>.

The disputed domain name <sofia-milansoldes.com> of Complainant’s mark albeit with the omission of the letter “i” after the element “milan” and the addition of the element “soldes”, in combination with the gTLD extension <.com>.

The Complainant’s mark is the dominant and only distinguishing feature in the disputed domain name <sofia-milani.com>. The hyphen

is likely to go unnoticed by Internet users, placed as it is between the two elements.

Similarly, the Complainant's mark is clearly recognizable and is in fact the dominant concept within the disputed domain name <sofia-milansoldes.com>, notwithstanding the absence of the letter "i", at the end of the element "milani" which is likely to go unnoticed as the element "milani" converts into the geographical placename "Milan" in the English language.

In the circumstances of this proceeding, the gTLD <.com> extension would be considered a necessary technical requirement for a domain name registration,

This Panel finds therefore that both of the disputed domain names are confusingly similar to the SOFIA MILANI mark in which Complainant has rights and Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

Complainant has made out a *prima facie* case that Respondents have no rights legitimate interests in the disputed domain names arguing that

- to satisfy the requirement of a *bona fide* and legitimate offer of services, according to Paragraph 4(c)(i) Policy, the websites to which the disputed domain names resolve, must accurately disclose the Respondents' relationship with the Complainant, and may not, for example, falsely suggest that it is operated by the Complainant or that the website is the Complainant's official site, but in the case at hand, the Respondents are making no effort to dissociate themselves from the Complainant;
- there is no evidence of any use or demonstrable preparations to use the disputed domain names by the Respondents with respect to a *bona fide* and legitimate offering of goods or services, according to Policy paragraph 4(c)(i);
- the screen captures of the websites to which the disputed domain names resolve, which are exhibited in an annex to the Complaint, show that the Respondents are using the disputed domain names to create the false impression of being affiliated with the Complainant by using the Complainant's distinctive SOFIA MILANI marks, company name, company keyword and logo on the websites;
- the Respondents use the company names "Sconto Sofia Milani in Italia" and "Sofia Milani Soldes Magasin LLC" which are identical to names used by the Complainant;
- the Respondents are offering jewellery products which are identical to those offered by the Complainant;
- product photographs and prices displayed on the Respondents' websites and shown in the exhibited screen captures, are taken from the Complainant's website without authorization;
- one of numerous examples, is that the Complainant's offering of "anchor" shaped earrings corresponds with purported offerings made by the Respondents on their websites as is shown in the exhibited screen captures;
- therefore, instead of setting themselves apart from the Complainant, the Respondents are deliberately trying to create the false impression of being affiliated with or endorsed by the Complainant.

It is well established that once a complainant makes out a *prima facie* case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondents have failed to discharge that burden and therefore this Panel must find that Respondents have no rights or legitimate interests in the disputed domain names.

Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

The Complainant has adduced clear and convincing, uncontested evidence that it has trademark and service mark rights, and an established goodwill and reputation in the SOFIA MILANI mark which predate the registration and first use of the disputed domain names on June 16, 2022 and June 22, 2022.

The Complainant's mark is a distinctive combination of two elements "SOFIA" and "MILANI" and it is highly unlikely that the two words would be chosen and registered in a domain name by coincidence without knowledge of the Complainant, its reputation and goodwill.

On the balance of probabilities, the disputed domain name was chosen and registered in bad faith, because of its similarity with the Complainant's mark to confuse and create confusion among Internet users.

This Panel finds therefore that on the balance of probabilities each of the disputed domain names was registered in bad faith with the Complainant's SOFIA MILANI mark in mind with the intention of taking predatory advantage of the Complainant's goodwill and reputation in the mark.

The uncontested evidence adduced by the Complainant shows that the disputed domain names are being used by the Respondent as the addresses of two almost identical websites that purport to offer discounted jewellery under the Complainant's brand. The websites prominently display the Complainant's marks and logos. The Respondents have no license or authority to use the Complainant's name, mark in this manner and give no indication that the Respondents or their websites have no association with the Complainant.

Furthermore, the Respondents have not filed any Response and they have availed of privacy services to conceal their identity on the published WhoIs.

The consequence is that, even if the Respondents are offering products as they purport to do, they are not a *bona fide* reseller of the Complainant's goods, but instead are using the disputed domain names which incorporate the Complainant's marks to impersonate the Complainant; and to confuse and mislead consumers, and misdirect Internet traffic intended for the Complainant, to the Respondent's competing website, thereby taking predatory advantage of, and damaging the Complainant's SOFIA MILANI trademark and service mark.

The Complainant has adduced evidence, albeit in the form of a redacted e-mail which purports to show that a customer known to the Complainant has been confused. On its own this redacted document, which is presented with very little context or information about the sender has little or no probative value, but it stands uncontested.

This Panel finds that the Respondents' use of the Complainant's distinctive registered trademarks and service marks within the disputed domain names for the purposes of impersonating Complainant, and confusing and misdirecting unsuspecting Internet users constitutes use of the disputed domain names in bad faith for the purposes of the Policy.

As this Panel has found that the disputed domain names were registered and are being used in bad faith, Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **sofia-milani.com**: Transferred
- 2. **sofia-milansoldes.com**: Transferred

PANELLISTS

Name	James Bridgeman
------	-----------------

DATE OF PANEL DECISION	2023-01-08
------------------------	------------

Publish the Decision