Decision for dispute CAC-UDRP-105029

Case number	**CAC-UDRP-105029**
Time of filing	**2022-12-20 10:28:40**
Domain names	**estods.com, hoganshop-us.com, SHOESTODS.COM, STORETODS.COM, TODS-SHOES.COM, TODS-SHOP.COM, TODS-STORE.COM, TODS-US.COM**

Case administrator

Organization	**Denisa Bilík (CAC) (Case admin)**

Complainant

Organization	**TOD'S S.p.A.**

Complainant representative

Organization	**Convey srl**

Respondents

Name	**Pdk Pdk**
Name	**Lin63 Yao**
Name	**Abgdf Ungtr**
Name	**Gbde Ykijiw**
Name	
Name	**Jing68 Zhang**
Name	**Juan Zhao**
Name	**liangxuan zhang**

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

Tod's S.p.A. is the owner of various trademark registrations, in particular:

- EUTM no. 010158889 TOD'S - cl. 3, 9, 14, 18, 25 and 35 registered on 29/12/2011 and duly renewed;
- EUTM no. 407031 TOD'S - cl. 9 registered on 13/09/2004 and duly renewed;
- IR no. 1006548 TOD'S - cl. 14 registered on 01/06/2009 and duly renewed;
- IR no. 858452 TOD'S - cl. 3, 9, 18, 25 and 35 registered on 20/05/2005 and duly renewed;
- Australian TM no. 1498996 TOD'S - cl. 3, 9, 25 and 35 registered on 02/04/2012 and duly renewed;
- IR no. 1014830 HOGAN - cl. 9, 18 and 25 registered on 24/07/2009 and duly renewed;
- IR no. 1014831 HOGAN - cl. 9, 18 and 25 registered on 24/07/2009 and duly renewed;
- IR no. 774193 HOGAN cl. 3, 9, 18 and 25 registered on 18/12/2001 and duly renewed;
- IR no. 1129649 HOGAN cl. 3, 9, 18 and 25 registered on 23/03/2012 and duly renewed;
- EUTM no. 5184536 HOGAN cl. 3, 9, 18, 25 and 35 registered on 20/01/2010 and duly renewed.

FACTUAL BACKGROUND

1) TOD'S S.P.A. (hereinafter referred to as the Complainant) submits that despite some differences in the details provided in the official WHOIS records for the eight domain names included in the complaint, the domain names should be considered to be under common control. This also in consideration of the fact that there are substantial commonalities in the web sites to whom the disputed domain names resolved.

2) The Complainant declares to be the operating holding of a Group, amongst the leading players in the world of luxury goods, with the trademarks Tod's, Hogan, Fay and Roger Vivier with about 4.600 employees worldwide. Furthermore, the Complainant informs to have numerous stores around the world, including showrooms and large flagship stores in Europe, the U.S., China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia.

3) According to the Complainant, the high standard of quality met by the products is guaranteed by the strong craftsmanship involved in every and each phase of the production: every product is handmade, crafted with techniques of the highest skilled handcraftsmanship. The Complainant also informs that the 2022 Annual revenues of Tod’s Group were almost 668 million of Euros of which 50% came from the trademark "TOD’S".

4) The Complainant has duly proved to be the owner of the registered well-known trademarks "TOD'S" and "HOGAN" in several classes in numerous countries all over the world including China, where all the Respondents are located and that these trademark registrations long predate the registration of the disputed domain names (all registered on 2022).

5) The Complainant has been extensively using the "TOD'S" and the "HOGAN" denominations on all internet environments including and not limited to the company's official websites https://www.tods.com. The Complainant has registered a number of domain names containing the wording TODS (considering that due to technical limitations the apostrophe cannot be included in domain names) and HOGAN, for example <tods.com>, <tods.it>, <tods.fr>, <tods.eu>, <tods.cn>, <hogan.com>, <hogan.it>, <hogan.fr>, <hogan.eu>, <hogan.cn>. The Complainant also has official accounts on the major social networks such as Facebook, Instagram and Twitter.

6) Before the commencement of this proceedings, on October 12, 2022, the Complainant made an attempt to contact the owners of the disputed domain names through a cease and desist letter sent via form online indicated in the corresponding websites related to the domain names. The addresses have simply disregarded said communication.

7) According to the Complainant, the domain names in dispute are similar to its "TOD'S" and "HOGAN" trademarks. Actually, in all cases the domain names incorporate the Complainant’s "TOD’S" or "HOGAN" trademarks in its entirety with the mere adding of non-distinctive elements such as geographical indicators or generic words.

8) The Complainant informs that the owners of the disputed domain names are not licensees or authorized agents of the Complainant and that they are not authorized to use the Complainant’s trademarks. Furthermore, the Complainant has not found that the owners of the disputed domain names are commonly known by the disputed domain names or that they have any protectable interest over the domain names in dispute.

9) The Complainant argues that by virtue of the extensive worldwide use, the Complainant trademarks "TOD’S" and "HOGAN" have become well-known trademarks in the sector of shoes and leather goods. Therefore, it is clear, in the Complainant's view, that the Respondents were well aware of the trademarks "TOD’S" and "HOGAN" and decided to register the disputed domain names with the clear intention to refer to the Complainant and its trademarks "TOD'S" ad "HOGAN".

10) According to the Complainant, the use of the disputed domain names in connection with commercial websites where the Complainant trademarks are misappropriated and counterfeit "TOD’S" and "HOGAN" branded goods are offered for sale, clearly indicates that the Respondent purpose in registering the disputed domain names was to capitalize on the reputation of the Complainant trademarks by diverting Internet users seeking "TOD’S" and "HOGAN" products to their websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said websites.

PARTIES CONTENTIONS

Complainant´s contentions are summarised in the Factual background section above.

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).

PROCEDURAL FACTORS

Consolidation of Respondents
According to Article 3(c) of Rules for Uniform Domain Name Dispute Resolution Policy ("Rules"), the Complaint may relate to more than one domain name, provided that the disputed domain names are registered by the same domain-name holder. According to Article 10(e) of Rules a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.
The Complainant requests to consolidate its claims against the registrants of the disputed domain names notwithstanding that the registrant details are different, on the grounds that all the disputed domain names are subject to common control and that it is equitable and procedurally efficient to consolidate the proceedings. The Complainant relies on the following factors that all the disputed domain names have in common, namely that they each use the .com Top Level Domain extension, the same hosting provider, the same Autonomous System Number and the same registrar. In addition, according to the Complainant, all the disputed domain names (i) share the same lay-out of the websites and of the offers, (ii) share the same products offered for sale (except for hoganshop-us.com), (iii) share the same opening hours of the shops, (iv) share the same footer of the websites including the same ways of payment and the pattern of the copyright. Finally, the Complainant notes that all the disputed domain names incorporate either the Complainant's "TOD'S" or "HOGAN" mark in its entirety and couple it with geographical and/or descriptive terms.

Notwithstanding the differences in registrant details, the Panel considers that all the disputed domain names are under the same common control. In addition to the points raised by the Complainant, it must be noted that the dates of registration of the disputed domain names are really close (between April 2022 and September 2022), all the websites pretend to give the impression to be official websites of the Complainant and all the Respondents originate from China. Finally, the Respondents have had the opportunity to challenge in these proceedings the Complainant assertions of common control but have chosen not to do so.
In previous cases similar to the one at hand the Panel has decided to order the consolidation (see, for example, Tod's SPA v Web Commerce Communications Limited; CAC Case No. 103815) and the Panel therefore agrees to the Complainant’s request, even considering that, due to the circumstances of the present case, it is equitable and procedurally efficient to consolidate the proceedings.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1a) <hoganshop-us.com>

The Complainant has demonstrated rights through registration and use on the "HOGAN" trademark. The Panel finds that the disputed domain name <hoganshop-us.com> is confusingly similar with the "HOGAN" trademark of the Complainant. Actually, the disputed domain name incorporates said trademark of the Complainant in its entirety. This is sufficient to establish confusing similarity (Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525). The word “shop” which is added in the disputed domain name does not avoid a finding of confusing similarity as it is a descriptive, non-distinctive term, denoting the operation of the website as an online shop (Accenture Global Services Limited v. Jean Jacque / Luck Loic, WIPO Case No. D2016-1315; Wragge Lawrence Graham & Co LLP v. Registration Private, Domains by Proxy LLC / Ian Piggin, WIPO Case No. D2015-0135). The word “-us” which is added in the disputed domain name is disregarded as it is a geographic, non-distinctive term (BHP Billiton Innovation Pty Ltd v. Oloyi, WIPO Case No. D2017-0284, Accenture Global Services Limited v. Jean Jacque / Luck Loic, WIPO Case No. D2016-1315; Wragge Lawrence Graham & Co LLP v. Registration Private, Domains by Proxy LLC / Ian Piggin, WIPO Case No. D2015-0135). The generic Top-Level Domain (“gTLD”) “.com” is also disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons only (Rexel Developpements SAS v. Zhan Yequn, WIPO Case No. D2017-0275; Hay & Robertson InternationalLicensing AG v. C. J. Lovik, WIPO Case No. D2002-0122). Therefore, the Panel finds that the disputed domain name <hoganshop-us.com> is confusingly similar to the "HOGAN" trademark of the Complainant.

1b) <estods.com>; <tods-us.com>

The Complainant has demonstrated rights through registration and use on the "TOD'S" trademark. The Panel finds that also the disputed domain names <estods.com> and <tods-us.com> are confusingly similar with the Complainant's trademark ("TOD'S" in this case). Actually, even in this case, the disputed domain name incorporates said trademark of the Complainant in its entirety and it is per se sufficient to establish confusing similarity. As seen above, the addition of geographic terms (the prefix "es" for Spain or the suffix "-us" for United States of America) does not prevent a finding of confusing similarity between the disputed domain names and the "TOD'S" trademark while, as a mere technical part of the disputed domain name, the gTLD “.com” may be disregarded in determining confusing similarity.

1c) <shoestods.com>; <storetods.com>; <tods-shoes.com>; <tods-shop.com>; <tods-store.com>

As seen above, the Complainant has demonstrated rights through registration and use on the "TOD'S" trademark. The Panel finds that also the disputed domain names <shoestods.com>; <storetods.com>; <tods-shoes.com>; <tods-shop.com> and <tods-store.com> are confusingly similar with the Complainant's "TOD'S" trademark. Actually, even in this case, the disputed domain name incorporates said trademark of the Complainant in its entirety and it is per se sufficient to establish confusing similarity. As seen above, the addition of generic terms as shop/store (which merely indicates the operation of the website as an online shop/store) or shoes (which are the main products sold by the Complainant with the "TOD'S" trademark) does not prevent a finding of confusing similarity between the disputed domain names and the "TOD'S" trademark while, as a mere technical part of the disputed domain name, the gTLD “.com” may be disregarded in determining confusing similarity.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are confusingly similar to trademarks in which the Complainant has rights. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant demonstrated that the websites to which the disputed domain names are linked allegedly offer for sale authentic merchandise bearing the "TOD'S" or "HOGAN" trademarks. The Complainant clearly considers that Respondent has the hope and the expectation that Internet users looking for the brand "TOD'S" or "HOGAN" will be directed to the websites corresponding to the disputed domain names. The Panel finds that said activity, of course, does not provide a legitimate interest in the disputed domain names under the Policy. Furthermore, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain names as it is not commonly known under the disputed domain names and was never authorized to use the "TOD'S" or "HOGAN" trademarks by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain names. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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.

The Respondent registered the disputed domain names years after the use and registration of the "TOD'S" and HOGAN" marks by the Complainant. In consideration of the reputation achieved by "TOD'S" and "HOGAN" it is clear that the Respondent was surely aware of the Complainant trademarks when he registered the domain names in dispute. Moreover, the Respondent appears to have attempted to benefit commercially from the appropriation of the "TOD'S" and "HOGAN" mark in the disputed domain names. The use of the famous marks "TOD'S" and "HOGAN", which are both well-known worldwide in the fashion sector, for selling fashion items, clearly indicates

that the disputed domain names were chosen by the Respondent to take advantage of the Complainant marks reputation. This finding leads to the obvious conclusion that the disputed domain names have been registered in bad faith (Research In Motion Limited v. Privacy Locked LLC/Nat Collicot - WIPO Case No. D2009-0320; The Gap, Inc. v. Deng Youqian - WIPO Case No. D2009-0113; AXA S.A. v. P.A. van der Wees - WIPO Case No. D2009-0206; BHP Billiton Innovation v. Ravindra Bala - WIPO Case No. D2008-1059).

The Panel also finds that, by linking the disputed domain names to websites offering for sale alleged "TOD'S" and "HOGAN" items, the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain, by causing a likelihood of confusion with the trademark "TOD'S" and "HOGAN" as to the source, sponsorship, affiliation or endorsement of its websites and the products promoted therein.

Furthermore, the Respondent has ignored Complainant's attempt to resolve this dispute outside of this administrative proceeding by refusing to answer the cease and desist letters. Past UDRP panels have held that failure to respond to a cease and desist letter may properly be considered a factor in finding bad faith (see, for instance, Encyclopedia Britannica v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330 and RRI Financial, Inc., v. Chen, WIPO Case No. D2001-1242).

As the conduct described above clearly falls within paragraph 4(b)(iv) of the Policy (Triumph International Vietnam Ltd v. Tran Quoc Huy - WIPO Case No. D2017-0340), the Panel concludes that the Respondent registered and is using the disputed domain names in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **estods.com**: Transferred
2. **hoganshop-us.com**: Transferred
3. **SHOESTODS.COM**: Transferred
4. **STORETODS.COM**: Transferred
5. **TODS-SHOES.COM**: Transferred
6. **TODS-SHOP.COM**: Transferred
7. **TODS-STORE.COM**: Transferred
8. **TODS-US.COM**: Transferred

PANELLISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2023-02-01

Publish the Decision