

Decision for dispute CAC-UDRP-104938

Case number	CAC-UDRP-104938
Time of filing	2023-01-16 10:31:18
Domain names	golashoes-nz.com, gola-polska.com, gola-france.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	D. Jacobson & Sons Limited
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Complainant representative

Organization	TLT LLP
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Respondent

Organization	Web Commerce Communications Limited
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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 names.

IDENTIFICATION OF RIGHTS

In these proceedings, the Complainant relies on the following registered trademarks:

- GOLA, UK Registration No. 00000272980, registered as of May 22, 1905, in the name of the Complainant;
- GOLA, UK Registration No. 00001097140, registered as of June 14, 1978, in the name of the Complainant;
- GOLA, European Union Trade Mark No. 001909936, registered as of October 4, 2000, in the name of the Complainant;
- GOLA, European Union Trade Mark No. 003399681, registered as of October 8, 2003, in the name of the Complainant;
- GOLA, European Union Trade Mark No. 011567625, registered as of February 12, 2013, in the name of the Complainant.

It is worth noting that, the Complainant owns many other trademark registrations for GOLA in various countries, which have not been relied upon in these proceedings. In particular, the Complainant is the owner of two trademark registrations for GOLA in Malaysia, where the Respondent is apparently located, under nos. 02005946 and 02005947, registered as of May 23, 2002 (although they may have expired last year, the Malaysian IP Office's online data not being clear on this point).

FACTUAL BACKGROUND

According to evidence provided by the Complainant and not refuted by the Respondent, the Complainant is “a UK based designer, importer, seller and exporter of ladies', men's and children's footwear. In particular, the Complainant owns the internationally famous "GOLA" brand, which it has very successfully applied (amongst other things) to its range of footwear and bag designs. The Complainant's footwear and bag products are sold throughout the world”, also through its numerous websites. The Panel considers that the Complainant has sufficiently proven its GOLA marks reputation in the world.

The Complainant owns a good-sized portfolio of trademarks worldwide including the wording "GOLA", among which a UK (home) registration dating back to May 1905! It also has a successful internet and social media presence, while it owns a multitude of related domain names, like <gola.co.uk> since December 17, 1997 and <golausa.com> since February 14, 2002.

All three (3) disputed domain names, <golashoes-nz.com>, <gola-polska.com> and <gola-france.com>, were registered between June and August 2022 by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to its GOLA trademark, as they are combinations of this wholly incorporated trademark and of geographical terms. This last element is sufficient to support the finding that the disputed domain names are confusingly similar to the Complainant's trademark. The mere addition of geographical terms to the Complainant's trademark does not change the overall impression of a most likely connection with the trademark GOLA of the Complainant, since the Complainant is active in all relevant countries. As to the gTLD “.com”, the Complainant suggests that it should be disregarded, as per usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain names because the Respondent is not known by the disputed domain names, the Complainant is neither affiliated with the Respondent nor has it ever authorised the Respondent to register its trademark as a domain name, and the Complainant has no business with the Respondent.

According to the Complainant, given the seniority, distinctiveness and worldwide reputation of the GOLA trademark, the Respondent registered the disputed domain names with full knowledge of the Complainant's trademark in an intentionally designed way, with the aim to create a likelihood of confusion with the Complainant's trademarks and domain names, and this is evidence of the fact that the disputed domain names were registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has used the disputed domain names to mirror the Complainant's own websites, so as to mislead users into believing that they are purchasing authentic GOLA items, when they are not, a fact that -in combination with the incorporation of a famous trademark in a domain name- proves use in bad faith. The Complainant specifically claims that the Respondent has acted in a passing off and in an unfair competition way.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain names in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

Before launching itself into the usual threefold test, according to paragraph 4(a) of the Policy, the Panel needs to address the issue of the request by the Complainant for consolidation of the three (3) disputed domain names and of their respective Respondents. This matter was well presented by the Panel in WIPO Case No. D2010-0281 Speedo Holdings.

The Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") stipulate under Rule 3(c):

3 The Complaint

(c) The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

The Rules have a further provision, Rule 10(e), which enables the Panel to decide in its own discretion upon a request for consolidation:

10 General Powers of the Panel

(e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

Based on these provisions alone, it could be inferred that, in the present case, consolidation is possible, as all three disputed domain

names have been registered by the same domain-name holder.

Also, as decided in WIPO Case No. D2010-0281, “consolidation will permit multiple domain name disputes arising from a common nucleus of facts and involving common legal issues to be heard and resolved in a single administrative proceeding. Doing so promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, and generally furthers the fundamental objectives of the Policy”.

With all the above in mind, the Panel decides to admit, in its sole discretion, the Complainant’s implicit request for consolidation of the three cases at hand, which is consistent with the UDRP Policy and the Rules and seems to be “procedurally efficient and fair and equitable to all parties”.

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 names consist of the Complainant’s whole trademark GOLA, in combination with geographical terms (“.nz”, country code for New Zealand; “polska”, Poland in Polish language, and; “france”, France). The addition of the specific geographical words in the disputed domain names is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark of the Complainant. Such words actually reinforce the confusion, as they either relate to the large geographical scope of its market presence.

As far as the gTLD “.com” is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, Panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the GOLA trademark in a domain name, and that it had never licensed its trademarks to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain names in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain names.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names. In order to rebut the Complainant’s arguments, the Respondent had the possibility to make his own defense. However, the Respondent has not filed any Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the seniority and reputation of the Complainant’s trademark and the fact that the disputed domain names fully incorporate this trademark (even in combination with geographical terms), it is evident that, at the respective times of the registrations of the disputed domain names, the Respondent was well aware of the Complainant’s trademark. The registration as domain name of a third party’s well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain names correspond to commercial websites, which mirror the Complainant’s websites and, thus, may mislead the consumers into believing that they are buying original GOLA products. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain names. For this Panel, same as for many

previous panels, such misleading behaviour clearly amounts to use in bad faith. Consequently, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate.

Further, from the evidence filed by the Complainant and not refuted by the Respondent, it seems that the Respondent has adopted a certain pattern of registering similar domain names that incorporate the trademark of the Complainant, in combination with geographical terms. The Panel has accordingly traced at least two similar UDRP decisions, nos. 104400 and 104407, both issued in 2022, where the same parties were involved and where the Panels transferred the relevant domain names to the Complainant.

Therefore, the Panel finds it clear that the disputed domain names were used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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

The disputed domain names wholly incorporate the Complainant's trademark, written in combination with geographical words. The disputed domain names are therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademarks in the disputed domain names, and the Complainant never licensed its trademark to the Respondent. The Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain names with full knowledge of the Complainant's reputable trademark. His use of the disputed domain name is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **golashoes-nz.com**: Transferred
- 2. **gola-polska.com**: Transferred
- 3. **gola-france.com**: Transferred

PANELLISTS

Name	Sozos-Christos Theodoulou
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DATE OF PANEL DECISION 2023-02-15

Publish the Decision