Decision for dispute CAC-UDRP-102514

Case number	CAC-UDRP-102514
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Domain names	hugobossdiscount.com, hugobossclearance.com, hugobossoutletclearance.com, hugobosssaleclearance.com

Case administrator

Name	Iveta Špiclová (Case admin)

Complainant

Organization	HUGO BOSS Trade Mark Management GmbH & Co
Organization	HUGO BOSS AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	wang su qing

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

Chinese Trade Mark Registration No. 253481 for HUGO BOSS in relation to various clothing goods in class 25, dated 30 June 1986.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainants are Hugo Boss Trade Mark Management GmbH & Co and Hugo Boss AG (hereinafter referred to collectively as "the Complainant"). They are part of the Hugo Boss group, which is a well-known fashion business founded in Germany in 1924. The Hugo Boss group manufactures, markets and retails clothing, shoes and other accessories, as well as fragrances, skincare products, watches, eyewear and kidswear various trademarks including HUGO BOSS, BOSS ORANGE, BOSS and HUGO.

The Complainant employs almost 14,000 people worldwide and has generated net sales of EUR 2,796 in the financial year ending June 2018. It operates a number of websites, including one located at <www.hugoboss.com>.

The Complainant owns numerous trademark registrations in various jurisdictions that contain or consist of HUGO BOSS and are registered in relation to clothing related goods in class 25. These include the above mentioned Chinese Trade Mark Registration that has remained registered for other 30 years.

The Complainant is also the registrant of numerous domain names containing or consisting of HUGO BOSS.

The four disputed domain names all consist of the words HUGOBOSS followed by descriptive terms and ending with the .com gTLD suffix. They were registered at various times between November 2016 and September 2018. "wang su qing" is listed as the Registrant for all four disputed domain names and an address in the Chinese province of FuJian is provided. However other contact details vary slightly, including the fact that 3 of the disputed domain names list the registrant e-mail address as "19868165@qq.com" whilst the other disputed domain name, <hugobosssaleclearance.com> lists the registrant e-mail address as "674713@qq.com".

The language of the registration agreements for all the disputed domain names is Chinese.

The disputed domain names all redirect to websites offering clothing goods of sale. They are in English. At the time of the Complaint all four such websites used the "HUGO BOSS" trademark in page headings. Further, the website located at <hugobossdiscount.com> prominently displayed the Complainant's HUGO BOSS logo as a heading and the website located at <hugobossoutletclearance.com> contained a statement saying "Official HUGO BOSS USA Online Shop".

The Complainant asserts all four websites are intended to mislead consumers into believing they are genuine online stores of the Complainant. The Complainant asserted its trademark rights and demanded transfer of three of the four disputed domain names from the Respondent in an e-mail sent some months ago in October 2018. It received no response.

The Respondent's "674713@qq.com" e-mail address is listed as the registrant contact for numerous other domain names containing or consisting of well-known clothing brands. The Complainant asserts this is evidence of a pattern of conduct of bad faith domain name registration.

The Complainant now requests that the language of the proceedings be in English and the Panel find that despite the said discrepancies in some contact details the Respondent is the same person who is the registrant for all 4 disputed domain names.

PARTIES CONTENTIONS

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

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

A. LANGUAGE OF THE PROCEEDINGS

The Complainant has made the following procedural submissions:

"The Complainant requests that the language of proceedings be English and provides the following supporting arguments and evidence:

1. The websites associated with the disputed domain names are displayed in English;
2. The disputed domain names include the Complainant's trademark HUGO BOSS in its entirety combined with generic English terms "discount", "clearance", "outlet" and/or "sales", which are closely related to the Complaint's business activities.

The above facts show that the Respondent obviously understands English. To avoid any potential unfairness or unwarranted delay in ordering the Complainant to translate the Complaint, the Complainant requests that the proceeding language should be in English."

Paragraph 11(a) of the Rules reads:

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Registration Agreement is in Chinese and not English

It has been stated that the discretion to decide upon the language of the proceeding under Rule 11(a) "must be exercised in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs" (Transtrands Handelsaktiebolag v. Jack Terry; WIPO Case No. D2005-0057). However it is without doubt that the command of language is the most vital consideration in the sense that if a respondent has no understanding of the language of the complaint, and therefore is unable to even understand that a type of complaint which calls upon a response has been made against them, then there would be an obvious injustice to proceed in a language other than that of the Registration Agreement to which the respondent agreed.

However the vital nature of this consideration does not require overwhelming evidence from a Complainant that the Respondent is in fact highly proficient in the language in order for the Panel to deem it the appropriate language of the proceeding. No words indicating such a high onus exist in paragraph 11(a) of the Rules. Further it is the Panel's view that if the preliminary matter of the language of the proceeding can be decided on the facts fairly without delaying the proceeding then such a decision ought to be made.

The Panel finds in the present matter on the question of whether the Respondent has sufficient command of the English language that is enough that the facts show a likelihood that the Respondent had sufficient knowledge of this language to;

(a). understand that a complaint had been made against it; and

(b). be able to make the decision, as it did, to refrain from filing a response.

Such facts have been shown by the registration of the disputed domain names in latin characters together with the use of the disputed domain names to redirect to websites which displayed many full sentences in the English language. The above

question has therefore been answered in the affirmative. It is unnecessary to investigate the proficiency of the Respondent's understanding of English any further. The Respondent has sufficient knowledge to satisfy the above. With such sufficient knowledge, if the Respondent believed it was prejudiced by the Complainant's request that the language of the proceeding be in English it ought to have filed a response saying so and setting out its reasons. It has not done so, in any language.

As to the remaining relevant factors the Panel accepts that the Complainant would incur costs and delay if proceeding were to be conducted in Chinese which, given the facts set out above, are unjustified. The disputed domain names have clearly been used to communicate to consumers through websites in the English language and it is entirely appropriate for the proceedings to be conducted in that same language. As the Respondent has chosen not to file a response, it is not prejudiced in the same manner even if its preferred language was Chinese.

B. SUBSTANTIVE LAW

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain names are identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and

2) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and

3) the disputed domain names have been registered and are being used in bad faith.

The Panel is satisfied that the Complainant has satisfied all three elements for the principal reasons set out below.

C. RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant claims registered rights over a number of trade marks containing or consisting of HUGO BOSS. However the Panel has focused on one trade mark registration in particular, being Chinese Trade Mark Registration No. 253481 for HUGO BOSS in relation to various clothing goods in class 25, dated 30 June 1986.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a single trademark in a single jurisdiction that predates the registration of the disputed domain names (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijike KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436).

The next question is whether the disputed domain names are confusingly similar to the HUGO BOSS trademark.

HUGO BOSS is a distinctive sign with no generic meaning in relation clothing. By contrast, the further elements of the disputed domain names constitute purely descriptive terms in the context of online clothing retail. A consumer will likely ignore the latter elements and focus on the HUGO BOSS element in each of the disputed domain names.

The Panel is therefore satisfied that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

D. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name appears the same for each of the disputed domain names. Although there is some differences in contract details, it is clear to the Panel that the Respondent is the same entity in each case.

The Respondent's name bears no resemblance to the disputed domain names. Further, the websites to which users are directed does not disclose any legitimate interests in the disputed domain names. There is a number of clothing and accessory items labeled "Hugo Boss" offered for sale on these websites, however it is unclear if they are genuine goods originating from the Complainant or not. Even if they were genuine goods, this would not alter the Panel's decision due to the misleading use of the domain names as mentioned below.

There is simply no basis to conclude that the Respondent has rights or interests in the disputed domain names.

E. BAD FAITH

In relation to bad faith it must first be said that it is completely inconceivable that the Respondent did not know of the HUGO BOSS trade mark when first registered the disputed domain names. And the inclusion of HUGO BOSS in the disputed domain names is without doubt a reference to the Complainant's business and goods. Indeed it is difficult to see how a use of words HUGO BOSS could be anything other than such a reference for three reasons:

(1). As the evidence establishes, HUGO BOSS is presently a well-known global brand.

(2). HUGO BOSS has been an established brand for a long period of time and hence its reputation with consumers has been reinforced over time.

(3). HUGO BOSS is inherently distinctive. It is not a common or generic term. A brand may be well-known, but lack a degree of inherent distinctiveness meaning that persons may innocently use it to describe a circumstance or thing. For example MCDONALD'S is a well-known brand in relation to take-away food, however it is also a common surname of Scottish origin. It could be used innocently for it surname significance. However they same cannot be said for a unique mark like HUGO BOSS.

These three reasons highlight that HUGO BOSS is an exceptionally recognizable global brand.

Secondly, even if the Respondent used the websites to sell genuine HUGO BOSS goods (which is unknown to the Panel) it has still acted in bad faith in its use and registration of the disputed domain names. All the websites used HUGO BOSS as a heading, indicating they offered a HUGO BOSS retail service. One of the websites went one step further and stated it was the "Official HUGO BOSS USA Online Shop" when clearly it was not.

Although this latter false statement was only made on one of the four disputed domain names it provides a strong indication as to the Respondent's motives in registering all the disputed domain names. This is further supported by the Respondent's repeated use of one of its e-mails in the registrant contact section for numerous other domain names containing or consisting of well-known clothing brands. The Panel accepts the Complainant's assertion this is evidence of a pattern of conduct of bad faith domain name registration.

Finally, although evidence of ignoring a letter of demand is not conclusive evidence of bad faith the Complainant's communication does show without doubt the Respondent was aware of the rights in HUGO BOSS and nevertheless proceeded with its misleading use of the disputed domain names.

It is clear that the Respondent has registered and used the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HUGOBOSSDISCOUNT.COM**: Transferred
2. **HUGOBOSSCLEARANCE.COM**: Transferred

3. **HUGOBOSSOUTLETCLEARANCE.COM**: Transferred
4. **HUGOBOSSSALECLEARANCE.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2019-07-14

Publish the Decision