Decision for dispute CAC-UDRP-103207

Case number	CAC-UDRP-103207
Time of filing	2020-07-30 09:23:26
Domain names	DANIELWELLINGTONUS.COM

Case administrator

Name	Iveta Špiclová (Case admin)

Complainant

Organization	Daniel Wellington AB

Complainant representative

Organization	SILKA Law AB

Respondent

Name	Nguyễn Thanh Dũng

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 submitted evidence that it is the registered owner of the following registrations for the trademark "DANIEL WELLINGTON":

- the international trademark registration No. 1135742 for word "DANIEL WELLINGTON", registered since 3 July 2012 for the classes 9, 14 and 35, designating numerous countries (including Vietnam); and

- the international trademark registration No. 1260501 for device "DW Daniel Wellington", registered since 11 March 2015 for the classes 9, 14, 18, 25 and 35, designating numerous countries (including Vietnam).

The Complainant has also registered several domain names, under various top-level domains, containing the term "danielwellington" or its abbreviation "dw", for example <danielwellington.com> (created on 16 February 2011); <danielwellington.vn> (created on 2 July 2015); <danielwellington.asia> (created 30 May 2013); and <dwwatch.shop> (created on 22 September 2016).

FACTUAL BACKGROUND

The Complainant is a company established in Sweden that manufactures and sells stylish design watches. It was founded in 2011 and has based its marketing efforts through extensive use of social media. The Complainant operates on global scale and enjoys popularity on major social media platforms.

The disputed domain name <danielwellingtonus.com> was registered on 22 March 2018.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is Vietnamese. On 7 September 2020, the Complainant filed request to change the language of the proceedings to English.

The Respondent has not filed a Response. CAC is unaware of whether written notice of the Complaint has been received by the Respondent. One of the e-mails sent to the Respondent was successfully relayed; the Respondent never accessed the online platform.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

The Complainant argues that that the disputed domain name incorporates the Complainant's trademark DANIEL WELLINGTON in its entirety adding the geographical identifier "us" for United States. The Complainant states that the geographical designation "us" does not prevent a finding of confusing similarity as the key element, DANIEL WELLINGTON, is reproduced in the disputed domain name. The gTLD .com should be disregarded for the purposes of comparison. The gTLD ".com" is a mere technical requirement and does not affect the identity between a domain name and a trademark. The same reasoning applies in the present case and as such, the Complainant concludes that the first element of the UDRP is fulfilled.

The Complainant further contends that the Respondent has no right or legitimate interest in respect of the disputed domain name. In particular, the Complainant states that there is no bona fide offering of goods or services since the disputed domain name incorporates a trademark which is not owned by the Respondent, nor is the Respondent known by the name "Daniel Wellington". The purpose of a domain name is to induce consumers into visiting the related website under the misapprehension that the website is, in this case, endorsed by the Complainant and/or where the Complainant offers its watches. The disputed domain name resolves to a replica of the Complainant's genuine website www.danielwellington.com. The website connected to the disputed domain name not only incorporates elements of the Complainant's branding, i.e., the Complainant's trademark, but it also offers for sale goods which are highly similar to the products offered by the Complainant on the genuine website www.danielwellington.com. The Respondent is using the disputed domain name with intent for commercial gain and misleadingly to divert consumers. This use is also intended to tarnish the trademark at hand. There is no evidence to suggest that there is due cause or legitimate interest in the use and registration of the disputed domain name. The Complainant then refers to a similar case decided by CAC (Case No. 102550 Daniel Wellington AB v. Zheng Zebiao). The Complainant goes on to conclude that there is nothing to show that the Respondent has any rights in the name DANIEL WELLINGTON and the website is clearly used for commercial purposes. Therefore, the Complainant believes it has succeeded to prove the second element of the Policy (as defined below).

Turning to the bad faith argument, the Complainant asserts that the disputed domain name resolves to a website which flagrantly seeks to imitate that of the Complainant. The Complainant finds it clear that the Respondent registered the disputed domain name with full knowledge of the Complainant's business. The behaviour of the Respondent is disrupting the business of the Complainant. The Respondent is purporting to be the Complainant and is on its website selling "Daniel Wellington"-branded products which are not authorized by the Complainant. The active business presence of the Complainant in Vietnam also makes it unlikely that the Respondent was unaware of the unlawful registration of the disputed domain name. It is evident from the screen shots that the Respondent registered the disputed domain name only due to its fame.

The Complainant adds that the submitted evidence demonstrates that the Respondent is not only using the Complainant's trademark on the website but also displays the same look and feel as that of the Complainant's website. The disputed domain name is used for a website similar to that of the Complainant and uses the Complainant's trademark including the logotype. The pictures and the layout of the website clearly resemble that of the Complainant's own main website.

Finally, the Complainant points to the fact that the Respondent is using a privacy shield. Although use of a privacy or proxy registration service is not in itself an indication of bad faith, the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith. The Complainant would like to emphasize that the reason for using a privacy service in this instance seems to have been to increase the difficulty for the Complainant of identifying the Respondent, which does not reflect good faith. Consequently, the Complainant argues that there is an increased risk of confusion as customers may more easily be confused or misled into believing that the disputed domain name and website belongs to or is associated with the Complainant. With all that in mind, the Complainant concludes that the Respondent should be considered to have registered and to be using the disputed domain name in bad faith.

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).

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).

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).

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 Complainant requested that the language of the proceedings be changed from Vietnamese to English. The Rules (as defined below) provide that the language of proceedings is the language of the registration agreement (in this case, Vietnamese): "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".

In support of its request, the Complainant notes that its mark is well known internationally; that the Respondent will not suffer no prejudice if English is made the language of the proceedings if it will default in these proceedings; and that references to the English word "US" for the United States in the domain name as well as certain element of images on the website in English suggest that the Respondent must be conversant in English language. The Complainant also makes the point that the proceedings would become inadequately costly and lengthy should they be conducted in Vietnamese.

Given that the Respondent has not submitted its Response and has not accessed the platform, it has failed to address the issue of language of proceedings. Upon query from the Panel, the CAC confirmed that it had notified the Complaint to the Respondent also in Vietnamese.

Taking in consideration the facts of the matter as well as the Complainant's arguments, and having regard to the principle of fairness, equality and efficiency of proceedings, the Panel has decided to accept the change of the language of the proceedings to English. Given the flagrant infringement of the Complainant's various rights by imitating its website, given the use of English-worded trademark in the disputed domain name, given the use of English language elements on the website

operated on the disputed domain, and given the fact that according to the CAC the Respondent received notification of the Complaint in the language of the registration agreement (i.e. Vietnamese), the Panel considers it justified to allow the change of language of proceedings to English. The Respondent was given fair opportunity to comment and it chose not to act.

PRINCIPAL REASONS FOR THE DECISION

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, a complainant must prove each of the following: (i) the 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 domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainant demonstrated that it owns the asserted trademark registrations for the marks "DANIEL WELLINGTON" and " DW Daniel Wellington", both of which were registered before the registration of the disputed domain name by the Respondent. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix .com may be disregarded when considering whether a disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain name incorporates the Complainant's trademark "DANIEL WELLINGTON" in its entirety. The Panel believes that the adding of abbreviation “US” must be considered as insufficient to prevent or diminish confusing similarity. Such addition does not change the overall impression of the disputed domain name as being connected to the Complainant's trademark "DANIEL WELLINGTON", particularly given that the addition of “US” would most likely be understood as geographical identifier of the United States.

The Panel therefore finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Upon review of the submitted evidence, the Panel finds that the disputed domain name resolved, at least at the time of filing the Complaint, to a replica of the Complainant’s genuine website imitating the overall look and feel, branding and products as those on the Complainant’s genuine website. In such situation, the Panel is indeed satisfied that there is no bona fide offering of goods or services and that the Respondent is clearly using the disputed domain name with intent for commercial gain and misleadingly to divert consumers. There is no evidence or indication to suggest that there is due cause or legitimate interest in the use and registration of the disputed domain name, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant’s trademark for its commercial activities. Finally, the Respondent is not commonly known by the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy.

The Panel therefore finds that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainant states, in summary: (a) that the disputed domain name resolves to a website which flagrantly imitates the Complainant's website; (b) that the Respondent registered the disputed domain name with full knowledge of the Complainant's business; and (c) that the Respondent is using a privacy shield in order to increase the difficulty for the Complainant of identifying the Respondent.

First of all, the Panel has already found that the disputed domain name is confusingly similar to the Complainant's trademark "DANIEL WELLINGTON". It is well established that mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith.

The Panel believes that the Complainant submitted evidence sufficiently demonstrating that the Respondent must have been aware of the existence of the Complainant, its trademark, its numerous domain names, and its business. The Panel has also accepted the Complainant's argument that the imitation of the overall impression of the Complainant' website on the disputed domain name is a very clear indication of the Respondent's bad faith. It is really difficult, if not impossible, to find any good faith reason for the registration of the disputed domain name by the Respondent.

Therefore, the Panel finds that the disputed domain name has been registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DANIELWELLINGTONUS.COM**: Transferred

PANELLISTS

Name	**Mgr. Vojtěch Chloupek**

DATE OF PANEL DECISION 2020-09-25

Publish the Decision