Decision for dispute CAC-UDRP-103264

Case number	CAC-UDRP-103264
Time of filing	2020-10-27 09:33:58
Domain names	PandoraOnlineRomania.com, PandoraRomania.ro, Pandora-Mexico.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Pandora A/S

Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.

Respondent

Name	"Fisher" "Yvonne"

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 several trademark registrations consisting of the term “PANDORA”, in particular European Union Trademark no. 003397858 registered on April 18, 2007 and International trademark no. 1004640 registered on May 14, 2009 and protected in a number of territories.

FACTUAL BACKGROUND

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

It results from the Complainant’s undisputed allegations that the Complainant is a company incorporated in Denmark, which designs, manufactures and markets hand-finished and contemporary jewellery and its products have been marketed and sold under “Pandora” in more than 100 countries and through more than 7,700 points of sale.

The Complainant contends that its trademark PANDORA is well-known worldwide, enjoying a high degree of global recognition for jewellery.

It is also the owner of the domain name <pandora.net> and use it to promote and sell online its products.

The disputed domain name <PANDORAONLINEROMANIA.COM> was registered on August 18, 2020, the disputed domain name <PandoraRomania.ro> was registered on August 23, 2019, the disputed domain name <Pandora-Mexico.com> was registered on September 9, 2020, the disputed domain name <pandorawebshop.com> was registered on August 8, 2019, the disputed domain name <PandoraWebshopHU.com> was registered on June 12, 2020.

All the aforementioned disputed domain names resolve to websites promoting and selling alleged products of the Complainant. In particular, <PandoraRomania.ro> redirects automatically to <PANDORAONLINEROMANIA.COM>, therefore they resolve to an identical website. Said website is also identical (except for the language) to the website to which <Pandora-Mexico.com> resolves. In addition, <pandorawebshop.com> redirects automatically to <PandoraWebshopHU.com>, therefore they resolve to an identical website. Said website is highly similar/almost identical (except for the language and the background image) and use the same template as the website to which <PANDORAONLINEROMANIA.COM> resolves.

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 Respondents 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.

According to the information provided by the Registrars upon the Request for Registrar Verification sent by Online ADR Center of the Czech Arbitration Court, the disputed domain names are registered by different Registrants (Respondents): i.e. Fisher Yvonne (Germany) is the Registrant of <PANDORAONLINEROMANIA.COM>, Patrick Sommer (Germany) is the Registrant of <PandoraRomania.ro>, Lang Daniel (Germany) is the Registrant of <Pandora-Mexico.com>, Mike Etheridge (United States of America) is the Registrant of <pandorawebshop.com>, Mathias Lehmann (Germany) is the registrant of <PandoraWebshopHU.com>.

In its Amended Complaint the Complainant requests the Panel to consolidate the cases.

Under Paragraph 10(e) of the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) “A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules”.

As specified in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) at point 4.11.2 “Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants’ identity(ies) including pseudonyms, (ii) the registrants’ contact information including email address(es), postal address(es),

or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behaviour, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

The Panel notes that the evidence submitted by the Complainant is pretty confusing and rather unorganized. Nevertheless, the Panel considers the evidence as being sufficient to justify the consolidation in terms of common control of the disputed domain names or corresponding websites and fairness and equitableness of the consolidation to all parties.

The Panel considers the consolidation as appropriate, taking into consideration – in particular – the following factors: (1) the disputed domain names resolve to websites that present identical/almost identical content and layout (the content and layout of the websites corresponding to the disputed domain names give evidence of a common control of the domain names at issue). In particular, <PandoraRomania.ro> redirects automatically to <PANDORAONLINEROMANIA.COM>, therefore they resolve to an identical website. Said website is also identical (except for the language) to the website to which <Pandora-Mexico.com> resolves. In addition, <pandorawebshop.com> redirects automatically to <PandoraWebshopHU.com>, therefore they resolve to an identical website. Said website is highly similar/almost identical (except for the language and the background image) and use the same template as the website to which <PANDORAONLINEROMANIA.COM> resolves. (2) Furthermore, there are irregularities in relation to the Registrants' addresses disclosed for all the disputed domain names, since it results from the Complainant's undisputed allegations that these addresses do actually not exist. (3) Finally, the disputed domain names share similarities in relation to the naming patterns which can be summarised as either <mark+reference to webshop/online> (i.e. <pandorawebshop.com>) or <mark+reference to webshop/online+country/country code> (i.e. <PANDORAONLINEROMANIA.COM> and for <PandoraWebshopHU.com>) or <mark+country> (i.e. <PandoraRomania.ro> and <Pandora-Mexico.com>).

The Panels notes that the Complainant failed however to provide sufficient evidence that all the disputed domain names are allegedly hosted with the same internet provider. On this regard the Annexes 21, 22 and 23 are considered as not being relevant as they do not indicate the internet provider for the disputed domain names.

On the balance of probabilities and taking into account the above circumstances of the present case, the Panel nevertheless finds that the disputed domain names are under common control. The Panel is also satisfied that consolidation of these disputes is fair and equitable to all parties, and that they should be consolidated in the interest of procedural efficiency (s. Pandora A/S v. Larry Sack, Alice Ferri, marino blasi, Sirkin Mösening, Meghan Pier, Monica Lugo, Tom Fargen, CAC Case No. 103259).

Finally, the Panel notes that it might have been better if the Complaint had been amended to include as Respondents all the names given as alleged Registrants of the disputed domain names in their registrations. Nevertheless, the true Respondent is the common entity controlling the disputed domain names, and one of the names used by that entity is the name given for the Respondent in the Complaint (i.e. Fisher Yvonne). Indeed, this is the name used for the Registrant of one of the five disputed domain names, i.e. <PANDORAONLINEROMANIA.COM>.
The Panel also notes that the Complaint was duly notified to the e-mail addresses provided for the Registrant, administrative contact, technical contact and billing contact for each of the disputed domain names, as well as postmaster@ for each of the domain names. Under these circumstances, the Panel considers that the proceedings are properly constituted and have been duly notified to the Respondents in accordance with paragraph 2 of the UDRP Rules (s. Pandora A/S v. Larry Sack, Alice Ferri, marino blasi, Sirkin Mösening, Meghan Pier, Monica Lugo, Tom Fargen, CAC Case No. 103259).

PRINCIPAL REASONS FOR THE DECISION

1. Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain names are identical or confusingly similar to a trademark in which the

Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of various trademark registrations for the term PANDORA. Reference is made, in particular, to European Union Trademark no. 003397858 registered on April 18, 2007 (which has been duly renewed and is in force) and International trademark no.1004640 registered on May 14, 2009 and protected in a number of territories (also this mark has been duly renewed and is in force). These trademark registrations predate the creation date of the disputed domain names.

The Panel finds that the disputed domain names are confusingly similar to the Complainant's trademarks. Many panels have found that a disputed domain name is confusingly similar to a Complainant's trademark where the disputed domain name incorporates the Complainant's trademark in its entirety (e.g. Philip Morris Products S.A. v. Cihan Atalay, WIPO Case No. D2020-2169; Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2020-1923; F. Hoffmann-La Roche AG v. Jason Barnes, ecnopt, WIPO Case No. D2015-1305; Compagnie Générale des Etablissements Michelin v. Christian Viola, WIPO Case No. D2012-2102; Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070; The Chancellor, Masters and Scholars of the University of Oxford v. Oxford College for PhD Studies, WIPO Case No. D2015-0812; Rhino Entertainment Company v. DomainSource.com, Inc., WIPO Case No. D2006-0968; SurePayroll, Inc. v. Texas International Property Associates, WIPO Case No. D2007 0464; Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2019-1409). This is the case in the case at issue where the Complainant's trademarks "PANDORA" are fully included in the disputed domain names. The geographical and descriptive terms that follow (i.e. online, webshop, Romania, Mexico, HU - being the county code for Hungary) the Complainant's trademark "PANDORA" in the disputed domain names are not able to prevent the possibility of confusion amongst consumers. In fact, the trademark "PANDORA" is clearly recognizable within the disputed domain names. On the contrary, the descriptive terms are related to the Complainant's sale/promotion's modalities and are likely to increase the possibility of confusion amongst consumers. Furthermore, it is the view of this Panel that the addition of the geographic indication "Romania", "Mexico" or "HU" does not add distinctive matter so as to distinguish it from Complainant's trademark. Previous panels have found that the addition of a geographic indication to a distinctive trademark does not diminish the distinctiveness of the trademark. In this particular case, this term rather leads to confusing the Internet users who will think that the websites triggered through the disputed domain names may represent the Romanian, Mexican, or Hungarian branch of the Complainant's business.

2. Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain names. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a prima facie case that none of these circumstances are found in the case at hand and, therefore, that the Respondents lack rights or legitimate interests in the disputed domain names.

According to the Complaint, which has thus remained unchallenged, the Complainant has not authorized the Respondents' use of the trademark PANDORA, e.g. by registering the disputed domain names comprising said trademark entirely. Furthermore, the Panel notes that there is no evidence showing that the Respondents might be commonly known by the disputed domain names in the sense of paragraph 4(c)(ii) of the Policy.

Finally, it results from the Complainant's non-contested evidence that the disputed domain names resolve to websites on which alleged products of the Complainant are promoted and sold. Since this use is clearly commercial, it cannot be considered a legitimate non-commercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. Furthermore, such use cannot be qualified a bona fide offering of goods or services in accordance with paragraph 4(c)(i) of the Policy and the Oki Data jurisprudence (e.g. Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903) as it is misleading and diverting consumers, making them erroneously believe that the Respondents are authorized dealers, retailers, or re-sellers of PANDORA products, and are authorized to promote sales of PANDORA products.

This is reinforced by the following facts: (1) the Respondents did not add any note, information or disclaimer pointing out that they actually have no relationship with the Complainant; (2) the websites are accessible under domain names that comprise Complainant's trademark entirely, see also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ('WIPO Overview 3.0'), section 2.8.1: "Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Oki Data test', the following cumulative requirements will be applied in the specific conditions of a UDRP case: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark. The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

It is acknowledged that once the Panel finds such prima facie case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondents in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondents have no rights or legitimate interests in the disputed domain names.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

3. According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy). It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant's documented allegations that the disputed domain names resolve to websites on which alleged products of the Complainant are promoted and sold. For the Panel, it is therefore evident that the Respondents positively knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondents also knew that the disputed domain names included the Complainant's trademark when they registered the disputed domain names. Registration of the disputed domain names which contains a third party's mark, in awareness of said mark and in the absence of rights or legitimate interests amounts to registration in bad faith (see e.g., Philip Morris Products S.A. v. Cihan Atalay, WIPO Case No. D2020-2169; F. Hoffmann-La Roche AG v. Jatin Jani, Expired Domains LLC, WIPO Case No. D2019-0344; KOC Holding A.S. v. VistaPrint Technologies Ltd, WIPO Case No. D2015-1910; The Chancellor, Masters and Scholars of the University of Oxford v. Oxford College for PhD Studies, WIPO Case No. D2015-0812; The Chancellor, Masters and Scholars of the University of Oxford v. Almutasem Alshaikhissa, WIPO Case No. D2014-2100; Deutsche Lufthansa AG v. Mustermann Max, Muster AG, WIPO Case No. D2015-1320).

The finding of bad faith registration and use is supported by the further circumstances resulting from the case at hand which are (i) the failure to submit a response; (ii) the failure to provide any evidence of actual or contemplated good-faith use; (iii) the implausibility of any good faith use to which the domain names may be put; (iv) the Respondents' providing false contact information (i.e. it results from the Complainant's undisputed allegations that the Registrants' addresses, disclosed for all the disputed domain names, do actually not exist).

In the light of the above the Panel finds that the disputed domain names have been registered and are being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PANDORAONLINEROMANIA.COM**: Transferred
2. **PANDORAWEBSHOP.COM**: Transferred
3. **PANDORAWEBSHOPHU.COM**: Transferred
4. **PANDORAROMANIA.RO**: Transferred
5. **PANDORA-MEXICO.COM**: Transferred

PANELLISTS

Name	**Dr. Federica Togo**

DATE OF PANEL DECISION 2021-01-09

Publish the Decision