

Decision for dispute CAC-UDRP-104097

Case number CAC-UDRP-104097

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Domain names daniellington.shop

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Daniel Wellington AB

Complainant representative

Organization SILKA AB

Respondent

Name Tessie Anderson

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 <daniellington.shop>.

IDENTIFICATION OF RIGHTS

Founded in 2011 by Mr Filip Tysander, Daniel Wellington AB (the Complainant) is a Swedish fashion company focused on designing and manufacturing watches, jewellery and accessories.

The Complainant further states and provides evidence to support, that it is the owner, among others, of an international portfolio of trademark registrations for the trademark "DANIEL WELLINGTON":

- International Trademark n° 1135742 DANIEL WELLINGTON (word mark), registered on July 3, 2012, in international classes 9, 14 and 35. The trademark designates, inter alia, Iceland;
- International Trademark n° 1260501 DW Daniel Wellington (word mark), registered on March 11, 2015, in international classes 9, 14, 18, 25 and 35. The trademark designates, inter alia, Iceland;
- European Union ("EU") Trademark n° 010553345 DANIEL WELLINGTON (word mark), registered on June 7, 2012, in international classes 9, 14 and 35;
- United States Trademark n° 4386043 DANIEL WELLINGTON (word mark), registered on August 20, 2013, in international classes 14 and 35; and

- United States of America Trademark n° 4948629 DW DANIEL WELLINGTON (word mark), registered on May 3, 2016, in international classes 9, 14, 18, 25 and 35.

The Complainant is also the owner of the domain name <danielwellington.com>, registered in 2011 and has also a significant social media platform presence, including Facebook, Instagram and Twitter.

FACTUAL BACKGROUND

The Complainant is a manufacturer of timepieces on which it uses the DANIEL WELLINGTON trademark and is the owner of the portfolio of trademark registrations identified above.

The Complainant also incorporates the DANIEL WELLINGTON mark as part of its company name and has an established Internet presence using its domain name <danielwellington.com>, created on February 16, 2011.

The disputed domain name <daniellington.shop> was registered on May 25, 2021, and resolves to a website which prominently displays the Complainant's DANIEL WELLINGTON mark and purportedly offers for sale a number of the Complainant's DANIEL WELLINGTON-branded products.

PARTIES' CONTENTIONS:

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

COMPLAINANT:

- The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the Respondent's registered disputed domain name is identical, or – at least – confusingly similar, to the Complainant's trademark DANIEL WELLINGTON. Essentially, <daniellington.shop> exactly reproduces the Complainant's well-known trademark DANIEL WELLINGTON, with the mere deletion of the letters "wel" from the Complainant's DANIEL WELLINGTON mark, which according to the Complainant amounts to a case of "typosquatting".

Bearing in mind the close similarity between the two domain names and the use of the disputed domain name to purportedly offer for sale a number of the Complainant's DANIEL WELLINGTON-branded products, the Complainant believes that the Respondent registered the disputed domain name precisely because it believed that it was confusingly similar to the Complainant's DANIEL WELLINGTON mark.

The Complainant states that the disputed domain name also incorporates the generic Top-Level Domain ("gTLD") ".shop", which does not have the capacity to dispel confusing similarity between the disputed domain name and the mark for the purposes of the Policy. It is important to highlight that gTLDs are commonly viewed as a standard registration requirement, and as such, they are disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11).

- The Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant argues that the Respondent has no rights to the disputed domain name, and any use of the DANIEL WELLINGTON mark has to be authorized by the Complainant. Nobody has been authorized or licensed by the above-fashion house to use the disputed domain name. According to the Complainant, there is no doubt that the disputed domain name seeks to capitalize on the goodwill of the Complainant's DANIEL WELLINGTON mark, misleading consumers into thinking that the website is operated by or affiliated with the Complainant.

The Complainant further states that:

- there is no evidence that the Respondent has been commonly known by the disputed domain name or by the term "daniellington". In fact, the registrar verification shows that the owner is called Tessie Andersson located in Spain;

- there is nothing to suggest that the Respondent owns any identical or similar trademarks to the disputed domain name or to the term “daniellington”;
 - the term “daniellington” does not have any meaning in English or Icelandic language;
 - the disputed domain name resolves to a website in the Italian language which displays the Complainant’s DANIEL WELLINGTON registered trademark and purportedly offers for sale a number of the Complainant’s DANIEL WELLINGTON-branded products;
 - the disputed domain name resolves to a website on which footwear and accessories bearing the Complainants’ trademarks are sold;
 - the composition and the use of the disputed domain name, which is a misspelling of the Complainant’s DANIEL WELLINGTON mark and resolves to the website which displays the DANIEL WELLINGTON mark on top, offering for sale DANIEL WELLINGTON-branded goods, reinforce the likelihood of confusion with the Complainant, as consumers would assume that the disputed domain name is a URL for one of the Complainant’s websites.
- The disputed domain name has been registered and is being used in bad faith

The Complainant claims that the disputed domain name was registered and is used in bad faith. The Complainant’s DANIEL WELLINGTON mark was registered and has been in use worldwide well before the registration of the disputed domain name. Considering that the disputed domain name almost reproduces in full the Complainant’s DANIEL WELLINGTON mark, and that Internet users commonly associate “DANIEL WELLINGTON” and “daniellington” with the Complainant, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of Complainant and Complainant’s mark when the disputed domain name was registered.

The Complainant provides that this case appears to be a case of typosquatting and typosquatting itself can be considered as an additional argument in favour of finding bad faith registration and use.

Since the disputed domain name resolves to a website which prominently displayed the Complainant’s DANIEL WELLINGTON mark and purportedly offers for sale a number of the Complainant’s DANIEL WELLINGTON-branded products, these facts support the inference that the Respondent registered the disputed domain name in bad faith, in order to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant’s DANIEL WELLINGTON mark.

The Complainant concludes that in view of the above, the Respondent is using without permission the Complainant’s DANIEL WELLINGTON mark in order to intentionally attempt to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant’s DANIEL WELLINGTON mark as to the source, sponsorship, affiliation or endorsement of the web site or goods or services offered on it, which amounts to registration and use in bad faith in accordance with paragraph 4 (b)(iv) of the Policy.

PARTIES CONTENTIONS

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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.

PRINCIPAL REASONS FOR THE DECISION

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that a complainant must prove each of the following to obtain transfer or cancellation of a domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
2. that respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights (Para.4(a)(i) of the Policy).

The Complainant has provided evidence and proved to be the owner of several DANIEL WELLINGTON trademark registrations in various jurisdictions. Essentially, the Respondent has appropriated the trademark DANIEL WELLINGTON with the mere deletion of the letters "wel" from the Complainant's DANIEL WELLINGTON mark to presumably lead consumers to believe that it is affiliated with the Complainant.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark DANIEL WELLINGTON since the mere deletion of the letters "wel" does not eliminate any confusing similarity. This is especially true where, as here, the trademark is "the dominant portion of the domain name," LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents "the most prominent part of the disputed domain name [] which will attract consumers' attention." Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768.

In conclusion, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark DANIEL WELLINGTON.

2) The Respondent lacks rights or legitimate interests in the disputed domain name (Para. 4(a)(ii) of the Policy).

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Respondent is not in any way affiliated with the Complainant nor has been authorized or licensed by the above-

mentioned fashion house to register the disputed domain name. The Panel agrees with the Complainant that the Respondent is not commonly known by the disputed domain name or that it has legitimate interest over the disputed domain name. When entering the term "daniellington" in the Google search engine, the returned results point to the Complainant and its business activities.

In the present case, the Respondent failed to file an administratively compliant Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith (Paragraph 4(a)(iii) of the Policy).

The Panel agrees with the Complainant that its trademark DANIEL WELLINGTON is well-known. The fact that the Respondent has registered a domain name that is confusingly similar to the Complainant's trademark indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent had knowledge (or should have known) of the Complainant's trademark and that they had such knowledge prior to the registration and use of the disputed domain name.

The fact that the Respondent registered the disputed domain name with the misspelling of the trademark DANIEL WELLINGTON (by mere deletion of the letters "well") clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. It is reasonable to conclude that this is evidence of registration of the domain name in bad faith.

The fact that a complainant's trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (see section 3.3, WIPO Overview 3.0).

In the present case, the Panel is of the opinion that the Complainant's trademark is distinctive and well known, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

In addition, the disputed domain name resolves to a website which displays the Complainant's DANIEL WELLINGTON registered trademark and purportedly offers for sale a number of the Complainant's DANIEL WELLINGTON-branded products. The Policy defines that one of the actions which constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy is the use of the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's web site or location or of a product or service on respondent's web site or location.

The Panel believes it is likely that this was at least one of the reasons behind the Respondent's registration and use of the disputed domain name. Accordingly, the Panel finds that the Respondent has engaged in typosquatting to cause confusion with the Complainant's trademark for their own commercial gain, and therefore the disputed domain name was registered and is being used in bad faith within the meaning of Paragraph 4(a)(iii) of the Policy.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. DANIELLINGTON.SHOP: Transferred

PANELLISTS

Name **Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION **2022-04-29**

Publish the Decision
