

Decision for dispute CAC-UDRP-104283

Case number CAC-UDRP-104283

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Domain names todsshoesale.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization TOD'S S.p.A.

Complainant representative

Organization Convey srl

Respondent

Name shikai qiang

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 has started its business since early 1900 in Italy and is the owner of the TOD trademark including but not limited to the followings:

- European Trademark n. 010158889 – 3, 9, 14, 18, 25, 35;
- European Trademark n.. 9;
- International Trademark n. 1006548- 14;
- International Trademark n. 858452 – 3, 9, 18, 25, 35 designating also Turkey;
- United States Trademark n. 1459226 - 18, 25;
- Australian Trademark n. 1498996 – . 3, 9, 25, 35;
- International Trademark n. 1006548 – 14 designating also China.

Furthermore, the Complainant has been extensively using the “TOD’S” denominations on all internet environments including and not limited to the company’s official websites <https://www.todsgroup.com> and <https://www.tods.com> - among which are “tods.it”, “tods.fr”, “tods.eu”, “tods.cn” (a list of Complainant’s domain names could be provided upon request) - and its

official accounts on the major social networks such as Facebook, Instagram and Twitter.

FACTUAL BACKGROUND

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

The Complainant, Tod's SpA, is a company with headquarters in Sant'Elpidio al Mare, FM (ITALY). The Complainant has its roots in the early 1900. The company was renamed to J. P. Tod's in the late 70's and the J.P. was dropped in 1997. Tod's first success came with the Gommino driving shoe, which has gummy little rubber pebbles on the soles. In few years the production was expanded to the bags and in 1997 the D-Bag was launched becoming in few years an iconic model.

The Complainant is the operating holding of a Group, amongst the leading players in the world of luxury goods, with the trademarks Tod's, Hogan, Fay and Roger Vivier with about 4,600 employees worldwide. Tod's has numerous stores around the world, about 403 mono-brand stores, including showrooms and large flagship stores in Europe, the U.S., China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia. In November 2015, Tod's acquired further stock in the Roger Vivier shoe brand for €415 million reaching about 60%.

2020 Annual revenues of Tod's Group were almost 650 million of Euros of which almost 47% came from the trademark TOD'S. Diego and his younger brother, Andrea, who is vice president, own a 61 percent stake in the company, which was listed on the Milan stock exchange in 2000.

The Registration Date of the disputed domain name is February 21, 2021.

PARTIES CONTENTIONS

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).

First, the Complainant claims rights in the TOD'S mark through its trademark registration. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

Second, the Complaint claims that the industrial related descriptive terms "SHOE" and "SALE" do not distinguish the disputed domain name from Complainant's TOD'S trademark. In addition, the ".com" generic top-level domain ("gTLD") is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant claims that the Respondent is not a licensee, authorized agent of the Complainant or in any other way

authorized to use Complainant's trademarks. In addition, the Complainant further claims that the Respondent is not commonly known by the disputed domain name as individuals, business or other organization and their family names do not correspond to TOD'S or the disputed domain name.

Second, the Complainant argues that Respondent redirects the traffics from the disputed domain name to the website on dhapp77.com reproducing pornographic contents. UDRP panels have recognized that no rights or legitimate interests derive from using trademarks to divert Internet users to pornographic websites on a number of UDRP decision. The Complainant also provides a screenshot of the illicit content on dhapp77.com. Having reviewed the illicit content, the Panel finds that Respondent attempts to pass off as Complainant to offer such content, failing to use the domain name in connection with a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant reaffirms that by virtue of its extensive worldwide use, the Complainant's trademark TOD'S has become a well-known trademark in the sector of shoes and leather goods items. Therefore, it is clear that the Respondent was well aware of the trademark and he has registered the disputed domain name with the intention to refer to the Complainant and its trademarks. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name evinces bad faith under paragraph 4(a)(iii) of the Policy. See ARCELORMITTAL (SA) v. acero, 102399 (CAC 2019-04-22). The Panel is of the view that at the time of registration of the disputed domain name, the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks and that registration of domain names containing well-known trademarks constitutes bad faith per se. The Panel also notes that the disputed domain name was registered more than 20 years after the registration of Complainant's first TOD'S trademark. The Panel agrees with Complainant and finds that Respondent should have actual knowledge of Complainant's mark, demonstrating bad faith registration under Policy paragraph 4(a)(iii).

Second, the Complainant asserts that the Respondent disrupts Complainant's business by diverting potential customers to the website on dhapp77.com promoting adult content. Using a confusingly similar domain name in a manner disruptive of a complainant's business by trading upon the goodwill of a complainant for commercial gain evinces bad faith under paragraph 4(b)(iii) & (iv) of the Policy. See BIGMAT FRANCE v. Wang Wang, 104204 (CAC 2022-02-01) ("Given the use of the disputed domain name to resolve to adult content, the Panel is of the opinion that the Respondent has registered the disputed domain name primarily for the purpose of taking advantage of its reputation. The Respondent has intentionally attempted to illegitimately attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's well-known trademark BIGMAT, in the meaning of paragraph 4(b)(iv) of the Policy."). Accordingly, the Panel agrees that Respondent disrupts Complainant's business and attempted to commercially benefit off Complainant's mark in bad faith under paragraph 4(b)(iii) & (iv) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TODSSHOESALE.COM**: Transferred
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PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION **2022-02-19**

Publish the Decision
