

Decision for dispute CAC-UDRP-104793

Case number	CAC-UDRP-104793
Time of filing	2022-08-18 09:31:39
Domain names	zapatillasdiadoraoutlet.com, diadorajpshoes.com , diadoracasale.com, diadoraturkiye.com, diadoracanada.com , diadoradanmark.com, diadoradeutschland.com, diadorafrance.com , cheapdiadoracanada.com, diadoraskoroutlet.com, diadorascarpeitalia.com, diadora-polska.com, diadorasaleuk.com, diadoramalaysia.com, diadoraportugal.com, diadorafactoryoutlet.com, diadora-espana.com, diadorahungary.com, diadoraireland.com, diadora-portugal.com, diadora-nederland.com

Case administrator

Name	Iveta Špiclová (Case admin)
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Complainant

Organization	Diadora S.p.A.
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Complainant representative

Organization	Convey srl
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Respondent

Organization	Whoisprotection.cc
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OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain names <zapatillasdiadoraoutlet.com>; <diadorajpshoes.com>; <diadoracasale.com>; <diadoraturkiye.com>; <diadoracanada.com>; <diadoradanmark.com>; <diadoradeutschland.com>; <diadorafrance.com>; <cheapdiadoracanada.com>; <diadoraskoroutlet.com>; <diadorascarpeitalia.com>; <diadora-polska.com>; <diadorasaleuk.com>; <diadoramalaysia.com>; <diadoraportugal.com>; <diadorafactoryoutlet.com>; <diadora-espana.com>; <diadorahungary.com>; <diadoraireland.com>; <diadora-portugal.com>; and <diadora-nederland.com> (“the disputed domain names”).

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- International trade mark registration no. 682095, registered on 31 July 1997, for the word mark DIADORA, in classes 3, 9, 12, 14, 16, 18, 25 and 28 of the Nice Classification;
- EU trade mark registration no. 000339093, registered on 7 January 1999, for the word mark DIADORA, in classes 18, 22 and 25 of the Nice Classification; and

- Italian trade mark registration no. 0001297135, registered on 31 May 2010, for the figurative mark DIADORA, in classes 18, 25 and 28 of the Nice Classification.

(hereinafter, collectively or individually, “the Complainant’s trade mark”; “the Complainant’s trade mark DIADORA”; or “the trade mark DIADORA” interchangeably).

FACTUAL BACKGROUND

The Complainant’s contentions can be summarised as follows:

A. Background History

The Complainant is an athletic footwear and apparel manufacturer founded in 1948 in Italy by Marcello Danieli. The Complainant’s name derives from the Greek word “dia-dora” which has the meaning in English of “to share gifts and honours”. The Complainant produces football boots and athletic shoes in addition to a wide range of apparel. The Complainant’s products have been worn in connection with major sports events worldwide.

In addition to the trade marks mentioned in the above section “Identification of rights”, and many other trade marks in its portfolio, the Complainant informs that it is also the owner of numerous domain names which contain the term “diadora”, most notably <diadora.com> (registered on 19 October 2013), and <diadora.cn> (registered on 21 May 2014).

The Complainant seeks to obtain the ownership of disputed domain names on the grounds set out in section B below.

B. Legal Grounds

B.1 Preliminary Matter: Application for Consolidation

The Complainant informs that the registrant/holder on record of the following disputed domain names is “Whoisprotection.cc”:

<zapatillasdiadoraoutlet.com>; <diadoracasale.com>; <cheapdiadoracanada.com>; and <diadoraskoroutlet.com>.

The Complainant further informs that the registrant/holder on record of the following disputed domain names is “Web Commerce Communications Limited”:

<diadorajpshoes.com>; <diadoraturkiye.com>; <diadoracanada.com>; <diadoradanmark.com>; <diadoradeutschland.com>; <diadorafrance.com>; <diadorascarpeitalia.com>; <diadora-polska.com>; <diadorasaleuk.com>; <diadoramalaysia.com>; <diadoraportugal.com>; <diadorafactoryoutlet.com>; <diadora-espana.com>; <diadorahungary.com>; <diadoraireland.com>; <diadora-portugal.com>; and <diadora-nederland.com>.

Notwithstanding the above, the Complainant avers that the disputed domain names are subject to an evident common control, thereby making the consolidation of these UDRP proceedings equitable and procedurally efficient (“the Complainant’s Application for Consolidation”).

The Complainant’s Application for Consolidation is grounded on the following factors:

- i. the disputed domain names share the same generic Top-Level Domain (“gTLD”) <.com>;
- ii. the disputed domain names were all registered with the same Registrar;
- iii. the dispute domain names contain generic terms/country names in their string in addition to the DIADORA trade mark;
- iv. the websites corresponding to the disputed domain names contain the identical sections “Social Medial Follow Us” and “Newsletter Sign-Up”; and

v. the same products are offered for sale on the websites at the disputed domain names.

The Complainant's Application for Consolidation also takes stock of paragraph 4.11.2 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), which enumerates circumstances underpinning the panel's consideration of a consolidation application.

For the foregoing reasons, the Complainant requests that the disputed domain names and the named Respondents be consolidated into a single UDRP proceeding.

For present purposes, the registrants/holders on record of the disputed domain names are hereinafter referred to collectively as "the Respondent".

B.2 Substantive Grounds

I. The disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant submits that the disputed domain names incorporate the Complainant's trade mark DIADORA in its entirety; that the addition of the generic/geographical terms in the disputed domain names have no bearing on the confusing similarity test nor does the gTLD <.com>; instead, the geographical terms are all the more apt to induce confusion among Internet users, in so far as such combination could suggest a link between the Complainant and the registrants/holders of the disputed domain names. The Complainant concludes that the disputed domain names are confusingly similar to the Complainant's trade mark DIADORA.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain names

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent does not carry out any activity for, or has any business with, the Complainant. Neither licence nor authorisation has been given to the Respondent to make any use of the Complainant's trade mark DIADORA or the disputed domain names. Moreover, the Respondent is not known by the disputed domain names as individual, business, or other organisation, and the Respondent's family names do not correspond to the word "Diadora" or the disputed domain names.

The Complainant further asserts that the disputed domain names were registered between April 2021 and April 2022, and that, save for the disputed domain names <diadoracasale.com> and <diadorafactoryoutlet.com>, they all resolve to websites (of similar layouts) on which the Complainant's prima facie counterfeit DIADORA products appear to be commercialised ("the Respondent's websites"). The Complainant claims that the Respondent's websites demonstrate neither a bona fide offering of goods nor a legitimate interest of the Respondent. In addition, the Complainant claims that the Respondent has failed to meet the Oki Data test to the extent that the Respondent's websites do not disclose accurately and prominently the Respondent's relationship with the trade mark holder (third requirement).

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain names.

III. The Respondent registered and is using the disputed domain names in bad faith

Registration

The Complainant argues that it is inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the disputed domain names. The Complainant further argues that the Respondent's actual knowledge of the DIADORA trade mark is demonstrated by the Respondent's offering for sale of replicas of the Complainant's goods and by the Respondent's use of the DIADORA trade mark and copyrighted images on the websites corresponding to the disputed domain names.

The Complainant contends that, by registering the disputed domain names which are confusingly similar to the DIADORA trade mark, the Respondent has been engaged in a pattern of conduct preventing the Complainant from reflecting the DIADORA trade mark in corresponding domain names (paragraph 4(b)(ii) of the UDRP Policy).

Use

The Complainant avers that the Respondent uses the disputed domain names in bad faith in so far as the Respondent's websites create the false impression of a potential affiliation or connection with the Complainant, without authorisation being given to the Respondent to register and use the trade mark DIADORA on the Respondent's websites or at all.

Furthermore, the Respondent's websites do not contain express disclaimers regarding the absence of relationship between the Complainant and the Respondent.

In order to further support the Complainant's assertions under this Policy ground, the Complainant alludes to paragraph 3.3 of the WIPO Jurisprudential Overview 3.0.

As additional indicia giving rise to a presumption of bad faith, the Complainant refers to the Respondent's failure to respond to the Complainant's cease-and-desist letter.

Moreover, the Complainant asserts a separate bad faith claim in respect of the disputed domain names <diadorafactoryoutlet.com> and <diadorasale.com>.

The Complainant contends that the above disputed domain names are held passively, and that this can give rise to a finding of bad faith registration and use according to the passive holding doctrine as follows: (i) the Complainant's trade mark has a strong reputation and is widely known; (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain names; (iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name; (iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement; and (v) taking account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would not be illegitimate, such as by been a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trade mark law.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain names in bad faith.

PARTIES CONTENTIONS

The Respondent has not provided a Response within the time prescribed under the UDRP Rules, or at all.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP 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 UDRP 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 UDRP Policy).

PROCEDURAL FACTORS

Preliminary Matter: Complainant's Application for Consolidation

The Complainant has advanced an application to consolidate its UDRP claims against the two registrants/holders of the disputed domain names (identified in section B.1 above) into one single UDRP proceeding, for the reasons articulated in the same section B.1.

The Panel has considered the available record, the UDRP legal framework, and the WIPO Jurisprudential Overview 3.0 (paragraph 4.11.2).

Under the UDRP Rules (Rule 10(b) and Rule 10(c)), the Panel shall seek to promote procedural (cost and time) efficiency while also ensuring that the parties are treated with equality and that each party is given a fair opportunity to present its case. Furthermore, the Panel is of the opinion that interlocutory/interim applications sought by parties in UDRP proceedings require panels to apply the balance of convenience test, according to which panels would have a duty to consider who would suffer the greatest inconvenience as a result of the panel's determination.

The Panel has perused paragraph 4.11.2 of the WIPO Jurisprudential Overview 3.0, which lists a whole host of considerations which may assist panels in the determination of whether a consolidation is appropriate. Of particular note, the Panel considers the following factors as most compelling to a finding in favour of the Complainant: (i) the registrants' identical country of origin (Malaysia) and similar email addresses (@webnic.cc) on record; (ii) the similarities of content and layout of the websites corresponding to most of the disputed domain names; (iii) the fact that the registrants have targeted a specific sector and mark; and (iv) the naming patterns in the disputed domain names being <mark+country/country initials> and <mark+generic term> or <generic term+mark+generic term>.

On balance, it would therefore appear to the Panel that the disputed domain names are subject to common control. In addition, the Panel has weighed the balance of convenience and opted to grant the Complainant's Application for Consolidation. The dismissal would likely to cause the Complainant the greatest burden and interfere with the overall due expedition of the UDRP proceedings.

In view of the above, the two registrants/holders of the disputed domain names are to be treated, for the purpose of this UDRP case, as a single Respondent.

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. UDRP Threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to obtain the ownership of the disputed domain names:

- i. The disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- ii. The Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- iii. The disputed domain names have been registered and is being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the

UDRP proceedings is the balance of probabilities, which lays down the foundations for panels to determine each of the three UDRP Policy grounds.

B. Identical or Confusingly Similar

The UDRP test under the first element provides for a juxtaposing approach, according to which the textual components of the disputed domain names and the Complainant's trade mark are to be compared side by side.

In order to succeed under the first element of the UDRP Policy, the Complainant must provide evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain names are identical or confusingly similar to the Complainants' trade mark.

The Panel is satisfied that the Complainant owns trade mark rights in "DIADORA" since 1997.

The disputed domain names were registered between April 2021 and April 2022, and all of which incorporate the Complainant's trade mark DIADORA in their string.

Most of the disputed domain names contain the word "Diadora" + country name (sometimes written in the country's official language) or country initials as a suffix:

<diadoraturkiye.com>; <diadoracanada.com>; <diadoradanmark.com>; <diadoradeutschland.com>; <diadorafrance.com>; <diadora-polska.com>; <diadoramalaysia.com>; <diadoraportugal.com>; <diadora-espana.com>; <diadorahungary.com>; <diadoraireland.com>; <diadora-portugal.com>; and <diadora-nederland.com>.

Some of the disputed domain names contain the word "Diadora" accompanied by a country name/initials as a prefix or suffix and a generic term which either evokes the act of purchasing goods or the goods themselves:

<diadorajpshoes.com>; <cheapdiadoracanada.com>; <diadorascarpeitalia.com>; and <diadorasaleuk.com>.

The remainder of the disputed domain names consist of the word "Diadora" + a generic term which evokes the act of purchasing goods:

<diadorafactoryoutlet.com>, <zapatillasdiadoraoutlet.com>, <diadoracasale.com>, <diadoraskoroutlet.com>.

Furthermore, the Panel notes that TLD suffixes are typically disregarded in the assessment of this Policy ground, the reason being that the TLD is part of the anatomy of a domain name (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

The Panel has no difficulty in recognising the Complainant's trade mark DIADORA within the disputed domain names, the result of which being that the Complainant has prevailed under this UDRP Policy ground.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The Respondent has not submitted a Response within the time prescribed under the UDRP Rules or at all. The Panel is however empowered to draw adverse inferences from the Respondent's default position (Rule 14 (b) of the UDRP Rules).

The Panel notes that the Complainant denies any affiliation and/or association with, or authorisation for, the Respondent of any nature. Moreover, the Complainant further argues that the Respondent is not known by the disputed domain names; and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain names.

The Respondent has submitted no evidence to refute any of the Complainant's assertions. On balance, the Panel considers the

available evidence to lend credence to the Complainant's contentions.

The Panel also notes that the Complainant claims not to have authorised the Respondent to use the Complainant's trade mark DIADORA nor to sell the Complainant's products on the Respondent's website. On this particular point, the Panel refers to paragraph 2.8 of the WIPO Jurisprudential Overview 3.0, according to which resellers, distributors or service providers using a domain name containing a complainant's trade mark 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. UDRP Panels have termed this as the "Oki Data test" (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

1. The respondent must actually be offering the goods or services at issue;
2. The respondent must use the site to sell only the trade marked goods or services;
3. The website must accurately and prominently disclose the registrant's relationship with a trade mark holder; and
4. The respondent must not try to "corner the market" in domain names that reflect the trademark.

The Complainant asserts that the Respondent would have failed the Oki Data test under item 3 above. The Respondent would indeed fail to meet the Oki Data test, the Panel being unable to locate any disclaimer regarding the relationship between the Respondent and the Complainant (item 3. above).

In addition, in the Panel's view, the choice of a domain name which incorporates a complainant's trade mark wholly (as in this case) or virtually wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for this coincidence, could further evidence a lack of rights or legitimate interests.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

D.1 Registration in bad faith

The following facts are compelling evidence to this Panel that the disputed domain names were registered in bad faith:

- The Complainant's trade DIADORA was first registered in 1997 and the Complainant has extensive trade mark protection worldwide;
- The Complainant operates its activities through the domain name <diadora.com>, which was registered in 2013;
- The disputed domain names were registered between April 2021 and April 2022;
- The lack of any credible evidence-backed rationale for the Respondent's choice of the disputed domain names; and
- UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known in its field of business.

D.2 Use in bad faith

The Complainant alleges that the Respondent has engaged in the conduct described in paragraph 4(b)(ii) of the UDRP Policy, which provides as follows:

"[the Respondent] has registered the domain name in order to prevent the owner of the trademark or service mark from

reflecting the mark in a corresponding domain name, provided that [the Respondent] has engaged in a pattern of such conduct”.

Furthermore, the Complainant alludes to the Respondent’s failure to respond to the Complainant’s cease-and-desist letter as additional evidence of bad faith use.

Finally, the Complainant asserts a separate bad faith claim on the basis of passive holding in respect of the disputed domain names <diadorafactoryoutlet.com> and <diadorasale.com>.

The Panel notes that, at the time of writing, most of the disputed domain names do not resolve to active websites, with the exception of the disputed domain names <zapatillasdiadoraoutlet.com>; <diadorafrance.com>; <diadorasaleuk.com>; and <diadora-nederland.com>. The Complainant, however, has provided robust evidence of use of most of the disputed domain names.

In order to further determine this Policy ground, the Panel refers in tandem to paragraph 3.1.2 (pattern of conduct) and paragraph 3.3 (passive holding) of the WIPO Jurisprudential Overview 3.0, according to which panels have found various types of evidence to support a finding of bad faith under the above circumstances. The Panel considers the most conducive factors to a finding in favour of the Complainant under this Policy ground to be (i) the established pattern of conduct of the Respondent in registering trade mark-abusive domain names directed at the same brand owner (the Complainant); (ii) the degree of distinctiveness and reputation of the Complainant’s trade mark; (iii) the Respondent’s default and overall disinterest pre- and throughout the UDRP proceedings; and (iv) the implausibility of any good faith use to which the disputed domain names may be put.

In view of the above, the Panel finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ZAPATILLASDIADORAOUTLET.COM**: Transferred
2. **DIADORAJPSHOES.COM** : Transferred
3. **DIADORACASALE.COM**: Transferred
4. **DIADORATURKIYE.COM**: Transferred
5. **DIADORACANADA.COM** : Transferred
6. **DIADORADANMARK.COM**: Transferred
7. **DIADORADEUTSCHLAND.COM**: Transferred
8. **DIADORAFRANCE.COM** : Transferred
9. **CHEAPDIADORACANADA.COM**: Transferred
10. **DIADORASKOROUTLET.COM**: Transferred
11. **DIADORASCARPEITALIA.COM**: Transferred
12. **DIADORA-POLSKA.COM**: Transferred
13. **DIADORASALEUK.COM**: Transferred
14. **DIADORAMALAYSIA.COM**: Transferred
15. **DIADORAPORTUGAL.COM**: Transferred
16. **DIADORAFACTORYOUTLET.COM**: Transferred
17. **DIADORA-ESPANA.COM**: Transferred
18. **DIADORAHUNGARY.COM**: Transferred
19. **DIADORAIRELAND.COM**: Transferred
20. **DIADORA-PORTUGAL.COM**: Transferred
21. **DIADORA-NEDERLAND.COM**: Transferred

PANELLISTS

Name	Dr Gustavo Moser
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DATE OF PANEL DECISION 2022-09-27

Publish the Decision