

Decision for dispute CAC-UDRP-105189

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| Case number | CAC-UDRP-105189 |
| Time of filing | 2023-02-13 09:22:04 |
| Domain names | allsaintsmexico.com, allsaints-outlet.com |

Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |
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Complainant

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| Organization | All Saints Retail Limited |
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Complainant representative

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| Organization | Stobbs (IP) Ltd. |
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RESPONDENTS

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| Organization | Web Commerce Communications Limited |
| Name | Tanja Lemann |

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 relies on its trade name ALL SAINTS and numerous registered trademarks, amongst which the followings:

- ALL SAINTS (word), European registration No. 004702601, filed on 24 October 2005 and granted on 4 November 2009, for goods and services in classes 18, 25 and 35;
- ALL SAINTS (word), European registration No. 004610945, filed on 30 August 2005 and granted on 10 November 2009, for goods and services in classes 3, 9, 14, 18, 25 and 35;
- ALL SAINTS (word), European registration No.006659817, filed on 12 February 2008 and granted on 2 April 2009, for goods in classes 4, 16 and 24;
- ALL SAINTS (word), European registration No. 011874633, filed on 5 June 2013 and granted on 9 July 2015, for goods and services in classes 3, 9, 14, 35 and 41;
- ALL SAINTS (word), Mexican registration No.1446399, filed on 10 February 2012 and granted on 10 April 2014, for goods in class 25;
- ALL SAINTS (word), Mexican registration No.1377872, filed on 10 February 2012 and granted on 25 June 2013, for goods in class 25;
- ALL SAINTS (word), Mexican registration No.1650201, filed on 23 May 2016 and granted on 1 August 2016, for services in class 35;
- ALL SAINTS (word), Mexican registration No.1745461, filed on 5 February 2016 and granted on 20 April 2017, for goods in class

FACTUAL BACKGROUND

The Complainant in the current proceedings is All Saints a British fashion retailer headquartered in London, UK. The company was founded in 1994 by Stuart Trevor, and Kait Bolongaro and incorporated during October 2000 (UK Company Registration No. 04096157). The brand name "All Saints" was named after the former founder's pseudonym, "The Saint", based on his initials "ST" and updated at the 1993 Notting Hill Carnival that he attended, spending much of his time on AllSaints Road.

All Saints started as a wholesale menswear brand that sold exclusively to high-end retailers such as Harvey Nichols and Harrods. All Saints now sells menswear, womenswear, apparel, footwear, and accessories in 281 stores, and has approximately 2,200 employees across 27 countries including the UK, USA, Canada, Mexico, Russia, South Korea and Taiwan.

All Saints has a noticeable international presence and uses social platforms to promote and market their products through Twitter (81,000+ followers), Facebook (1 Millions+ followers), Instagram (900,00+ followers) and YouTube (23,000+ subscribers), which contributes to their global presence and reputation.

All Saints acquired their main commercial website allsaints.com in 2009 and commenced use of it to market their products later that year. All Saints now delivers to over 200 countries. Visits to the 'www.allsaints.com' website in December 2022 totalled 3.5 million, and its global mailing list includes 760,000 members.

In 2021, All Saints turnover was over GBP 337 million.

According to evidence provided by the Complainant and not refuted by the Respondent, the Complainant is a UK based designer, importer, seller and exporter of menswear, womenswear, apparel, footwear, and accessories. In particular, the Complainant owns the internationally "ALL SAINTS" brand, which it has very successfully applied (amongst other things) to its range of clothes, footwear and accessories. The Complainant's products are sold throughout the world, also through its websites. The Panel considers that the Complainant has sufficiently proven its ALL SAINTS marks reputation in the world.

The Complainant owns a portfolio of trademarks worldwide for ALL SAINTS, among which a UK (home) registration, EU and Mexican registration. It also has a large internet and social media presence, and owns at domain name <allsaints.com> since at least 2009.

All two (2) disputed domain names:

- allsaintsmexico.com
- allsaints-outlet.com

were registered respectively on 4 December 2012 and 1 December 2012 by the Respondent.

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).

All Saints, has shown to be the owner of at least ALL SAINTS, word Community trademark registration No. 4610945, dating back to 2005 for goods and services in classes 3, 9, 14, 18, 25, 35. The Domain Names <allsaintsmexico.com> and <allsaints-outlet.com> incorporate the Complainant's earlier ALL SAINTS trademark in its entirety and that the addition of the generic term "outlet" as well as of geographical indication "Mexico", which in principle should simply inform the Internet users of a geographical location, is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark ALL SAINTS and that, according to other UDRP panels, "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilii Terkin).

The addition of the geographical locations is likely to give the false impression of an association with the Complainant.

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain names (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

For all reasons mentioned above, the Panel is satisfied that the first requirement under the Policy is met.

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 Policy).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the complainant to establish a prima facie case that the respondent lacks rights or legitimate interests in the domain name to shift the burden of proof to the respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the ALL SAINTS trademark in a domain name, and that it had never licensed its trademarks to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain names in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain names.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. Yet, the Respondent has not filed any Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the seniority and reputation of the Complainant's trademark and the fact that the disputed domain names fully incorporate this trademark (even in combination with geographical terms or a descriptive one), it is evident that, at the respective times of the registrations of the disputed domain names, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain names correspond to active websites, though not copycat websites, it is clear that the websites have been set up with the intention of creating a connection with the Complainant's genuine site. The Respondent is offering goods for sale on the website at significantly reduced prices. The intention of the Respondent is to lure consumers to the false site with the promise of significant reductions in the cost of products that could be inferred also by the fact that according to the Complainant the existence of these websites was first alerted to the Complainant by a customer. The Complainant had thus reason to suspect that no actual product is available and the Respondent is using the disputed domain names to obtain personal data from customers, including financial data, amounting to fraudulent use of the disputed domain names.

Further, from the evidence filed by the Complainant and not refuted by the Respondent, it seems that the Respondent has adopted a certain pattern of registering similar domain names that incorporate the trademark of the Complainant, in combination with geographical terms or other descriptive terms. The Panel has accordingly traced at least four similar UDRP decisions, nos. 105020, 104400 and 104407, issued in 2022, and no. 104938 issued early 2023 where the same Respondent was involved and where the Panels transferred the relevant domain names to the Complainant.

Therefore, the Panel finds it clear that the disputed domain names were used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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

As the Respondent did not file an administratively compliant Response, pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate. Thus, the Panel considers the contentions of the Complainant as conceded by the Respondent.

A. The disputed domain names are confusingly similar to the ALL SAINTS trademarks of the Complainant.

The Complainant has, to the satisfaction of the Panel, shown that it has valid trademarks rights in the term "ALL SAINTS".

The Panel finds that the disputed domain names are confusingly similar to the Complainant's ALL SAINTS trademarks. Both disputed domain names contain the Complainant's ALL SAINTS trademark in its entirety, together with the name of a country and, in one case, the suffix "outlet". Neither the geographical designations nor the addition of "outlet" changes the fact that the Complainant's ALL SAINTS trademarks, as the first and dominant component, is fully recognisable therein on a simple side-by-side comparison. This is in particular the case since the focus of the ALL SAINTS brand is on the sale of menswear, womenswear, apparel, footwear, and accessories. The addition of the word "outlet" therefore constitutes a purely descriptive addition, which does not change the fact that the ALL SAINTS brand is fully recognisable.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain names within the meaning of the Policy.

The Respondent is not known by the disputed domain names. The Panel notes that there is no commercial relationship between the Parties, that the Complainant has not authorized the Respondent to use its trademarks in the disputed domain names and on the associated websites, and that the content set out on the websites operated under the disputed domain names offer products at a very low price and that customer informed the Complainant. No legitimate interest of the Respondent in the disputed domain names is evident nor indicated. None of the alternatives of 4(c) of the Policy applies. The Complainant assumes that the Respondent merely wants to obtain personal data from the Complainant's customers, without providing any further information. By presenting such products on the website, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its web sites, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its web site. This is completely opposite to a bona fide offering of goods and services not does it indicate a legitimate non-commercial or fair use of the disputed domain names.

Based on the considerations set out above, in accordance with paragraph 4(c)(iii) of the Policy, the Panel is satisfied that the Respondent has no rights and legitimate interests in the disputed domain names.

C. The disputed domain names have been registered and are being used in bad faith within the meaning of the Policy.

The Complainant's trademark ALL SAINTS is widely known. Given the distinctiveness of the Complainant's trademark and reputation, it can be concluded that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trademarks.

The Complainant has argued, without contradiction, that the websites associated with the disputed domain names have been presenting similar goods bearing the Complainant's trademark. The Respondent could only have registered the disputed domain names with full knowledge of the Complainant's trademark.

Due to the very high similarity of the Respondent's websites to the Complainant's websites, there is a high probability that internet users will assume that the websites in question are the Complainant's websites or websites associated with the Complainant.

Registration in bad faith is specifically presumed under paragraph 4(b)(iv) of the policy if the use of the domain name has been deliberately intended to attract Internet users to a website for commercial gain by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the website or a product on the website.

The Complainant has stated convincingly that there are no business relations or other connections between the Complainant and the Respondent. Accordingly, there is a high likelihood that internet users will be misled about the origin, sponsorship, affiliation or endorsement of the website or a product on the website.

Based on these considerations, the Panel is satisfied that the Respondent registered the two disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **allsaintsmexico.com**: Transferred
2. **allsaints-outlet.com**: Transferred

PANELLISTS

Name **David-Irving Tayer**

DATE OF PANEL DECISION **2023-03-15**

Publish the Decision