

Decision for dispute CAC-UDRP-105191

Case number	CAC-UDRP-105191
Time of filing	2023-02-27 10:41:43
Domain names	golashoesusa.com, golashoesindia.com, golatrainersireland.com, golashoestoronto.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	D. Jacobson & Sons Limited
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Complainant representative

Organization	TLT LLP
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Respondents

Organization	Web Commerce Communications Limited
Name	Katharina Werner

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, inter alia, the owner of the European Union Trademark registration 001909936 GOLA registered on March 22, 2002 in classes 18, 25 and 28, inter alia for shoes., and being in effect.

FACTUAL BACKGROUND

The Complainant is a UK based designer, importer, seller and exporter of ladies', men's and children's footwear. In particular, the Complainant owns the "GOLA" brand, which it has applied (amongst other things) to its range of footwear and bag designs. The Complainant's footwear and bag products are sold throughout the world, including through its various websites registered under domain names such as <gola.co.uk> and <golausa.com>.

The disputed domain name <golashoestoronto.com> subject of these proceedings was registered on January 4, 2023 and resolved to a website advertising shoes branded with GOLA.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

The Complainant is arguing on the basis of UK trademark infringement standards including passing off. Translated into the UDRP system test, the Complainant contends that the disputed domain name is confusingly similar to the trademark GOLA. The Complainant further contends that the Respondent is not affiliated with or authorized by the Complainant. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Given the presentation of GOLA shoes, Complainant finally contends that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark.

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 Complainant had related to 4 domain names, i.e. <golashoesusa.com> <golashoesindia.com>, <golatrainersireland.com> and <golashoestoronto.com> as discussed above whereas the <golashoestoronto.com> has another owner than the other three ones. The Complainant requested a consolidation of these domain names since the domain names, inter alia, shall follow the same format, were registered by the same registrar and contents of the websites (almost) mirror each other.

According to paragraph 10(e) of the Rules of UDRP Policy "a Panel shall decide on a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules". According to Paragraph 3(c) of the UDRP Rules states that: "The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder".

Practice (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, Section 4.11.2) has established in order to file a single complaint against multiple respondents, the complaint shall meet the following criteria: (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties.

The Panel is not convinced that the three other domain names <golashoesusa.com> <golashoesindia.com>, <golatrainersireland.com> are under the same control as <golashoestoronto.com>. The owners are different and the websites have similarities but are not identically designed.

Given the above reasons, the Panel rejects the Complainant's request to have the Complaint filed against multiple respondents. In the circumstances, with a view to expediting the administrative proceeding, this decision shall, in the Panel's sole discretion, deal only with the disputed domain name <golashoestoronto.com>. The Panel had announced his view of that and gave the opportunity to choose the domain names resp. the set of domain names to be decided upon here. Since this choice was not exercised, the Panel will proceed with the disputed domain name <golashoestoronto.com>.

Therefore, the other disputed domain names <golashoesusa.com>, <golashoesindia.com> and <golatrainersireland.com> are not analyzed under this proceeding and the Panel orders that the Complaint is terminated without prejudice as to the disputed domain names <golashoesusa.com>, <golashoesindia.com> and <golatrainersireland.com>. Nevertheless, this Panel leaves the rights of the

Complainant intact, regarding the disputed domain names <golashoesusa.com>, <golashoesindia.com> and <golatrainersireland.com>, should the Complainant decide to file another complaint under the Policy in relation to said domain names.

Otherwise, 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

In order to succeed in its claim, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

1.

Identical or Confusingly Similar

The Complainant has established the fact that it has valid trademark rights for "GOLA".

The disputed domain name is confusingly similar to the Complainant's mark since the addition of a geographical identifier such as the name of a city like „Toronto“ and a descriptive term such as „shoes“ does not have a relevant influence on the similarity of signs.

The Panel therefore considers the disputed domain name to be confusingly similar to the trademark „GOLA“ in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

1. Rights or Legitimate Interests

The Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to the Respondent to use its trademarks or designations confusingly similar to its trademarks. Furthermore, the Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication that the Respondent is commonly known by the name "GOLASHOESTORONTO" or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The latter could be discussed since Respondent seems to offer products from the Complainant. However, the majority opinion of panelists follows in cases where a legitimate interest of resellers of original goods to use a trademark in the domain name is in question, the test of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, <okidataparts.com> after which such use might be legitimate if the use comprise the actual offering of goods, only the trademarked goods are sold on the site, and the site is accurately and prominently disclosing the registrant's relationship with the trademark holder.

Although this Panel follows even the argumentation that any reseller is not allowed to use the trademark, unless otherwise authorized, in a manner which goes beyond the scope of informing the customer about the core of its business activities (see also *Ferrero S.p.A. v. Fistagi S.r.l.*, WIPO Case No. D2001-0262; *Raymond Weil SA v. Watchesplanet (M) Sdn Bhd*, WIPO Case No. D2001-0601; dissenting opinion in *DaimlerChrysler A.G. v. Donald Drummonds*, WIPO Case No. D2001-0160) and unless it is not clear for the customer that the retailer is not an authorized partner of the Trademark owner, the present case does not meet even the less strong criteria of the test after *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, <okidataparts.com>, since the website under the disputed domain name creates the impression of being the one from the Complainant.

The Panel therefore finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

1. Registered and Used in Bad Faith

This Panel does not see any conceivable legitimate use that could be made by the Respondent of this particular domain name without the Complainant's authorization.

The circumstances of this case furthermore indicate that the Respondent registered and uses the disputed domain name primarily with the intention of attempting to attract, for commercial gain, Internet users to its potential website or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website or location, or of a product or service on such website or location. The Panel therefore considers the disputed domain name to have been registered and used in bad faith in accordance with paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **golashoesusa.com**: Remaining with the Respondent
 2. **golashoesindia.com**: Remaining with the Respondent
 3. **golatrainersireland.com**: Remaining with the Respondent
 4. **golashoestoronto.com** : Transferred
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PANELLISTS

Name	Dietrich Beier
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DATE OF PANEL DECISION **2023-04-08**

Publish the Decision
