

Decision for dispute CAC-UDRP-105313

Case number CAC-UDRP-105313

Time of filing 2023-03-29 09:25:17

Domain names hardtailshop.com

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Name Richard R. Cantrell

Complainant representative

Organization HSS IPM GmbH

Respondent

Name Zhou Xiuyun5

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 bases its Complaint especially on the following HARD TAIL trademarks:

COUNTRY	TM	REG. NO.	REG DATE	OWNER
USA	Hard Tail Wordmark	1814975	Jan. 04, 1994	Cantrell, Richard R & Cantrell, Patricia L.
USA	Hard Tail (& Device	2503577		Cantrell, Richard R &

	logo)	Mark		Nov. 06, 2001	Cantrell, Patricia L.
USA	Hard Tail Jeans	Wordmark	2427542	Feb. 06, 2001	Cantrell, Richard R & Cantrell, Patricia L.
IR (AU, CH, EG, EM, IL, RU, SG, VN)	Hard Tail	Wordmark	1064600	Dec. 28, 2010	Cantrell, Richard R & Cantrell, Patricia L.
Singapore	Hard Tail	Wordmark	T1101653F	May 26, 2011	Cantrell, Richard R & Cantrell, Patricia L.
Canada	Hard Tail (& logo)	Device Mark	TMA605307	Mar 16, 2004	Cantrell, Richard R & Cantrell, Patricia L.

FACTUAL BACKGROUND

Hard Tail is a Santa Monica-based premium active and lifestyle clothing brand founded in 1992 by Richard R. Cantrell and Patricia L. Cantrell and represented in these proceedings by HSS IPM GmbH.

Hard Tail is a leader in the evolution of lifestyle activewear by offering a delicious color palette, soft fabrics and signature design elements. It has evolved into an internationally renowned, family-owned and operated business, recognized as much for its focus on California manufacturing and classic designs as its commitment to strong females everywhere.

The official website of Hard Tail is found at <http://hardtailforever.com/>, which was registered on January 17, 2000.

The trademark registrations invoked by the Complainant predate the registration date of the disputed domain name <hardtailshop.com> which is August 29, 2022.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

The disputed domain names <hardtailshop.com> is confusingly similar to the Complainant's earlier trademarks HARD TAIL.

The Complainant asserts that the disputed domain name directly and entirely incorporates Complainant's registered trademark HARD TAIL along with the generic term "shop", a term that can be considered related to Complainant's business. In the Complainant's view, his HARD TAIL mark is the initial, dominant and only distinctive element in the disputed domain name. The Complainant contends that the generic term "shop" adds no distinguishing character, is irrelevant and does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademarks.

In the Complainant's view, the reference to "shop" in the disputed domain name exaggerates the impression that Respondent is somehow affiliated with Complainant and Respondent is somehow doing business using Complainant's trademarks.

The Complainant further contends that the addition of the generic Top-Level Domains (gTLD) ".com" does not add any distinctiveness to the disputed domain name.

For these reasons, the Complainant concluded that the disputed domain name is confusingly similar to his trademark HARD TAIL.

Further, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

To this end, the Complainant asserts that the disputed domain name is not being used in connection with a bona fide offering of goods or services. At the time when the Complainant prepared the filed Complaint, such asserts that the disputed domain name hosted an online shop with the infringing use of Complainant's trademark "HARD TAIL FOREVER" that purports to sell a variety of goods, such as bottoms, tops, activewear, dresses & jumpsuits of the Complainant.

The Complainant asserts that following the case *Oki Data Americas, Inc. v. ASD, Inc.* WIPO Case No. D2001-0903, the use of a trademark as a domain name by an authorized or non-authorized third party is only to be regarded as a bona fide offering of goods or services within the meaning of paragraph 4(c) of the Policy if the following conditions are satisfied:

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

As to condition a) herein above, the Complainant asserts that the Respondent offers the goods at below market prices displaying a "Sale!" sign at the top of each of the images. In the Complainant's view, it can be inferred that the Respondent is pretending to sell counterfeit versions of Complainant's goods. The Complainant further contends that the Respondent is not offering the actual goods and for these reasons, and thus, the herein above condition a) is not satisfied.

Regarding Condition b) herein above, the Complainant asserts that although Respondent offers only the trademarked goods, they are offered at below-market prices which is evidence of counterfeit products. Moreover, the Complainant asserts that such conducted a test purchase and received two separate error messages and did not receive any confirmation after placing its order. This indicates in the Complainant's view that the Respondent is not using the site to sell only the trademarked goods, but it is using it to steal users' sensitive information. Therefore, in the Complainant's view, condition b) herein above is not satisfied.

In regards to condition c) herein above, the Complainant asserts that the Respondent did not disclose or disclaim its total lack of relationship or connection to the Complainant anywhere on the website linked to the disputed domain name. The Complainant further contends that the only information that appeared at the footer of the website is the following: "Copyright 2023 © www.hardtailshop.com". This information, in the Complainant's view, does not meet the Oki Data standard of "accurately and prominently" disclosing the Respondent's relationship with the Complainant.

As to condition d), herein above, the Complainant asserts that Respondent tries to corner the market in the disputed domain name because it is composed of a common related and important term for the Complainant, such as "shop" and which is relevant to Complainant's business of selling clothing online.

For these reasons, the Complainant asserts that the Respondent's use of the disputed domain name does not satisfy the Oki Data requirements.

The Complainant further contends that it is undeniable that Respondent was aware of Complainant's marks prior to the acquisition of the disputed domain name and the establishment of Respondent's website. The Complainant asserts that the Respondent has made no claims to either having any relevant prior rights of its own or to have become commonly known by the disputed domain name. The Complainant underlines that it has never authorized Respondent to use its trademarks or contents in any manner, so the use of the disputed domain name could not be considered legitimate use.

The Complainant further asserts that, the Respondent uses the disputed domain name to perpetrate a phishing scheme that cannot constitute legitimate rights and interests in the disputed domain name pursuant to Policy 4(a)(ii). The Complainant contends that the Respondent is using the disputed domain name in a fraudulent scheme to deceive Internet users into providing their credit card and personal information. The Complainant underlines that the website simulates the purchase of products where customers have to provide their credit card information and contact details. The Complainant alleges that such has followed the entire purchase process and conducted a test purchase with a Visa Gift Card and received two separate error messages and did not receive a confirmation email after placing their order.

Thus, for these reasons, the Complainant concludes that the use of the disputed domain name is not in connection with a bona fide offering of goods or services as required by the Policy.

Further, the Complainant asserts that, such has not found that Respondent is commonly known by the disputed domain name or that it has any interest in the domain name or the major part of it. The Complainant further underlines that it appears on the WHOIS information that the Registrant of the disputed domain name is Zhou Xiuyun5, who is located in Xiqing District, Tianjin, China, and which is the only evidence that relates Respondent to the disputed domain name. By performing a search on the Global Brand Database (WIPO), the Complainant asserts that it can be seen that the Respondent has no trademarks registered in China related to HARD TAIL; thus, in his view, the Respondent is not commonly known either by the trademark or the domain name. The Complainant also asserts that when entering the term "HARD TAIL" in the Google search engine, the returned results point to Complainant and its business activity and that Respondent could easily perform a similar search before registering the disputed domain name and would have quickly learned that Complainant owns the trademarks and that Complainant has been using its trademarks extensively. The Complainant underlines again that such has not authorized Respondent to use any of its trademarks, and that the Complainant does not have any other relationship or association, or connection with Respondent.

Further, the Complainant contends that, the Complainant has not found any evidence that Respondent has made any known legitimate, non-commercial use of the disputed domain name. The Complainant alleges that, the website associated with the disputed domain name is not being used for the purposes of information or criticism or any other use that could potentially be deemed fair use. Respondent is not making a legitimate, noncommercial, or fair use of the domain name but instead, is using the domain name in furtherance of fraudulent activity, namely posing as Complainant, in the Complainant's view.

For these reasons, the Complainant concluded that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Further, the Complainant further asserts that the disputed domain name was registered and is being used in bad faith.

To this end, the Complainant asserts that his HARD TAIL trademarks long predate the registration of the disputed domain name and Respondent has never been authorized by Complainant to register the disputed domain name. The Complainant further asserts that, the active business presence of the Complainant in different markets and on a significant scale around the world, makes it apparent that the Respondent was aware that the registration of the disputed domain name was unauthorized and improper.

The Complainants asserts that the trademark HARD TAIL is registered by the Complainant in numerous territories and has been used by Complainant's group for several decades. Further, the Complainant contends that when entering the term "HARD TAIL" in the Google search engine, the returned results point to Complainant's business activity and that points to an inference of knowledge and, therefore, of bad faith targeting, in the Complainant's view.

For these reasons, the Complainant concluded that, it is reasonable to infer that Respondent knew or should have known of Complainant's mark at the time of registration.

The Complainant further asserts that the disputed domain name is in use and it resolves to a website on which customers can purchase clothes at a discounted price. The Complainant underlines that the website associated with the disputed domain name has the appearance of being an official webshop of the Complainant, in particular, because it contains the Complainant's HARD TAIL word trademark and it reproduces photographs – without permission – copied from the Complainant's website. The Complainant also asserts that the website associated with the disputed domain name claims to offer for sale clothes that are also sold by the Complainant. In the Complainant's view, the foregoing makes it very likely that Internet users will assume that there is an association between the disputed domain name and the Complainant.

The Complainant further contends that the addition of the term "shop" in the disputed domain name makes it even more likely that the Respondent wishes to give the impression that the webshop is affiliated with Complainant. This indicates in the Complainant's view that, the Respondent's intention to attempt to attract Internet users to its website by creating a likelihood of confusion between the disputed domain name and the HARD TAIL trademarks. For this reason, in the Complainant's view, the Respondent must have had actual knowledge of Complainant's rights in the HARD TAIL mark since the disputed domain name almost fully incorporates Complainant's mark and resolves to a copycat website. This demonstrates, in the Complainant's view that, Respondent was not only aware of Complainant's rights but specifically targeted it as part of an attempt to deceive potential customers into believing that the disputed domain name's website was owned or operated by Complainant.

Further, the Complainant contends that it appears to be fake or copied information on the website associated with the disputed domain name. To this end, the Complainant gives as examples, the terms and conditions of Respondent's website are governed by the law of Scotland; however, the dress of the business claims to be in Savannah. This can be considered in the Complainant's view bad faith because this important information seems to be also copy-pasted from a third-party website.

From the Complainant's point of view, Respondent intentionally chose the disputed domain name based on the trademark HARD TAIL, along with the term "shop" in order to try to generate more traffic to its own business. In the Complainant's view, Respondent uses the disputed domain name to intentionally attempt to attract, for commercial gain, internet users to the website by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

Last but not least, the Complainant underlines that his trademark registrations long predate Respondent's disputed domain name registration. This constitutes bad faith due to the gap of more than ten years between the registration of the Complainant's trademarks and the Respondent's registration of the disputed domain name, in the Complainant's view.

For these reasons, the Complainant concluded that the disputed domain name has been used in bad faith by Respondent.

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 underlines that, the trademarks invoked by the Complainant as basis of this Complaint are owned in co-ownership with Ms. Patricia L. Cantrell.

On May 3rd, 2023, the Panel has issued a procedural order by which it requested the Complainant Richard R. Cantrell to provide a declaration/ confirmation from Patricia L. Cantrell, including through correspondence from the latter which states that the latter agrees as co-owner of the HARD TAIL trademarks with the UDRP procedure initiated by the complainant Richard R. Cantrell in this file and with the transfer of the disputed domain name <hardtailshop.com> to the Complainant, Richard R. Cantrell, in case such prevails in this procedure.

On May 8th, 2023, the authorized representative of the Complainant has filed a declaration mentioning that Ms. Patricia L. Cantrell has died on April 4th, 2023, attaching also her death certificate and also by declaring that, at the date when the Complaint was filed, the authorized representative had instructions from both the Complainant, Richard R. Cantrell and Ms Patricia L. Cantrell, husband and wife, and that the transfer of the disputed domain name <hardtailshop.com> should be made to the Complainant, Richard R. Cantrell, in case such prevails in this procedure.

Considering the response received to the issued procedural order, 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

1. Confusing Similarity

The Panel agrees that the disputed domain name <hardtailshop.com> is confusingly similar to the Complainant's earlier HARD TAIL trademarks. The disputed domain name incorporates entirely the Complainant's earlier HARD TAIL trademark and the addition of the generic term "shop", which is closely related to the business activities carried under the trademark HARD TAIL, is not sufficient to escape the finding that the domain name is confusingly similar to the Complainant's trademark and it does not change the overall impression of the designations as being connected to the trademark HARD TAIL.

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain name (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.*).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

2. Lack of Respondent's rights or legitimate interests

The 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 proof 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 UDRP.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Complainant has never authorised the Respondent to register the disputed domain name nor to use any of its trademarks nor to make use of its HARD TAIL trademark in the disputed domain name. There is no evidence in the file that the Complainant has any relationship or association, or connection with Respondent.

On the basis of the evidence available in the file, the disputed domain name does not appear to be used in connection with a bona fide offering of goods or services. At the time when the Complaint was prepared to be filed, the disputed domain name hosted an online shop that purports to sell a variety of goods, such as bottoms, tops, activewear, dresses & jumpsuits of the Complainant. Considering the evidence in the file, the conditions from the case *Oki Data Americas, Inc. v. ASD, Inc.* WIPO Case No. D2001-0903, namely:

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

are not met in this case, mainly, as the Respondent seem to offer the goods at below market prices displaying a "Sale!" sign at the top of each of the images, a fraudulent scheme seem to be put in place to deceive Internet users into providing their credit card and personal information, the Respondent did not seem to disclose or disclaim its total lack of relationship or connection to the Complainant anywhere on the website linked to the disputed domain name and also considering that the disputed domain name is composed of the generic term "shop" closely related to the business carried under the HARD TAIL trademarks, essentially of selling clothing online.

On the basis of the available evidence in the file, the website associated with the disputed domain name seem to create an association with / to pose as the Complaint, and there is no evidence in the file that, the Complainant has any relationship or association, or connection with Respondent.

The Panel notes that the Respondent had an opportunity to comment on the Complainant's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

3. Bad Faith

The Complainant's HARD TAIL trademarks long predate the registration of the disputed domain name and Respondent has never been authorized by Complainant to register the disputed domain name. The Respondent has chosen to register the domain name containing entirely the Complainant's earlier HARD TAIL trademark with the addition of the generic term "shop", which is closely related to the business activities carried under the trademarks HARD TAIL. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant's HARD TAIL trademark.

In the present case, the following factors should be considered:

- (i) the disputed domain name resolves to a website which has the appearance of being an official webshop of the Complainant, especially as it contains the Complainant's HARD TAIL word trademark and as it reproduces photographs copied from the Complainant's website without permission;
- (ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;
- (iii) the Respondent registered the disputed domain name containing entirely the Complainant's earlier HARD TAIL trademark with the addition of the generic term "shop", which is closely related to the business activities carried under the trademarks HARD TAIL;
- (iv) the Respondent was never authorised to use a domain name similar to the Complainant's trademark;
- (v) there is no evidence in the file that there is any relationship or association, or connection between the Complainant with the Respondent.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

Accepted

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

1. **hardtaiishop.com**: Transferred

PANELLISTS

Name	Delia-Mihaela Belciu
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DATE OF PANEL DECISION **2023-05-10**

Publish the Decision
