

Decision for dispute CAC-UDRP-105378

Case number **CAC-UDRP-105378**

Time of filing **2023-04-21 09:49:45**

Domain names **golachile.com**

Case administrator

Organization **Iveta Špiclová (Czech Arbitration Court) (Case admin)**

Complainant

Organization **D. Jacobson & Sons Limited**

Complainant representative

Organization **TLT LLP**

Respondent

Name **Nadine Seiler**

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 Complainants rely on the following trademarks:

1. UK Registration GOLA no. 1097140 - registered on June 1978 and duly renewed for class 18;
2. UK Registration "Wing Flash Logo" - registered on November 25, 1975 and duly renewed for class 25;
3. UK Registration GOLA no. 272980 - registered on May 22, 1905 and duly renewed for class 25;
4. EU Registration for GOLA no. 1909936 - registered on October 4, 2000 and duly renewed for classes 18, 25 and 28;
5. EU Registration for GOLA no. 3399681 - registered on October 8 2003 and duly renewed for classes 5, 10, 12 and 35; and
6. EU Registration for GOLA (stylised) no. 11567625 - registered on July 4, 2013 and duly renewed for classes 18, 25 and 35.

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 rights on GOLA trademark, which has very successfully applied 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>. Customers in the UK, EU and US are able to purchase the Complainant's products through the above-mentioned websites.

The Complainant notes that the domain name in dispute is <golachile.com> and that it was registered on August 24, 2021.

Furthermore, the Complainant informs that the domain name in dispute is not connected with nor authorized by the Complainant. In particular the Complainant has never authorized or permitted to the Respondent to use the mark GOLA in its domain name. The Complainant believes that the Respondent has no legitimate interests in the domain names in dispute as it is most likely they are used to defraud third parties.

In addition, the Complainant infers that the domain name in dispute is confusingly similar to the GOLA trademark since they entirely include the Complainant's trademark.

Finally, the Complainant assumes that the domain name in dispute is registered in bad faith as the sole purpose for the registration was and is to impersonate the Complainant for fraudulent purposes. The Respondent's impersonation of the Complainant is designed to deceive third parties into believing that the domain names in dispute are owned by the Complainant and are offering legitimate products, when in fact the Respondent is instead defrauding consumers.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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).

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 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.

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a disputed domain name should be transferred or cancelled:

- (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 in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and are being used in bad faith.

The Panel has reviewed in detail the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS

Paragraph 4(a)(i) of the Policy establishes the obligation of Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of different trademarks registrations pertaining the term GOLA for different products, including bags, cases, articles of clothing, gymnastic and sporting articles, etc.

The Complainant's trademarks were registered way prior to 2021, the year of the creation date of the disputed domain name.

In the current case, the disputed domain name is composed of trademark GOLA and the country name CHILE.

In assessing confusing similarity, the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, as it incorporates the entirety of the GOLA trademark plus the name of a country i.e. Chile. In this regard, UDRP panels agree that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is confusingly similar to Complainant's GOLA mark.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this vein, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the disputed domain name on behalf of the Respondent such as:

- (i) before any notice to Respondent of the dispute, Respondent is using or provides with demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) The Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent did not reply to the Complaint despite the efforts made by this Center to notify the Complaint. In this regard, the Complainant has confirmed in the Complaint that the disputed domain name is not connected with or authorized by the Complainant in any way.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the disputed domain name.

The Respondent's name Nadine Seiler provided in the Registrar's Verification dated April 20, 2023 is all what it links the disputed domain name with the Respondent. Absent of any other evidence such as a corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the disputed domain name.

In terms of the evidence provided by the Complainant, the website linked to the following disputed domain name has been used by replicating or at least copy in an extremely close manner Complainant's website in Spanish language using GOLA's trademarks.

The Complainant presented a comparison between some parts of the Complainant's official website and that copied by the Respondent and it is clear that the Respondent set up a website to mirror the Complainant's genuine websites.

From the evidence presented, it is then clear that the Respondent acquired and set up the disputed domain name with intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue and, therefore, the Panel neither finds a bona fide offering of goods and service nor legitimate non-commercial or fair use of the disputed domain name.

In light of the reasons above mentioned, the Panel concludes that the Complainant has satisfied the second element of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the disputed domain name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) The Respondent has registered the disputed 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 Respondent has engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

For the current case, the evidence at hand confirms that Complainant's GOLA trademark is distinctive and it has a strong reputation in the footwear and bag industry. In addition, the Complainant's trademarks were registered long before the disputed domain name was created. Based on those elements, the Panel is of the opinion that Respondent knew or should have known that its domain name registration would be confusingly similar to the GOLA trademarks.

Furthermore, the Complainant provided with evidence showing that the disputed domain name was set up by the Respondent to mirror the Complainant's genuine websites with the purpose to mislead internet consumers who are attempting to purchase products through the disputed domain name into believing that it is doing so from the Complainant's genuine website or from a website that is in some way connected to or associated with the Complainant. In this sense, the Complainant has confirmed that no authorization was granted to the Respondent to register it and no counterargument has been submitted by Respondent. This is a clear indication that the disputed domain name is set up with the only intention to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

The Complainant indicated that the disputed domain name would be linked to the UDRP Cases 1041970 but did not provide with evidence (such as copies of the cases) supporting the involvement of the Respondent in those UDRP Disputes.

In terms of the current UDRP jurisprudence, it has been accepted that a Panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.

This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name, consulting historical resources such as the Internet Archive in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopedias (e.g., Wikipedia), or accessing trademark registration databases.

Since the Complaint was able to at least identify the UDRP case number, the Panel was able to research on the portal of this Arbitration Centre the UDRP Dispute 104197. This dispute was filed by Complainant against another Respondent regarding different domain names with Complainant's GOLLA trademark and it could not be confirmed per se that there is a pattern of conduct. The only link that may be found is that in this very case and the dispute referred to the Respondents are based in Germany. This could not be inferred as a pattern of conduct unless further evidence be provided by the Complainant. In the limited factual research conduct that may conduct the Panel, it comes out the existence of a dispute filed before the arbitration center Forum, Claim Number: FA2107001954954, demonstrating a similar pattern of conduct from the Respondent as well as the Respondent in the UDRP Cases 1041970 and an identical registrar. This situation may not be considered as a mere coincidence yet cannot be conclusive unless further proven by the Complainant.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the disputed domain name and the Complainant's GOLLA trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact that the disputed domain name is being used to mirror the Complainant's genuine websites with the purpose to mislead internet consumers, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith within the meaning of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **golachile.com**: Transferred

PANELLISTS

Name	David-Irving Tayer (Presiding Panelist)
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DATE OF PANEL DECISION 2023-05-28

Publish the Decision
