

Decision for dispute CAC-UDRP-105413

Case number	CAC-UDRP-105413
Time of filing	2023-05-05 10:03:22
Domain names	golaparis.com, golashoessingapore.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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Respondent

Organization	Web Commerce Communications Limited
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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 a UK based designer, importer, seller and exporter of ladies', men's and children's footwear. The Complainant's customers in the UK, EU and US are able to purchase online the products through 'www.gola.co.uk' and 'www.golausa.com'

The Complainant owns the following Trademarks:

- UK Trademark GOLA, Reg. No. 00000272980, IC 25, registered on May 22, 1905, and in force until May 22, 2033.
- UK Trademark GOLA, Reg. No. 00001097140, IC 18, registered on June 14, 1978, and in force until June 14, 2029.
- EUIPO Trademark GOLA, Reg. No. 001909936, ICs 18, 25 and 28, registered on October 4, 2000, and in force until October 4, 2030.
- EUIPO Trademark GOLA, Reg. No. 003399681, ICs 5, 10, 12 and 35, registered on October 8, 2003, and in force until October 8, 2023.
- EUIPO Trademark GOLA, Reg. No. 011567625, ICs 18, 25, and 35, registered on February 12, 2013, and in force until February 12, 2033.

FACTUAL BACKGROUND

The Complainant is a UK based designer, importer, seller and exporter of ladies', men's and children's footwear. The Complainant's customers in the UK, EU and US are able to purchase online the products through 'www.gola.co.uk' and 'www.golausa.com'.

The Complainant is the owner of the Trademark GOLA in multiple jurisdictions, which it has been reproduced in its entirety in the disputed domain names, affecting the Complainant's Trademark Rights.

The disputed domain names <golaparis.com> registered on **February 20, 2023** and <golashoessingapore.com> was registered on **March 6, 2023**, resolve to websites with potential malicious and dangerous content.

PARTIES CONTENTIONS

Complainant Contentions:

- The Complainant asserts that is the owner of the internationally famous registered trademark GOLA across multiple jurisdictions; that the Complainant has over many years and throughout the world sold hundreds of thousands of pairs of footwear and bags under the Trademark GOLA, which features on its client's products and promotional and advertising material, including through its domain names; that as a result, the Complainant has acquired substantial goodwill, notoriety and reputation over the Trademark GOLA in the UK and European Union in relation to its footwear products and business.
- The Complainant contends that the disputed domain names are identical or highly similar to its Trademark GOLA.
- The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain names, due to are not connected with or authorized by the Complainant in any way, and as they are most likely being used to defraud third parties; that the Complainant has serious cause for concern that the Disputed Domains either are being or will be used fraudulently by the Respondent to obtain the personal and financial information of the Complainant's customers.
- The Complainant contends that the Infringing Domains have clearly been set up by the Respondent to mirror the Complainant's genuine website addresses, through use of the disputed domain names which include the Complainant's GOLA Trademarks.
- The Complainant contents that the registrations and use of the Disputed Domain Names by the Respondent and the use of the GOLA Trademarks will likely mislead relevant members of the public who are attempting to purchase products through the Disputed Domain Names into believing that they are doing so from the Complainant's genuine website or from a website that is in some way connected to or associated with the Complainant, contrary to the fact.
- The Complainant contends it is inconceivable that at the time of registration, the Respondent did not know of the similarity between the Disputed Domain Names and the Gola Domains and Trademarks as the Disputed Domain Names are materially identical to the Trademarks and the Gola Domains.
- The Complainant contends that the Disputed Domain Names were registered in bad faith as the sole purpose for their 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 Disputed Domain Names are owned by the Complainant and is offering legitimate products, when in fact the Respondent is instead defrauding consumers.

Response

The Respondent did not reply to any of the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names 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

In accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 is being used in bad faith.

The Panel will consider each of these requirements in turn.

1. Identical or Confusingly Similar

The Complainant has produced sufficient evidence of having Trademark Rights over the word GOLA, since 1905.

The disputed domain name <golaparis.com> is the result of the exact incorporation of Complainant's Trademark GOLA, plus a geographical term, being the name of a city "paris"; the disputed domain name <golashoessingapore.com> is the result of the exact incorporation of Complainant's Trademark GOLA, plus a descriptive term as "shoes", intrinsically related to Complainant's products, and a geographical term, being the name of a city-state "singapore", terms that would not prevent a finding of confusing similarity to the Complainant's trademark (see Section 1.8 of WIPO Overview 3.0).

In relation to the gTLD ".com", it is well established that such element is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see Section 1.11.1 of the WIPO Overview 3.0).

Therefore, the disputed domain names <golaparis.com> and <golashoessingapore.com> are confusingly similar to Complainant's GOLA Trademark.

2. Rights or Legitimate Interests

Paragraph 4(c) of the Policy, establish the following non-exclusive defenses, in order to demonstrate rights or legitimate interests in a domain name, being:

- (i) before any notice of the dispute, the respondent's use of, or 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 noncommercial 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.

In this case, no Response or any communication has been submitted by the Respondent on its defense, however as multiple UDRP panelists have been established, such absence does not automatically result in a Decision in favor of the Complainant.

According to the facts and the evidence of this case:

- (1) the Respondent registered the disputed domain name <golaparis.com> on February 20, 2023 and <golashoessingapore.com> on March 6, 2023, very well after the Complainant's acquired its Trademark Rights over GOLA in 1905.
- (2) the Respondent is not associated or affiliated to the Complainant, nor has been authorized by the Complainant to offer any product or service, or any rights to apply for registration of the disputed domain names by the Complainant.
- (3) there is no evidence that the Respondent has become commonly known by the terms "golaparis.com" or "golashoessingapore.com".
- (4) there is no evidence showing that the Respondent has been using, or preparing to use, the disputed domain names in connection with a *bona fide* offering of goods and services or has made a legitimate noncommercial or fair use of the disputed domain names, in contrary, the disputed domain names resolve in websites with potential harmful, malicious and dangerous content, which besides the confusion generated among the Complainant's customers, and the Internet users, who seek or expect to find the Complainant on the Internet, could land or being trapped in a complex scenario with disastrous and endless consequences, as *e.g.*: data breach, data leak through malwares; malware distribution, phishing, scams, and many others sophisticated online illicit tactics.

Section 2.13.1 of the WIPO Overview 3.0, states that:

"Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types

of fraud) **can never confer rights or legitimate interests on a respondent.**" (emphasis added).

Therefore, according to the facts, the evidence of this case, and considering the absence of Response by the Respondent, meaning of any relevant evidence on its favor, this Panel determines that the Complainant has established its *prima facie* case in relation to the Second Element of the Policy, and this Panel concludes, that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

3. Registered and Being Used in Bad Faith

a) Registration in Bad Faith:

The Complainant acquired its Trademark Rights over the word GOLA in 1905 (e.g.: UK Trademark GOLA, Reg. No. 00000272980, IC 25, registered on May 22, 1905, and in force until May 22, 2033), meaning that the Respondent has more than sufficient time to learn about the Complainant. According to the evidence submitted before this Panel, the Complainant is a worldwide company, with a well-known Trademark as GOLA with significant commercial activity, including on the Internet (*D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 105207).

Section 3.2.1 of the WIPO Overview 3.0 related to additional bad faith consideration factors, has established that:

"Particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) **the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion)** (...) (vi) **a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name**, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant." (emphasis added).

Section 3.2.2 of the WIPO Overview 3.0 related to the assessment of respondent's knowledge ("Knew or should have known"), has established that:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, **any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark.** (...)" (emphasis added).

Given that, this Panel, determines that the Respondent was fully aware about Complainant's GOLA Trademark's value, and intentionally registered the disputed domain names with Complainant's in mind.

Therefore, this Panel concludes that the disputed domain names were registered in bad faith.

b) Bad Faith Use:

In this case, the Complainant has only asserted that "has serious cause for concern that the Disputed Domain Names either are being or will be used fraudulently by the Respondent to obtain the personal and financial information of the Complainant's customers", without providing any evidence, apart from the indication of the disputed domain names, of how the Respondent is obtaining such data and or the Respondent's malware distribution. Nevertheless, this Panel, in accordance to Paragraph 10 of the Rules, has exceptionally determined that in the particular circumstances of this case it is reasonable, not to issue a Panel Order, and to undertake limited factual research restricted to visiting the websites associated with the disputed domain names (see *Humble Bundle, Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. D2016-0914 and Section 4.7 of the WIPO Overview 3.0).

This Panel at the moment of each disputed domain name's content analysis, have found that <golaparis.com> and <golashoessingapore.com> are blocked by [its] protection software with a high-level warning of malware distribution, infection and data leak; fact that confirms the Complainant's concerns.

As described in the Second UDRP Element Analysis (Section 2.(4)), the disputed domain names resolve to websites with potential malicious content, constituting an strong indicia of bad faith use. "[A] respondent's spreading malware "implies abusive conduct of a particularly serious nature," conduct that "goes well beyond the activities of the typical cybersquatter." Id. Here, when the Respondent engaged in such activity, it must have been aware of those who would be affected, including the Complainant and its customers." (see *Humble Bundle, Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. D2016-0914; *D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 104197).

In addition, this Panel notes that the Respondent has established a pattern of conduct in accordance to Paragraph 4(b)(ii) of the Policy, due to the existence of previous CAC Decisions, being as far: *D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 104197, *D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 104294, *D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 104314, *D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 104400, *D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 104707, *D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 104938, and *D. Jacobson & Sons Limited v. Web Commerce Communications Limited*, CAC-UDRP Case No. 105207.

Therefore, this Panel, considers, under the circumstances of this case, in particular where the Respondent has remained silence during the entire proceeding, that not granting the remedy requested by the Complainant would contribute and reinforce the Respondent's conduct, playing against the Complainant and specially the Internet User.

In consideration of the above, the Panel concludes that the Respondent is using the disputed domain names in bad faith as well.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **golaparis.com**: Transferred
- 2. **golashoessingapore.com**: Transferred

PANELLISTS

Name	María Alejandra López García
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DATE OF PANEL DECISION 2023-06-05

Publish the Decision