

Decision for dispute CAC-UDRP-105484

Case number CAC-UDRP-105484

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Domain names moushoesale.com

Case administrator

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

Complainant

Organization MOU Limited

Complainant representative

Organization SILKA AB

Respondent

Name zhang xue ming

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain name <moushoesale.com> ('the disputed domain name').

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- EU trade mark registration no. 1001663, registered on 8 April 2009, designating, amongst others, China, for the figurative mark MOU, in classes 3 and 25 of the Nice Classification;
- United States trade mark no. 3663689, registered on 4 August 2009, for the word mark MOU, in class 25 of the Nice Classification;
- Chinese trade mark registration no. 15676762, registered on 28 December 2015, for the figurative mark MOU, in class 24 of the Nice Classification; and
- Chinese trade mark registration no. 15676761, registered on 14 March 2016, for the figurative mark MOU, in class 26 of the Nice Classification.

The Complainant further relies on national trade marks worldwide held by the Complainant.

(Hereinafter, collectively or individually, 'the Complainant's trade mark' or 'the (trade) mark MOU' interchangeably).

The Complainant advises that prior UDRP panels have recognised the reputation and well-known nature of the trade mark MOU (eg

Mou Limited v Song Li Hong, WIPO Case No. D2018-2912, in respect of the domain name <mou-saleonline.com>).

Additionally, the Complainant informs that it has established an online presence through the use of domain names bearing the trade mark MOU, most notably <mou-online.com>, which was registered in 2006.

The disputed domain name was registered on 14 February 2023, and, at present, resolves to an online store on which products of a Complainant's competitor appear to be commercialised, the particulars of which are discussed further below ('the Respondent's website').

FACTUAL BACKGROUND

The Complainant's contentions can be summarised as follows:

A. Background history

The Complainant, founded in 2002 in London by Shelley Tichborne, provides hand-crafted footwear and accessories such as bags, wallets, hats and gloves for men, women and children. The Complainant's products are ethically produced, made in sustainable materials, and are sold online and also via selected boutiques and department stores worldwide, including in China.

The Complainant seeks to obtain the transfer of the disputed domain name <moushoesale.com> on the grounds set out in section B.2 below.

B.1 Preliminary Matter: Language of the Proceeding

On the matter of the language of the proceedings, the Panel notes the following:

- The Complaint is written in English and the Complainant has made a pre-emptive request that English be the language of this UDRP administrative proceeding;
- The registrar's verification response provided that the language of the registration agreement for the disputed domain name is Chinese; and
- The Complainant's grounds for English to be the language of this UDRP administrative proceeding can be summarised as follows: (i) the disputed domain name is formed by letters in Roman characters, as opposed to Chinese script, and incorporates the terms 'shoe' and 'sale', which are words in the English language; (ii) the disputed domain name resolves to a website which displays content in English; (iii) the Complainant is based in the UK and the Complainant's representative in Sweden, and none of them have knowledge of Chinese language, but they are able to communicate in English, which is the primary language for international relations; and (iv) the Panel's determination of Chinese as the language of the proceeding would be inequitable and burdensome owing to the delay and costs associated with translations.

B.2 Substantive grounds

I. The disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant submits that the disputed domain name <moushoesale.com> is confusingly similar to the Complainant's trade mark, to the extent that the disputed domain name reproduces the trade mark MOU in its entirety. The addition of the generic terms 'shoe' and 'sale' to the disputed domain name string does not prevent a finding of confusing similarity with the Complainant's trade mark MOU.

Furthermore, the gTLDs, in this case <.com>, are typically disregarded by UDRP panels under this Policy ground (see paragraph 1.11 the WIPO Panel Views on Selected UDRP Questions, Third Edition ('WIPO Jurisprudential Overview 3.0')).

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Claimant asserts that the Respondent lacks rights or legitimate interests in respect of the disputed domain name, owing to the following indicia:

- The Respondent is not affiliated or otherwise connected with the Respondent, nor has the Complainant authorised the Respondent to use the trade mark MOU in any form, not least in the disputed domain name;
- The Complainant does not hold any trade mark rights on the disputed domain name or the term 'moushoesale';
- The disputed domain name and the term 'moushoesale' have no meaning in both English and Chinese languages;
- There is no evidence that the Respondent has been commonly known by the disputed domain name or by the term 'moushoesale';
- The Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. The Respondent's website offers for sale footwear products of a Complainant's competitor;

- The Respondent's website previously hosted content bearing the Complainant's trade mark MOU, apparently offering for sale MOU-branded goods, without any disclaimer in a clear and prominent manner stating its lack of relationship with the Complainant. Therefore, this prior use of the disputed domain name cannot be considered a bona fide use and it does not meet the cumulative requirements of the Oki Data test. Moreover, Respondent changed the content of the website once the Complainant has contacted the Registrar to submit a notice of infringement; and
- The composition of the disputed domain name, which wholly incorporates the Complainant's trade mark MOU, together with the generic terms 'shoe' and 'sale', reinforces the likelihood of confusion with the Complainant's trade mark MOU.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

Registration

The Complainant states that the disputed domain name was registered in bad faith, owing to the following indicia:

- The Complainant's trade mark MOU has been in use for more than a decade, well before the registration of the disputed domain name;
- The Complainant holds numerous trade mark registration for MOU worldwide, including in China, where the Respondent appears to reside;
- Internet users are likely to associate 'mou shoe sale' with the Complainant and its trade marks;
- A simple search via online trade mark registers or through Google search engine would have revealed the existence of the Complainant and the trade mark MOU, such that it is inconceivable that the Respondent did not have the Complainant in mind at the time of registration of the disputed domain name;
- Paragraph 3.1.4 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ('WIPO Jurisprudential Overview 3.0') provides that the mere registration of a domain name that is identical or confusingly similar to a famous trade mark, as it is the case here, by an unaffiliated entity, can by itself create a presumption of bad faith; and
- The content of the Respondent's website has changed following the Complainant's contact with the Registrar to seek information to submit a notice of infringement, which supports the inference that the Respondent has registered the disputed domain name in bad faith.

Use

Under this ground, the Complainant avers that the Respondent's purpose is to capitalise on the reputation of the MOU trade mark by diverting Internet users seeking MOU products to the Respondent's website, for financial gain, by intentionally creating a likelihood of confusion with the MOU trade mark as to the source, sponsorship, affiliation, or endorsements of the Respondent's website and/or the goods offered or promoted through the Respondent's website ((paragraph 4(b)(iv) of the UDRP Policy).

The Complainant adduces evidence that the disputed domain name previously resolved to an online shop which prominently displayed the Complainant's trade mark MOU on top of the landing page, in an unauthorised manner and without disclosing the lack of relationship with the Complainant.

Lastly, the Complainant argues that the current use of the disputed domain name diverts Complainant's customers to an online shop which offers ON-branded footwear (a competitor of the Complainant), and that this disrupts the Complainant's business by competing with the Complainant for Internet traffic, and by interfering with the Complainant's ability to control the use of its trade marks.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are set out above.

The Respondent has failed to serve a Response within the deadline prescribed under Rule 5 of the UDRP Rules, or at all.

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 UDRP 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 UDRP 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 UDRP Policy).

PROCEDURAL FACTORS

A. Complainant's Language Request

The Panel is given discretion under Rule 11 of the UDRP Rules to determine the appropriate language of the UDRP administrative proceeding. The Panel notes Rule 10 of the UDRP Rules, which vests the Panel with authority to conduct the proceedings in a manner it deems appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

On this particular matter, the Panel takes the liberty to adopt the language of proceeding test applied in CAC Case no. 104144, *Writera Limited v. alexander ershov*, which helpfully sets out the following six guiding factors:

- (i) the language of the disputed domain name string: the Panel considers that English is the only identifiable language in the disputed domain name string;
- (ii) the content of the Respondent's website: the Respondent's website hosts content in English only, which suggests to the Panel that the Respondent has knowledge of the English language;
- (iii) the language(s) of the Parties: the Complainant is a company based in England and the Respondent appears to be a Chinese national residing in China. Neither English nor Chinese would be considered neutral for both Parties. Consequently, this factor is immaterial to the Panel's determination on this occasion;
- (iv) the Respondent's behaviour: the Panel notes that the Respondent has shown no inclination to participate in this UDRP administrative proceeding;
- (v) the Panel's overall concern with due process: the Panel has discharged its duty under Rule 10 (c) of the UDRP Rules; and
- (vi) the balance of convenience: while determining the language of the UDRP administrative proceeding, the Panel has a duty to consider who would suffer the greatest inconvenience as a result of the Panel's determination. On the one hand, the determination of English as the language of this UDRP administrative proceeding – a widely spoken language – is unlikely to cause the Respondent any inconvenience, not least given that the Respondent's website hosts content in English only. The determination of Chinese as the language of this UDRP administrative proceeding, on the other hand, is very likely to cause the Complainant inconvenience, and to interfere with the overall due expedition of the proceedings under the UDRP Rules.

In view of the above factors, the Panel has decided to accept the Complainant's language request, such that the decision in the present matter will be rendered in English.

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

A. UDRP Threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the following threshold for the Complainant to meet for the granting of the relief sought (transfer of the disputed domain name):

- (i) The disputed domain name is identical or confusingly similar to a trade mark 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.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP administrative proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP Policy grounds in turn.

B. Identical or Confusingly Similar

The Complainant has established registered rights in the mark MOU since as early as 2009.

The disputed domain name <moushoesale.com> was registered on 14 February 2023, and consists of the joint terms 'mou', 'shoe', and 'sale'.

The Panel notes that the Complainant's trade mark MOU is wholly incorporated into the disputed domain name, the only difference being the additional words 'shoe' and 'sale' contiguous with the term 'mou'. In the Panel's view, the generic terms 'shoe' and 'sale' are immaterial to produce any distinctive character and, in turn, insufficient overall to dispel the textual, auditory, and visual confusion with the trade mark MOU. On the contrary, these generic terms enhance the impression that the Respondent is somehow affiliated with the Complainant, particularly given the Complainant's business focus on the sale of footwear.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The Respondent has defaulted in this UDRP administrative proceeding. Nevertheless, the Panel is empowered to draw adverse inferences from the Respondent's silence (Rule 14 (b) of the UDRP Rules).

The Panel notes that the Respondent does not carry out any activity for, or has any business or relationship of any nature with, the Complainant. There is no contractual arrangement between the Parties to that effect, nor has the Complainant otherwise authorised the Respondent to make any use of the Complainant's trade mark. Moreover, there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name.

The Panel also notes that there is no evidence on the record to suggest that the Respondent is affiliated with, or endorsed by, the Complainant (and, in any event, any affiliation or endorsement has been firmly denied by the Complainant).

The Complainant claims that, if the Panel were to apply it, the Respondent would have failed to meet the Oki Data test as a reseller or distributor of the Complainant, for the reasons set out above in section B.2 II above.

On this point, the Panel alludes to the jurisprudential view formed by domain name disputes under the UDRP Policy and UDRP Rules (see WIPO Jurisprudential Overview 3.0, paragraph 2.8), according to which resellers and distributors using a domain name containing a complainant's trade mark to undertake sales related to the complainant's goods or services may be making a bona fide offering of goods and services, and thus have a legitimate interest in such domain name. UDRP panels have termed this as the 'Oki Data test' (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

1. The Respondent must actually be offering the goods or services at issue;
2. The Respondent must use the website associated with the disputed domain name to sell only the trade marked goods or services;
3. The Respondent's website must accurately and prominently disclose its relationship with the Complainant; and
4. The Respondent must not try to 'corner the market' in domain names that reflect the trade mark.

The Parties are reminded that the above requirements are cumulative, so that the failure to satisfy any of them would result in a finding for the Complainant under this UDRP Policy ground.

The Panel has considered the evidence on the record and notes that the Respondent would have failed to meet the Oki Data test, the Panel being unable to locate a disclaimer regarding the relationship between the Respondent and the Complainant.

In light of the Panel's determination of item 3) above, the Panel shall not consider the other requirements of the Oki Data test as any such finding would consequently be immaterial to the outcome of this UDRP administrative proceeding under this UDRP Policy ground.

The Panel is furthermore unconvinced that, before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services.

In addition, the Panel is of the view that the choice of a domain name which incorporates a complainant's trade mark wholly or nearly wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for such coincidence, could further evidence a lack of rights or legitimate interests.

Lastly, there is evidence on the available record suggesting that the Respondent has previously attempted to impersonate the Complainant, as discussed under section D below.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and evidence adduced by the Complainant in this UDRP administrative proceeding, the Panel finds that the Complainant has made prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name under the UDRP Policy.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

D. Registered and Used in Bad Faith

The Panel has looked at the totality of the evidence and considers it to be sufficient to give rise to a finding of bad faith registration and use of the disputed domain name by the Respondent, for the following reasons:

- The disputed domain name <moushoesale.com> incorporates the Complainant's trade mark MOU in its entirety. The presence of the generic words 'shoe' and 'sale' in the disputed domain name string is insufficient to dispel the textual, auditory, and visual confusion established between the disputed domain name and the Complainant's trade mark MOU;
- There is no credible explanation for the Respondent's choice of the disputed domain name, which was registered in 2023, bearing in mind that the Complainant has registered trade mark rights in MOU since as far back as 2009. The Panel does not look favourably upon the Respondent, and finds it that the Respondent was well aware of the Complainant given, most notably, the use on the Respondent's website (as discussed further below);
- The Respondent has not provided a Response within the time prescribed under the UDRP Rules, or at all, and has thus failed to offer any explanation or justification to the matters raised by the Complainant in the context of this UDRP administrative proceeding;
- There is nothing on the record suggesting that the Respondent is affiliated or otherwise connected with the Complainant and the Complainant denies any association;
- The Respondent's website appeared to have commercialised, at some point in time, MOU products in an unauthorised manner, and absent any disclosure as to the relationship between the Respondent and the Complainant. The Panel finds that the Respondent has attempted to suggest an affiliation with, or a connection to, or an endorsement of the Complainant or, rather likely, to impersonate the Complainant through the use of the trade mark MOU on the Respondent's website. The Respondent's behaviour would consequently fall in the realm of paragraph 4(b)(iv) of the UDRP Policy;
- At present, the Respondent's website resolves to an online store which offers for sale footwear products from a Complainant's competitor. The Panel considers that the current use of the disputed domain name would fall within the disruptive behaviour set out in paragraph 4(b)(iii) of the UDRP Policy;
- The Respondent did not provide any evidence of actual or contemplated evidence good faith use of the disputed domain name; and
- Taken the above together, the overall unlikelihood of any good faith use of the disputed domain name.

In view of the above, the Panel finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **moushoesale.com**: Transferred

PANELLISTS

Name	Yana Zhou
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DATE OF PANEL DECISION 2023-06-30

Publish the Decision
