

Decision for dispute CAC-UDRP-105464

Case number	CAC-UDRP-105464
Time of filing	2023-05-31 12:52:36
Domain names	hoodrichjas.com, hoodrichschweiz.com, hoodrichnederland.com, hoodrichsuomi.com, hoodrichdanmark.com, hoodrichportugal.com, hoodrichbelgium.com, hoodrichnorge.com, hoodrichbrasil.com, hoodrichchile.com, hoodrichchaleco.com, xn--hoodrichespaa-tkb.com, hoodrichbulgaria.com, xn--hoodrichmagyarorszg-7ub.com, hoodrichgreece.com, hoodrichhrvatska.com, hoodrichisrael.com, hoodrichlietuva.com, hoodrichromania.com, hoodrichserbia.com, hoodrichsudadera.com, hoodrichtokyo.com, xn--hoodrichtrkiye-osb.com, hoodrichireland.com, hoodrichsouthafrica.com, hoodrichaustralia.com, hoodrichcanada.com, hoodrichuk.org, hoodrichnz.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Hoodrich Limited
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Complainant representative

Organization	HSS IPM GmbH
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Respondents

Name	Qiu Xiaofeng
Name	Stajic NEVENA
Name	Kieran HUGHES
Name	Molla MONJUR ELAHI
Name	Hayden HOWE
Name	Zak BROWNE
Name	Evie CLEMENTS
Name	Isabella BOOTH
Name	Cameron THORPE
Name	Birzu GALINA
Name	Hayrapetyan MARIANNA

Name Richard Prause

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 has a portfolio of various national and international registered marks. It relies on the following marks.

1. Two UK national marks, numbers UK00906391049, registered in 2008, and UK00003360288, registered in 2019, both for the word mark, Hoodrich, in classes 18, 25 & 35.

2. An EUTM, number 006391049, registered in 2008 for the word mark, Hoodrich, in classes 18, 25 & 35.

3. An international mark, number 1599630, applied for in 2021 in classes 18, 25 & 35 in Albania, Australia, Bosnia and Herzegovina, Canada, Switzerland, China, Indonesia, Israel, India, Japan, Korea (Republic of), Montenegro, Republic of North Macedonia, Malaysia, New Zealand, Serbia, Singapore, Thailand, Türkiye.

It also has common law rights arising from use in those common law jurisdictions that recognize them.

The official website of Complainant is at <https://hoodrichuk.com/> and that domain name was registered on 26 March 2015.

FACTUAL BACKGROUND

The Complainant is a British streetwear clothing brand founded in 2014 by Jay Williams and a leader in streetwear inspired urban fashion, offering a wide range of products, but focused on tracksuits, and hoodies and other casual wear.

On 7 March 2023, the 29 disputed domain names, the subject of this case, were registered by these 12 respondents, but all from the same geographic location, namely Central Singapore. Five different but similar IP addresses were used as follows: 165.231.253.42, 165.231.253.43, 165.231.253.44, 165.231.253.45 and 165.231.253.46. The disputed domain names were registered by three different registrars: 1. Paknic (Private) Limited, 2. NETIM SARL and 3. Gransy, s.r.o. At the time of filing the Complaint all twenty-nine (29) disputed domain names were active and resolved to the same websites, namely an online shop (in various languages) that appears to sell the Complainant's clothing.

The Complainant seeks to consolidate the cases against the 12 respondents. Only one respondent acknowledged service of the Complaint. By an email from <prauserrichard@fotemail.com> that respondent stated that he has nothing to do with the matter or the disputed domain name. The others did not respond but appear to have been served at the emails given in the WHOIS information and so validly served under the UDRP and CAC rules.

PARTIES CONTENTIONS

THE COMPLAINANT:

1. Similarity

The disputed domain names incorporate Complainant's registered trademark with the addition of the following business-related terms:

- Geographic Terms: Schweiz (Switzerland), Brasil, UK, Bulgaria, Lietuva (Lithuania), Belgium, Ireland, Canada, Romania, Norge (Norway), Nederland (Netherlands), Danmark (Denmark), Chile, South Africa, Israel, Turkiye and its variation Trkiye along with meaningful letters like xn and osb, España and its variation Espaa along with meaningful letters like xn and tkb, Rvatska, Portugal, Australia, Greece, Magyarország (Hungary) and its variation Magyarorszag along with meaningful letters and numbers xn and 7ub, Suomi (Finland), Tokyo, Serbia, and NZ (New Zealand).
- Clothing Terms: Sudadera (Hoodie), Chaleco (Vest), Jas (Jacket)

The Complainant's trade mark is the dominant and distinctive element in the disputed domain names. The geographic and clothing related terms are generic or descriptive and therefore irrelevant for similarity and do not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademarks.

2. As to legitimate rights and interests, the Complainant denies these online stores are valid distributors or resellers making legitimate or fair use. It says the disputed domain names are not being used in connection with a bona fide offering of goods or services as the online shop(s) fail to satisfy the criteria in *Oki Data Americas, Inc. v. ASD, Inc.* WIPO Case No. D2001-0903 which has the following conditions:

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.

The Complainant says as to condition (1), as the Respondent offers the goods at below market prices and due to the lack of any authorization or distributorship, it can be inferred that the Respondent is selling counterfeit versions. As to (2) it says the below-market prices evidence that these are counterfeit products. The online form login page appears to be an attempt to gather and phish customers' personal information. As to (3) the Respondents do not disclose or disclaim their lack of relationship or connection to the Complainant anywhere on the website and there is a footer "COPYRIGHT © 2023 HOODRICHUK.". This information does not meet the *Oki Data* standard of "accurately and prominently" disclosing the Respondent's relationship with the Complainant. As to (4) the Respondent tries to corner the market in the disputed domain names by use of the mark with geographic and clothing terms.

3 As to Bad Faith, the Complainant says the disputed domain names are in use and resolve to a website on which customers can purchase clothes. The websites associated have the appearance of being official because they contain the Complainant's trademark and they reproduce photographs – without permission – copied from the Complainant's official website. Moreover, the website offers lower prices. This makes it very likely that internet users will assume that there is an association with the Complainant. The addition of the geographic and clothing related terms in the disputed domain names makes it likely that the impression given is that the webshops are affiliated with Complainant. The Respondents intentionally chose the disputed domain names, along with the geographic and clothing-related terms in order to try to generate more traffic to its own business.

THE RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 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 have been registered and are 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

The UDRP policy (the Policy) provides at paragraph 4 as follows:

4. Mandatory Administrative Proceeding.

1. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present(emphasis added)."

1. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint..... Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.

Even though there is no defence, the Policy and the rules do not provide for default decisions. A Complainant must still discharge their burden and the panel will consider potential defences arising on the face of the case.

There is no question that the Complainant has Rights in a mark similar to the disputed domain names, both from its registered marks and arising from its use in trade.

This is an unusual case. There is an obvious connection between these 29 domain names as they were all registered on the same day and from the same place, Singapore. However there are 12 different Respondents. Only one, Mr. Prause, has Responded (informally) to say he has nothing to do with the relevant domain name. It seems likely that all or some of the respondents may be innocent victims whose emails have been harvested or hacked and used to disguise the actual ultimate respondent in fact. If that was the case, and the evidence does not address that, the provision of incorrect information is a standalone ground of bad faith.

The evidence does not reveal who that the actual ultimate respondent in fact is. While this is an uncomfortable position, it does appear that the Complaint has been validly served to the addresses in the WHOIS and duly verified by the Registrars. It seems likely that some or all of the respondents may have become unwittingly involved and without any knowledge. Or they may not have understood the relevance to them of the Complaint.

But there is a scheme here and the single date, place, similar IP addresses, the same modus operandi for the content and names, means consolidation is sensible and this is granted.

The Panel finds the disputed domain names are all and each confusingly similar to the word mark for the first limb of the Policy, the similarity analysis, as they all contain and indeed start with the full word mark of the Complainant, combined with endings that are geographic or generic/descriptive terms. Most have a .com ending. These factors all suggest the site is official and does not signal a mere licensee or retailer or distributor. Panellists tend to find impersonation when a mark is used in these circumstances.

The real issue in the case is in relation to the second limb of the Policy, namely whether there is a legitimate use by a retailer selling the genuine item. That is, the key issue on the very face of this case is whether the Respondent is making a bona fide offering of goods or services as a reseller and has a legitimate right or interest in doing so under the second limb of the Complainant's burden under the Policy.

No trade mark owner has the right to monopolise the resale of second hand or previously lawfully sold goods—including those sold at wholesale. This is the limit to and/or exhaustion of the rights of a trade mark owner. This balances the rights of owners against those of retailers, resellers, second hand dealers and consumers and distributors. The rule also protects descriptive uses necessary to indicate the kind, quality or purpose of goods, provided the use is exercised in accordance with honest practices — which encompasses a duty to act fairly in relation to the legitimate interests of the trade mark owner.

In UDRP jurisprudence this is reflected in the second limb of the Policy and WIPO Case No.D2001-0903 which provide that a reseller/distributor can make a bona fide offering of goods and services under rule 4(c) (i) of the Policy and have a legitimate interest in a domain name, provided that he complies with honest practices. In OKI DATA these were described as four conditions. But they should not be applied too prescriptively and the honesty test is what should be kept in mind. This is in fact appears to be a paradigm reseller case. The issue is whether the honesty test and its acceptable limits on use of a mark by a reseller have been observed here.

The Policy is very clear that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. We noted there is no procedure for a default judgment under the UDRP. Only once a prima facie case is made out will the evidential burden shift to a respondent. In this case, the Complainant commendably addressed this overt issue in the Complaint.

The Complainant says as the online store is not official nor an authorized licensee, then the goods must be counterfeit. However, it is well established in UDRP jurisprudence, that the OKI DATA rule applies to unauthorized or unofficial resellers and repairers just as it does to official agents, per WIPO Case D2001- 1292 (Volvo Trademark Holdings AB) (OKI DATA principles apply as long as he operates a business genuinely revolving around the owners' goods and services) and WIPO Case D2007 -1524 (nascartours) (OKI DATA applies to authorized and unauthorized sellers). See also Bettinger, 2nd Ed. P1387 III.E.310. It is highly likely these are grey goods or genuine goods –technically second-hand goods as sold once at wholesale –and that they are genuine and that this is reseller case. No evidence has been submitted to indicate that the goods displayed for sale at the disputed domain name are counterfeit. The Complainant could have made a test purchase. There is no evidence that consumers placed orders that were not delivered either. The fact that the goods are sold at discount to recommended retail price is not relevant either. That is perfectly legal and also consistent with the goods being genuine.

As to the relevant shop or site that these 29 domains are resolving to, the Complainant says they all resolve to "active content copycat website." But only three pages of the Complainant's official website were provided. The Complainant's site does not look exactly the same nor do the photos appear to be the same. It goes have a similar look and feel however. Screenshots from the "active content copycat websites" are provided and many are in other languages. They all have the same photos. There is no real or cogent evidence before the Panel that these photos are owned or licensed by the Complainant and this is a bare assertion. There is no evidence from a photographer nor other evidence to establish that the Complainant owns or licences the photographs used on the "active content copycat websites."

Here, the OKI Data condition 1 is neutral. As to condition 2, this is a limb of OKI Data that the panel takes issue with, in any event. It is too narrow. A genuine reseller can sell more than one brand online –just as he can offline. Allowing consumers to sign up and create an account is not necessarily for an illegitimate purpose. Condition 2 is met here however, and it does appear that the site(s) of the 29 domains also sell other brands. However, at conditions 3 & 4 we come unstuck. The disputed domain names do not fairly disclose or make clear their relationship to the Complainant or distinguish themselves from the Complainant and they have tried to corner the market by the number and pattern of registrations and choice of the .coms and with geographical terms which suggest the sites are official country sites of the Complainant. If we take for example the screenshot provided in evidence for hoodrichireland.com, it has the relevant copyright notice: Copyright © 2023 hoodrichireland. Arguably it is the opposite of a disclaimer and is also suggestive of an official country site. There is no disclaimer and the panel visited the hoodrichireland.com site on 11 July and could not locate any disclaimer.

The Panel finds the failure to disclaim and the cornering the market takes the use over the line of honest and acceptable conduct by a reseller so that it is not legitimate and fair.

Similarly, that finding is also relevant to, and determinative of, the third limb of the Policy, Bad Faith.

The Panel agrees that the ultimate respondent must have known of the Complainant. The attempt to disguise that individual and their identity and the possible provision of false WHOIS information would also support bad faith as standalone ground. Again, the Panel notes that some or all of the named respondents in this case may not have known anything about these registrations.

The Panel finds this is a case of registration and use in bad faith and orders transfer.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **hoodrichjas.com**: Transferred
2. **hoodrichschweiz.com**: Transferred
3. **hoodrichnederland.com**: Transferred
4. **hoodrichsuomi.com**: Transferred
5. **hoodrichdanmark.com**: Transferred

6. hoodrichportugal.com: Transferred
7. hoodrichbelgium.com: Transferred
8. hoodrichnorge.com: Transferred
9. hoodrichbrasil.com: Transferred
10. hoodrichchile.com: Transferred
11. hoodrichchaleco.com: Transferred
12. xn--hoodrichespaa-tkb.com: Transferred
13. hoodrichbulgaria.com: Transferred
14. xn--hoodrichmagyarorszg-7ub.com: Transferred
15. hoodrichgreece.com: Transferred
16. hoodrichhrvatska.com: Transferred
17. hoodrichisrael.com: Transferred
18. hoodrichlietuva.com: Transferred
19. hoodrichromania.com: Transferred
20. hoodrichserbia.com: Transferred
21. hoodrichsudadera.com: Transferred
22. hoodrichtokyo.com: Transferred
23. xn--hoodrichtrkiye-osb.com: Transferred
24. hoodrichireland.com: Transferred
25. hoodrichsouthafrica.com: Transferred
26. hoodrichaustralia.com: Transferred
27. hoodrichcanada.com: Transferred
28. hoodrichuk.org: Transferred
29. hoodrichnz.com: Transferred

PANELLISTS

Name	Victoria McEvedy
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DATE OF PANEL DECISION 2023-07-12

Publish the Decision
