

Decision for dispute CAC-UDRP-105588

| | |
|----------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Case number | CAC-UDRP-105588 |
| Time of filing | 2023-07-11 09:52:41 |
| Domain names | cotopaxicanada.com, cotopaxialpa.com, cotopaxinz.com, cotopaxiuk.com, cotopaxiireland.com, cotopaxiaustralia.com, cotopaxibelgie.com, cotopaxitrekking.com, cotopaxijapan.com, cotopaxiportugal.com, cotopaxibelgium.com, cotopaxigreece.com, cotopaxischweiz.com, cotopaximochilas.com, cotopaxitas.com, xn--cotopaxiespaa-tkb.com |

Case administrator

| | |
|------|-----------------------------|
| Name | Olga Dvořáková (Case admin) |
|------|-----------------------------|

Complainant

| | |
|--------------|----------------------|
| Organization | Global Uprising, PBC |
|--------------|----------------------|

Complainant representative

| | |
|--------------|--------------|
| Organization | HSS IPM GmbH |
|--------------|--------------|

Respondents

| | |
|------|----------------|
| Name | Qiu Xiaofeng |
| Name | Keira Stephens |

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 owns various trademark registrations for the word "COTOPAXI", including the international registration no. 1343635, which was registered on February 6, 2017, for various goods in class 25 (clothing etc.) and services in class 35 (on-line retail store services featuring clothing etc.). The countries and territories covered by this international registration comprise Australia, China, the European Union, India, Japan, Korea (Republic of), Mexico, and Singapore.

The Complainant also owns the domain name <cotopaxi.com>, registered on September 5, 1998, which the Complainant uses for its official website to promote and sell its "cotopaxi" branded goods.

All disputed domain names were registered on February 28, 2023, i.e., the Complainant's trademark registration cited above predates the registration of the disputed domain names.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a privately held American public benefit corporation (PBC) founded as a vehicle to fight extreme poverty by selling sustainably designed outdoor products. The Complainant operates primarily in the United States, but also has international sales distribution channels in the European Union, Canada, United Kingdom, Australia, New Zealand, and Japan. The Complainant operates as a direct-to-consumer, retail, and wholesale brand. The Complainant contends that due to extensive use, advertising, and revenue associated with the Complainant's "COTOPAXI" trademarks worldwide, the Complainant has become and continues to be an established player in the outdoor gear and apparel sector.

The dispute concerns the following disputed domain names:

1. <cotopaxicanada.com>, combining the Complainant's trademark with the geographical term "Canada";
2. <cotopaxialpa.com>, combining the Complainant's trademark with "allpa", with "Allpa" being a sub-brand which the Complainant uses for a collection of backpacks that are built for adventure travel;
3. <cotopaxinz.com>, combining the Complainant's trademark with the geographical term "NZ" for "New Zealand";
4. <cotopaxiuk.com>, combining the Complainant's trademark with the geographical term "UK" for "United Kingdom";
5. <cotopaxiireland.com>, combining the Complainant's trademark with the geographical term "Ireland";
6. <cotopaxiaustralia.com>, combining the Complainant's trademark with the geographical term "Australia";
7. <cotopaxibelgie.com>, combining the Complainant's trademark with the geographical term "Belgie", which is Flemish for "Belgium";
8. <cotopaxitrekking.com>, combining the Complainant's trademark with the descriptive term (for the Complainant's products) "trekking";
9. <cotopaxijapan.com>, combining the Complainant's trademark with the geographical term "Japan";
10. <cotopaxiportugal.com>, combining the Complainant's trademark with the geographical term "Portugal";
11. <cotopaxibelgium.com>, combining the Complainant's trademark with the geographical term "Belgium";
12. <cotopaxigreece.com>, combining the Complainant's trademark with the geographical term "Greece";
13. <cotopaxischweiz.com>, combining the Complainant's trademark with the geographical term "Schweiz", which is German for "Switzerland";
14. <cotopaximochilas.com>, combining the Complainant's trademark with the descriptive term (for the Complainant's products) "mochilas", which is Spanish for "bags";
15. <cotopaxitas.com>, combining the Complainant's trademark with the descriptive term (for the Complainant's products) "tas", which is Dutch for "bags"; and
16. <xn--cotopaxiespaa-tkb.com>, which is an IDN representing <cotopaxiespaña.com>, i.e., a combination of the Complainant's trademark with "España", which is the Spanish word for "Spain".

Most of the disputed domain names share the following four IP addresses to operate the corresponding websites:

- 231.253.43: two disputed domain names, namely <cotopaxicanada.com> and <cotopaxigreece.com>;
- 231.253.45: two disputed domain names, namely <cotopaxialpa.com> and <cotopaxiireland.com>;
- 231.253.42: six disputed domain names, namely <cotopaxinz.com>, <cotopaxiaustralia.com>, <cotopaxibelgie.com>, <cotopaxiespaña.com>, <cotopaxibelgium.com>, and <cotopaxitas.com>;
- 231.253.44: two disputed domain names, namely <cotopaxitrekking.com> and <cotopaxischweiz.com>.

The remaining disputed domain names each have a different IP addresses.

Two disputed domain names, namely <cotopaxiportugal.com> and <cotopaximochilas.com>, do not resolve to active websites. All other disputed domain names resolve to active websites that use various languages (e.g., English for <cotopaxicanada.com> or Finnish for <cotopaxialpa.com>) but are otherwise very similar. The Complainant contends that all these websites are "copycat websites" that appear to be official "COTOPAXI" online shops, prominently featuring the Complainant's trademark and the Complainant's own product photos, but

- are neither authorized nor licensed by the Complainant,
- allegedly offer the Complainant's products at highly discounted prices (e.g., offering a certain backpack at EUR 47.22 while its official list price is EUR 300.00, or a certain duffel bag at GBP 72.81 while its official list price is GBP 140), and
- do not disclose any information on the Respondent's identity and/or on the Respondent's relationship or connection to the Complainant, if any; the only information that appears at the footer of the websites are variations of the following phrase corresponding with the name of the applicable disputed domain name used for the respective website: "COPYRIGHT © 2023 COTOPAXITAS" (for <cotopaxitas.com>).

Pointing to the well-below-market-rate prices and the lack of any authorization or distributorship, the Complainant contends that the

Respondent is selling counterfeit versions of Complainant's goods.

PARTIES CONTENTIONS

Complainant's contentions are summarised above.

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.

In particular, the Panel considers it adequate to consolidate the disputes regarding all disputed domain names as requested by the Complainant in accordance with paragraph 4(f) of the Policy and paragraphs 3(c) and 10(e) of the Rules.

While there are formally two different Respondents, the Panel is convinced that (i) the domain names and corresponding websites are subject to common control, and (ii) the consolidation is fair and equitable to all parties (in accordance with paragraph 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, the "WIPO Overview 3.0").

The following factors demonstrate the common control for all disputed domain names:

- All disputed domain names were registered on exactly the same date.
- All disputed domain names follow the similar naming patterns <mark-country> or <mark-goods>, respectively.
- Except for <cotopaxiportugal.com> and <cotopaximochilas.com>, all disputed domain names are being used in exactly the same way.
- Except for <cotopaxiespaña.com>, all disputed domain names are registered in the name of the same Respondent, using the same Registrar; but the IP address being used to host the website under <cotopaxiespaña.com>, namely 165.231.253.42, is also used for the websites under <cotopaxinz.com>, <cotopaxiaustralia.com>, <cotopaxibelgie.com>, <cotopaxibelgium.com>, and <cotopaxitas.com>.

These similarities are sufficient to show that all disputed domain names and corresponding websites are subject to common control.

The Complainant has contended that its request to consolidate the proceedings is fair and equitable to all parties. Both Respondents failed to reply to the Complaint, i.e., they have not challenged the Complainant's contention. The Panel sees no reason why it would not be fair and equitable to consolidate the proceedings.

PRINCIPAL REASONS FOR THE DECISION

All disputed domain names are confusingly similar to the Complainant's distinctive trademark "COTOPAXI". The addition of

- the Complainant's own sub-brand "Allpa" in case of <cotopaxiallpa.com>,
- geographical terms such as "Canada" or "NZ" for "New Zealand", or
- generic terms such as "trekking" or the Spanish or Dutch words for "bags"

does not change the overall impression for any of the disputed domain name that the respective designation is connected to the Complainant's trademark "COTOPAXI".

The Panel further finds that the Complainant successfully submitted prima facie evidence that the Respondent has neither made any use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain names, nor is commonly known under the disputed domain names. Using most of the disputed domain names (i.e., all except <cotopaxiportugal.com> and <cotopaximochilas.com>) for "copycat websites" selling counterfeit versions of Complainant's goods may be considered a "use" of the respective disputed domain name in connection with an "offering of goods or services" – but such websites are evidently not a bona fide offering (see below on the corresponding aspects of bad faith). The Complainant's prima facie evidence was not challenged by Respondent.

Regarding most of the disputed domain names which are being used for these "copycat websites" (i.e., all except <cotopaxiportugal.com> and <cotopaximochilas.com>), the Panel further finds that the Complainant successfully submitted prima facie evidence that the Respondent has registered and used these disputed domain name in bad faith, namely by intentionally attempting to attract, for commercial gain, internet users to its websites, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites and the goods advertised for sale therein (paragraph 4(b)(iv) of the Policy). Given that the use of a domain name for a per se illegitimate activity such as the sale of counterfeit goods can never confer rights or legitimate interests on a respondent, such behaviour is manifestly considered evidence of bad faith (see WIPO Overview 3.0, section 3.1.4). Again, the Complainant's prima facie evidence was not challenged by the Respondent.

Regarding the two unused names <cotopaxiportugal.com> and <cotopaximochilas.com>, the Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent was aware of the Complainant's rights in the trademark "COTOPAXI" when registering these domain names. Again, this prima facie evidence was not challenged by Respondent, which allows the conclusion that the disputed domain names were REGISTERED in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Given the fact that <cotopaxiportugal.com> and <cotopaximochilas.com> do not resolve to active websites, the primary question for these two domain names is whether the Respondent has also USED them in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant's case regarding such bad faith use is that the Respondent is effectively engaged in "passive holding" of the disputed domain name within the terms originally established by Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. The panel in Telstra noted that the question as to which circumstances of "passive holding" may constitute use in bad faith cannot be answered in the abstract. This question may only be determined on the basis of the particular facts of each case. A panel should give close attention to all the circumstances of the Respondent's behaviour, and a remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith (cf. Sanofi-aventis v. Gerard Scarretta, WIPO Case No. D2009-0229; Mount Gay Distilleries Limited v. shan gai gong zuo shi, CAC Case No. 100707; RueDuCommerce v. TOPNET, CAC Case No. 100617; INFRONT MOTOR SPORTS LICENCE S.r.l. v. VICTOR LEE, CAC Case No. 100385).

With this approach in mind, the Panel has identified the following circumstances as material to this issue in the present case:

- The Complainant's trademark is highly distinctive. Given the Complainant's market position its trademark is widely known and has a strong reputation;
- the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, nor can the Panel conceive of any such good faith use;
- the Respondent's bad faith regarding all other disputed domain names (i.e., the ones other than <cotopaxiportugal.com> and <cotopaximochilas.com>) indicates that he is willing and able to abuse <cotopaxiportugal.com> and <cotopaximochilas.com> in just the same way.

Considering the Respondent's overall behaviour, the Panel cannot conceive of any plausible actual or contemplated active use of <cotopaxiportugal.com> and/or <cotopaximochilas.com> by the Respondent that would not be illegitimate. The Panel therefore finds that the Respondent's passive holding of the disputed domain names <cotopaxiportugal.com> and <cotopaximochilas.com> also constitutes use in bad faith. All requirements of paragraph 4(a)(iii) of the Policy are therefore met for these two domain names, too.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **cotopaxicanada.com**: Transferred

2. cotopaxialpa.com: Transferred
3. cotopaxinz.com: Transferred
4. cotopaxiuk.com: Transferred
5. cotopaxiireland.com: Transferred
6. cotopaxiaustralia.com: Transferred
7. cotopaxibelgie.com: Transferred
8. cotopaxitrekking.com: Transferred
9. cotopaxijapan.com: Transferred
10. cotopaxiportugal.com: Transferred
11. cotopaxibelgium.com: Transferred
12. cotopaxigreece.com: Transferred
13. cotopaxischweiz.com: Transferred
14. cotopaximochilas.com: Transferred
15. cotopaxitas.com: Transferred
16. xn--cotopaxiespaa-tkb.com: Transferred

PANELLISTS

| | |
|------|--------------------|
| Name | Dr. Thomas Schafft |
|------|--------------------|

DATE OF PANEL DECISION 2023-08-21

Publish the Decision
