

Decision for dispute CAC-UDRP-105756

Case number	CAC-UDRP-105756
Time of filing	2023-09-01 13:58:29
Domain names	golaargentina.com, golachilesale.com, golacolombiashop.com, golaperu.com, golabulgaria.com, golagreece.com, golahungary.com, golaisraelsale.com, golajapanstore.com, golakuwait.com, golalatvija.com, golaromania.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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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RESPONDENTS

Name	Faith Akhtar
Name	Zak Weston

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, between others, the following registered trademarks:

- 1) UK Registration GOLA no. 1097140 - registered on June 1978 and duly renewed for class 18;
- 2) UK Registration GOLA no. 272980 - registered on May 22, 1905 and duly renewed for class 25;
- 3) EU Registration for GOLA no. 1909936 - registered on March 22, 2002 and duly renewed for classes 18, 25 and 28;
- 4) EU Registration for GOLA no. 3399681 - registered on April 17, 2008 and duly renewed for classes 5, 10, 12 and 35;
- 5) 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 the internationally famous 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 names in dispute are:

- (1) <golaargentina.com>
- (2) <golachilesale.com>
- (3) <golacolombiashop.com>
- (4) <golaperu.com>
- (5) <golabulgaria.com>
- (6) <golagreece.com>
- (7) <golahungary.com>
- (8) <golaisraelsale.com>
- (9) <golajapanstore.com>
- (10) <golakuwait.com>
- (11) <golalatvija.com>
- (12) <golaromania.com>

The Complainant notes that all the above domain names were registered on May 31, 2023.

Even if the available Whois data show that domain names sub (1), (2), (3), (4) were registered by Mr. Faith Akhtar while the domain names sub (5), (6), (7), (8), (9), (10), (11), (12) were registered by Mr. Zak Weston, the Complainant believes that all the domain names in dispute are linked and are subject to common control especially because said domain names share many similarities namely: (a) registrants having a personal first name and last name; (b) registrants having an address and postcode in Madrid, Spain but no street name; (c) registrants e-mail addresses comprising a combination of the respondent names and numbers and "@kuomail.com"; d) all the domain names follow the same format i.e. the GOLA mark followed by a country name; e) all the domain names were registered on 31.05.23; f) all the domain names were registered by the same registrar; and g) the content of the underlying websites all mirror each other either exactly or very similarly.

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

Furthermore, the Complainant informs that the domain names in dispute are 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 names. 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.

Finally, the Complainant assumes that the domain names in dispute were 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

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 name have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

Consolidation of Respondents.

According to Article 3(c) of Rules for Uniform Domain Name Dispute Resolution Policy ("Rules"), the Complaint may relate to more than one domain name, provided that the disputed domain names are registered by the same domain-name holder. According to Article 10(e) of Rules a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

The Complainant requests to consolidate its claims against the registrants of the disputed domain names notwithstanding that the registrant details are different, on the grounds that all the disputed domain names are subject to common control and that it is equitable and procedurally efficient to consolidate the proceedings. The Complainant relies on the following factors that all the disputed domain names have in common, namely: (a) registrants having a personal first name and last name; (b) registrants having an address and postcode in Madrid, Spain but no street name; (c) registrants e-mail addresses comprising a combination of the respondent names and numbers and "@kuomail.com"; d) all the domain names follow the same format i.e. the GOLA mark followed by a country name (sometimes followed by a generic term); e) all the domain names were registered on 31.05.23; f) all the domain names were registered by the same registrar; and g) the Panel has accessed to all the website associated with the disputed domain names and has verified identical contents and layouts.

On the light of the above Complainant considerations, and notwithstanding the clear existence of two different registrants (Respondents), the Panel considers that all the disputed domain names are under the same common control. In addition to the points raised by the Complainant, it must be noted that all the websites connected to the disputed domain names pretend to give the impression to be official websites of the Complainant.

In previous cases similar to the one at hand the Panel has decided to order the consolidation (see, for example, Tod's SPA v Web Commerce Communications Limited; CAC Case No. 103815 and D. Jacobson & Sons Limited v Marcel Baum; CAC Case No. 104399) and the Panel therefore agrees to the Complainant's request, even considering that, due to the circumstances of the present case, it is equitable and procedurally efficient to consolidate the proceedings.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy provides that to obtain the transfer of the domain name, the complainant must prove that each of the following elements is present:

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

1) The Complainant has demonstrated rights through registration and use on the GOLA trademark. The Panel finds that the disputed domain names are confusingly similar to the GOLA trademark of the Complainant. Actually, all the disputed domain names incorporate said trademark of the Complainant in its entirety. This is sufficient to establish confusing similarity (Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525). Furthermore, terms as "store", "shop" or "sale", which are generic words related to the Complainant's business, do not prevent a finding of confusing similarity between the disputed domain names and the GOLA trademark, as well as the addition of geographic terms

(argentina/chile/colombia/peru/bulgaria/greece/hungary/israel/japan/kuwait/latvija/romania).

In addition, as a mere technical part of the disputed domain name, the gTLD “.com” may be disregarded in determining confusing similarity. Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are confusingly similar to trademark in which the Complainant has rights. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant demonstrated that almost all the websites to which the disputed domain names are linked allegedly offer for sale authentic merchandise bearing the GOLA trademark. The Complainant clearly considers that Respondent has the hope and the expectation that Internet users looking for the brand GOLA will be directed to the websites corresponding to the disputed domain names. The Panel finds that said activity, of course, does not provide a legitimate interest in the disputed domain names under the Policy. Furthermore, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain names as it was never authorized to use the GOLA trademark by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain names. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the disputed domain names registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the 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 names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain names primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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 or service on the Respondent's website or location.

The Respondent registered the disputed domain names decades after the use and registration of the GOLA mark by the Complainant. In consideration of the reputation achieved by GOLA it is clear that the Respondent was surely aware of the Complainant trademark when he registered the domain names in dispute. Moreover, the Respondent appears to have attempted to benefit commercially from the appropriation of the GOLA mark in the disputed domain names. The use of the famous mark GOLA, well-known worldwide in the footwear and bags sectors, for selling shoes and bags, clearly indicates that the disputed domain names were chosen by the Respondent to take advantage of the Complainant's marks reputation. This finding leads to the obvious conclusion that the disputed domain names have been registered in bad faith (Research In Motion Limited v. Privacy Locked LLC/Nat Collicot - WIPO Case No. D2009-0320; The Gap, Inc. v. Deng Youqian - WIPO Case No. D2009-0113; AXA S.A. v. P.A. van der Wees - WIPO Case No. D2009-0206; BHP Billiton Innovation v. Ravindra Bala - WIPO Case No. D2008-1059).

The Panel also finds that, by linking the disputed domain names to websites offering for sale alleged GOLA items, the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain, by causing a likelihood of confusion with the trademark GOLA as to the source, sponsorship, affiliation or endorsement of its websites and the products promoted therein. The conduct described above clearly falls within paragraph 4(b)(iv) of the Policy (Triumph International Vietnam Ltd v. Tran Quoc Huy - WIPO Case No. D2017-0340).

In consideration of the above, the Panel concludes that the Respondent registered and is using the disputed domain names in bad faith. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **golaargentina.com**: Transferred
2. **golachilesale.com**: Transferred
3. **golacolombiashop.com**: Transferred
4. **golaperu.com**: Transferred
5. **golabulgaria.com**: Transferred
6. **golagreece.com**: Transferred
7. **golahungary.com**: Transferred
8. **golaisraelsale.com**: Transferred

- 9. **golajapanstore.com**: Transferred
- 10. **golakuwait.com**: Transferred
- 11. **golalatvija.com**: Transferred
- 12. **golaromania.com**: Transferred

PANELLISTS

Name	Guido Maffei
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DATE OF PANEL DECISION	2023-10-05
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Publish the Decision
