

Decision for dispute CAC-UDRP-105713

Case number	CAC-UDRP-105713
Time of filing	2023-09-04 08:56:34
Domain names	karhulenkkaritale.com, karhutrainersuk.com, karhuparis.com, teniskarhumexico.com, karhusouthafricas.com, karhukengatsuomi.com, karhu-nz.com, karhutrainerssales.com, karhu-espana.com, karhulaufschuhesale.com, karhuoutlet.com, karhushoessale.com, karhuespana.com, karhubrasil.com

Case administrator

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

Organization	Karhu Holding B.V.
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Complainant representative

Organization	Carlos Mendez (Coöperatie SNB-REACT U.A.)
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Respondents

Organization	Web Commerce Communications Limited
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Name	Qiu Xiaofeng
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Organization	Whoisprotection.cc
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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

It results from the evidence provided by the Complainant, which remained undisputed, that the Complainant holds several trademark registrations containing or consisting of the word element KARHU, in particular US trademark KARHU (word), registered on February 16, 1971, with no. 0907891 for goods in classes 25 and others. This mark has duly been renewed and is in force.

FACTUAL BACKGROUND

The Complainant runs a 105-year-old brand for sneakers and sports apparel originating in The Netherlands.

The Complaint is directed against three Respondents and their respective disputed domain names as listed hereinafter (including the

dates on which the disputed domain names have respectively been registered):

(1) Web Commerce Communications Limited:

<karhulenkkaritale.com> (reg. 2021-08-30; no use)
<karhutrainersuk.com> (reg. 2022-01-10; no use)
<karhuparis.com> (reg. 2022-03-02; no use)
<teniskarhumexico.com> (reg. 2022-04-24; no use)
<karhusouthafricas.com> (reg. 2022-05-06; no use)
<karhukengatsuomi.com> (reg. 2022-07-22; no use)
<karhu-nz.com> (reg. 2022-10-27; no use)
<karhutrainerssales.com> (reg. 2022-11-12; no use)
<karhu-espana.com> (reg. 2022-11-28; no use)
<karhulaufschuhesale.com> (reg. 2023-02-01; no use)

(2) Qiu Xiaofeng:

<karhuoutlet.com> (reg. 2022-12-26; no use)

(3)

Whoisprotection.cc:

<karhushoessale.com> (reg. 2021-05-09; no use)
<karhuespana.com> (reg. 2021-05-11; no use)
<karhubrasil.com> (reg. 2021-05-17; no use)

It results from the Registrar's verification response that the registration language for all disputed domain names is English.

Finally, the undisputed evidence before the Panel shows that all disputed domain names resolve to web shops prominently featuring in the header the KARHU trademark and allegedly selling the Complainant's shoes in part at highly discounted prices.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

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 are met and there is no other reason why it would be inappropriate to provide a decision.

In particular, the Panel accepts the consolidated Complaint against all disputed domain names.

Paragraph 10(e) of the Rules empowers a Panel to consolidate multiple domain disputes in accordance with the Policy and Rules.

A consolidated complaint may be accepted where the criteria described below are *prima facie* met. Furthermore, it is up to the Panel to issue a final determination on consolidation, which may apply its discretion in certain circumstances to order the separation of a filed complaint. In all cases, the burden falls to the party seeking consolidation to provide evidence in support of its request (see paragraph 4.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "Overview 3.0").

Furthermore, where a complaint is filed against multiple respondents, as in the case at hand, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario (Overview 3.0, paragraph 4.11.2).

In the present case the Panel notes that the disputed domain names are registered on the name of three different Registrants.

All disputed domain names contain the same trademark (i.e. KARHU) and have been created following the same naming pattern with the trademark KARHU placed at the beginning of the domain name (except for <teniskarhumexico.com>) and followed by non-distinctive terms or abbreviations, such as descriptive or geographic terms. Furthermore, the Registrar indicated for the disputed domain names is identical (i.e. ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED) except for <karhuoutlet.com> registered with a different Registrar. Finally, all Respondents are actively using domain names for the same content, i.e. for a web shop prominently featuring in the header the KARHU trademark and allegedly selling the Complainant's shoes in part at highly discounted prices. In the light of the above facts, the Panel has no doubt that all disputed domain names are subject to common control.

This is also the case for <karhuoutlet.com>, the only domain name with a different Registrar. Also, this domain name follows the same naming pattern than the other domain names and is being used for the same type of web shop.

Finally, the three Registrants had the possibility to object the consolidation and respond to the Complaint but opted not to participate to these proceedings.

The Panel therefore does not see any reasons why a consolidation should not be fair and equitable and proceeds to deliver this decision regarding all disputed domain names.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name(s) should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (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 is satisfied that the registrants of record for the disputed domain names are the Respondents and will therefore proceed to analyse whether the three elements of paragraph 4(a) of the Policy are satisfied:

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights.

The Complainant is - amongst others - the owner of US trademark KARHU (word), registered on February 16, 1971, with no. 0907891 for goods in classes 25 and others. This mark has duly been renewed and is in force.

The Panel notes that the Complainant's registered trademark KARHU is fully included in all disputed domain names and merely followed (and in one case preceded) by non-distinctive terms or abbreviations, such as descriptive or geographic terms. It is the view of

this Panel that the combination of the trademark KARHU with such terms or abbreviations does not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademark. In fact, in accordance with the Overview 3.0, section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

The Top-Level Domain ".com", which is a technical requirement, is generally disregarded for the purpose of the analysis of confusing similarity (WIPO Overview 3.0, section 1.11.1).

In the light of the above, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondents have no rights or legitimate interests in respect of the disputed domain names.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate a Respondent's rights or legitimate interests in a disputed domain name. In the Panel's view, based on the Complainant's undisputed allegations, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondents lack rights or legitimate interests in the disputed domain names.

(1) First, the Panel notes that there is no evidence in the record or Whois information showing that the Respondents might be commonly known by the respective disputed domain names in the sense of paragraph 4(c)(ii) of the Policy.

(2) In addition, it results from the Complainant's uncontested evidence that all disputed domain names resolve to a web shop prominently featuring in the header the KARHU trademark and allegedly selling the Complainant's shoes in part at highly discounted prices. However, as the Complainant undisputedly brought forward, it has no relationship whatsoever with the Respondents and has never licensed or otherwise authorized the Respondents to use the "KARHU" trademark on the websites or in the disputed domain names. In this Panel's view, such use cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such use is likely to mislead Internet users. In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use these respective domain names.

(3) The Panel further notes that there is no evidence in the record either showing that the Respondents might be making a noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the Panel considers it obvious that the Respondents wanted to mimic the Complainant's original website, brand and products under these domain names which entirely incorporate the trademark KARHU. Noting the absence of any disclaimer, the disputed domain names' content exacerbates the confusion caused by the incorporation of the Complainant's - distinctive - trademark in the disputed domain names by further impersonating the Complainant. Accordingly, further to section 2.8 of the Overview 3.0, the Respondents' use of the disputed domain names to host impersonating webstores excludes any *bona fide* offering, noncommercial, or fair use of the disputed domain names from the outset. In addition, since the disputed domain names are used for commercial websites, any noncommercial use is excluded from the outset.

(4) It is acknowledged that once the panel finds a *prima facie* case has been established, the burden of production shifts to the respondent to come forward with relevant and concrete evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondents in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondents have no rights or legitimate interests in the disputed domain names.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain names have been registered and are being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain names' registration and use in bad faith.

(1) One of these circumstances that the Panel finds applicable is that the Respondents by using the disputed domain names, have intentionally attempted to attract, for commercial gain, internet users to their websites or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of their website or location or of a product or service on their website or location (paragraph 4(b)(iv) of the Policy).

It results from the documented and undisputed evidence provided by the Complainant that all the disputed domain names resolve to web shops prominently featuring in the header the KARHU trademark and allegedly selling the Complainant's shoes in part at highly discounted prices. However, the Complainant has not given any authorization for such use and is not linked to the Respondents. For the Panel, it is therefore evident that the Respondents positively knew the Complainant's trademarks and products. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondents also knew that the disputed domain names included the Complainant's trademark KARHU entirely when they registered the respective domain names. Registration of a domain name which contains a third party's trademark, in awareness of said trademark and in the absence of rights or legitimate interests is suggestive of registration in bad faith (see e.g. Vorwerk International AG v. ayoub lagnadi, Lagnadi LTD, WIPO Case No. D2022-1592 with further references). While the ability to purchase the goods is not known to the Panel, the alleged commercial offering and impersonation of the Complainant is sufficient to establish the Respondents' bad faith intent to mislead Internet users.

(2) Finally, the finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- the distinctiveness of the trademark KARHU which has existed since 1971;
- the trademark KARHU is fully and identically incorporated in all disputed domain names. At the date the Respondents registered the disputed domain names, Complainant had been using that designation in commerce for several decades;
- the Respondents' failure to submit a formal response;
- the Respondents' failure to provide any evidence of actual or contemplated good-faith use;
- the implausibility of any good faith use to which the disputed domain names may be put and
- the fact that the Respondents hide their identity behind a privacy shield.

In the light of the above the Panel finds that the disputed domain names have been registered and are being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **karhulenkkaritale.com**: Transferred
2. **karhutrainersuk.com**: Transferred
3. **karhuparis.com**: Transferred
4. **teniskarhumexico.com**: Transferred
5. **karhusouthafricas.com**: Transferred
6. **karhukengatsuomi.com**: Transferred
7. **karhu-nz.com**: Transferred
8. **karhutrainerssales.com**: Transferred
9. **karhu-espana.com**: Transferred
10. **karhulaufschuhesale.com**: Transferred
11. **karhuoutlet.com**: Transferred
12. **karhushoessale.com**: Transferred
13. **karhuespana.com**: Transferred
14. **karhubrasil.com**: Transferred

PANELLISTS

Name	Tobias Malte Müller
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DATE OF PANEL DECISION 2023-10-23

Publish the Decision
