

Decision for dispute CAC-UDRP-105947

Case number	CAC-UDRP-105947
Time of filing	2023-11-09 09:50:11
Domain names	hoganayakkabi.com, hogandanmark.com, hoganlisboa.com, hogan-norge.com, hoganoutletmexico.com, hogan-schoenen.com, hogan-belgie.com, hoganfactoryoutlet.com, hogan-india.com, hogan-ireland.com, hogan-italiaoutlet.com, hoganshoesdubai.com, hogansneakersoutlet.com, hogansrbija.com, hogansale.com, hoganshoesit.com, hogan-it.com, hoganoff.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	TOD'S S.p.A.
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Complainant representative

Organization	Convey srl
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RESPONDENTS

Organization	Web Commerce Communications Limited
Name	Lang Shunan

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

According to the evidence submitted by Complainant, Complainant is the owner of the following trademarks:

- International Trademark HOGAN, No 1014831 with registration date 24 July 2009;
- European Union Trademark HOGAN, No 005184536 with registration date 20 January 2010.

FACTUAL BACKGROUND

According to the information provided by the Complainant, the disputed domain names:

<hoganayakkabi.com>, <hogandanmark.com>, <hoganlisboa.com>, <hogan-norge.com>, <hoganoutletmexico.com>, <hogan-schoenen.com>, <hogan-belgie.com>, <hoganfactoryoutlet.com>, <hogan-india.com>, <hogan-ireland.com>, <hogan-italiaoutlet.com>,

<hoganshoesdubai.com>, <hogansneakersoutlet.com>, <hogansrbija.com>, <hogansale.com>, <hoganshoesit.com>, <hogan-it.com>, <hoganoff.com>, were registered on various dates in 2023.

According to the information provided by Complainant the disputed domain names resolve to websites which copy the content of the website of Complainant and offer for sale counterfeit products of Complainant.

PARTIES CONTENTIONS

COMPLAINANT:

According to the evidence submitted by Complainant, Complainant is the operating holding of a Group, amongst the leading players in the world of luxury goods, with various trademarks, including HOGAN, with about 4.890 employees worldwide. Complainant has numerous stores around the world, about 403 mono-brand stores, including showrooms and large flagship stores in Europe, the United States, China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia.

The registration agreement for the disputed domain name <hoganoff.com> is Chinese. Complainant requests that the proceeding is in English in light of the circumstances that the website corresponding to the disputed domain name is in English and Italian and that the disputed domain name contains Latin characters and the English word "off". These evidences reveal that Respondent has knowledge of the English language and understands English.

Complainant also requests consolidation of all disputed domain names. With the exception of <hoganoff.com>, all disputed domain names are registered in the name of the same Respondent. All websites under the disputed domain names currently or previously shared the same similarities: same products offered for sale, same use of copyrighted pictures, same lay-out of the websites and use of the trademark HOGAN and the black banner in the headers.

Complainant submits that the disputed domain names are confusingly similar to Complainant's HOGAN trademark. The trademark HOGAN, registered since many years, is distinctive and well-known all around the world in the sector of shoes and apparels. The trademark is included in its entirety in the disputed domain names; the addition of various generic and geographical words is not sufficient to avoid the likelihood of confusion with Complainant's trademark.

According to Complainant, Respondent has no rights or legitimate interest in the disputed domain names. Respondent is not a licensee, authorized agent of Complainant or in any other way authorized to use Complainant's trademark. Specifically, Respondent is not an authorized reseller of Complainant and has not been authorized to register and use the disputed domain names. Complainant submits that the disputed domain names are redirected by Respondent to websites where Complainant's trademarks HOGAN are published and counterfeit HOGAN branded products are offered for sale. Therefore such use of the disputed domain names cannot be deemed a legitimate non-commercial or fair use without intent for commercial gain.

According to Complainant the disputed domain names are registered and are being used in bad faith. In light of the registration and intensive use of the trademark HOGAN since 1986 and the advertising and sales of Complainant's products worldwide, Respondent could not have possibly ignored the existence of Complainant's trademark.

Complainant submits that the use of the disputed domain names in connection with commercial web sites where Complainant's trademark is misappropriated and where counterfeit HOGAN branded shoes are offered for sale clearly indicates that Respondent's purpose in registering and using the disputed domain names was to capitalize on the reputation of Complainant's trademark by diverting Internet users seeking HOGAN products to his website for financial gain.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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 Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant has, to the satisfaction of the Panel, shown 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

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 decides in accordance with paragraph 11(a) of the UDRP Rules that English is the language of the proceeding for the disputed domain name <hoganoff.com>. In accordance with section 3.3. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") the Panel takes into account that the website corresponding to this disputed domain name includes Complainant's well-known trademark, is in English and Italian and that this disputed domain name contains Latin characters and the English word "off". Finally, the Panel notes that there is lack of reaction on the part of Respondent after having been given a fair chance to comment.

The Panel decides in accordance with paragraph 10 (e) of the UDRP Rules to consolidate the multiple domain name disputes. According to WIPO Overview 3.0, section 4.11.2, consolidation is in order in situations in which the domain names are subject to common control and the consolidation would be fair and equitable and procedurally efficient to all parties. The Panel notes in this respect the following. All disputed domain names are a combination of the HOGAN trademark and a descriptive, geographical or generic term. The Panel thus concludes that on the balance of probabilities it is likely that the disputed domain names are under common control. Respondents did not react to Complainant's request for consolidation. The Panel concludes that consolidation is in order, also in view of the fact that it is equitable and procedurally efficient to allow consolidation. In this decision all Respondents are referred to as "Respondent".

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

In the opinion of the Panel the disputed domain names are confusingly similar to Complainant's HOGAN trademark. Many UDRP decisions have found that a disputed domain name is identical or confusingly similar to a complainant's trademark where the relevant trademark is recognizable within the disputed domain name. Complainant has established that it is the owner of trademark registrations for HOGAN. The disputed domain names incorporate the entirety of the well-known HOGAN trademark as its distinctive element. The addition of the various descriptive, geographical and generic terms is insufficient to avoid a finding of confusing similarity. The Top-Level Domain ("gTLD") ".com" in the disputed domain names may be disregarded. The Panel notes that Complainant's registration of its trademark predates the creation date of the disputed domain names.

In the opinion of the Panel Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain names. Complainant has not licensed or otherwise permitted Respondent to use its trademark or to register the disputed domain names incorporating its mark. Respondent is not making a legitimate noncommercial or fair use of the disputed domain names without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of Complainant. Respondent is not commonly known by the disputed domain names nor has it acquired trademark rights. Complainant has no relationship with Respondent. In addition Complainant has demonstrated that the disputed domain names resolve to websites where Complainant's trademarks HOGAN are published and counterfeit HOGAN branded products are offered for sale which does not does not represent a bona offering of goods or services.

Respondent did not submit any response.

Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain names.

The Panel finds that the disputed domain names have been registered and are being used in bad faith. Complainant has rights in the HOGAN trademark. Respondent knew or should have known that the disputed domain names include Complainant's well-known mark. The Panel also notes the undisputed submission of Complainant that the disputed domain names resolve to websites which incorporate Complainant's trademark in its entirety and which sell counterfeit HOGAN branded products, which indicates that Respondent registered and used the disputed domain names with the intention to attract, for commercial gain, Internet users to the websites by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

Finally the Panel observes that Respondent is a serial cybersquatter with in the year 2023 already 29 decisions of Czech Arbitration Court panels against Respondent in similar cases.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **hoganayakkabi.com**: Transferred
2. **hogandanmark.com**: Transferred
3. **hoganlisboa.com**: Transferred
4. **hogan-norge.com**: Transferred
5. **hoganoutletmexico.com**: Transferred
6. **hogan-schoenen.com**: Transferred
7. **hogan-belgie.com**: Transferred
8. **hoganfactoryoutlet.com**: Transferred
9. **hogan-india.com**: Transferred
10. **hogan-ireland.com**: Transferred
11. **hogan-italiaoutlet.com**: Transferred
12. **hoganshoesdubai.com**: Transferred
13. **hogansneakersoutlet.com**: Transferred
14. **hogansrbija.com**: Transferred
15. **hogansale.com**: Transferred
16. **hoganshoesit.com**: Transferred
17. **hogan-it.com**: Transferred
18. **hoganoff.com**: Transferred

PANELLISTS

Name	Dinant T.L. Oosterbaan
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DATE OF PANEL DECISION	2023-12-11
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Publish the Decision
