

Decision for dispute CAC-UDRP-105956

Case number	CAC-UDRP-105956
Time of filing	2023-11-10 09:08:43
Domain names	hoganargentina.com, hogancolombia.com, hoganhrvatska.com, hoganmexicostore.com, hoganromania.com, hoganslovenijashop.com, hoganuruguay.com, hoganbrasilshop.com, hoganchile.com, hogancz.com, hoganaustraliasale.com, hoganbelgique.com, hogandanmarkonline.com, hoganeesti.com, hoganirelandshop.com, hogannederlandsale.com, hoganportugalsale.com, hogansouthafrica.com, hogansuomi.com, hogannorgeoutlet.com, hogansuisse.com, hoganbelgieshop.com, hogansrbijastore.com, hogancanadasale.com, hoganbulgaria.com, hoganjapan.com, hoganlatvija.com, hoganlietuva.com, hoganisrael.com, hogankuwait.com, hoganuae.com, hogangreece.com, hoganuk.com, todsbulgaria.com, todsjapan.com, todslietuva.com, todsshoeslatvija.com, todsshopeesti.com, todsuae.com, todskuwait.com, todsisrael.net

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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

Name	Victoria Cooke
Name	Kiera Higgins
Name	Adam Gough
Name	Dylan Skinner
Name	Declan Craig
Organization	NA
Name	Shannon Barnes

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 trademark registrations for the marks TOD'S and HOGAN, among others, the following:

For the mark TOD'S:

- European trademark Reg. No. 010158889 registered on December 19, 2011 in classes 3, 9, 14, 18, 25, 35;
- European trademark Reg. No. 000407031 registered on September 13, 2004 in class 9;
- International trademark Reg. No. 1006548 registered on June 1, 2009 in 14;
- International trademark Reg. No. 858452 registered on May 20, 2005 in classes 3, 9, 18, 25, 35;
- United States trademark Reg. No. 1459226 registered on September 29, 1987 in classes 3, 9, 18, 25, 35; and
- Australian trademark Reg. No. 1498996 registered on November 12, 2012 in classes 3, 9, 25, 35.

For the mark HOGAN:

- International trademark Reg. No. 774193 registered on December 18, 2021 in classes 3, 9, 18, 25;
- International trademark Reg. No. 1129649 registered on March 23, 2012 in classes 3, 9, 18, 25; and
- European Union trademark Reg. No. 005184536 registered on January 20, 2010 in classes 3, 9, 18, 25, 35.

FACTUAL BACKGROUND

The Complainant, Tod's S.p.A., is a company with headquarters in Italy. It has its roots in the early '900. Its first success came with the Gommino driving shoe, which has gummy little rubber pebbles on the soles. In few years the production was expanded to the bags and in 1997 the D-Bag was launched becoming in few years an iconic model. From 2006 and 2009 the Complainant introduced ready-to-wear, promoting the apparels with the celebrities as Katie Holmes, Jessica Alba and Gwyneth Paltrow, and sunglasses. The brand HOGAN was founded in 1985 with the aim of creating the concept of luxury sneaker. In 2011, Tod's Group sponsored the restoration of the Colosseum in Rome with a disbursement of €25m in five years, it has also been a permanent founding member of the Fondazione Teatro alla Scala and one of main sponsor of Padiglione di Arte Contemporanea (PAC) in Milan. The Complainant has numerous stores around the world, about 403 mono-brand stores, including showrooms and large flagship stores in Europe, the U.S., China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia. 2022 annual revenues of the Complainant's Group were almost 668 million of Euros of which almost 50% came from the trademark TOD'S.

The disputed domain names were registered on May 25, 2023; June 19, 2023; June 20, 2023; July 22, 2023; and October 7, 2023.

The disputed domain names have been resolved to websites where the Complainant's trademarks TOD'S and HOGAN are published, and prima facie counterfeit products are offered for sale.

The Complainant sent a cease-and-desist letter to the Respondent on October 19, 2023.

PARTIES CONTENTIONS

COMPLAINANT:

i) The Complainant has rights in the TOD'S and HOGAN marks as identified in section "Identification of rights" above. The disputed domain names are confusingly similar to the Complainant's TOD'S and HOGAN marks because they incorporate the Complainant's marks in their entirety and add non-distinctive elements such as geographical terms, generic commercial terms and the generic top-level domains ".com" and ".net."

ii) The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademarks. The Respondent is not commonly known by the disputed domain names. The Respondent has not provided a bona fide offering of goods or services in connection with the disputed domain names. The disputed domain names have been redirected by the Respondent to websites where the Complainant's trademarks TOD'S and HOGAN are published, and prima facie counterfeit products are offered for sale. There is no disclaimer as to the Respondent's lack of relationship with the Complainant.

iii) The Respondent has registered and is using the disputed domain names in bad faith. The use of the disputed domain names in connection with commercial websites where the Complainant's trademarks are misappropriated and prima facie counterfeit TOD'S and HOGAN branded products are offered for sale, clearly indicates that the Respondent's purpose for registering the disputed domain names was to capitalize on the reputation of the Complainant's trademarks. The Respondent has been engaged in a pattern of conduct preventing the Complainant from reflecting the marks in the disputed domain names. The Respondent had knowledge of the Complainant's rights in the TOD'S and HOGAN marks before registering the disputed domain names, which constitutes bad faith registration.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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

PRELIMINARY ISSUE: MULTIPLE RESPONDENTS

The Complainant has alleged that it is likely that the disputed domain names are under the control of a single entity and consolidation is appropriate in this matter. Paragraph 3(c) of the Rules (the "Rules") for the Uniform Domain Name Dispute Resolution Policy (the "UDRP" or "Policy") provides that a "complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder." The Complainant contends that the disputed domain names are subject to an evident common control, thus making the consolidation of the dispute equitable and procedurally efficient. The disputed domain names, which all incorporate the trademarks TOD'S and HOGAN in their entirety, are under the control of a single individual or entity or, at least, reflective of a group of individuals acting in concert given that:

- (i) There are circumstances indicating that different registrants were alter egos of the same beneficial holder: (a) cases where respondents had common administrative contact or technical contact, or other instances of commonality in the registration information, such as the same postal address or email address; and (b) circumstances indicating that a single person or entity had registered multiple domain names using fictitious names;
- (ii) Substantial commonalities in the websites to which the disputed domain names resolved and the use of the same domain name servers; and
- (iii) The incorporation of the Complainants' trademarks in its entirety together with a descriptive or geographical term.

The first group of the disputed domain names has been registered using the registrar ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED being the registrant's country indicated in the Whois is the same, *i.e.* Spain, and the corresponding websites are identical, showing in foreground the word "SALES";

The second group of the disputed domain names has been registered using the registrar Paknic Private Limited being the registrant organization is Web Domains By Proxy. The corresponding websites show in foreground the word "SALES," which are identical to the ones in the first group, including for the favicons of the websites of both groups; and

The third group of the disputed domain names, including all the trademark TOD'S, has been registered using the registrar ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED being the registrant's country indicated in the Whois is the same, *i.e.*

Italy, and the corresponding websites are identical.

Each website described in the above-mentioned groups has the following similarities:

- *the banner in the header dedicated to the free delivery, the lower price guarantee, the extra discount for the first order and the return policy;*
- *same footer;*
- *the wording of the disclaimers: Copyright © 2023 "domain name without the extension";*
- *the icons of Social Media indicated in identical position: Facebook, Twitter, Pinterest, Instagram, TikTok and WhatsApp;*
- *same ways of payment: Visa, Mastercard, PayPal, Amazon, Google Wallet;*
- *identical subscription to the newsletter; and*
- *identical lay-out of the contact form.*

In light of all the information related above and the relationships between the use of the disputed domain names in each group, the Complainant believes that the present one is a clear case where the disputed domain names are under the actual control of a single individual or entity or, at least, reflective of a group of individuals acting in concert.

The Complainant provides exhibits showing the circumstances as listed above. The Panel finds that the circumstances indicated above are concrete and sufficient to prove that the disputed domain names are subject to a common control by a single entity. The Panel agrees and finds that the disputed domain names are commonly owned/controlled by a single Respondent who is using multiple aliases. Throughout the decision, the Respondents will be collectively referred to as "Respondent."

The Panel is satisfied that all other 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

Paragraph 15(a) of the Rules for the Policy instructs this Panel to "decide a complaint on the basis of the statements and documents submitted 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 that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (2) the respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnetmarketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights and Confusing Similarity

The Complainant claims rights in the TOD'S and HOGAN marks as identified in the section 'Identification of Rights' above. The Panel notes that international trademark registrations, EUIPO trademark registrations, and national trademark registrations are sufficient to establish rights in those marks. Since the Complainant provides evidence of the trademark registrations above, the Panel finds that the Complainant has established rights in the marks TOD'S and HOGAN. The Complainant contends that the disputed domain names are confusingly similar to the Complainant's marks because the disputed domain names incorporate the Complainant's marks TOD'S and HOGAN in their entirety with the addition of non-distinctive elements such as geographical terms, generic commercial terms and the generic top-level domains .com and .net.

The Panel notes that all of the disputed domain names incorporate the TOD'S mark or the HOGAN mark in their entirety and add generic, geographic terms and/or non-distinctive elements such as "store," "online," "outlet," "sale," "shop," etc. and/or geographical

indications such as “Argentina”, “Columbia,” “Kuwait,” “Israel,” etc. along with the generic top-level domains “.com” and “.net.” Adding a generic, descriptive and/or geographic term and a gTLD to a mark fails to sufficiently distinguish a disputed domain name from a mark per Policy paragraph 4(a)(i). See *MONCLER S.P.A. v. Qiu Xiaofeng, Agayeva SEVINC, Petrosyan YELENA, Birzu GALINA, Karapetyan IRINA, CAC-UDRP-105522* (CAC July 18, 2023) (“Adding a generic term and a gTLD to a mark fails to sufficiently distinguish a disputed domain name from a mark per Policy paragraph 4(a)(i).”); see also *Dell Inc. v. pushpender chauhan*, FA 1784548 (Forum June 11, 2018) (“Respondent merely adds the term ‘supports’ and a ‘.org’ gTLD to the DELL mark. Thus, the Panel finds Respondent’s disputed domain name is confusingly similar to Complainant’s DELL mark per Policy paragraph 4(a)(i).”). Therefore, the Panel finds the disputed domain names are confusingly similar to the Complainant’s marks per Policy paragraph 4(a)(i).

No rights or legitimate interests

The Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names under Policy paragraph 4(a)(ii), then the burden shifts to the Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant’s trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized for the registration and use of the disputed domain names. The Respondent is not commonly known by the disputed domain names as individual, business or other organization and their family names do not correspond to TOD’S and HOGAN marks or the disputed domain names.

When a response is lacking, WHOIS information may be used to determine whether a respondent is commonly known by the disputed domain names under Policy paragraph 4(c)(ii). See *H-D U.S.A., LLC, v. ilyas Aslan / uok / Domain Admin ContactID 5645550 / FBS INC / Whoisprotection biz*, FA 1785313 (Forum June 25, 2018) (“The publicly available WHOIS information identifies Respondent as ‘Ilyas Aslan’ and so there is no prima facie evidence that Respondent might be commonly known by either of the [and] domain names.”). Additionally, lack of authorization to use a complainant’s mark may indicate that the respondent is not commonly known by the disputed domain names. See *Google LLC v. Bhawana Chandel / Admission Virus*, FA 1799694 (Forum Sep. 4, 2018) (concluding that Respondent was not commonly known by the disputed domain name where “the WHOIS of record identifies the Respondent as ‘Bhawana Chandel,’ and no information in the record shows that Respondent was authorized to use Complainant’s mark in any way.”). The WHOIS information for the disputed domain names lists the registrants as “Victoria Cooke,” “Kiera Higgins,” “Adam Gough,” “Dylan Skinner,” “Declan Craig,” “Jay Jenkins,” and “Shannon Barnes.” Nothing in the record suggests that the Respondent was authorized to use the TOD’S and HOGAN marks. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain names per Policy paragraph 4(c)(ii).

The Complainant also contends that the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute. The disputed domain names have been redirected by the Respondent to websites where the Complainant’s trademarks TOD’S and HOGAN are published, and prima facie counterfeit products are offered for sale. Moreover, there is no disclaimer as to the Respondent’s lack of relationship with the Complainant. In light of the low prices, the shoes, offered for sale via the websites corresponding to the disputed domain names, are prima facie counterfeit and therefore such use of the domain names cannot be deemed a legitimate non-commercial or fair use without intent for commercial gain.

Where a respondent uses a domain to pass itself off as affiliated with a complainant and redirect users to sell counterfeit goods, the Panel may find the respondent fails to make a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy paragraph 4(c)(i) or (iii). See *Wolverine World Wide, Inc. v. Fergus Knox*, FA 1627751 (Forum Aug. 19, 2015) (finding no bona fide offering of goods or legitimate noncommercial or fair use existed where Respondent used the resolving website to sell products branded with Complainant’s MERRELL mark, and were either counterfeit products or legitimate products of Complainant being resold without authorization); see also *Dell Inc. v. Devesh Tyagi*, FA 1785301 (Forum June 2, 2018) (“Respondent replicates Complainant’s website and displays Complainant’s products. The Panel finds that this use is not a bona fide offering of goods or services under Policy paragraph 4(c)(i) & (iii).”). The Complainant provides evidence of the disputed domain names resolving to webpages displaying Complainant’s mark and product photos, as well as offering for sale prima facie counterfeit versions of Complainant’s goods. Therefore, the Panel finds that the Respondent fails to use the disputed domain names for a bona fide offering of goods or services or legitimate noncommercial or fair use under Policy paragraph 4(c)(i) or (iii).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

Bad faith

The Complainant contends that the Respondent registered and uses the disputed domain names in bad faith. The use of the disputed domain names in connection with commercial websites where the Complainant’s trademarks are misappropriated and prima facie

counterfeit TOD'S or HOGAN branded products are offered for sale, clearly indicates that the Respondent's purpose for registering the disputed domain names was to capitalize on the reputation of the Complainant's trademarks by diverting Internet users seeking the Complainant's products to their websites for financial gain according to paragraph 4(b)(iv) of the Policy.

The Panel recalls that the disputed domain names have been redirected by the Respondent to websites where the Complainant's TOD'S or HOGAN marks are published and prima facie counterfeit TOD'S or HOGAN branded products are offered for sale. The Panel also recalls that the Complainant provides screenshots of the disputed domain names' resolving websites which prominently display the TOD'S or HOGAN marks. Furthermore, the Panel notes that i) the goods are sold below market value; ii) the Respondent has misappropriated copyrighted images from the Complainant's website; iii) the Respondent has concealed his identity both on the Whois and on the websites corresponding to the disputed domain names; and iv) there is no evident disclaimer as to the Respondent's lack of relationship with the Complainant.

The Panel observes that use of a disputed domain name to pass off as a complainant and offer competing or counterfeited goods may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv). See *Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund*, FA 1790949 (Forum July 9, 2018) (finding bad faith per Policy Paragraph 4(b)(iii) and (iv) where the respondent used the disputed domain name to resolve to a website upon which the respondent passes off as the complainant and offers online cryptocurrency services in direct competition with the complainant's business), see also *Guess? IP Holder L.P. and Guess?, Inc. v. LI FANGLIN*, FA 1610067 (Forum Apr. 25, 2015) (finding respondent registered and used the domain name in bad faith per Policy Paragraph 4(b)(iii) because the respondent used the resolving website to sell the complainant's products, using images copied directly from the complainant's website), see also *Bittrex, Inc. v. Wuxi Yilian LLC*, FA 1760517 (Forum Dec. 27, 2017) (finding bad faith per Policy Paragraph 4(b)(iv) where "Respondent registered and uses the domain name in bad faith by directing Internet users to a website that mimics Complainant's own website in order to confuse users into believing that Respondent is Complainant, or is otherwise affiliated or associated with Complainant."). Therefore, the Panel concludes that the Respondent registered and uses the disputed domain names in bad faith per Policy paragraph 4(b)(iii) and (iv).

Next, the Complainant contends that the Respondent has been engaged in a pattern of conduct, by way of registering more than forty domain names, confusingly similar to the Complainant's TOD'S and HOGAN marks, preventing the Complainant from reflecting the marks in the disputed domain names. The Panel observes that a pattern of conduct as required in paragraph 4(b)(ii) of the Policy may involve multiple domain names directed against a single complainant. The Panel finds that the Respondent has registered as many as forty-one domain names containing the Complainant's trademarks. The Panel finds that the Respondent's registration of the disputed domain names thus indicates a pattern of bad faith registration and use pursuant to Policy paragraph 4(a)(ii). See *Ditec International AB / Global Preservation Systems, LLC v. ADAM FARRAR / HOSTGATOR / FRITS VERGOOSSEN / DITEC INTERNATIONAL CORPORATION / Christopher Alison*, FA 1763998 (Forum Feb. 1, 2018) ("Here, Respondent registered six domain names that all include Complainant's DITEC mark. Therefore, the Panel finds that Respondent's multiple registrations using the DITEC mark indicates bad faith registration and use per Policy paragraph 4(b)(ii).").

The Complainant further contends that the Respondent was fully aware of the reputation of the Complainant's mark and the Complainant company given the circumstances that the Complainant's trademarks TOD'S and HOGAN have become well-known trademarks in the sector of manufacturing luxury outerwear and that replicas of TOD'S and HOGAN branded products are being offered for sale on the active websites corresponding to the disputed domain names. The Panel infers, due to the notoriety of the Complainant's marks; the manner of use of the disputed domain names; and the registration of forty-one domain names incorporating the Complainant's marks that the Respondent had knowledge of the Complainant's rights in the TOD'S and HOGAN marks before registering the disputed domain names which constitutes bad faith registration per Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **hoganargentina.com**: Transferred
2. **hogancolombia.com**: Transferred
3. **hoganhrvatska.com**: Transferred
4. **hoganmexicostore.com**: Transferred
5. **hoganromania.com**: Transferred
6. **hoganslovenijashop.com**: Transferred
7. **hoganuruguay.com**: Transferred
8. **hoganbrasilshop.com**: Transferred
9. **hoganchile.com**: Transferred
10. **hogancz.com**: Transferred
11. **hoganaustraliasale.com**: Transferred
12. **hoganbelgique.com**: Transferred
13. **hogandanmarkonline.com**: Transferred

14. **hoganeeesti.com**: Transferred
15. **hoganirelandshop.com**: Transferred
16. **hogannederlandsale.com**: Transferred
17. **hoganportugalsale.com**: Transferred
18. **hogansouthafrica.com**: Transferred
19. **hogansuomi.com**: Transferred
20. **hogannorgeoutlet.com**: Transferred
21. **hogansuisse.com**: Transferred
22. **hoganbelgieshop.com**: Transferred
23. **hogansrbijastore.com**: Transferred
24. **hogancanadasale.com**: Transferred
25. **hoganbulgaria.com**: Transferred
26. **hoganjapan.com**: Transferred
27. **hoganlatvija.com**: Transferred
28. **hoganlietuva.com**: Transferred
29. **hoganisrael.com**: Transferred
30. **hogankuwait.com**: Transferred
31. **hoganuae.com**: Transferred
32. **hogangreece.com**: Transferred
33. **hoganuk.com**: Transferred
34. **todsbulgaria.com**: Transferred
35. **todsjapan.com**: Transferred
36. **todslietuva.com**: Transferred
37. **todsshoeslatvija.com**: Transferred
38. **todsshopeesti.com**: Transferred
39. **todsuae.com**: Transferred
40. **todskuwait.com**: Transferred
41. **todsisrael.net**: Transferred

PANELLISTS

Name **Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2023-12-16

Publish the Decision