

Decision for dispute CAC-UDRP-105942

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| Case number | CAC-UDRP-105942 |
| Time of filing | 2023-11-07 09:22:58 |
| Domain names | todsaustralia.com, todsbelgique.com, todsbrasil.com, todschile.com, todscolombia.com, todsdenmark.com, todsfinland.com, todshrvatska.com, xn--todsmxico-f4a.com, todsnederland.com, todsnorge.com, todsonlineargentina.com, todsoutletbelgie.com, todsoutletslovenija.com, todsportugal.com, todsprahacz.com, todssaleireland.com, xn--todssaleper-fhb.com, todssaleuruguay.com, todsschweiz.com, todssrbija.com, todssuisse.com, xn--todsespaa-s6a.com, xn--todstrkiye-eeb.com, xn--hoganespaa-19a.com, xn--hoganper-v5a.com, xn--hogantrkiye-yhb.com, xn--hoganmagyarorszg-tmb.com, hoganschweiz.net, hoganparis.com |

Case administrator

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

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

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|--------------|-------------------|
| Organization | Convey srl |
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Respondent

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|------|---------------------|
| Name | Qiu Xiaofeng |
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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

The Complainant has started its business since early 1900 in Italy and is the owner of the TOD'S and HOGAN trademarks including but not limited to the followings:

- European Trademark #010158889 – TOD'S – classes 3, 9, 14, 18, 25, 35;
- European Trademark #000407031 – TOD'S – class 9;
- International Trademark #1006548 – TOD'S – class 14;
- International Trademark #858452 – TOD'S – classes 3, 9, 18, 25, 35;
- United States Trademark #1459226 – TOD'S – classes 18, 25;
- Australian Trademark #1498996 – TOD'S – classes 3, 9, 25, 35;
- International Trademark #1014830 – HOGAN – classes 9, 18, 25;

- International Trademark #1014831 – HOGAN – classes 9, 18, 25;
- International Trademark #774193 – HOGAN – classes 3, 9, 18, 25;
- International Trademark #1129649 – HOGAN – classes 3, 9, 18, 25;
- European Union Trademark #005184536 – HOGAN – classes 3, 9, 18, 25, 35.

Furthermore, the Complainant has been extensively using the “TOD’S” denominations on all internet environments including and not limited to the company’s official websites <https://www.todsgroup.com> and <https://www.tods.com> - among which are “tods.it”, “tods.fr”, “tods.eu”, “tods.cn” (a list of Complainant’s domain names could be provided upon request) - and its official accounts on the major social networks such as Facebook, Instagram and Twitter.

FACTUAL BACKGROUND

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

The Complainant, Tod’s SpA, is a company with headquarters in Sant’Elpidio al Mare, FM (ITALY). The Complainant has its roots in the early 1900. The company was renamed to J. P. Tod’s in the late 70’s and the J.P. was dropped in 1997. Tod’s 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.

The Complainant is the operating holding of a Group, amongst the leading players in the world of luxury goods, with the trademarks Tod’s, Hogan, Fay and Roger Vivier with about 4,600 employees worldwide. Tod’s 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. In November 2015, Tod’s acquired further stock in the Roger Vivier shoe brand for €415 million reaching about 60%.

2022 Annual revenues of Tod’s Group were almost 668 million of Euros of which almost 50% came from the trademark TOD’S. Diego and his younger brother, Andrea, who is vice president, own a 61 percent stake in the company, which was listed on the Milan stock exchange in 2000.

The disputed domain names were registered between May 2023 and October 2023.

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).

First, the Complainant claims rights in the TOD’S and HOGAN marks through its trademark registration. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

Second, the Complaint claims that the disputed domain names incorporate the whole of the Complainant’s TOD’S or HOGAN trademark and the additional nondistinctive elements such as “outlet”, “online” and “spaas” and/or geographical indications such as “chile” “australia”, “schweiz” and “paris” does not affect the similarity.

By doing side-by-side comparisons, the Panel accepts that the disputed domain names are visually similar to Complainant’s TOD’S or HOGAN trademark and the additional terms/letters do not affect the distinctiveness of the marks. See paragraph 1.7 of the WIPO Overview 3.0.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names, and the burden of prove then

shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("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 name.").

First, the Complainant claims that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. In addition, the Complainant further claims that the Respondent is not commonly known by the disputed domain names as individuals, business or other organization and their family names do not correspond to TOD'S, HOGAN or the disputed domain names.

Second, the Complainant argues that Respondent redirects the traffics from the disputed domain names to websites offering counterfeit version of Complainant's products for sale at a heavily discounted price. Moreover, there is no disclaimer as to the Respondent's lack of relationship with the Complainant. Respondent's uses could be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names. Such wilful conduct clearly demonstrates, to the contrary, that Respondent is not intended to use the disputed domain names in connection with any legitimate purposes. Therefore, such use of the disputed domain names cannot be deemed a legitimate non-commercial or fair use without intent for commercial gain. Having reviewed the screenshots provided by the Complainant, the Panel finds that Respondent attempts to pass off as Complainant to offer such content, failing to use the disputed domain names in connection with a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain names. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain names. However, the Respondent has not submitted any response to rebut the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant reaffirms that by virtue of its extensive worldwide use, the Complainant's TOD'S and HOGAN trademarks have become well-known trademarks in the sector of fashion and clothing items. Therefore, it is clear that the Respondent was well aware of the trademark and he has registered the disputed domain names with the intention to refer to the Complainant and its trademarks. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain names evidences bad faith under paragraph 4(a)(iii) of the Policy. See *ARCELORMITTAL (SA) v. acero*, 102399 (CAC 2019-04-22). The Panel is of the view that at the time of registration of the disputed domain name, the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks and that registration of domain names containing well-known trademarks constitutes bad faith per se. The Panel also notes that the disputed domain name was registered more than 20 years after the registration of Complainant's first TOD'S or HOGAN trademark. The Panel agrees with Complainant and finds that Respondent should have actual knowledge of Complainant's mark, demonstrating bad faith registration under Policy paragraph 4(a)(iii).

Second, the Complainant asserts that the Respondents intentionally use the disputed domain names to sell counterfeit TOD'S and HOGAN goods at a heavily discounted price. Using a confusingly similar domain name in a manner disruptive of a complainant's business by trading upon the goodwill of a complainant for commercial gain evinces bad faith under paragraph 4(b)(iii) & (iv) of the Policy. See *TOD'S S.p.A. vs.* , 102869 (CAC 2020-03-06) ("The Panel finds that the Respondents have used the disputed domain names intentionally to attract Internet users to their websites offering counterfeit and other competing products for commercial gain by creating a likelihood of confusion with the Complainant's marks as to the source of the Respondents' website and the products promoted on it."); see also *Under Armour Inc. vs. Web Commerce Communications Limited/Whoisprotection.cc*, 104892 (CAC 2022-11-11) ("Beyond this, the fact that prima facie counterfeit "UNDER ARMOUR" branded shoes and apparel were offered for sale on the website corresponding to (most of) the disputed domain names indicates that the Respondents were fully aware of the Complainant's trademarks reputation and association with the Complainant. This also indicates that Respondents' purpose in registering the disputed domain names was solely to capitalize on the reputation of these trademarks by diverting internet users seeking products of the Complainant to their own commercial website."). Complainant provides screenshots of the resolving webpages, which display the TOD'S and HOGAN marks and various images of related items for sale. Accordingly, the Panel agree that Respondent disrupts Complainant's business and attempted to commercially benefit off Complainant's mark in bad faith under paragraph 4(b)(iii) & (iv) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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.

PRELIMINARY FINDINGS - CONSOLIDATION:

Pursuant to Paragraph 10(c) of the Rules that a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules. The Rules further state that Respondent means the holder of a domain name registration against which a complaint is initiated. The Complainant submitted a request for consolidation that all the disputed domain names were registered by the Respondent in accordance with the WHOIS disclosure by the registrar in the present case.

The Respondent did not submit a timely Response within the required period of time.

Having reviewed the WHOIS information of the disputed domain names, the Panel finds that all the disputed domain names were registered by the Respondent. On this basis, the Panel accepts the consolidation request in accordance with Paragraph 10(e) of the Rules and article 4.11.2 of the WIPO Overview 3.0.

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **todsaustralia.com**: Transferred
2. **todsbelgique.com**: Transferred
3. **todsbrasil.com**: Transferred
4. **todschile.com**: Transferred
5. **todscolumbia.com**: Transferred
6. **todsdenmark.com**: Transferred
7. **todsfinland.com**: Transferred
8. **todshrvatska.com**: Transferred
9. **xn--todsmxico-f4a.com**: Transferred
10. **todsnederland.com**: Transferred
11. **todsnorge.com**: Transferred
12. **todsonlineargentina.com**: Transferred
13. **todsoutletbelgie.com**: Transferred
14. **todsoutletslovenija.com**: Transferred
15. **todsportugal.com**: Transferred
16. **todsprahacz.com**: Transferred
17. **todssaleireland.com**: Transferred
18. **xn--todssaleper-fhb.com**: Transferred
19. **todssaleuruguay.com**: Transferred
20. **todsschweiz.com**: Transferred
21. **todssrbija.com**: Transferred
22. **todssuisse.com**: Transferred
23. **xn--todsespaa-s6a.com**: Transferred
24. **xn--todstrkiye-eeb.com**: Transferred
25. **xn--hoganespaa-19a.com**: Transferred
26. **xn--hoganper-v5a.com**: Transferred
27. **xn--hogantrkiye-yhb.com**: Transferred
28. **xn--hoganmagyarorszg-tmb.com**: Transferred
29. **hoganschweiz.net**: Transferred
30. **hoganparis.com**: Transferred

PANELLISTS

Name

Mr Paddy TAM

DATE OF PANEL DECISION

2023-12-20

Publish the Decision