

Decision for dispute CAC-UDRP-105939

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| Case number | CAC-UDRP-105939 |
| Time of filing | 2023-11-15 09:08:46 |
| Domain names | deichmannout1et.shop, deichmannsale.shop, deichmannoutlet.shop, deichmannoutlet.com, deichmannshoe.com, de1chmann.co |

Case administrator

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

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| Organization | Deichmann SE |
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Complainant representative

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| Organization | Lubberger Lehment Rechtsanwälte Partnerschaft mbB |
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Respondents

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| Name | he huanghui |
| Name | María Trinidad Trenas |
| Name | Mihaela Claudia Codita Carp |
| Name | Jonathan Serrano urbano |

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 is, inter alia, the owner of EU trademark registration no. 1041895 "DEICHMANN", registered on April 7, 2010, in classes 3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 30, and 35 (hereinafter referred to as the "Trademark"). The Trademark predated the registration dates of the disputed domain names.

FACTUAL BACKGROUND

The Complainant is the largest shoe retailer in Europe. The Complainant and their subsidiaries are operating 4,200 stores and 40 online stores worldwide. With a total of 41,000 employees, the Complainant generated annual sales of EUR 5.4 billion in 2020. In

Germany, business activities have been carried out under the Deichmann trademark since 1913. The Complainant is operating an online shop for footwear in several country versions, inter alia for Germany and for the UK, at <deichmann.com>.

The disputed domain names were registered on October 26, 2023, October 27, 2023, November 2, 2023, November 3, 2023, and November 4, 2023, respectively. These domains have all been utilized to host active websites that prominently feature the protected DEICHMANN device logo and showcase copyrighted pictures taken from the Complainant's official website.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant alleges that the disputed domain names are confusingly similar to the Trademark. They argue that they all contain the well-known Trademark, either in combination with generic words like "outlet," "shoe," or "sale," or with minor typographical errors that do not exclude similarity to the Trademark.

In addition, the Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain names. In particular, they state that the Respondent is using the disputed domain names to operate "fake shops" that, by using the Complainant's trademarks and original assets, appear as if they were operated by the Complainant with the sole purpose of attracting Internet users' attention to the websites and that such use is not a bona fide use under the Policy and cannot establish rights or legitimate interests in the disputed domain names. Further, the Complainant contends that the Respondent's websites do not accurately and prominently disclose its relationship with the trademark owner and would not be legitimate, even if the products offered were genuine.

Finally, the Complainant alleges that the disputed domain names were registered and are being used in bad faith. They state that the disputed domain names all resolve to websites that give the false impression that they are operated by the Complainant, which is not the case.

RESPONDENT:

The Center received an e-mail communication from the Respondent "Mihaela Codita Carp". The Respondent complained that it had placed an order and had not yet received the goods. After being informed by the Case Administrator that the Response had to be submitted through the Platform, a further statement was submitted through the Platform as Nonstandard Communication, again concerning the Respondent's order.

The only inference that the Panel can draw from the Respondent's communications is that the Respondent claims not to have received an order placed online. In the Panel's view, the Respondent's communications do not even indicate whether the orders were placed through the Complainant's website or a website accessible under one of the disputed domain names. In the Panel's view, the communications do not constitute a substantive reply to the Complaint and not a Response in the true sense of the word.

In light of the foregoing, the Complainant was also not required to pay the additional fees for a proceeding with a filed response.

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 were met and there is no other reason why it would be

inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

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1. Preliminary Issue: Consolidation of Respondents

Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.11.1, paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules 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. When considering a complaint filed against multiple respondents, section 4.11.2 of the WIPO Overview 3.0 states that "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".

In light of the Complainant's request to consolidate the multiple Respondents, the Panel concludes that the disputed domain names are indeed under common control for the following reasons:

- All of the disputed domain names were used in connection with completely identical websites that copied the Complainant's online store.
- All the disputed domain names were registered within a period of only eight days.
- The disputed domain names are all use the same name servers.

The foregoing suggests that the disputed domain names are under common control.

Furthermore, the Respondent has not contested or provided any rebuttal regarding the consolidation request made by the Complainant. Therefore, the Panel finds that consolidation would be fair and equitable, and henceforth refers to the four registrants collectively as the "Respondent" throughout this decision.

2. Substantive Issues

Paragraph 4(a) of the Policy requires the Complainant to establish each of the following three elements:

- (i) the disputed domain names are identical or confusingly similar to the Complainant's trademark; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

2.1 The Panel accepts that the disputed domain names are confusingly similar to the Trademark because the Trademark is recognizable in all of the disputed domain names. It is well established that a domain name that fully incorporates a trademark may be confusingly similar to such a trademark within the meaning of the Policy despite the addition of generic terms such as those used in the present case. Similarly, replacing the letters "l" or "i" with the number "1" does not eliminate the similarity between the Trademark and the disputed domain names in question. This is a clear case of typosquatting.

2.2 The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain names. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent has not denied these allegations and has therefore failed to establish any rights or legitimate interests in the disputed domain names.

Based on the evidence on file, the Panel cannot find any rights or legitimate interests of the Respondent either. In particular, the Panel finds that the Respondent's websites do not meet the Oki Data criteria as the Respondent, at least, has not disclosed its total lack of relationship or connection to the Complainant but rather prominently featured the Complainant's protected DEICHMANN device logo, which gives the false impression that the pages were at least authorized by the Complainant. Accordingly, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in respect of the disputed domain names under paragraphs 4(a)(ii) and 4(c) of the Policy.

2.3 The Panel is also satisfied that the Respondent registered the disputed domain names with full knowledge of the Complainant and its rights in the Trademark as the Respondent uses the disputed domain names to direct Internet users to a website containing the Complainant's trademarked DEICHMANN device logo.

As to bad faith use, by using the disputed domain names in connection with the websites mentioned above, the Respondent was, in all likelihood, trying to divert traffic intended for the Complainant's website to its own for commercial gain as set out under paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **deichmannout1et.shop**: Transferred
 2. **deichmannsale.shop**: Transferred
 3. **deichmannoutlet.shop**: Transferred
 4. **deichmannoutlet.com**: Transferred
 5. **deichmannshoe.com**: Transferred
 6. **de1chmann.co** : Transferred
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PANELLISTS

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| Name | Peter Müller |
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DATE OF PANEL DECISION 2023-12-30

Publish the Decision
