Decision for dispute CAC-UDRP-106127

Case number	**CAC-UDRP-106127**
Time of filing	**2024-01-04 09:42:29**
Domain names	**rudycycling.com, rudyprojectsale.com, bikerudyproject.com**

Case administrator

Name	**Olga Dvořáková (Case admin)**

Complainant

Organization	**Rudy Project S.p.A.**

Complainant representative

Organization	**Convey srl**

Respondents

Organization	**LiaoTaotao**
Name	**Li Guanfu**
Name	**Ahdsht Bhcjw**

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain names <rudycycling.com>; <rudyprojectsale.com>; and <bikerudyproject.com> (collectively, 'the disputed domain names').

IDENTIFICATION OF RIGHTS

The Complainant is the holder of the following registered trade marks, amongst others:

- EU trade mark registration no. 000110312, filed on 1 April 1996, for the figurative mark RUDY PROJECT, in classes 9, 14 and 25 of the Nice Classification; and
- International registration no. 665770, designating, inter alia, China, filed on 11 December 1996, for the figurative mark RUDY PROJECT, in classes 9, 14 and 25 of the Nice Classification.

(Hereinafter, collectively or individually, 'the Complainant's trade mark', 'the Complainant's trade mark RUDY PROJECT', or '(RUDY PROJECT) the trade mark (RUDY PROJECT)' interchangeably).

The disputed domain names were registered on the following dates:

- <rudycycling.com>: 9 January 2023

- <rudyprojectsale.com>: 21 September 2022
- <bikerudyproject.com>: 18 June 2022

At the time of writing, the disputed domain names resolve to online stores on which purported RUDY PROJECT products appear to be commercialised, the particulars of which are discussed further below (for present purposes, 'the Respondent's websites').

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant's contentions can be summarised as follows:

The Complainant, Rudy Project S.p.A., was founded in Treviso, Italy, in 1985, and has become a global leader in the field of sports eyewear. The Complainant manufactures and sell a wide array of products for sports, inter alia sunglasses, prescription sports, glasses, bike helmets, and cycling helmets. The Complainant's products are sold in more than 60 countries worldwide.

In addition to the trade marks mentioned in the above section 'Identification of Rights', and other trade marks in its portfolio, the Complainant operates its official website at <www.rudyproject.com> (registered in 1999).

The Complainant seeks to obtain the transfer of the disputed domain names on the grounds set out in section A.3 below.

B. Respondent's Factual Allegations

The Respondent has defaulted in this UDRP administrative proceeding and has therefore made no factual allegations.

PARTIES CONTENTIONS

A. Complainant

A.1 Preliminary Matter: Application for Consolidation

The Complainant informs that the disputed domain names are owned by the following individuals/entities:

- <rudycycling.com>: LiaoTaotao
- <rudyprojectsale.com>: Li Guanfu
- <bikerudyproject.com>: Ahdsht Bhcjw

The Complainant further informs that the Respondents are all based in China but it claims that the postal addresses belonging to the Respondents on record are false.

The Complainant avers that the disputed domain names are subject to a common control or a single individual/entity or, at least, by a group of individuals acting in concert, thereby making the consolidation of the proceedings equitable and procedurally efficient ('the Complainant's Application for Consolidation').

The Complainant's Application for Consolidation is grounded on the following factors:

i. the disputed domain names share the same generic Top-Level Domain ('gTLD') <.com>;

ii. the dispute domain names contain generic words in their string in addition to the trade mark RUDY PROJECT; and

iii. the websites corresponding to the disputed domain names contain identical sections, layouts, copyright disclaimers, login pages and payment options.

For the foregoing reasons, the Complainant requests that the disputed domain names and the named Respondents be consolidated into a single UDRP administrative proceeding.

For present purposes, the registrants/holders on record of the disputed domain names are hereinafter collectively referred to as 'the Respondent'.

A.2 Preliminary Matter: Language of the Proceeding

With respect to the language of the proceedings, the Panel notes the following:

- The Complaint is written in English and the Complainant has made a pre-emptive request that English be the language of this UDRP administrative proceeding;

• The registrar's verification response provided that the language of the registration agreements for the disputed domain names <rudycycling.com> and <bikerudyproject.com> is English; and the language of registration agreement for the disputed domain name <rudyprojectsale.com> is Chinese; and

• The Complainant's grounds for English to be the language of this UDRP administrative proceeding can be summarised as follows: (i) the disputed domain names contain Latin characters and the English words 'cycling', 'sale', and 'bike'; (ii) the disputed domain names resolve to websites which display content in English; and (iii) it would be unfair to proceed in Chinese owing to the delay and costs associated with translations.

A.3 Substantive grounds

A.3.1 The disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant submits that the disputed domain names <rudyprojectsale.com> and <bikerudyproject.com> are confusingly similar to the Complainant's trade mark because reproduce the trade mark RUDY PROJECT in its entirety. The non-distinctive elements 'sale' and 'bike' and the gTLD have no bearing on the confusing similarity test. Furthermore, the disputed domain name <rudycycling.com> is likewise confusingly similar in so far as it incorporates the Complainant’s trade mark RUDY PROJECT partially.

The Complainant submits that the combination of the trade mark RUDY PROJECT with generic words, all of which connected to the sector where the Complainant is active, are likely to increase the risk of association with the Complainant.

A.3.2 The Respondent has no rights or legitimate interests in respect of the disputed domain names

The Complainant avers that the disputed domain names are not being used in connection with a bona fide offering of goods or services. The disputed domain names resolve to online shops with the infringing use of the Complainant's trade mark RUDY PROJECT, purporting to sell a variety of goods, namely eyewear, helmets, personal protective equipment and accessories of the Complainant.

The Complainant claims that the Respondent is not licensee, authorised agent of the Complainant or in any other way authorised to use the Complainant's trade mark. Moreover, the Respondent is not an authorised reseller of the Complainant and has not been authorised to register or use the disputed domain names. There is no disclaimer as to the Respondent's lack of relationship with the Complainant on the Respondent's websites.

The Complainant further avers that the products on the Respondent's website are offered disproportionally below market value, some of which at half or even a third of the Complainant's prices. The Complainant argues that this is an indicium of counterfeit goods and that UDRP panels have held that the sale of counterfeit goods shall not confer rights on the Respondent or be considered a legitimate interest under paragraph 4 (c) of the UDRP Policy (see paragraph 2.13.1 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ('the WIPO Jurisprudential Overview 3.0')).

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

A.3.3 The Respondent registered and is using the disputed domain names in bad faith

Registration

The Complainant contends that the trade mark RUDY PROJECT long predates the registration of the disputed domain names, and that the Complainant's worldwide reputation in the eyewear sector makes it reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trade mark.

The Respondent's actual knowledge of the Complainant is furthermore demonstrated by the Respondent's offering of counterfeit products of the Complainant on the Respondent's websites.

Use

Under this UDRP Policy ground, the Complainant avers that the Respondent's purpose is to capitalise on the reputation of the RUDY PROJECT trade mark by diverting Internet users seeking RUDY PROJECT products to the Respondent's websites, for financial gain, by intentionally creating a likelihood of confusion with the RUDY PROJECT trade mark as to the source, sponsorship, affiliation, or endorsements of the Respondent's websites and/or the goods offered or promoted through the Respondent’s websites (paragraph 4(b)(iv) of the UDRP Policy).

The Complainant further informs that it has sent a cease-and-desist letter to the Respondent which remains unanswered, the consequence of which being that the Panel is entitled to draw adverse inferences therefrom.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain names in bad faith.

B. Respondent

The Respondent has defaulted in this UDRP administrative proceeding and has therefore failed to advance any substantive case on the merits.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP 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 UDRP 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 UDRP Policy).

PROCEDURAL FACTORS

1. Complainant's Application for Consolidation

The Complainant has made an application to consolidate its UDRP claims against the three registrants/holders of the disputed domain names (identified in section A.1 above) into one single UDRP administrative proceeding, for the reasons articulated in the same section A.1.

The Panel has considered the available record, the UDRP legal framework, and the WIPO Jurisprudential Overview 3.0 (paragraph 4.11.2) which enumerates circumstances underpinning the panel's consideration of a consolidation request.

Under the UDRP Rules (Rule 10(b) and Rule 10(c)), the Panel shall seek to promote procedural (cost and time) efficiency while also ensuring that the parties are treated with equality and that each party is given a fair opportunity to present its case.

The Panel considers that interlocutory/interim applications sought by parties in UDRP administrative proceedings require panels to apply the balance of convenience test, according to which panels would have a duty to consider who would suffer the greatest inconvenience as a result of the panel's determination.

The Panel has perused paragraph 4.11.2 of the WIPO Jurisprudential Overview 3.0, which lists a whole host of considerations which may assist panels in the determination of whether a consolidation is appropriate. Of particular note, the Panel considers the following factors as most compelling to a finding in favour of the Complainant in the present matter: (i) the registrants' identical country of origin (China); (ii) the striking similarities of content and layout of the websites corresponding to the disputed domain names; (iii) the fact that the registrants have targeted a specific sector and mark; and (iv) the naming patterns in the disputed domain names being <mark+generic term> or <generic term+mark>.

On balance, it would appear to the Panel that the disputed domain names are subject to common control. In addition, the Panel has weighed the balance of convenience and decided to accede to the Complainant's Application for Consolidation. The dismissal would likely to cause the Complainant the greatest burden and interfere with the overall due expedition of the UDRP administrative proceeding.

In view of the above, the three registrants are to be treated, for the purpose of this case, as a single Respondent.

2. Complainant's Language Request

The Panel is given discretion under Rule 11 of the UDRP Rules to determine the appropriate language of the UDRP administrative proceeding. The Panel notes Rule 10 of the UDRP Rules, which vests the Panel with authority to conduct the proceedings in a manner it deems appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

With regard to this particular matter, the Panel takes the liberty to adopt the language of proceeding test applied in CAC Case no. 104144, Writera Limited v. alexander ershov, which helpfully sets out the following six guiding factors:

(i) the language of the domain name string: the Panel considers that English is the only identifiable language in the string of each of the three disputed domain names;

(ii) the content of the Respondent's website: the Respondent's websites host content in English only, which suggests to the Panel that the Respondent has knowledge of the English language;

(iii) the language(s) of the Parties: the Complainant is incorporated in Italy and the Respondent appears to be an individual/entity resident or incorporated in China. The English language would therefore be considered neutral for both Parties;

(iv) the Respondent's behaviour: the Panel notes that the Respondent has shown no inclination to participate in this UDRP administrative proceeding;

(v) the Panel's overall concern with due process: the Panel has discharged its duty under Rule 10 (c) of the UDRP Rules; and

(vi) the balance of convenience: while determining the language of the UDRP administrative proceeding, the Panel has a duty to consider who would suffer the greatest inconvenience as a result of the Panel's determination. On the one hand, the determination of English as the language of this UDRP administrative proceeding – a widely spoken language – is unlikely to cause the Respondent any inconvenience, not least given that the Respondent's website hosts content in English only. The determination of Chinese as the language of this UDRP administrative proceeding, on the other hand, is very likely to cause the Complainant inconvenience, and to interfere with the overall due expedition of the proceedings under the UDRP Rules.

In view of the above factors, the Panel has decided to accept the Complainant's language request, such that the decision in the present matter will be rendered in English.

3. Miscellaneous

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

A. UDRP Threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the grounds which the Complainant must establish to succeed:

> i) The disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
>
> 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.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP administrative proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP Policy grounds in turn.

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns trade mark rights in 'RUDY PROJECT' since at least 1996.

The disputed domain names were registered between 2022 and 2023, and all of them incorporate the Complainant's trade mark RUDY PROJECT in their string, either fully or partially.

The disputed domain names <rudyprojectsale.com> and <bikerudyproject.com> are composed of the joint terms 'rudyproject', 'sale', and 'bike'. The generic words 'sale' and 'bike' either evoke the act of purchasing the Complainant's goods or refer to the goods themselves which belong to the Complainant's niche market.

The disputed domain name <rudycycling.com> reproduces the dominant element of the Complainant's trade mark RUDY PROJECT. The additional term 'cycling' enhances the risk of affiliation with the Complainant given that it elicits the Complainant's business segment.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The Respondent has defaulted in this UDRP administrative proceeding. Nevertheless, the Panel is empowered to draw adverse inferences from the Respondent's silence (Rule 14 (b) of the UDRP Rules).

The Panel notes that the Complainant denies any affiliation and/or association with, or authorisation for, the Respondent of any nature. There is no contractual arrangement between the Parties to that effect, nor has the Complainant otherwise authorised the Respondent to make any use of the Complainant's trade mark. Moreover, there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain names.

The Complainant claims that the Respondent is not an authorised reseller of the Complainant and that the Respondent's websites do not contain disclaimers as to the parties' lack of relationship.

On this point, the Panel alludes to the jurisprudential view formed by domain name disputes under the UDRP Policy and UDRP Rules (see WIPO Jurisprudential Overview 3.0, paragraph 2.8), according to which resellers and distributors using a domain name containing a complainant's trade mark to undertake sales related to the complainant's goods or services may be making a bona fide offering of goods and services, and thus have a legitimate interest in such domain name. UDRP panels have termed this as the 'Oki Data test' (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

1. The Respondent must actually be offering the goods or services at issue;

2. The Respondent must use the website associated with the disputed domain names to sell only the trade marked goods or services;

3. The Respondent's website must accurately and prominently disclose its relationship with the Complainant; and

4. The Respondent must not try to 'corner the market' in domain names that reflect the trade mark.

The Parties are reminded that the above requirements are cumulative, so that the failure to satisfy any of them would result in a finding for the Complainant regarding this UDRP Policy ground.

The Panel has considered the evidence on the record and notes that the Respondent would have failed to meet the Oki Data test, the Panel being unable to locate a disclaimer regarding the relationship between the Respondent and the Complainant (requirement 3 above).

Moreover, the Panel is unconvinced that, before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a bona fide offering of goods or services.

Lastly, there is evidence on the available record suggesting that the Respondent has attempted to impersonate the Complainant, as discusser in section D. below.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and evidence adduced by the Complainant in this UDRP administrative proceeding, the Panel finds that the Complainant has made prima facie showing of the Respondent’s lack of rights or legitimate interests in the disputed domain names under the UDRP Policy.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

D. Registered and Used in Bad Faith

Registration

The following factors are compelling evidence to this Panel that the disputed domain names were registered in bad faith:

• The Complainant has been using the trade mark RUDY PROJECT since at least 1996;

• The Complainant operates its activities through the domain name <rudyproject.com>, which was registered in 1999;

• The disputed domain names were registered between 2022 and 2023;

• The disputed domain names incorporate the Complainant's trade mark RUDY PROJECT either entirely or partly, the only differences being the generic words 'sale', 'bike' and 'cycling', all of which connected with the commercialisation of the Complainant's products and the Complainant’s segment of business; and

• UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known in its segment of business.

Use

The Complainant alleges that the Respondent has engaged in the conduct described in paragraph 4(b)(ii) of the UDRP Policy, which provides as follows:

> '(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location'.

The following factors are compelling evidence to this Panel that the disputed domain names have been used in bad faith:

• There is nothing on the record suggesting that the Respondent is affiliated or otherwise connected with the Complainant, and the Complainant firmly denies any association;

• The Respondent did not provide any evidence of actual or contemplated evidence good faith use of the disputed domain names; and

• The Respondent's websites appear to commercialise purported RUDY PROJECT products in an unauthorised manner, and absent

any disclosure as to the relationship between the Respondent and the Complainant. The Panel finds that the Respondent has attempted to suggest an affiliation with, or a connection to, or an endorsement of the Complainant or, rather likely, to impersonate the Complainant through the use of the trade mark RUDY PROJECT on the Respondent's websites. The Respondent's behaviour would consequently fall in the realm of paragraph 4(b)(iv) of the UDRP Policy.

In view of the above, the Panel finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **rudycycling.com**: Transferred
2. **rudyprojectsale.com**: Transferred
3. **bikerudyproject.com**: Transferred

PANELLISTS

Name	**Yana Zhou**

DATE OF PANEL DECISION 2024-02-02

Publish the Decision