Decision for dispute CAC-UDRP-106185

Case number	CAC-UDRP-106185
Time of filing	2024-01-25 16:39:04
Domain names	deichmannmall.top, deichmannshop.top, deichman-eu.shop, deichmanncount.com, DEICHMANNRABATTSS.SHOP, DEICHMANNOUTLETS.SHOP, DEICHMANN-AT.SHOP, deichmann-valuefinds.shop, deichmshop.com, deichmannschuhes.com, deichman-uk.com, deichmann-outlet.shop

Case administrator

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

Complainant

Organization	Deichmann SE

Complainant representative

Organization	Lubberger Lehment Rechtsanwälte Partnerschaft mbB

Respondents

Name	Han Chao
Name	stephen wilson
Name	sadsxcsda sfafsafd
Name	chen xiao
Name	lin jie
Name	Tony Oconner
Name	Daniel Chambers
Organization	Web Commerce Communications Limited
Name	Colin Derby

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain names <deichmannmall.top>; <deichmannshop.top>; <deichman-eu.shop>; <deichmanncount.com>; <deichmannrabattss.shop>; <deichmannoutlets.shop>; <deichmann-at.shop>; <deichmann-valuefinds.shop>; <deichmshop.com>; <deichmannschuhes.com>; <deichman-uk.com>; and <deichmann-outlet.shop> (collectively referred to as 'the Domain Names').

IDENTIFICATION OF RIGHTS

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

• EU trade mark registration no. 1041895, registered on 7 April 2010, for the word mark DEICHMANN, in classes 3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 30, and 35 of the Nice Classification; and

• EU trade mark registration no. 1172457, registered on 1 July 2013, for the figurative mark DEICHMANN, in classes 3, 9, 14, 16, 18, 21, 24, 25, 26, 28, 30, and 35 of the Nice Classification

(Collectively or individually referred to as 'the Complainant's trade mark', 'the Complainant's trade mark DEICHMANN, or 'the trade mark DEICHMANN').

The Domain Names were registered on the following dates:

<deichmannmall.top>	25 December 2023
<deichmannshop.top>	25 December 2023
<deichman-eu.shop>	22 December 2023
<deichmanncount.com>	20 December 2023
<deichmannrabattss.shop>	21 December 2023
<deichmannoutlets.shop>	2 January 2024
<deichmann-at.shop>	28 December 2023
<deichmann-valuefinds.shop>	14 January 2024
<deichmshop.com>	8 September 2023
<deichmannschuhes.com>	19 December 2023
<deichman-uk.com>	21 September 2023
<deichmann-outlet.shop>	12 November 2023

At the time of writing, the Domain Names resolve to (i) online stores on which purported DEICHMANN/third party products appear to be commercialised, namely <deichmann-at.shop> <deichmannschuhes.com>; and <deichmshop.com>; and (ii) (the remainder of which) inactive, deceptive and/or potentially fraudulent websites, the details of each are particularised further below (for present purposes, the websites are collectively referred to as 'the Respondent's websites', and the registrants/holders on record of the Domain Names as 'the Respondent').

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant's allegations of fact can be summarised as follows:

The Complainant, Deichmann SE, is the largest shoe retailer in Europe. The Complainant and its subsidiaries operate 4,200 stores and 40 online stores around the globe, with a sales revenue of EUR 5.4bn in 2020.

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.deichmann.com> (registered in 1994).

The Complainant seeks to obtain the transfer of the Domain Names on the grounds set out in section A.2 below under 'Parties Contentions'.

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 Issues

A.1.1 Application for Consolidation of Complaints against Multiple Registrants

In the Complaint, the Complainant advises that the Domain Names are owned by the following individuals/entities:

<deichmannmall.top> and <deichmannshop.top>	Han Chao
<deichman-eu.shop> and <deichmanncount.com>	Stephen Wilson
<deichmannrabattss.shop>	sadsxcsda sfafsafd
<deichmannoutlets.shop>	Chen Xiao
<deichmann-at.shop>	Lin Jie
<deichmann-valuefinds.shop>	Tonny Oconner
<deichmshop.com>	Daniel Chambers
<deichmannschuhes.com> and <deichman-uk.com>	Web Commerce Communications Limited
<deichmann-outlet.shop>	Colin Derby

The Complainant asserts that the Domain Names are subject to a common control, 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:

- the Domain Names were registered within a short time frame of only five months (September 2023 through to January 2024);
- nine out of the twelve Domain Names use cloudflare name server;
- the Domain Names share a highly similar structure using the trade mark DEICHMANN in their strings;
- the Domain Names <deichmann-at.shop>, <deichmannschuhes.com>, <deichman-uk.com>, and <deichmshop.com> resolve to identical or very similar websites which mimic the Complainant’s online store; and
- the Respondents have all failed to reply to the Complainant’s contentions.

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

A.1.2 Language of the Proceeding Request

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

• The Complaint is written in English;

• The registrar's verification response provided that the language of the registration agreement for the Domain Names <deichmannmall.top> and <deichmannshop.top> is Chinese, whereas the language of registration agreement for the remaining Domain Names is English; and

• Having been notified of the above by the CAC Secretariat, the Complainant requested that English be the language of the proceeding for the Domain Names <deichmannmall.top> and <deichmannshop.top> but the Respondent has failed to provide reasons for such request.

A.2 Substantive grounds

A.2.1 The Domain Names are identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant submits that the Domain Names are all identical or confusingly similar to the Complainant's trade mark DEICHMANN. The Domain Name <deichmshop.com>, on its turn, contains the element 'deichm' in its string which is likewise confusing.

The Complainant further submits that the presence of descriptive elements in the strings of the Domain Names, for example 'outlet', 'shoe' or 'shop' is irrelevant for the assessment of identity or confusing similarity test under this UDRP Policy ground. The Top-Level Domains ('TLDs') have also no bearing on the test. Moreover, the replacement of one or more characters, addition or omission of letters and numbers in the strings are generally insufficient to dispel the similarity between a domain name and a complainant's trade mark.

A.2.2 The Respondent has no rights or legitimate interests in respect of the Domain Names

The Complainant avers that the Domain Names are not being used in connection with a bona fide offering of goods or services. On the contrary, the Domain Names <deichmann-at.shop>, <deichmannschuhes.com>, <deichman-uk.com>, and <deichmshop.com> resolve to online stores which may appear to be operated by the Complainant.

The Complainant asserts that there is no relationship between the Parties, and that the Respondent is not an authorised reseller of the Complainant. There is no disclaimer as to the Respondent's lack of relationship with the Complainant on the Respondent's websites.

With respect to the remainder of the Domain Names, which do not resolve to active websites or resolve to websites without content/under construction, the Complainant submits that UDRP panels have held that such use can neither be considered a bona fide offering of goods or services nor a legitimate noncommercial or fair use within the meaning of the UDRP Policy.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the Domain Names.

A.2.3 The Respondent registered and is using the Domain Names in bad faith

The Complainant submits that the Domain Names are identical or confusingly similar to the Complainant's trade mark DEICHMANN; and that the trade mark DEICHMANN long predates the registration of the Domain Names.

With regard to the use in bad faith, the Domain Names <deichmann-at.shop>, <deichmannschuhes.com>, <deichman-uk.com>, and <deichmshop.com> resolve to online stores which may create the false impression of these shops being operated by the Complainant.

As to the remainder of the Domain Names, the Complainant alludes to the doctrine of passive holding to support its claim for a finding of bad faith.

The Complainant therefore concludes that the Respondent has registered and is using the 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.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names <deichmannrabattss.shop>, <deichmannoutlets.shop>, <deichmann-at.shop>, <deichmannschuhes.com>, <deichman-uk.com>, and <deichmann-outlet.shop> 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 <deichmannrabattss.shop>, <deichmannoutlets.shop>, <deichmann-at.shop>, <deichmannschuhes.com>,<deichman-uk.com>, and <deichmann-outlet.shop> (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 <deichmannrabattss.shop>, <deichmannoutlets.shop>, <deichmann-at.shop>, <deichmannschuhes.com>,<deichman-uk.com>, and <deichmann-outlet.shop> 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 in respect of twelve Domain Names featuring nine different registrants (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 Panel Views on Selected UDRP Questions, Third Edition ('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.

Considerations conducive to a finding of common control would include commonalities and patterns in the registrant information, for example shared administrative or technical contacts, email or postal addresses, the content and layout of the website to which the domain name resolves, and any other circumstances which could point in the direction of a unity of interests, such that the registrants may be treated as a single domain name holder within the scope of Rule 3(c) of the UDRP Rules.

Turning to the present case, the Panel has identified the following registrants and Disputed Domain Names (defined below) which share sufficient links contributing to a finding in favour of the Complainant's application:

Registrant	Domain Name(s)	Registration date	Registrar
sadsxcsda sfafsafd	<deichmannrabattss.shop>	21 December 2023	Web Commerce Communications Limited dba WebNic.cc
Chen Xiao	<deichmannoutlets.shop>	2 January 2024	Web Commerce Communications Limited dba WebNic.cc
Lin Jie	<deichmann-at.shop>	28 December 2023	Web Commerce Communications Limited dba WebNic.cc

Web Commerce Communications Limited	<deichmannschuhes.com> and <deichman-uk.com>	19 December 2023 21 September 2023	Alibaba.com Singapore e-commerce Private Limited
Colin Derby	<deichmann-outlet.shop>	12 November 2023	Dynadot Inc

The Panel notes that the registrant of the Domain Names <deichmannschuhes.com> and <deichman-uk.com> share nearly identical name and similar e-mail addresses [**@webnic.cc] with the registrar of the Domain Names <deichmannrabattss.shop>, <deichmannoutlets.shop> and <deichmann-at.shop> , the three of which being registered around the same time and bearing an identical TLD (<.shop>). The Panel further notes that the Domain Names <deichmannoutlets.shop>, <deichmann-at.shop> and <deichmann-outlet.shop> share the registrant country, namely China. On its turn, the Domain Name <deichmann-at.shop> resolves to an online store which mimics the website associated with the Domain Name <deichmannschuhes.com>. Furthermore, the Domain Names <deichmannrabattss.shop> and <deichmannoutlets.shop>, while inactive, are delegated to the same nameservers. The Domain Name <deichmann-outlet.shop> contains a rather similar string structure to the Domain Name <deichmannoutlets.shop> and were registered within less than two months apart. Despite not sharing registrant names, contact details, nameserver or registrar, it seems far-fetched to the Panel that these registrations were coincidental, by pure chance. In Panel's assessment, the above are compelling indicia of common control.

The Panel therefore accedes to the Complainant's request for consolidation in respect of the Disputed Domain Names <deichmannrabattss.shop>, <deichmannoutlets.shop>, <deichmann-at.shop>, <deichmannschuhes.com> and <deichman-uk.com>, and the Panel will refer to them collectively as 'the Respondent', and the above domain names as 'the Disputed Domain Names' in the remainder of the decision.

Turning to the other Domain Names listed in the Complaint, the Panel notes the following relevant details:

Registrant	**Domain Name(s)**	**Registration date**	**Registrar**
Han Chao	<deichmannmall.top> and <deichmannshop.top>	25 December 2023	Alibaba Cloud Computing Ltd. d/b/a/HiChina (www.net.cn)
Stephen Wilson	<deichman-eu.shop> <deichmanncount.com>	22 December 2023 20 December 2023	NameSilo, LLC
Daniel Chambers	<deichmshop.com>	8 September 2023	OwnRegistrar, Inc.
Tony Oconner	<deichmann-valuefinds.shop>	14 January 2024	Dynadot Inc

The Panel does not find commonalities or links conducive to a finding of common control among the above registrants. There is no common connection among the registrant names, registrar, or naming patterns, nor do they share technical/administrative contacts, e-mail addresses or nameservers.

The Panel is furthermore unpersuaded by the Complainant's argument that the respondents' default would be indicative of a common control of the Domain Names.

The UDRP claims against the respondents Han Chao, Stephen Wilson, Daniel Chambers, and Tony Oconner will therefore be dismissed without prejudice. The Complainant is at liberty to re-file separate UDRP complaints under the UDRP Policy against the above respondents and concerned Domain Names, accompanied by evidence to support a claim for common control or to make an

individualised case against each such respondent.

2. Complainant's Language Request

In view of the Panel's finding under item 1 above, the Complaint is denied as regards the Domain Names whose registration agreement is in Chinese, namely <deichmannmall.top> and <deichmannshop.top>. Consequently, the Complainant's Language Request has been superseded owing to the supervenient lack of cause of action.

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 based on 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 has UDRP-relevant rights in the registered trade mark DEICHMANN since at least 2010.

The Disputed Domain Names are <deichmannrabattss.shop>, <deichmannoutlets.shop>, <deichmann-at.shop>, <deichmannschuhes.com>, <deichman-uk.com>, and <deichmann-outlet.shop>. They were registered between September 2023 and January 2024 and each of which contains the Complainant's trade mark DEICHMANN in its entirety, together with the terms 'outlets', 'outlet', 'rabattss' (misspelled version of the German word 'rabatts' for 'discount'), 'schuhes' (German word for 'shoes'), as well as the geographical abbreviations 'uk' (for United Kingdom) and 'at' (for Austria). These additional terms and abbreviations have no material impact on the recognisability of the Complainant's trade mark in the strings of the Disputed Domain Names.

Moreover, the TLDs are typically disregarded by UDRP panels under this UDRP Policy ground (see paragraph 1.11 of the WIPO Jurisprudential Overview 3.0).

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 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:

> i. The Respondent must actually be offering the goods or services at issue;
>
> ii. The Respondent must use the website associated with the Disputed Domain Names to sell only the trade marked goods or services;

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

iv. 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 iii above) in the websites associated with the Disputed Domain Names <deichmann-at.shop> and <deichmannschuhes.com>. The remaining Disputed Domain Names do not resolve to active websites.

Moreover, the Panel is unconvinced that, before any notice of the dispute, the Respondent used, or made 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 discussed 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

The Complainant raises a number of factors that may indicate registration and use in bad faith of the Disputed Domain Names. Firstly, the Complainant's trade mark predates the registration of the disputed domain names by many years, in fact for over a decade. Secondly, the Disputed Domain Names all bear the trade mark DEICHMANN in their strings, coupled with terms and abbreviations immaterial to affect the recognisability of the Complainant's trade mark. Therefore, the Panel has no hesitation in finding that the Respondent registered the Disputed Domain Names with knowledge of, and intention to target, the Complainant.

As regards the use in bad faith, the Panel notes that the Disputed Domain Names <deichmann-at.shop> and <deichmannschuhes.com> resolve to online stores which appear to commercialise purported DEICHMANN 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 using the trade mark DEICHMANN on the Respondent's websites. The Respondent's behaviour would consequently fall in the realm of paragraph 4(b)(iv) of the UDRP Policy.

The Panel further notes that the Complainant has alluded to the doctrine of passive holding (see WIPO Jurisprudential Overview 3.0, paragraph 3.3) to support its claim for a finding of bad faith in relation to the Disputed Domain Names which do not resolve to active websites, which – at the time of writing – are the following: <deichmannrabattss.shop>, <deichmannoutlets.shop>, <deichman-uk.com>, and <deichmann-outlet.shop>.

In relation to the use of the Disputed Domain Names listed above, the Panel considers the most compelling indicia to decide in favour of the Complainant to be: (i) the degree of distinctiveness and reputation of the Complainant's trade mark in the footwear industry, which the Panel accepts; (ii) the Complainant's use of a similar domain name <deichmann.com> for nearly 30 years before the Respondent's registration of the Disputed Domain Names; (iii) the Respondent's failure to present a credible-backed rationale for registering the Disputed Domain Names; and (iv) the implausibility of any good faith use to which the Disputed Domain Names may be put.

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

E. Decision

For the foregoing reasons, in accordance with paragraph 4(a) of the UDRP Policy and Rule 15 of the UDRP Rules, the Panel orders that the Disputed Domain Names <deichmannrabattss.shop>, <deichmannoutlets.shop>, <deichmann-at.shop>, <deichmannschuhes.com>,<deichman-uk.com>, and <deichmann-outlet.shop> be transferred to the Complainant.

The Panel dismisses, without prejudice, the Complainant's claims regarding the Domain Names <deichmannmall.top>, <deichmannshop.top>, <deichman-eu.shop>, <deichmanncount.com>, <deichmann-valuefinds.shop>, and <deichmshop.com>. The Complainant is however at liberty to file separate UDRP complaints to seek the transfer of the above Domain Names, accompanied by evidence to support a claim for common control or to make an individualised case against each respondent.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **deichmannmall.top**: Remaining with the Respondent
2. **deichmannshop.top**: Remaining with the Respondent
3. **deichman-eu.shop**: Remaining with the Respondent
4. **deichmanncount.com**: Remaining with the Respondent
5. **DEICHMANNRABATTSS.SHOP**: Transferred
6. **DEICHMANNOUTLETS.SHOP**: Transferred
7. **DEICHMANN-AT.SHOP**: Transferred
8. **deichmann-valuefinds.shop**: Remaining with the Respondent
9. **deichmshop.com**: Remaining with the Respondent
10. **deichmannschuhes.com**: Transferred
11. **deichman-uk.com**: Transferred
12. **deichmann-outlet.shop**: Transferred

PANELLISTS

Name	**Yana Zhou**

DATE OF PANEL DECISION 2024-03-14

Publish the Decision