Decision for dispute CAC-UDRP-106224

Case number	CAC-UDRP-106224
Time of filing	2024-02-07 09:58:30
Domain names	off-whiteturkey.com, off-whitecolombia.com, off-whitedanmark.com, off-whitedeutschland.com, off-whitegreece.com, off-whitehungary.com, off-whiteindonesia.com, off-whitemexico.com, off-whitenetherlands.com, off-whitesuomi.com, off-whitepolska.com, off-whiteromania.com, off-whiteschweiz.com, off-whitesverige.com, off-whiteargentina.com, offwhite-canada.com, offwhite-chile.com, off-whiteespana.com, offwhite-greece.com, offwhite-hungary.com, offwhite-ireland.com, offwhiteitalia.com, offwhite-japan.com, offwhitemexico.com, off-whitenz.com, offwhiteperu.com, off-whiteschuhe.com, offwhiteslovenija.com, off-whitesrbija.com, offwhiteuae.com, off-whiteindia.com, offwhiteshoe.com, off-whiteuk.com, off-whiteusa.com, offwhitehoodieofficial.com, off--whites.com, offwhiteshoodie.com, offwhitesoutlet.com, off-whitenike.com, off-whiteonline.com, off-white-colombia.com, offwhitesouthafrica.com, offwhite-romania.com, off--whiteclothing.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	OFF-WHITE LLC

Complainant representative

Organization	Convey srl

Respondent

Organization	Web Commerce Communications Limited

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 submitted evidence that it is the registered owner of the following trademark registrations:

- European Union Trademark No. 012450466 for OFF-WHITE, registered since 15 July 2014 for the international classes 18, 25 and 35;
- International Trademark No. 1526379 for OFF-WHITE, registered since 14 March 2020 for the international class 9;
- International Trademark No. 1527289 for OFF-WHITE, registered since 14 March 2020 for the international class 14;

- International Trademark No. 1528727 for OFF-WHITE, registered since 3 April 2020 for the international class 4;
- US Trademark No. 3409331 for OFF-WHITE, registered since 19 November 2019 for the international class 25;
- US Trademark No. 6075289 for OFF-WHITE, registered since 9 June 2020 for the international class 4.

FACTUAL BACKGROUND

The Complainant is a U.S. company founded by designer Virgil Abloh. The company was first founded as "Pyrex Vision" in Milan, Italy in 2012. Abloh then rebranded the company as Off-White in 2013, which he described as "the grey area between black and white as the color off-white" to the fashion world. It has shown collections at Paris Fashion Week shows, and is sold in boutiques in Hong Kong, Tokyo, Milan, London and New York. In August 2019, José Neves, owner of Farfetch, purchased New Guards Group, the parent organization of the Complainant, for US$675 million. The Complainant has collaborated with many world's leading brands and designers.

The trademark OFF-WHITE, registered since years, is distinctive and well known all around the world specializing in luxury fashion. The Complainant has been extensively using the OFF-WHITE denomination on all internet environments including the company's official website www.off---white.com and its official accounts on social media.

The disputed domain names were registered by the Respondent in 2022 and 2023, without authorization of Complainant, and have been pointed to websites offering for sale the Complainant's products. On 27 November 2023, the Complainant's representative sent a cease-and-desist letter requesting immediate cease of any use and transfer of the disputed domain names to the email addresses indicated on the websites corresponding to the <offwhite-romania.com> and <off-whitepolska.com> domain names, but the Respondent has not deemed it appropriate to answer.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain names, and that the language of the registration agreements is English.

The Respondent has not filed any Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain names incorporate the whole of the Complainant's trademark OFF-WHITE and the fact that they include a non-distinctive element such as generic commercial terms (i.e. "outlet", "online" or "shoe" in English) and/or geographical terms and the generic Top-Level Domain .com does not affect the confusing similarity. The Complainant suggests that OFF-WHITE is an internationally well-known mark in the sector of luxury fashion and the Complainant's products are sold worldwide. The combination of the trademark OFF-WHITE with generic and geographical terms could suggest improperly to consumers that the disputed domain names and corresponding web sites might be directly controlled or authorized by the Complainant.

RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Complainant argues that it has made a prima facie case that the Respondents have no rights or legitimate interest in respect of the disputed domain names. The Respondent is not a licensee or authorized dealer of the Complainant nor has been authorized by the Complainant to use the trademark OFF-WHITE in the disputed domain names or in any other manner. Upon information and belief, the Respondent is not commonly known by the disputed domain names as individual, business or other organization. Furthermore, the Respondent has not provided the Complainant with any evidence of its 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 Respondent has not made any attempt to refute the Complainant's prima facie case, or replied to it at all.

The Complainant submitted evidence showing that the disputed domain names were redirected by the Respondent to websites with similar layouts where the Complainant's trademarks OFF-WHITE (both word and logo) were published and prima facie counterfeit OFF-WHITE branded products were offered for sale. In light of the following circumstances, the Complainant finds it evident that the goods offered for sale on the websites are counterfeit: the goods are sold disproportionately below market value, more than half the Complainant's prices; the Respondent has misappropriated copyrighted images from the Complainant's website; and the Respondent offers for sale goods using the images of the Complainant's website.

The Complainant concludes that the Respondent's use cannot be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names, and that such wilful conduct clearly demonstrates, to the contrary, that the Respondent did not intend to use the disputed domain names in connection with any legitimate purpose.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE BEING USED IN BAD FAITH

Turning to the bad faith argument, the Complainant points out that the Respondent could not have possibly ignored the existence of the Complainant's trademark, identical to the disputed domain names, particularly because of the registration and intensive use of the trademark OFF-WHITE since many years. The Complainant contends that the OFF-WHITE trademark enjoys worldwide reputation in luxury fashion sector and that the disputed domain names were all registered in 2022 and 2023, which is years after the Complainant adopted the sign OFF-WHITE for his items and services. Therefore, it is clear that the Respondent was well aware of the Complainant's trademark, and he has registered the disputed domain names with the intention to refer to the Complainant and its trademarks. Considering the trademark's distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant's registered trademarks at the time of the registration of the Domain Names, with which it is confusingly similar.

As to the use of the disputed domain names in bad faith, the redirections to websites where replicas of OFFWHITE products are offered for sale indicates that the Respondent was fully aware of the reputation of the Complainant's mark and its association with the Complainant and that his purpose in registering the disputed domain names, which incorporates the Complainant's trademark OFF-WHITE, was solely intended to capitalize on the reputation of Complainant's mark by diverting Internet users seeking products under the OFF-WHITE mark to its own commercial web sites.

The Complainant notes that the disputed domain name <offwhite-hungary.com> was at the time of filing the Complaint not redirected to an active website, whereas before the cease-and-desist letter was sent, the corresponding website had been similar to the other ones. The Complainant suggests that this situation could be evaluated according to the passive-holding doctrine. In the present case, the trademark OFF-WHITE has a high degree of distinctiveness, the Respondent has not replied to the cease-and-desist letter, the Respondent has concealed his identity in the Whois records and there is not any chance of good faith use by the Respondent.

Furthermore, the Respondent has targeted the Complainant, registering forty-four domain names including the trademark OFF-WHITE, which prevents the Complainant from reflecting the marks in the corresponding domain names. The Complainant suggests that the Respondent has engaged in a pattern of conduct.

As an additional circumstance demonstrating bad faith, the Complainant makes the point that the Respondent failed to respond to a cease-and-desist letter.

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 Complainant made a request to consolidate all disputed domain names in a single UDRP proceedings. The Complainant explicitly "believes that the disputed domain names, which all incorporate the trademark OFF-WHITE 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".

The Panel notes that, according to the Registrar Verification, all disputed domain names are registered by the same and only one entity – the Respondent. Therefore, the Panel agrees to consider all disputed domain names in a single proceeding pursuant to Paragraph 4(f) of the Policy and Paragraph 10(e) of the Rules.

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

This is a proceeding under Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. According to Paragraph 4(a) of the Policy, a complainant must prove each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

(A) Identical or confusingly similar domain name

The Complainant demonstrated that it owns the asserted trademark registrations for the word and logo mark "OFF-WHITE", which was registered long before the registration of the disputed domain names by the Respondent. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix may be disregarded when considering whether a disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain names all incorporate the Complainant's trademark "OFF-WHITE" in its entirety, either with or without a hyphen, but always in the distinctive beginning part of the disputed domain names. Adding additional words, such as country names, country abbreviations, or generic terms common to the Complainant’s industry (i.e. fashion), to the Complainant’s trademark is not sufficient to escape the finding that the disputed domain names are confusingly similar to the Complainant’s trademark.

The Panel therefore finds that the disputed domain names are confusingly similar to the trademark in which the Complainant has rights.

(B) Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant’s trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain names pursuant to Paragraph 4(c)(ii) of the Policy. Furthermore, it was demonstrated by evidence submitted by the Complainant that the content displayed on the disputed domain names looks as if the relevant websites were owned and run by the Complainant. The websites operated on the disputed domain names not only show similar layouts where the Complainant’s trademarks OFF-WHITE (both word and logo) are used and apparently counterfeit OFF-WHITE branded products are offered for sale. The Respondent has not provided the Complainant with any evidence of its 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. At the very least, the Respondent takes advantage of the Complainant’s renown in the field of fashion. The Panel is convinced that the Respondent is intentionally trying to gain commercial monetary profit from the use and registration of the disputed domain names and is trying to benefit from and cause detriment and damage to the Complainant’s trademark without there being any bona fide reason to do so.

The Panel therefore finds that the Respondent has no rights or legitimate interest in the disputed domain names.

(C) Registration and use of the disputed domain name in bad faith

The Panel has already found that the disputed domain names are confusingly similar to the Complainant's trademark “OFF-WHITE”. It is well established that the mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith. In addition, the Panel holds that the Complainant submitted evidence of several other signs of the Respondents’ bad faith in registration and use of the disputed domain names, namely: (a) use of the “OFF-WHITE” brand and logo on the respective websites; (b) creating such contents on those websites that make an impression of the Complainant’s own or authorized websites and e-shops; (c) offering products on those websites that are apparently counterfeits of the Complainant’s products; and (d) not responding to the Complainant’s cease-and-desist letter.

With respect to the <offwhite-hungary.com> domain name, the Complainant points out that it became inactive after the cease-and-desist letter was sent to the Respondent, although it had contained similar content as the other disputed domain names before. As of the moment of making the Complaint, the Complainant suggests that bad faith can be found based on the passive-holding doctrine. The Panel in principle agrees that the typical conditions for application of the passive-holding doctrine are met in this case given that (i) the Complainant’s trademark is highly distinctive in luxury fashion industry; (ii) the Respondent has not submitted any Response; (iii) the Respondent’s identity was concealed in the Whois records; and (iv) it is implausible to find any good faith use to the which respective domain name may be put. In addition, the Panel is of the view that the actual proven use of this particular domain name prior to the sending of the cease-and-desist letter by the Complainant and the subsequent de-activation of the domain name by the Respondent would be sufficient to finding a bad faith.

It seems very clear that the Respondent must have had actual knowledge of the Complainant's trademark and that it has attempted to attract Internet users for commercial gain to their own websites by use of the Complainant's trademark. In view of the Panel, there is no plausible reason for the Respondent to register the disputed domain names in good faith.

Consequently, the Panel finds that the disputed domain names have been registered and have been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **off-whiteturkey.com**: Transferred
2. **off-whitecolombia.com**: Transferred
3. **off-whitedanmark.com**: Transferred
4. **off-whitedeutschland.com**: Transferred
5. **off-whitegreece.com**: Transferred
6. **off-whitehungary.com**: Transferred
7. **off-whiteindonesia.com**: Transferred
8. **off-whitemexico.com**: Transferred
9. **off-whitenetherlands.com**: Transferred
10. **off-whitesuomi.com**: Transferred
11. **off-whitepolska.com**: Transferred
12. **off-whiteromania.com**: Transferred
13. **off-whiteschweiz.com**: Transferred
14. **off-whitesverige.com**: Transferred
15. **off-whiteargentina.com**: Transferred
16. **offwhite-canada.com**: Transferred
17. **offwhite-chile.com**: Transferred
18. **off-whiteespana.com**: Transferred
19. **offwhite-greece.com**: Transferred
20. **offwhite-hungary.com**: Transferred
21. **offwhite-ireland.com**: Transferred
22. **offwhiteitalia.com**: Transferred
23. **offwhite-japan.com**: Transferred
24. **offwhitemexico.com**: Transferred
25. **off-whitenz.com**: Transferred
26. **offwhiteperu.com**: Transferred
27. **off-whiteschuhe.com**: Transferred
28. **offwhiteslovenija.com**: Transferred
29. **off-whitesrbija.com**: Transferred
30. **offwhiteuae.com**: Transferred
31. **off-whiteindia.com**: Transferred
32. **offwhiteshoe.com**: Transferred
33. **off-whiteuk.com**: Transferred
34. **off-whiteusa.com**: Transferred
35. **offwhitehoodieofficial.com**: Transferred
36. **off--whites.com**: Transferred
37. **offwhiteshoodie.com**: Transferred
38. **offwhitesoutlet.com**: Transferred
39. **off-whitenike.com**: Transferred
40. **off-whiteonline.com**: Transferred

41. **off-white-colombia.com**: Transferred
42. **offwhitesouthafrica.com**: Transferred
43. **offwhite-romania.com**: Transferred
44. **off--whiteclothing.com**: Transferred

PANELLISTS

Name	**Vojtěch Chloupek**

DATE OF PANEL DECISION 2024-04-01

Publish the Decision