Decision for dispute CAC-UDRP-106377

Case number	CAC-UDRP-106377
Time of filing	2024-04-03 09:42:19
Domain names	buffalogreece.com, buffaloofficieel.com, buffalosuisse.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	BUFFALO BOOTS GMBH

Complainant representative

Organization	MIIP - MADE IN IP

Respondents

Name	LUCAS REID
Name	MARY BROWN
Name	ZHANG QIANG

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

In these proceedings, the Complainant relies on the following trademarks:

- “Buffalo” (stylized word), International Registration No. 717749, registered as of July 1, 1999, in the name of Buffalo Boots GmbH (the Complainant), duly renewed; and

- “Buffalo” (stylized word), International Registration No. 1251324, registered as of April 28, 2015, in the name of Buffalo Boots GmbH (the Complainant), also duly renewed.

It is worth noting that, the Complainant owns many similar trademarks in various countries, including where the Respondents are allegedly located, which have not been cited in these proceedings.

FACTUAL BACKGROUND

According to information provided by the Complainant and not disputed by the Respondents, the Complainant is a large German footwear company, well known in the ‘90s because of its successful collaboration with the musical group “The Spice Girls”. Ever since, the Complainant and its goods have acquired commercial presence and reputation all around the world.

The Complainant owns a good-sized portfolio of trademarks including the wording "Buffalo", among which two International registrations dating back to 1999 and 2015. It also owns several related domain names, such as its official website <buffalo-boots.com> since November 21, 1995.

The disputed domain names <buffalogreece.com> / <buffalosuisse.com> / <buffaloofficieel.com> were registered on May 31, 2023 / August 24, 2023 / November 1, 2023, respectively, by the three Respondents.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to its Buffalo trademark, as they wholly incorporate this trademark, which is in each case accompanied by a geographical or a generic term. This last element is sufficient to support the finding that the disputed domain names are confusingly similar to the Complainant's trademark. Indeed, the mere addition of a geographical or a generic term to the Complainant’s trademark does not change the overall impression of a most likely connection with the trademark Buffalo of the Complainant. As to the gTLD “.com”, the Complainant suggests that it should be disregarded, as per the usual practice.

The Complainant basically maintains that the Respondents lack rights or legitimate interests in the disputed domain names, because the Respondents are not known by the disputed domain names, the Complainant is not affiliated with nor has it ever authorised the Respondents to register their trademarks as domain names and the Complainant has no business with the Respondents.

According to the Complainant, given the distinctiveness and reputation of the Buffalo trademark, the Respondents registered the disputed domain names with full knowledge of the Complainant's trademark in an intentionally designed way with the aim to create a likelihood of confusion with the Complainant’s trademarks and domain names, and this is evidence of the fact that the disputed domain names were registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondents have used the disputed domain names as pages that essentially copy the Complainant’s official website, a fact that -in combination with the incorporation of a famous trademark in a domain name- proves use in bad faith.

For all these reasons, the Complainant concludes that the Respondents registered and used the disputed domain names in bad faith.

RESPONDENTS:

No administratively compliant Response has been filed.

RIGHTS

Before launching itself into the usual threefold test, according to paragraph 4(a) of the Policy, the Panel needs to address the issue of the request by the Complainant for consolidation of the three (3) disputed domain names and of their respective Respondents. This matter was well presented by panels in quite a few occasions, such as in WIPO Case No. D2016-0759 Mou Limited v Zeng Xiang et al.

Article 4(f) of the Uniform Domain Name Dispute Resolution Policy (“UDRP”) provides, among others, that the “Administrative Panel may consolidate before it any or all such disputes in its sole discretion”.

Further, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") stipulate under Rule 3(c):

The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

The Rules have a further provision, Rule 10(e), which confirms Article 4(f) UDRP mentioned above and enables the Panel to decide in its own discretion upon a request for consolidation:

"A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules."

Also, as decided in WIPO Case No. D2010-0281 Speedo Holdings v Programmer et al., “consolidation will permit multiple domain

name disputes arising from a common nucleus of facts and involving common legal issues to be heard and resolved in a single administrative proceeding. Doing so promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, and generally furthers the fundamental objectives of the Policy".

The WIPO Jurisprudential Overview 3.0 analyses the topic of a complaint consolidated against multiple respondents under its Paragraph 4.11.2, where it is stated:

"Where a complaint is filed against multiple respondents, 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.

Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)."

In the case at hand, the Complainant cited the following as reasons to support its allegation that the three disputed domain names are subject to common control:

- All the disputed domain names are (or have been) hosted by FIBERGRID as demonstrated by the Whois record of <buffalosuisse.com>) and the exchanges between the Complainant and Cloudflare.

- Each domain name is (or have been) connected to a fake Buffalo website (reproducing the applicant's logo) adapted to the country concerned, but the design of all the sites is identical and certain photos are found on several sites.

- The 3 disputed domain names include the Complainant's trademark "BUFFALO", which is well known, particularly in Germany.

- 2 of the 3 domain names, <buffalosuisse.com> and <buffalogreece.com>, share the same "BUFFALO + country" structure.

On its part, the Panel finds the following:

- No sufficient concrete evidence has been furnished by the Complainant, to establish that all three disputed domain names are subject to common control.

- Indeed, the three disputed domain names have been registered at different dates, by different registrants, apparently residing in different countries. No obvious connection seems to exist between them.

- Only by its own initiative to compare the websites' screenshots corresponding to the disputed domain names could the Panel infer that, the interface appearance of <buffalogreece.com> and <buffalosuisse.com> is similar to such an extent that it cannot be a mere coincidence. The presentation of the two pages is almost identical, with same colours used, same arrangement of pictures, similar wording (in Greek and French, respectively), same code and sale percentage on top, etc. This is not true for the third disputed domain name <buffaloofficieel.com>, that boasts a whole other concept, with a quite different layout, fonts and colours.

With all the above in mind, the Panel decides to admit, in its sole discretion, the Complainant's request for consolidation of two out of the three disputed domain names (<buffalogreece.com> and <buffalosuisse.com>), so as to be consistent with the UDRP Policy and the Rules, and to be "procedurally efficient and fair and equitable to all parties". It is, of course, open to the Complainant to bring a separate Complaint in respect of the disputed domain name <buffalloofficieel.com>, if it so desires.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names <buffalogreece.com> and <buffalosuisse.com> 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).

The disputed domain names wholly incorporate the Complainant's trademark (Buffalo). The mere addition of geographical terms ("greece" and "suisse") in the disputed domain name is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark of the Complainant.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondents to have no rights or legitimate interests in respect of the disputed domain names <buffalogreece.com> and <buffalosuisse.com> (within the meaning of paragraph 4(a)(ii) of the Policy).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued, among others, that it had never authorised the Respondents to register the Buffalo trademark in a domain name, and that it had never licensed its trademark to the Respondents.

Furthermore, the Respondents have not demonstrated any use of the disputed domain names in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names.

Finally, there is no other evidence in the case file that could demonstrate that the Respondents have been commonly known by the disputed domain names.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondents lack rights and legitimate interests in the disputed domain names. In order to rebut the Complainant's arguments, the Respondents had the possibility to make their own defense. However, the Respondents have chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names <buffalogreece.com> and <buffalosuisse.com> have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark and the fact that the disputed domain names wholly incorporate this trademark (even with the addition of geographical terms), it is evident that, at the time of the registration of the disputed domain names, the Respondents were well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain names resolve to pages that copy the Complainant’s official website to a large extent. This fact is to be combined with the incorporation of the Complainant’s reputable trademark in the disputed domain names. For this Panel, same as for many previous panels, such misleading behaviour clearly amounts to use in bad faith. Therefore, it is impossible to conceive any plausible active use of the disputed domain names that would be legitimate.

Therefore, the Panel finds it clear that the disputed domain names were used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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

The disputed domain names <buffalogreece.com> and <buffalosuisse.com> wholly incorporate the Complainant's trademark, with the addition of geographical terms. The disputed domain names are therefore confusingly similar to the Complainant's trademark.

The Respondents were not authorised to include the Complainant's trademark in the disputed domain names, and the Complainant never licensed its trademarks to the Respondents. The Respondents are not using the disputed domain name in connection with a

bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondents registered the disputed domain names with full knowledge of the Complainant's reputable trademark. Their use of the disputed domain names is in bad faith as there is no conceivable use of the disputed domain names that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **buffalogreece.com**: Transferred
2. **buffaloofficieel.com**: Terminated (consolidation not granted)
3. **buffalosuisse.com**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2024-05-10

Publish the Decision