

Decision for dispute CAC-UDRP-106445

Case number	CAC-UDRP-106445
Time of filing	2024-04-25 10:06:08
Domain names	goladubaimall.com, golashoesuk.com, golasneakersoutletusa.com, golathailand.com

Case administrator

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

Organization	D. Jacobson & Sons Limited
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Complainant representative

Organization	Mr Edward John Charles Downes (TLT LLP)
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Respondents

Name	Zoe Zhang
Name	Griffin Downey
Name	Leslie Maldonado
Name	Ingrid Nelson

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 owns the following registered Trademarks:

UK trademark No 00001097140 GOLA in class 18 registered on 14 June 1978, renewed;

UK trademark No 00001055606 Wing Flash Logo in class 25 registered on 25 November 1975, renewed;

UK trademark No 00000272980 GOLA, registered in class 25 on 22 May 1905, renewed;

EU trademark No 001909936 GOLA, registered in classes 18, 25, 28 on 4 October 2000, renewed;

EU trademark No 003399681 GOLA, registered in classes 5, 10, 12, 35 on 8 October 2003; and

EU trademark No 011567625 GOLA (stylised), registered in classes 18, 25, 35 on 12 February 2013.

FACTUAL BACKGROUND

The disputed domain names were registered in April/May 2022 and are being used to offer for sale GOLA branded footwear and bags. The Complainant is a UK based designer, importer, seller and exporter of ladies', men's and children's footwear. In particular, the Complainant owns the internationally famous "GOLA" brand, which it has very successfully applied (amongst other things) to its range of footwear and bag designs. The Complainant's footwear and bag products are sold throughout the world, including through its various websites registered under domain names such as <gola.co.uk> and <golausa.com> (the Gola Domains). Customers in the UK, EU and US are able to purchase the Complainant's products through the GOLA domain names.

All domains in question were registered on the same date (18 October 2023).

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

The Complainant already filed various UDRP complaints in past years against a Respondent i.e. in the following similar cases:

- UDRP Case 104400 and decision ordering the transfer of <golasingapore.com>, <golashoescanada.com>, <goladeutschland.com>;
- UDRP case 104400 and decision ordering the transfer of <golasingapore.com>, <golasingapore.com>, <golasireland.com>, <golaportugal.com>, <golaespana.com>, <golaaustralia.com> and <golacolombia.com>.

The Complainant strongly believes that despite being registered by seemingly separate Respondents, the disputed domain names are all linked and have in fact been registered by either the same Respondent or a connected entity.

No administratively compliant Response has been filed.

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).

The disputed domain names wholly incorporate the GOLA Trademarks.

They only differ from the GOLA trademarks by the addition of a geographical name, and by the addition of the designation of the branded GOLA products and of a geographical name.

Adding a geographical name only aims at targeting the web users of the designated country.

It is not sufficient to avoid any likelihood of confusion with the GOLA trademarks.

The disputed domain names are recognizable by the GOLA trademark that they are composed with.

It is largely admitted that the gTLD serves a technical purpose and is to be disregarded for a finding of confusing similarity.

Thus, the disputed domain names are confusingly similar to the GOLA trademarks.

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 (within the meaning of paragraph 4(a)(ii) of the Policy).

The Respondents are not related in any way with the Complainant and that it did not grant authorization to use the GOLA trademarks or to register the disputed domain names. This allegation was not contested by the Respondents

The Respondents are using the disputed domain names for phishing purposes, as it already happened before.

The Respondents did not respond to the Complainant to rebut its prima facie case. They did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain names.

Therefore, the Complainant has established a prima facie case that the Respondents have no rights or legitimate interests in respect to the disputed domain names.

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).

The GOLA trademark was first registered in 1905, and duly renewed since then. The disputed domain names were registered in October 2023.

The Panel agrees that the GOLA trademarks are highly distinctive. Given the use of the disputed domain names, providing access to websites presenting GOLA branded shoes, the Respondents were well aware of the GOLA trademarks before the registration of the disputed domain names.

The Panel finds that Respondents are intending to profit from a likelihood of confusion, and finds this is evidence of bad faith. The disputed domain names have clearly been set up by the Respondents to mirror the Complainant's genuine websites, through use of a domain which includes the Complainant's Gola Marks, content from its website and prominently features the Trade Marks at the top of the website and in the product advertising appearing on the website homepages and other pages throughout the

website. In fact, it is evident that the Respondents purposefully used the Trade Marks fraudulently to deceive the public into a mistaken belief that the disputed domain names are owned by the Complainant, or is associated or connected with the Complainant.

Therefore, the Panel considered that the Respondents have registered the disputed domain names for the purpose of disrupting the business of the Complainant.

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. The fact that all disputed domain names were targeting the Complainant's trademarks resolving to almost identical websites with most information bearing similarities to that disclosed for the other respondents, grounded the panel's decision to allow the consolidation (see also Case No. D2022-4020). On the balance of probabilities the Panel found the consolidation is warranted given the above-mentioned factors:

- The disputed domain names all follow a very similar format i.e. the GOLA mark followed by a country name or indicator, and/or a specific term such as "mall", "shoe", or "sneaker" etc.;
- All domains were registered on the same date (18 October 2023);
- The Respondents' names (Zoe Zhang, Griffin Downey, Leslie Maldonado, and Ingrid Nelson) are all unremarkable and follow the same basic form (generic first and last name);
- The Respondents' email addresses are all very similar, with the domain name being "mail.com" and the username being a random string of letters:

(a) haiswiztocknegde@mail.com;

(b) leadresizebri@mail.com;

(c) velbiwhacbiro@mail.com; and

(d) fecbethemitzhun@mail.com;

- The Respondents' locations all purport to be in North America (US or Canada); and the content of the underlying websites all mirror each other exactly.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain names wholly incorporate the GOLA trademarks.

The addition of a geographical name is not sufficient to avoid any likelihood of confusion with the GOLA trademarks.

The Complainant asserts that the Respondents are not related in any way with the Complainant and that it did not grant authorization to use the GOLA trademarks or to register the disputed domain names. This allegation was not contested by the Respondents.

The Complainant argues that the Respondent is using the disputed domain names for phishing purposes, as it already happened before.

The GOLA trademark was first registered in 1905, and dully renewed since then. The disputed domain names were registered in April/May 2022.

The Panel agrees that the GOLA trademarks are highly distinctive. Given the use of the disputed domain names, providing access to websites presenting GOLA branded shoes, the Respondents were well aware of the GOLA trademarks before the registration of the disputed domain names.

The Panel finds that Respondents are intending to profit from a likelihood of confusion, and finds this is evidence of bad faith.

The Respondents did not respond to the Complainant to rebut its prima facie case. They did not provide any evidence or allege any circumstance to establish that they have rights or legitimate interests in the disputed domain names.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **goladubaimall.com**: Transferred
- 2. **golashoesuk.com**: Transferred
- 3. **golasneakersoutletusa.com**: Transferred
- 4. **golathailand.com**: Transferred

PANELLISTS

Name	Thomas Hoeren
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DATE OF PANEL DECISION	2024-05-18
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Publish the Decision