

Decision for dispute CAC-UDRP-107011

Case number	CAC-UDRP-107011
Time of filing	2024-10-30 09:53:05
Domain names	uniqlo-romaniaro.com, uniqlohungary-eu.com, uniqloportugal-pt.com, uniqloaustralia-au.com, uniqlo-irelandie.com, uniqlo-nzshop.com , uniqlosjapan.shop, uniqlono-norge.com, uniqlogreeceeshop.com, uniqloenmexico-mx.com, uniqlobrasil-br.com, uniqlodanmark-dk.com, uniqlosk-slovensko.com, uniqlobelgium-be.com, uniqlosuomi-fi.com, uniqlonederland-nl.com, uniqlosverige-se.com, uniqloturkey-tr.com, uniqlophilippines-ph.com, uniqlomalaysia-my.com, uniqlo-sg.com, uniqlooinindia.com , uniqlosindia-in.com, uniqlosouthafrica-za.com, uniqlo-uruguayuy.com, uniqloslovenia-si.com, uniqlo-hrvatskahr.com, uniqlocanada-ca.com, uniqlosingapore-sg.com, uniqlolondon-uk.com , uniqlo-argentinaar.com, uniqlo-ecuadorec.com, uniqloperu-pe.com, uniqloes-espana.com, uniqlo-polskapl.com , uniqloaustria-at.com, uniqlo-japanjp.com, uniqlomy.com, uniqlo.co.com, uniqlonederland.shop, uniqlosingapore.biz, uniqlojapan.biz, uniqloportugal.biz, uniqloaustralia.biz, uniqloschweiz.biz, uniqlohrvatska.biz, uniqloosterreich.biz, uniqloeutschland.biz

Case administrator

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

Organization	FAST RETAILING CO., LTD.
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Complainant representative

Organization	Zacco Sweden AB
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Respondents

Name	Florian Lehman
Name	Michelle Nagel
Name	Bernd Kohl
Name	Kristian Faber
Name	Martin Nagel
Name	Yvonne Reiniger
Name	Ursula Junker
Name	Anke Pfaff
Name	Brigitte Konig

Organization	ebay i
Name	Jonas Biermann
Name	Antje Beckenbauer
Name	Daniela Walter
Name	Mandy Bachmeier
Name	Daniela Masberg
Name	Daniela Mager
Name	Maria Wurfel
Name	Cornelia Ross
Name	Daniela Fuchs

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 a large portfolio of trademarks for UNIQLO in several jurisdictions. As such, and by way of example before the European Union Intellectual Office registration number 001663749, registered on December 4, 2001; United States Patent and Trademark Office with registration number 2720333, registered on June 3, 2003.

FACTUAL BACKGROUND

The Complainant is a global developer of fashion brands doing business worldwide. The Company opened its first retail clothing store in 1984 and currently it has 2394 stores worldwide. The Complainant has FY2024 sales of ¥ 2640 trillion.

UNIQLO trademark is to be considered well-known for UDRP purposes.

All the disputed domain names were registered between May 11 and May 22, 2024 (herein after group 1) excluding <uniqlomy.com> and <uniqlo.co.com> (herein after group 2) both registered on July 15, 2024.

Currently, the disputed domain names are inactive except <uniqloes-espana.com> and <uniqloperu-pe.com> which redirect to a website that purports to be the Complainant. However, the Complainant has provided evidence of use of most of the disputed domain names by means of screenshots displaying to different sites with the look and feel of the Complainant's.

PARTIES CONTENTIONS

THE COMPLAINANT

The Complainant requests the consolidation of all the disputed domain names in a single UDRP procedure based on the common control by the same registrant. For such, the Complainant alleges that the disputed domain names have been connected to very similar websites and the domain name string is similar, that is, combining UNIQLO mark with a geographical term. The Complainant also alleges that apart from <uniqlo.co.com> all the disputed domain name were registered following a same string or composition. In respect of the latter, the Complainant notes that the registrant is the same as in <uniqlomy.com>.

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

In particular, the Complainant alleges that the disputed domain names are composed by the Complainant's trademark UNIQLO in its

entirety, together with geographical or generic terms such as “Portugal”, “nzshop”, etc. Indeed, says the Complainant, the addition of generic top-level domains such as <.com>, <biz> or <shop> do not have any impact in the assessments of the first requirement.

The Complainant also contends that none of the circumstances depicted in paragraph 4 (c) of the Policy applies in this case. Indeed, the Complainant alleges that the disputed domain names have been chosen to generate traffic and income through websites displaying a clear copy of the Complainant’s official website.

The Complainant initiated a takedown procedure before the domain name registrar and the hosting provider. However, the Respondent ignored the attempts of contacts made.

Furthermore, Complainant’s trademark is well-known and the Respondent is using the disputed domain names in attempt to target and deceive local consumers into believing that they are operated by the Complainant or by an affiliated party.

THE RESPONDENT

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).

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 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.

PRELIMINARY PROCEDURAL ISSUE: REQUEST FOR CONSOLIDATION OF THE COMPLAINT

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are under common control and thus requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

As noted, the disputed domain name registrants did not comment on the Complainant’s request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant’s request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 4.11.2.

As regards common control, the Panel notes that the evidence supports a common control over the group 1 of disputed domain names, that is to say except for group 2. Accordingly, the similarities of the disputed domain names in group 1 strings by using the UNIQLO trademark plus a geographical term, the date of registration, the fact that the majority of the disputed domain names are registered before the same Registrar, the addresses are always referred to individuals located in Germany and, all the records show a <Hotmail> e-mail address.

Additionally, the Panel finds that common control is also met since the use of the disputed domain name prior to the take down procedure before the Registrar, yielded to websites with a feel and like of the Complainant’s in at least 35 of them. In this regard, the

inactive disputed domain names are owned by registrants with other active disputed domain names except <uniqlojapan.biz> and <uniqlohrvatska.biz>. Having in mind the rest of the circumstances, on balance, this does not avoid common control of the Respondent.

Regarding fairness and equity, the Panel sees no reason why consolidation of the disputes in connection to group 1 would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding with regard to all the dispute domain names of group 1.

That said, the Panel notes that <uniqlomy.com> and <uniqlo.co.com>, or group 2, were registered on a slightly different period of time, the string of the composition do not match with the disputed domain names in group 1 (note that <uniqlomy.com> does not reproduce the country or an hyphen but only the ISO 3166 code being the only example in the Complaint) and the contact details differ in several features: the registrant (a seemingly corporation versus an individual), the country (China versus Germany), the language (Chinese characters versus Latin) or the type of e-mail account used (Gmail versus Hotmail). Further, there is no indicia of any use of the disputed domain names of the group 2 by contrast of most of the group 1.

PRINCIPAL REASONS FOR THE DECISION

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1. Identical or Confusingly Similar

The Complainant has shown rights in respect of UNIQLO trademark for the purposes of the Policy. It is apparent that the mark UNIQLO is reproduced in all the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. Further, the addition of a geographical term (country, city and or ISO 3166 country code) or even a hyphen or a generic term (<uniqlo-nzshop.com>) to a trademark do not avoid a finding of confusing similarity.

The Panel also finds that a misspelling as it occurs in <uniqloeuetschland.biz>, <uniqlgreeceeshop.com>, <uniqlslojapan.shop>, or <uniqllooinindia.com> does not avoid confusing similarity for UDRP purposes. Likewise, by adding the Spanish preposition "en" to the string in <uniqloenmexico-mx.com> the Respondent does not avoid confusing similarity with the trademark.

The applicable Top Level Domain ('TLD') in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element test.

The Panel finds the first element of the Policy has been established.

1. Rights or Legitimate Interest

Paragraph 4(c) of the Policy sets out non-exclusive examples in which the Respondent may establish rights or legitimate interests in the disputed domain name. However, while the burden of proof in UDRP proceedings rests on the complainant, panels have recognized that proving a respondent lack or rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative". Accordingly, panels have established, since the inception of the UDRP, that it is sufficient to raise a prima facie case against the respondent and then the evidential burden of production shifts to the respondent (See CAC-UDRP-106452).

The Panel finds that the circumstances referred in paragraph 4(c) do not apply for the Respondent or, even any other legitimate circumstance which may apply in favor to the Respondent. Indeed, the composition of all the disputed domain names and the corresponding sites to which most domain names divert, support a finding of impersonation which cannot grant rights or legitimate interests.

Besides, the silence of the Respondent, once received the Complaint, has avoided the Panel to assess if any circumstances may oppose to the Complainant's prima facie showing.

The Panel finds the second element of the Policy has been established.

3. Register and Used in Bad Faith

Noting that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark, the Panel now looks at the third requirement of the test.

By registering the disputed domain names that reproduces Complainant's well-known trademark, the Respondent targeted the Complainant. Accordingly, the Panel determines that the Respondent knew or should have known about the Complainant and its trademarks when registering the disputed domain names.

Additionally, the Panel finds other factors in assessing whether the Respondent's registration of the disputed domain names is in bad faith. As such, the nature of the disputed domain names incorporating UNIQLO mark plus geographic term; a clear absence of rights or legitimate interests coupled with no response, or the set of disputed domain names suggesting that the Respondent had targeted the Complainant. Therefore, the Panel concludes that the disputed domain names registration falls within what is deemed

to be considered bad faith registration.

The Panel notes that all the disputed domain names are inactive except two of them. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel notes the distinctiveness and the reputation of the Complainant's trademark and the composition of the disputed domain name to contend that, in the circumstances of this case, the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

Indeed, the only two domain names active, i.e., <uniqloes-espana.com> and <uniqloperu-pe.com> divert to a website that purports to be the Complainant when this is not the case, and the sites reproduce its trademarks and seemingly its copyrights. This also matches with the circumstances in at least 35 disputed domain names prior to the take down procedure before the Registrar or website provider.

Besides, the Panel has checked all the contact details provided by the Registrars and has concluded that either the address or the Zip code is inaccurate. By providing false contact details the Respondent cast doubt on the Registrants bona fide.

The Panel finds that the Complainant has established the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **uniqlo-romaniaro.com**: Transferred
2. **uniqlohungary-eu.com**: Transferred
3. **uniqloportugal-pt.com**: Transferred
4. **uniqloaustralia-au.com**: Transferred
5. **uniqlo-irelandie.com**: Transferred
6. **uniqlo-nzshop.com** : Transferred
7. **uniqlosjapan.shop**: Transferred
8. **uniqlono-norge.com**: Transferred
9. **uniqlogreeceeshop.com**: Transferred
10. **uniqloenmexico-mx.com**: Transferred
11. **uniqlobrasil-br.com**: Transferred
12. **uniqlodanmark-dk.com**: Transferred
13. **uniqlosk-slovensko.com**: Transferred
14. **uniqlobelgium-be.com**: Transferred
15. **uniqlosuomi-fi.com**: Transferred
16. **uniqlonederland-nl.com**: Transferred
17. **uniqlosverige-se.com**: Transferred
18. **uniqloturkey-tr.com**: Transferred
19. **uniqlophilippines-ph.com**: Transferred
20. **uniqlomalaysia-my.com**: Transferred
21. **uniqlo-sg.com**: Transferred
22. **uniqlooinindia.com** : Transferred
23. **uniqlosindia-in.com**: Transferred
24. **uniqlosouthafrica-za.com**: Transferred
25. **uniqlo-uruguayuy.com**: Transferred
26. **uniqloslovenia-si.com**: Transferred
27. **uniqlo-hrvatskahr.com**: Transferred
28. **uniqlocanada-ca.com**: Transferred
29. **uniqlosingapore-sg.com**: Transferred
30. **uniqlolondon-uk.com** : Transferred
31. **uniqlo-argentinaar.com**: Transferred
32. **uniqlo-ecuadorec.com**: Transferred

33. **uniqloperu-pe.com**: Transferred
34. **uniqloes-espana.com**: Transferred
35. **uniqlo-polskapl.com** : Transferred
36. **uniqloaustria-at.com**: Transferred
37. **uniqlo-japanjp.com**: Transferred
38. **uniqlomy.com**: Terminated (consolidation not granted)
39. **uniqlo.co.com**: Terminated (consolidation not granted)
40. **uniqlonederland.shop**: Transferred
41. **uniqlosingapore.biz**: Transferred
42. **uniqlojapan.biz**: Transferred
43. **uniqloportugal.biz**: Transferred
44. **uniqloaustralia.biz**: Transferred
45. **uniqloschweiz.biz**: Transferred
46. **uniqlohrvatska.biz**: Transferred
47. **uniqloosterreich.biz**: Transferred
48. **uniqlodeutschland.biz**: Transferred

PANELLISTS

Name	Manuel Moreno-Torres
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DATE OF PANEL DECISION	2024-12-24
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Publish the Decision
