Decision for dispute CAC-UDRP-107252

Case number	CAC-UDRP-107252
Time of filing	2025-01-21 15:14:41
Domain names	renecaovillashoes.shop

Case administrator

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

Complainant

Organization	René Caovilla S.p.A.

Complainant representative

Organization	GriffeShield S.r.l.

Respondent

Name	Richard Bergeron

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 name.

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the trademarks bearing “RENÉ CAOVILLA”, inter alia, the following:

- European Union trademark “RENÉ CAOVILLA” n°003128311, registered on June 30, 2004;
- International device trademark including element “RENÉ CAOVILLA” n°834807, registered on May 5, 2004.

Moreover, the Complainant is also the owner of the domain name <renecaovilla.com>, registered on June 18, 2002.

FACTUAL BACKGROUND

The Complainant is named after its founder, who is an Italian shoe designer born in 1938, René Caovilla. The Complainant is a family company in footwear and bag industry since at least 1960s and worked with various names in the industry throughout the years such as Christian Dior, Chanel and Karl Lagerfeld. Various celebrities including Jennifer Aniston, Tyra Banks, Heidi Klum, Kim Kardashian, and Rihanna, have been observed wearing footwear designed by René Caovilla.

The Complainant is the owner of various trademark registrations in various countries including the element “RENÉ CAOVILLA”

registered since 2004 and domain name <renecaovilla.com>, registered since 2002.

On August 7, 2024; the Respondent registered the disputed domain name <renecaovillashoes.shop>. The disputed domain is active and in use for offering shoes for sale.

PARTIES CONTENTIONS

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

1. THE DISPUTED DOMAIN NAME IS IDENTICAL

The disputed domain name is confusingly similar to the Complainant's formerly registered distinctive and internationally well-known trademarks, as they bear the Complainant's "RENÉ CAOVILLA" trademark as a whole with the addition of the descriptive term "SHOES", which would not prevent a finding of confusing similarity. The combination of the trademark "RENÉ CAOVILLA" with the term "SHOES", which are the products sold by the Complainant, could suggest improperly to consumers that the disputed domain name and corresponding website might be controlled by the Complainant or with the Complainant's authorization.

The Complainant refers to earlier decisions and claims that the generic Top-Level Domain ("gTLD") ".shop" is merely technical requirement and will be disregarded, so the domain names remain confusingly similar despite their inclusion. In this specific case, the addition of gTLD ".shop" can lead the online users even more into confusion since they can be induced to believe that this is the Complainant's e-commerce where to buy its shoes.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant states that considering the low prices of the shoes on display within the content of the disputed domain name, they are counterfeit and therefore such use of the disputed domain name cannot be deemed a legitimate non-commercial or fair use without intent for commercial gain. The Complainant submits that the sale of counterfeit products is circumstantial evidence supporting the Respondent's illegal activity and refers to the WIPO Overview 3.0, section 2.13 and 3.1 and several previous decisions, such as WIPO Case No. D2015-2088, Guccio Gucci S.p.A. v. Zhang Jiawen / Zeng Aiqin / Zhou Honghai / Zhuhonghai / Zhou Hong Hai / Honghai Zhou / Liu Min / Jianghong Wang where the Panel stated that "the websites at the Disputed Domain Names offer for sale prima facie counterfeit GUCCI products, along with products of the Complainant's competitors, which does not support a finding of rights or legitimate interests". It is argued that clearly the Respondent's use could be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name and such wilful conduct clearly demonstrates, to the contrary, that Respondent is not intended to use the disputed domain name in connection with any legitimate purposes.

The Complainant also states that the Respondent is neither affiliated nor authorized by the Complainant in any way and neither license nor authorization has been granted to the Respondent to use the Complainant's trademarks, and it is also not an authorized reseller.

The Respondent has no rights on the disputed domain name as the Respondent is not known as the disputed domain names and as the Respondent does not hold any trademark or domain name with "RENÉ CAOVILLA".

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant claims that Complainant's "RENÉ CAOVILLA" trademarks are well-known and predate the disputed domain name. The Respondent could not have possibly ignored the existence of the Complainant's trademarks and it is inconceivable for the Respondent to be unaware of the existence of the Complainant when he registered the disputed domain names. The fact that the Respondent registered the disputed domain names while knowing about the trademarks of the Complainant constitutes bad faith in registering the disputed domain names. In this regard, previous case law was referred to by the Complainant.

The Complainant asserted the fact that replicas of the Complainant's shoes are offered for sale on the website corresponding to the disputed domain name indicates the Respondent's full awareness of the reputation of the Complainant's trademark. This situation is argued to be causing a high risk of association between the Respondent and the Complainant and the Respondent's purpose in registering the disputed domain name incorporating the Complainant's trademark "RENÉ CAOVILLA" trademark is solely to capitalize on the reputation of Complainant's trademark by diverting Internet users seeking products under the "RENÉ CAOVILLA" trademark to its own commercial web site for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites, according to paragraph 4(b)(iv) of the Policy.

Moreover, it was stated that on the website corresponding to the disputed domain name, there is no disclaimer informing the users as to the Respondent's lack of relationship with the Complainant and the Respondent. Considering the high discounts proposed to the internet users and of low prices of the products sold via the website corresponding to the disputed domain name and by looking at the photos of the shoes offered for sale, the Complainant argued that the Respondent sells counterfeit goods, referring to a previous decisions WIPO Case No. D2012-0793, Belstaff S.R.L. v. jiangzheng ying and WIPO Case No. D2012-1968 Oakley, Inc. v. Victoriaclassic.Inc, as well as WIPO Overview 3.0, section 2.13 and 3.1.

Furthermore, the Complainant asserts that a legal search on the CAC's decisions database and on the WIPO's database has been

conducted regarding the Respondent and found that the Respondent was a party to different UDRP proceedings that were all accepted by the previous Panels, deciding to transfer all the disputed domain names to the legitimate trademark's owners, such as the following cases:

- CAC-UDRP-107071, where the Respondent registered the domain name <lindtchocolatebliss.shop> in order to "attract users familiar with the Complainant to a site which passes off as operated or authorized by such, and to derive commercial gain from confused internet users who, believing they are interacting with a site legitimately associated with the Complainant, attempt to purchase the purported (and apparently discounted) offerings";
- WIPO Case No. D2024-3348, Williams-Sonoma, Inc. v. BergeronRichard,
- WIPO Case No. D2024-3853, Colgate-Palmolive Company, The Murphy-Phoenix Company, Hill's Pet Nutrition, Inc. v. DODSONCLAYTON, KathleenCarter, BergeronRichard, du yan,
- WIPO Case No. D2024-4125, Ellos AB v. BergeronRichard.

Overall, the Complainant concluded that the Respondent's engagement in similar acts of cybersquatting can be considered as serious evidence of its bad faith conduct, reflecting a propensity to target multiple distinct brands and exploit their notoriety. Accordingly, the Complainant alleges that the disputed domain name was registered and is being used in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 name (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 name has been registered and is 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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

1. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

2. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of "RENÉ CAOVILLA" trademark.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's "RENÉ CAOVILLA" trademark and the addition of the term "SHOES" is not sufficient to vanish the similarity.

Moreover, the addition of the gTLD ".SHOP" is not enough to abolish the identity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

2. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

It is understood from the explanations of the Complainant that the Respondent and the Complainant has no relationship or agreement on the use of the disputed domain name. In the absence of a response, the Panel considers that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain dame, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

The Panel concludes that the Complainant's "RENÉ CAOVILLA" trademark is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the "RENÉ CAOVILLA" trademark, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the use of the confusingly similar domain name for commercial gain on a website offering counterfeit or unauthorized versions of Complainant's products in direct competition with the Complainant's products is considered use in bad faith to create confusion with Complainant's trademarks. (see e.g. Forum Case No. 1612750, Xylem Inc. and Xylem IP Holdings LLC v. YinSi BaoHu YiKaiQi, CAC Case N° 104392, ZV HOLDING v. Luis Alberto Fernandez Garcia, CAC Case No. 104561, IM PRODUCTION v. Guilan Wei.) Especially considering they sell Complainant's products or their counterfeit at discounted prices without the knowledge of the Complainant.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii)

of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **renecaovillashoes.shop**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2025-03-05

Publish the Decision