

Decision for dispute CAC-UDRP-104399

Case number	CAC-UDRP-104399
Time of filing	2022-04-25 09:04:52
Domain names	golasouthafrica.com, golanederland.com, golaschweiz.com , golashoesnz.com, gola-india.com, golamexico.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	TLT LLP
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Respondent

Name	marcel baum
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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, D. Jacobson & Sons Limited, 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. 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 Complainant is the owner of several trademarks bearing the word element "GOLA", such as:

- UK Trademark no. 00001097140, registered June 14, 1978;
- UK Trademark no. 00000272980, registered May 22, 1905;
- EU Trademark no. 001909936, registered October 4, 2000;

- EU Trademark no. 003399681, registered October 8, 2003; and
- EU Trademark no. 011567625, registered February 12, 2013.

The Complainant is also the owner of several domain names, bearing the word element "GOLA", such as <gola.co.uk> and <golausa.com>, which were registered on December 17, 1997, and February 13, 2002 respectively.

The disputed domain names were registered as follows:

- <golasouthafrica.com>, registered August 11, 2021;
 - <golanederland.com>, registered August 28, 2021;
 - <golaschweiz.com>, registered August 18, 2021;
 - <golashoesnz.com>, registered August 11, 2021;
 - <gola-india.com>, registered August 11, 2021; and
 - <golamexico.com>, registered August 24, 2021.
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FACTUAL BACKGROUND

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

PARTIES' CONTENTIONS:

COMPLAINANT:

I. Consolidation of the proceedings

The Complainant requests that the Panel applies its discretion and allows this complaint to be filed against all six Respondents under a single complaint. The Complainant believes that the disputed domain names are subject to common control and that consolidation of the complaint is fair and equitable to all parties.

II. The disputed domain names are confusingly similar to the protected mark

According to the Complainant, the disputed domain names make use of a mark which is identical or highly similar to the Complainant's marks without its authorisation or permission.

The Complainant argues that it is inconceivable that at the time of registration, the Respondent did not know of the similarity between the disputed domain names and the GOLA marks and domain names as the accessible disputed domain names are materially identical to the Complainant's marks and domain names.

The Complainant also provides that it has acquired substantial goodwill and reputation in relation to its business, such, that the GOLA marks denote the notoriety of the Complainant's products and business and no other.

III. The Respondent does not have any rights or legitimate interest in the disputed domain names

The Complainant provides that it has nothing to do with the disputed domain names or the Respondent. The Respondent has no legitimate interest in the disputed domain names as they are most likely being used to defraud third parties.

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

The Complainant contends that the Respondent has clearly set up the disputed domain names to mirror the Complainant's genuine websites, through the use of domains which include the Complainant's Gola marks, content from its website and prominently features the Complainant's trademarks at the top of all pages of the (accessible) websites and in the product advertising appearing on the website homepages and other pages throughout the websites.

IV. The disputed domain names have been registered and are being used in bad faith

The registration and use of the disputed domain names by the Respondent and the use of the GOLLA marks within (at least) the UK are likely to mislead relevant members of the public who are attempting to purchase products through the disputed domain names into believing that they are doing so from the Complainant's genuine website or from a website that is in some way connected to or associated with the Complainant, contrary to the fact.

The Complainant provides that the disputed domain names were registered in bad faith as the sole purpose for their registration was and is to impersonate the Complainant for fraudulent purposes. The Respondent's impersonation of the Complainant is designed to deceive third parties into believing that the disputed domain names are owned by the Complainant and are offering legitimate products, when in fact the Respondent is instead defrauding consumers.

PARTIES CONTENTIONS

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

As stated above, the Complainant requests that the Panel applies its discretion and allows this complaint to be filed against all six Respondents under a single complaint. The Respondents to this complaint are:

- <golasouthafrica.com> – Marcel Baum;
- <golanderland.com> – Vanessa Kortig;
- <golaschweiz.com> – Christin Luft;

- <golashoesnz.com> – Markus Adler;
- <gola-india.com> - Thorsten Koehler; and
- <golamexico.com> – Sebastian Maurer.

The Complainant submits that there are a number of commonalities between the underlying registration details as disclosed by the registrar and similarities in the websites to which the respective disputed domain names relate:

- The registration details of all six disputed domain names all follow a similar pattern, namely: i) a personal first name and last name; ii) an apparent street address in Germany, and iii) an email address comprising a combination of letters and numbers and “@163.com”;
- The disputed domain names all follow the same format i.e. the GOLA mark followed by a country name or indicator;
- They were all registered in August 2021 (three on the same day);
- They were registered by the same registrar; and
- Of the six domains, 3 are websites which are accessible in the UK. The content of those websites all mirrors each other substantially.

The Panel obtains guidance on this procedural issue from i) Article 3 (c) of the Policy, which stipulates that the complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder, followed by ii) the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 4.11.2, which states:

“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 e-mail 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).”

Applying these considerations to the instant case, the Panel determines that the Complainant has established that the disputed domain names are more likely subject to the common control. What is pertinent to the Panel’s conclusion is the fact that all six disputed domain names were registered in August 2021, three on the same day, by the same registrar. The Panel notes that the registration details of all six disputed domain names follow the same format, namely the GOLA mark followed by a country name. The content of the respective websites is essentially similar in that they offer the sale of GOLA branded footwear and bags. Additionally, the content and design of three of the disputed domain names all mirror each other substantially. The targeting of the Complainant’s well-known mark and similarity of the content of the websites reflect common conduct by the Respondent. The aforesaid are all factors which indicate that the disputed domain names are linked.

In view of the aforesaid considerations, the Panel finds that the consolidation of the multiple domain name disputes involving the six nominally distinct Respondents would be procedurally efficient and consistent with the aims of the Policy.

PRINCIPAL REASONS FOR THE DECISION

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
2. that respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

1) The disputed domain names are confusingly similar to a trademark in which the Complainant has rights

The Complainant has, to the satisfaction of the Panel, shown that it has valid trademark rights in the term “GOLA”. The Panel finds that the disputed domain names are confusingly similar to the Complainant's GOLA mark. All six disputed domain names contain the Complainant's GOLA trademark in its entirety, together with the name of a country. Previous UDRP panels have found that the fact that a domain name wholly incorporates a complainant’s registered mark is sufficient to establish identity or confusing similarity for the purposes of the Policy (see, e.g., *Oki Data Americas Inc. v ASD, Inc.*, WIPO Case No. D2001-0903).

The Panel finds that the disputed domain names show a clear visual, phonetic and conceptual resemblance to the Complainant’s GOLA mark, and could confuse Internet users into thinking that the disputed domain names are associated with the Complainant or its trademarks.

In these circumstances, the Panel finds that the disputed domain names are confusingly similar to the Complainant's GOLA mark.

2) The Respondent lacks rights or legitimate interests in the disputed domain names

Under the Policy, a complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Panel concludes that the Respondent does not have a legal right to use the GOLA mark as part of its domain names. The Respondent's use of the disputed domain names created a misleading impression of association with the Complainant, when in fact there is no affiliation between the Complainant and the Respondent, and its offering of allegedly counterfeit goods via the disputed domain names does not give rise to any rights or legitimate interests in the disputed domain names within the meaning of the Policy.

By copying the website content of the Complainant, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its web site. This is completely opposite to a bona fide offering of goods and services nor does it indicate a legitimate non-commercial or fair use of the disputed domain names.

In the present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain names.

3) The disputed domain names have been registered and are being used in bad faith

The Panel agrees with the Complainant that its trademark GOLA is distinctive and well-known. The registration of the Complainant's well-known trademark GOLA predates the registration of the disputed domain names. Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trademark.

The Complainant has argued, without contradiction, that the websites associated with the disputed domain names have been set up to mirror the Complainant's genuine websites and that they contain content copied from the Complainant's websites. The said websites and the disputed domain names prominently use the Complainant's GOLA mark and a very similar structure and design to the Complainant's website. Under these circumstances, the Respondent could only have registered the disputed domain names with full knowledge of the Complainant's trademark.

The Panel finds that the Respondent's choice of the disputed domain names, all of which incorporate wholly the well-known GOLA mark and are used in relation to the offering of apparently counterfeit goods reflects bad faith and an intention on the Respondent's part to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the websites or of a product or services on the websites. Looking at the Respondent's websites, the Panel is persuaded that the Respondent no doubt knew of the Complainant and its GOLA trade mark, and registered the disputed domain names for no other reason other than for the aforesaid purpose.

Accordingly, the Panel concludes that the Complainant has satisfied the third element of the Policy, that is that the Respondent's registration and use of the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GOLASOUTHAFRICA.COM**: Transferred
2. **GOLANEDERLAND.COM**: Transferred
3. **GOLASCHWEIZ.COM** : Transferred
4. **GOLASHOESNZ.COM**: Transferred
5. **GOLA-INDIA.COM**: Transferred
6. **GOLAMEXICO.COM**: Transferred

PANELLISTS

Name	Mgr. Barbora Donathová, LL.M.
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DATE OF PANEL DECISION	2022-06-03
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Publish the Decision
