

Decision for dispute CAC-UDRP-104707

Case number	CAC-UDRP-104707
Time of filing	2022-07-08 09:09:05
Domain names	gola-espana.com, gola-ireland.com, golashoesmalaysia.com, gola-singapore.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

Organization	Web Commerce Communications Limited
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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 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.

The Complainant is the registrant of the GOLA domain names, which were registered on 17 December 1997 and 13 February 2002 respectively.

The disputed domain names <gola-espana.com>, <gola-ireland.com>, <golashoesmalaysia.com> and <gola-singapore.com> are not connected with or authorised by the Complainant in any way.

The disputed domain names were registered in April/May 2022 and are being used to offer for sale GOLA branded footwear and bags.

FACTUAL BACKGROUND

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

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.

The Complainant has over many years sold hundreds of thousands of pairs of footwear and bags under its GOLA Mark and Wing Flash Logo. The Complainant has acquired substantial goodwill and reputation in the GOLA Marks in the UK and European Union in relation to its footwear products and business, such that the GOLA Marks denote the notoriety the Complainant's products and business and no other.

The Complainant already filed two UDRP complaints in 2022 against a Respondent of the same name, i.e. "Web Commerce Communications Limited", 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 believes that the disputed domain names are all linked and have been registered by the same Respondent for the following reasons:

- 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 April/May 2022;
- they were registered by the same registrar. The content of those websites all mirror each other either exactly or very similarly; and they follow the same format as these previous successful UDRP complaints.

The Complainant has serious cause for concern that the disputed domain names are being used fraudulently by the Respondent to obtain the personal and financial information of the Complainant's customers.

The concern is that the disputed domain names may be adopting the same tactic as those domains and prompting individuals to enter their personal details.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

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

The use of the above Trademarks in the disputed domain names implies that there is a commercial relationship between the Complainant and the disputed domain names when there is none.

The accessible disputed domain names have clearly been set up by the Respondent to mirror the Complainant's genuine websites, through use of domains which include the Complainant's GOLA Marks. Its available websites prominently features the trademarks at the top of all pages and in the product advertising.

The registration and use of the disputed domain names by the Respondent and the use of the Trademarks 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.

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 Domains and Trademarks as the accessible disputed domain names are materially identical to the Trademarks and the GOLA domain names.

In fact, it is evident that the Respondent purposefully used the trademarks 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.

To reiterate, the Complainant 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.

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.

RIGHTS

The Complainant is a British company that owns several GOLA trademarks, such as:

- the UK trademark No 00001097140 GOLA registered in class 18 on 14 June 1978, renewed;
- the UK trademark No 00000272980 GOLA, registered in class 25 on 22 May 1905, renewed;
- the EU trademark No 001909936 GOLA, registered in classes 18, 25, 28, on 4 October 2000, renewed;
- the EU trademark No 003399681 GOLA, registered in classes 5, 10, 12, 35 on 8 October 2003; and
- the EU trademark No 011567625 GOLA (stylised), registered in classes 18, 25, 35, on 12 February 2013.

The disputed domain names <gola-espana.com>, <gola-ireland.com>, <golashoesmalaysia.com> and <gola-singapore.com> wholly incorporate the GOLA Trademarks.

They only differ from the GOLA trademarks by the addition of a geographical name, and for <golashoesmalaysia.com> 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.

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain names by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the Respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Whois information record identifies the Respondent as "Web commerce Communications Limited" domiciled in Kuala Lumpur (Malaysia). The Respondent is not commonly known under the Disputed Domain Name. Furthermore, it was already involved as Respondent in two UDRP cases that the Complainant had to file in 2022. Under the circumstances of the case, the Panel considers that the same Respondent in this case is the same as in these two prior cases.

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

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

It relies on two prior UDRP decisions against a Respondent called the same name and using similar strategies.

The Panel has considered the possibility that the Respondent might be selling the Complainant's genuine goods under the Complainant's GOLLA trademark. If it had been the case, it could have established that it was actually offering for sale only the trademarked goods and to show that its website accurately and prominently disclosed its (lack of) relationship with the Complainant.

The Respondent did not respond to the Complainant to rebut its prima facie case. It 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 Respondent has no rights or legitimate interests in respect to the disputed domain names.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the disputed domain names.

It provides that:

"For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

- (i) circumstances indicating that the Respondent has registered or the respondent has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the Domain Name; or
- (ii) the Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location."

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 Respondent, was well aware of the GOLA trademarks before the registration of the disputed domain names.

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

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

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.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain names <gola-espana.com>, <gola-ireland.com>, <golashoesmalaysia.com> and <gola-singapore.com> 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 Respondent is 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 Respondent.

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

It relies on two prior UDRP decisions against a Respondent called the same name and using similar strategies.

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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 Respondent, was well aware of the GOLA trademarks before the registration of the disputed domain names.

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

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

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINANT IS

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Accepted

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

1. **GOLA-ESPANA.COM**: Transferred
 2. **GOLA-IRELAND.COM**: Transferred
 3. **GOLASHOESMALAYSIA.COM**: Transferred
 4. **GOLA-SINGAPORE.COM**: Transferred
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PANELLISTS

Name	Marie-Emmanuelle Haas, Avocat
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DATE OF PANEL DECISION	2022-08-12
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Publish the Decision
