

Decision for dispute CAC-UDRP-105020

Case number **CAC-UDRP-105020**

Time of filing **2022-12-01 09:30:09**

Domain names **todsoutletromania.com, todsshoesaustraliaau.com, todsshoesirelandie.com, todsshoesoutletgr.com, todsshoesukoutlet.com, todssingaporeonlinestore.com, todsusaonlineshop.com, hoganskotilbud.com**

Case administrator

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

Complainant

Organization **TOD'S S.p.A.**

Complainant representative

Organization **Convey srl**

Respondent

Organization **Web Commerce Communications Limited**

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 bases its Complaint on several TOD's and HOGAN trademark registrations listed in annexes to the Complaint, among which:

- European Trademark "TOD'S", no. 010158889, filed on July 28, 2011, registered on December 29, 2011, for goods and services in classes Cl. 3, 9, 14, 18, 25, 35;
- European Trademark "TOD'S", no. 000407031, filed on November 14, 1996, registered on September 13, 2004, for goods and services in class 9;
- International Trademark "TOD'S", no. 1006548, registered on June 1, 2009, for goods in class 14;
- International Trademark "TOD'S", no. 858452, registered on May 20, 2005, for goods and services in classes 3, 9, 18, 25, 35;
- United States Trademark "TOD'S", no. 1459226, registered on September 29, 1987, for goods in classes 18, 25;
- Australian Trademark "TOD'S", no. 1498996, filed on April 2, 2012, registered for goods and services in classes 3, 9, 25, 35;
- International Trademark "HOGAN", no. 1014830, registered on July 24, 2008, for goods in classes 09, 18, 25;
- International Trademark "HOGAN", no. 1014831, registered on July 24, 2009, for goods in classes 09, 18, 25;
- International Trademark "HOGAN", no. 774193, registered on January 18, 2001, for goods in classes 3, 9, 18, 25;
- International Trademark "HOGAN", no. 1129649, registered on March 23, 2012, for goods in classes 3, 9, 18, 25;
- European Union Trademark "HOGAN", no. 005184536, registered on January 20, 2010, for goods and services in classes 3, 9,

FACTUAL BACKGROUND

The Complainant asserts that according to the Registrar's disclosure response as of November 28, 2022, there is a unique entity as registrant of the disputed domain names, namely Web Commerce Communications Limited. In the Complainant's view, the disputed domain names which all incorporate the trademark TOD'S and HOGAN in their entirety are under the control of a single individual or entity or, at least, reflective of a group of individuals acting in concert.

For this reason, the Complainant requested that the disputed domain names and the named Respondent be consolidated in a single UDRP proceeding.

The Complainant underlined that the disputed domain names share the following similarities:

- same hosting provider Fiber Grid Inc.;
- the same Registrar: Alibaba.Com Singapore E-Commerce Private Limited;
- same extension of the domain names .com;
- same products offered for sale, except for hoganskotilbud.com;
- same lay-out of the websites: Tod's/Hogan logo in the middle of the webpages; same icons in the webpages; same contact form;
- sharing the presence in each domain name of generic terms/country names and/or codes after the trademarked denomination "Tod's/Hogan";
- same favicon of the websites, except for hoganskotilbud.com;
- same period of registration, i.e. March 2022, except for hoganskotilbud.com (July 2022).

Moreover, the Complainant asserts that except for <hoganshop-us.com>, the other domain names share the same lay-out of their websites and the same products offered for sale in their websites.

This Complaint, Tod's SpA, asserts that such is a company with headquarters in Sant'Elpidio al Mare, FM, Italy, having its roots in the early '900, when Filippo della Valle founded a small family business near Ancona in Italy. The Complainant further asserts that, Tod's first success came with the Gommino driving shoe, which has gummy little rubber pebbles on the soles. In few years the production was expanded to the bags and in 1997 the D-Bag was launched becoming in few years an iconic model. From 2006 and 2009 Tod's introduced ready-to-wear, promoting the apparels with the celebrities as Katie Holmes, Jessica Alba and Gwyneth Paltrow, and sunglasses.

In 2011, according to what the Complainant asserts, Tod's Group sponsored the restoration of the Colosseum in Rome with a disbursement of €25m in five years, it has also been a Permanent Founding Member of the Fondazione Teatro alla Scala and one of main sponsor of Padiglione di Arte Contemporanea (PAC) in Milan.

Today, according to the Complainant, Tod's SpA is the operating holding of a Group, amongst the leading players in the world of luxury goods, with the trademarks Tod's, Hogan, Fay and Roger Vivier with about 4.890 employees worldwide. The Complainant underlines that Tod's has numerous stores around the world, about 403 mono-brand stores, including showrooms and large flagship stores in Europe, the U.S., China, Japan, Malaysia, Singapore, Hong Kong, Indonesia, Turkey and Australia. In November 2015, Tod's acquired further stock in the Roger Vivier shoe brand for €415 million reaching about 60%.

The Complainant also underlines the promotion of Tod's Group on social media, including the collaboration with Chiara Ferragni - an Italian digital entrepreneur, fashion blogger, influencer and designer with a massive following on social media (over 23 million followers on her Instagram account).

The Complainant asserts that the high standard of quality met by the products is guaranteed by the strong craftsmanship involved in

every and each phase of the production: every product is handmade, crafted with techniques of the highest skilled handcraftsmanship.

All products are crafted in the Groups' owned factories, a total of 6 for shoes and 2 for leather goods, and in a limited number of specialized laboratories (with which the Group has bonded long term business relations). The buying of materials, the supervision of all the production phases and the control of the finished products, are centralized at the headquarters - this is done for all of the products as well as for the ones created in the external laboratories.

2022 Annual revenues of Tod's Group were almost 668 million of Euros of which almost 50% came from the trademark TOD'S, according to the Complainant assertions.

The Complainant owns numerous registrations around the world for the TOD's and HOGAN trademarks.

The Complainant underlines that it has extensively used the "TOD'S" and "HOGAN" denominations on all internet environments including and not limited to the company's official websites <https://www.todsgroup.com> and <https://www.tods.com>, among which are "tods.it", "tods.fr", "tods.eu", "tods.cn" – and www.hogan.com, among which are "hogan.it", "hogan.fr", "hogan.eu", "hogan.cn" and its official accounts on the major social networks such as Facebook, Instagram and Twitter.

The disputed domain names were registered by the Respondent between March, 2022 and July, 2022, without authorization of Complainant, as per the Complainant assertions, and have been pointed to websites where Complainant's counterfeit products are offered for sale.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS: COMPLAINANT:

1. The Complainant's contentions are the following:

In the Complainant's view, the disputed domain names registered by the Respondent are confusingly similar to trademarks in which Complainant has rights.

The Complainant further asserts that the disputed domain names incorporate the whole of the Complainant's trademark TOD'S and HOGAN and the fact that they include non-distinctive elements - such as "shoes", "outlet", "online" – geographical indications – such as "aus" (for Australia), "Singapore", "Ireland", "Greece", "us", "India" - the generic Top Level Domain .com does not affect the confusing similarity.

In the Complainant's view, the combination of the trademark TOD'S and HOGAN with generic and geographical terms as could suggest improperly to consumers that the disputed domain names and corresponding web sites might be controlled by the Complainant or with the Complainant's authorization.

The Complainant underlines that it operates online offering for sale its products. The addition of the latter, referring to the sector in which Complainant operates, to the TOD'S trademark in the domain name, supported also by using generic term as "online store" or "online shop" creates a risk of confusion as to the sources of the domain name, according to the Complainant. The consumers may be led to believe that there is a connection between the disputed domain names and the Complainant's trademarks.

In light of the above, in the Complainant view, the disputed domain names are confusingly similar to the prior registered trademark in which the Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

Further, the Complainant contends that the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Complainant underlines that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademark. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain names.

Upon information and belief of the Complainant, the Respondent, according to the Complainant, is not commonly known by the disputed domain names as individuals, business or other organization and his family name does not correspond to TOD'S, HOGAN or the disputed domain names.

The Complainant asserts that the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute.

The Complainant further asserts that the disputed domain names are redirected by the Respondent to websites where the Complainant's trademarks TOD'S and HOGAN are published and counterfeit products are offered for sale.

Moreover, the Complainant asserts that there is no disclaimer as to the Respondent's lack of relationship with the Complainant.

In the Complainant's view, the Respondent's uses could be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names.

Moreover, the Complainant underlines that the Respondent has not reply to the cease-and-desist letter providing a valid reason for the registrations of the disputed domain names confusingly similar to the Complainant's trademark, this circumstance excludes that the Respondent could have rights or legitimate interests in respect of the disputed domain names.

Further, the Complainant underlines that, in light of the low prices, prima facie the shoes, offered for sale via the websites corresponding to the disputed domain names, are counterfeit and therefore such use of the disputed domain names cannot be deemed a legitimate non-commercial or fair use without intent for commercial gain.

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

Further, the Complainant asserts that, in light of the registration and intensive use of the trademarks TOD'S and HOGAN since many years, the advertising and sales of the Complainant's products worldwide, the Respondent could not have possibly ignored the existence of the Complainant's trademarks, confusingly similar to the disputed domain names. The Complainant underlines that it has many boutiques and a distribution network worldwide.

In the Complainant's view, the aforesaid trademark of the Complainant enjoys worldwide reputation in the sector of shoes and apparel goods items. The disputed domain names were registered in 2022, years after the Complainant obtained its trademark registrations.

Furthermore, the Complainant asserts that the actual knowledge of TOD'S and HOGAN trademarks by Respondent at the time of the registration of the disputed domain names is demonstrated by the facts that the Respondent has offered for sale replicas of Complainant's shoes reproducing also the trademark TOD'S and HOGAN in the websites corresponding to the disputed domain names.

By virtue of its extensive worldwide use, the Complainant's trademarks TOD'S and HOGAN have become a well-known trademark in the sector of shoes and leather goods items, in the Complainant's view. Therefore, it is clear that the Respondent was well aware of the trademark and he has registered the disputed domain names with the intention to refer to the Complainant and its trademarks.

Furthermore, the Complainant contends that, the fact that replicas of TOD'S and HOGAN shoes are offered for sale on the websites corresponding to the disputed domain names indicate that the Respondent has been fully aware of the Complainant's mark's reputation and association with the Complainant and that his purpose in registering the disputed domain names, which incorporates the Complainant's trademark TOD'S and HOGAN, was solely to capitalize on the reputation of Complainant's marks by diverting Internet users seeking products under the TOD'S and HOGAN mark to its own commercial websites.

Moreover, on the websites corresponding to the disputed domain names, there are no disclaimer informing the users as to the Respondent's lack of relationship with the Complainant and the Respondent, as per the assertions of the Complainant.

In light of the high discounts proposed to the internet users and of low prices of the shoes sold via the website corresponding to the disputed domain names, prima facie the Respondent sells counterfeit goods, as per the Complainant's assertions.

Moreover, the Complainant underlines that the Respondent failed to respond to the cease-and-desist letter.

In view of the above, the Complainant asserts that the disputed domain names were registered and are being used in bad faith.

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).

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.

The Panel agrees for the disputed domain names and the named Respondent be consolidated in a single UDRP proceeding, mainly, considering that, there is a unique entity as registrant of the disputed domain names, namely Web Commerce Communications Limited, that all the disputed domain names incorporate the trademark TOD'S and HOGAN in their entirety and seem to be under the control of a single entity.

PRINCIPAL REASONS FOR THE DECISION

1. Confusing Similarity

The Panel agrees that the disputed domain names:

<todsoutletromania.com>

<todsshoesaustraliaau.com>

<todsshoesirelandie.com>

<todsshoesoutletgr.com>

<todsshoesukoutlet.com>

<todssingaporeonlinestore.com>

<todsusaonlineshop.com>

<hoganskotilbud.com>

incorporates the Complainant's earlier TOD's and HOGAN trademarks in their entirety and that the addition of the generic terms such as "shoes", "outlet", "online", "onlineshop", "suk", "onlinestore", as well as of geographical indications, such as "romania", "australia", "aus", "ireland", "ie", "gr", "singapore", "usa", "Greece", "us", which in principle should simply inform the Internet users of a geographical location, is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademarks TOD's and HOGAN and that, according to other UDRP panels, "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

The addition of the geographical locations is likely to give the false impression of an association with the Complainant.

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain names (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v. Tina Smith, WIPO Case No. D2008-0820 Titoni AG v. Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

1. Lack of Respondent's rights or legitimate interests

The complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof 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.

Based on the available evidence, the Respondent is not a licensee of, nor has any kind of relationship with the Complainant, including not an authorized reseller of such, which has an extensive trademarks and domain names portfolio which incorporates the TOD's and HOGAN names. The Complainant has never authorised the Respondent to make use of its trademarks, nor of a confusingly similar trademark in the disputed Domain Names.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

1. Bad Faith

Based on the filed evidences, Complainant holds several TOD's and HOGAN prior trademark registrations, whose products, protected under such trademarks, are sold and advertised worldwide. Therefore, the Panel concludes that at the time of registration of the disputed domain names, the Respondent was well aware of the Complainant's trademarks and has intentionally registered the disputed domain names in order to benefit from the reputation of the Complainant's trademarks.

In the present case, the following factors should be considered:

(i) the Complainant's trademarks, which are all earlier rights, are distinctive;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain names;

(iii) the Respondent registered the disputed domain names containing in their entirety distinctive trademarks;

(iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name similar to the Complainant's trademarks;

(v) the disputed domain names seem to sell products at a lower price than the ones sold by the Complainant, putting thus a question mark regarding the authenticity of the products, trying thus to gain commercial profit from the use and registration of the disputed domain names and benefiting from the Complainant's registered trademarks.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain names in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **todsoutletromania.com**: Transferred
2. **todsshoesaustraliaau.com**: Transferred
3. **todsshoesirelandie.com**: Transferred
4. **todsshoesoutletgr.com**: Transferred
5. **todsshoesukoutlet.com**: Transferred
6. **todssingaporeonlinestore.com**: Transferred
7. **todsusaonlineshop.com**: Transferred
8. **hoganskotilbud.com**: Transferred

PANELLISTS

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| Name | Delia-Mihaela Belciu |
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| DATE OF PANEL DECISION | 2023-01-10 |
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| Publish the Decision |
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