

Decision for dispute CAC-UDRP-105517

Case number	CAC-UDRP-105517
Time of filing	2023-06-12 09:13:30
Domain names	karhu-shoesau.com, karhulenkkarit.com, karhusneakersdanmark.com, karhuturkiye.com, karhusalecanada.com, karhukobenhavn.com, karhuukstockists.com, karhutokyo.com, zapallaskarhu.com, karhushoesschweiz.com, karhusneakersdames.com, karhubelgique.com, karhusneakersnorge.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Karhu Holding B.V.
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Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.
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Respondents

Organization	Web Commerce Communications Limited
Name	Qiu Xiaofeng

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 is the registrant, among others, of the EU trademark registration No. 006954903 "KARHU", registered on July 15, 2010, for goods and services in classes 18, 25 and 28.

FACTUAL BACKGROUND

The Complainant is a Dutch sportswear brand founded in 1916, specialized in the creation of sneakers and other sports apparel.

The Complainant commercializes its products through its official domain <karhu.com> which it has owned since April 12, 1999.

From May 2021 to December 2022, the thirteen disputed domain names, the subject of this case, were registered by two respondents, all of them from Asia; some of them have been registered in the name of an individual, some of them have been registered in the name of a reseller of the respective provider of domain name registration services. The disputed domain names were registered by two different registrars: Paknic Limited and Alibaba.com Singapore E-commerce Private Limited. At the time of filing the Complaint all thirteen disputed domain names were active and resolved to the same type of website, namely an online shop (in various languages) that appeared to sell the Complainant's items. The Complainant seeks to consolidate the cases against the two Respondents.

PARTIES CONTENTIONS

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

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

CONSOLIDATION OF THE COMPLAINT FOR THE DISPUTED DOMAIN NAMES

It is well established that where the particular circumstances of a given case indicate that common control is being exercised over the disputed domain names, consolidation may be granted, provided that it would be fair and equitable to all parties.

In accordance with the evidence of the case, the registrant of:

<karhutokyo.com> (registered on December 5, 2022)
<zapatillaskarhu.com> (registered on September 28, 2022)
<karhushoesschweiz.com> (registered on September 28, 2022)
<karhusneakersdames.com> (registered on September 28, 2022)
<karhubelgique.com> (registered on September 28, 2022)
<karhusneakersnorge.com> (registered on September 28, 2022)

is Qiu Xiaofeng, while the registrant of:

<karhu-shoesau.com> (registered on July 8, 2022)
<karhusalecanada.com> (registered on June 7, 2022)
<karhukobenhavn.com> (registered on July 22, 2022)
<karhuukstockists.com> (registered on July 22, 2022)

<karhulenkkarit.com> (registered on May 11, 2021)
<karhusneakersdanmark.com> (registered on May 14, 2021)
<karhuturkiye.com> (registered on May 17, 2021)

is Alibaba.com Singapore E-commerce Private Limited.

The Complainant points out that the registrant of the last seven disputed domain names is, in fact, a reseller of the registrar, therefore

the underlying owner of these disputed domain names has not been disclosed.

The Complainant asserts that, on the balance of probabilities, all of the disputed domain names are owned or under the effective control of a single person or entity, or a group of individuals acting in concert.

The Complaint identifies a number of common factors:

- All of the disputed domain names are hosted on the same two IP-address zones: 104.21 and 172.67;
- All of the disputed domain names use Cloudflare.com Nameservers;
- All of the disputed domain names use a similar naming pattern, namely the entirety of Complainant's trademark, accompanied by a geographical term and/or a generic term;
- All of the disputed domain names use the same 'privacy protection service'.
- All of the websites related to the disputed domain names use the same 'favicon' (favicon.ico image) depicting the Complainant's registered trademark consisting of the "KARHU" figurative trademark;
- All of the domain names resolve to very similar websites that impersonate the Complainant and which serve the same function, namely the sale of alleged "KARHU" products;
- All of the disputed domain names contain the Complainant's visual mark in the header of the page, and substantially the same fake copyright notice at the bottom.
- All of the websites related to the disputed domain names mention the same message: "Free Delivery Over [amount]" in a slider on the header;
- Some of the disputed domain names use identical Privacy Notices, albeit in translated versions;
- All of the websites related to the disputed domain names contain the same contact form text and layout in their respective "Contact Us" pages; and
- All of the disputed domain names were registered between May 2021 and December 2022; some of them in groups on the same date.

The Panel, in line with decisions of other panels in similar cases (see, for example, CAC case No. 105420), considers that, on the balance of probabilities, all of the disputed domain names are under the control of a single person or entity, or group of individuals acting in concert.

Therefore, the Panel decides to grant the requested consolidation.

LANGUAGE OF THE PROCEEDINGS

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

The language of the Registration Agreement for some of the disputed domain names is Chinese, therefore the language of the proceedings as regards these disputed domain names should be Chinese, unless otherwise agreed by the parties. The Complaint, however, was filed in English and the Complainant submitted a request to change the language of the proceedings into English based, *inter alia*, on the following reasons:

- 1) The disputed domain names are in Latin characters and not in Chinese characters;
- 2) All of the domain names include the English-language trademark;
- 3) All of the disputed domain names are in the international ".com" zone;
- 4) The Respondent uses English on a number of the disputed domain names, demonstrating that he or she is familiar with the English language;
- 5) The Respondent used the Registrar's English-language website to register the disputed domain names;
- 6) Requiring the Complainant to translate the Complaint into another language would create an undue burden and delay;
- 7) The Respondent has not brought forward any arguments that using the English language in this proceeding would not be fair and efficient;

Having considered the Complainant's submission regarding the language of the proceedings and the overall circumstances of this case, the Panel accepts English as language of the proceedings.

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of a domain name, the complainant has to demonstrate that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) The respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain names are identical with, or confusingly similar to, the Complainant's trademark.

There are two elements of this test: for each domain name, the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain names must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "KARHU", identified in section "Identification of rights" above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain names.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain names to the Complainant's trademark.

The disputed domain names differ from the Complainant's trademark "KARHU":

- as regards <karhu-shoesau.com> by the addition of the hyphen, of the words "shoes" and "au" and by the top-level domain ".COM";
- as regards <karhulenkkarit.com> by the addition of the word "lenkkarit" and by the top-level domain ".COM";
- as regards <karhusneakersdanmark.com> by the addition of the words "sneakers" and "danmark" and by the top-level domain ".COM";
- as regards <karhuturkiye.com> by the addition of the word "turkiye" and by the top-level domain ".COM";
- as regards <karhusalecanada.com> by the addition of the words "sale" and "canada" and by the top-level domain ".COM";
- as regards <karhukobenhavn.com> by the addition of the word "kopenhagen" and by the top-level domain ".COM";
- as regards <karhuukstockists.com> by the addition of the words "uk" and "stockists" and by the top-level domain ".COM";
- as regards <karhutokyo.com> by the addition of the word "tokyo" and by the top-level domain ".COM";
- as regards <zapatillaskarhu.com> by the addition of the word "zapatillas" and by the top-level domain ".COM";
- as regards <karhushoesschweiz.com> by the addition of the words "shoes" and "schweiz" and by the top-level domain ".COM";
- as regards <karhusneakersdames.com> by the addition of the words "sneakers" and "dames" and by the top-level domain ".COM";
- as regards <karhubelgique.com> by the addition of the word "belgique" and by the top-level domain ".COM";
- as regards <karhusneakersnorge.com> by the addition of the words "sneakers" and "norge" and by the top-level domain ".COM".

In the present case the addition of the words "shoes", "au", "lenkkarit", "sneakers", "danmark", "turkiye", "sale", "canada", "kopenhagen", "uk", "stockists", "tokyo", "zapatillas", "schweiz", "dames", "belgique" and "norge" have no impact on the distinctive part "KARHU". It is well established that, where the relevant trademark is recognizable within the domain name, the addition of other terms would not be sufficient to prevent a finding of confusing similarity (see, for example, CAC case No. 104755).

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

The Panel observes that it is well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain names are confusingly similar to the Complainant's trademarks.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in each of the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the respondent has rights or legitimate interests in a domain name:

- (i) before any notice to [the Respondent] 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] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [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.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain names.

In particular, the Complainant states that:

- the Respondent has not acquired any prior trademark or service mark rights, and the Respondent's use and registration of the thirteen disputed domain names were not in any way authorized by the Complainant;
- the registration of the disputed domain names was done several decades after the Complainant commenced its use of the "KARHU" trademark;
- the Complainant has no relationship whatsoever with the Respondent and has never licensed or otherwise authorized the Respondent to use the "KARHU" trademark on the websites or in the disputed domain names;
- the Respondent cannot demonstrate any legitimate offering of goods or services under the "KARHU" trademark;
- the Respondent has not been commonly known by the disputed domain names prior to the registration of them;
- the Respondent does not intend to make non-commercial use of the disputed domain names, as multiple goods are allegedly being offered for sale;
- the Respondent uses the image of the "KARHU" figurative trademark at the left top corner of every page, on each of its thirteen websites in connection with the sale of sneakers;
- the Respondent uses a misleading copyright mention on each of its thirteen websites;
- the Respondent does not use any disclaimer which clearly and unambiguously states its lack of a commercial relation with the Complainant.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain names.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain names.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain names, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain names resolve to websites similar to the official "KARHU" website.

The Panel considers that, on the balance of probability, the Respondent knew the Complainant's trademark and registered the disputed domain names with knowledge of the Complainant's rights. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark in mind, when registering and using the disputed domain names. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain names.

Taking into account that the Respondent's use and registration of the disputed domain names were not authorized by the Complainant, that the registration and use of the Complainant's "KARHU" trademark predates the registration of the disputed domain names, that the Complainant has no relationship with the Respondent, that the Respondent is not commonly known by the disputed domain names, that the Respondent uses the Complainant's trademark on each of the websites connected with the disputed domain names in a way similar to the Complainant's official website, that the disputed domain names resolve to websites where it appears that the Complainant's items are sold, that a misleading copyright disclaimer appears on the website connected to the disputed domain names, and that no appropriate disclaimer which states the lack of commercial relation with the Complainant can be found, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

- (i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] 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 [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site 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] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain names were registered in bad faith and that they have been used in bad faith.

The Complainant considers that the fact of registering many variations containing the "KARHU" trademark in combination with other elements amounts to a 'pattern of conduct', supporting a finding of abusive registration.

The Panel agrees that the registration of several domain names which contain the same trademark is evidence of bad faith (see CAC Case No. 105266).

The Complainant considers that the Respondent was using the Complainant's trademarks without permission to get traffic to its websites and to obtain commercial gain by creating a false impression of affiliation or connection with the Complainant.

Indeed, the Respondent is offering goods similar to those of the Complainant under the Complainant's trademarks and such use may create a false impression of affiliation or connection with the Complainant. The Panel takes the view that this constitutes evidence of bad faith, as found by other panels in similar cases (see for example CAC Case No. 105047).

The Complainant underlines that the Respondent uses a privacy service and notes that although privacy services might be legitimate in certain cases, it is difficult to see in the present case why the Respondent needs to protect its identity except to make it difficult for the Complainant to protect its trademark rights. The Panel agrees that in the present circumstances, the use of a privacy service supports a finding of bad faith (see WIPO Case No. D2022-0669).

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain names it would have filed a Response in this proceeding.

The Panel, having taken into account the registration of several domain names which contain the same trademark, the use of the Complainant's trademark in a way which creates a false impression of affiliation or connection with the Complainant, and the use of a privacy service,, considers that the disputed domain names were registered and are being used in bad faith.

Accordingly, the Panel finds that the disputed domain names were registered and are being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **karhu-shoesau.com**: Transferred
2. **karhulenkkarit.com**: Transferred
3. **karhusneakersdanmark.com**: Transferred
4. **karhuturkiye.com**: Transferred
5. **karhusalecanada.com**: Transferred
6. **karhukobenhavn.com**: Transferred
7. **karhuukstockists.com**: Transferred
8. **karhutokyo.com**: Transferred
9. **zapallaskarhu.com**: Transferred
10. **karhushoesschweiz.com**: Transferred
11. **karhusneakersdames.com**: Transferred
12. **karhubelgique.com**: Transferred
13. **karhusneakersnorge.com**: Transferred

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION	2023-07-17
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Publish the Decision	
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