Panel Decision for dispute CAC-ADREU-006247

Case number	CAC-ADREU-006247
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Domain names	ECCOSKO.EU

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization	ECCO Sko A/S

Respondent

Name	qingniang zhuang

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is unaware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The domain name ECCOSKO.EU was registered on December 29, 2011.

The Complainant, ECCO Sko A/S, is a well-known manufacturer of shoes, bags, belts and shoe care products, founded in 1963. Complainant's net turnover in 2010 was DKK 6.111 millions. Complainant has a total workforce worldwide of approximately 17.500 employees. Complainant is the owner of the trademark ECCO registered in several jurisdictions worldwide, inter alia the following:

Community Trademark Reg. No. 001149871, reg. date 06/02/2003
Community Trademark Reg. No. 002967040, reg. date 02/05/2007
US Trademark Reg. No. 1935123, reg. date 14/11/1995
US Trademark Reg. No. 3090429, reg. date 9/5/2006
Canadian Trademark Reg. No. TMA280654, reg. date 26/3/1983
Canadian Trademark Reg. No. TMA752707, reg. date 10/11/2009
Australian Trademark reg. No. 375267, reg. date 10/5/1982
Chinese Trademark Reg. No. 208743, reg. date 30/5/1984
Chinese Trademark Reg. no. G738941, reg. date 31/10/2005

A. COMPLAINANT

Complainant asserts that the first and most distinctive part of the disputed domain name consists of the Complainant's trademark ECCO. Furthermore, the domain name contains the generic and descriptive term SKO, meaning "shoe(s)" in Danish/Norwegian/Swedish, which is also part of the company name of the Complainant. The disputed domain name is therefore confusingly similar to the Complainant's trademark ECCO, registered as CTM and national trademark worldwide, and identical to the Complainant's company name, which is protected under Danish law. The disputed domain name is displaying the ECCO logo, registered in several countries worldwide, as well as pictures taken from some past versions of the ECCO.COM official website, thus enhancing the risk of confusion / likelihood of association with the Complainant's trademark. All in all, the domain name will be perceived as a reference to the official website of the Complainant or a website selling ECCO shoes.

Further the Complainant asserts that the Respondent can hardly be known under the name ECCO. Due to Complainant's long-standing use of the trademark ECCO for "shoes", "leather goods" and other goods and services in many countries worldwide, Complainant finds that Respondent cannot have any legitimate rights in the disputed domain name. Respondent is neither an authorized dealer of

Complainant’s products, nor has the trademark ECCO otherwise been licensed to Respondent. Accordingly, Respondent has no rights or legitimate interests in respect of the disputed domain name. It is made evident by the fact that Complainant’s trademark has such a prominent place in the disputed domain name that Respondent is intentionally attempting to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with Complainant's trademark ECCO and company name ECCO Sko.

The risk of confusion/association is enhanced by the Respondent’s unauthorized use of the Complainant’s logo and pictures taken from past versions of the Complainant’s official website ECCO.COM. In addition, the Respondent is using his website to sell fake ECCO shoes. As a matter of fact, it is not even possible to compare the original ECCO shoes with the models displayed on the Respondent’s homepage, as there is no correspondence or similarity whatsoever; the only thing that the shoes shown on the Respondent’s homepage have in common with the Complainant’s products is the trademark ECCO. The sale of poor quality (fake) shoes under the trademark ECCO on a poor quality e-commerce platform is indeed liable of causing a very big harm to the image of the Complainant and the repute of his brand.

The following decisions support the case:

CAC:
Case No. 100357, ECCO-STOVLER.COM
Case No. 100259, ECCOSHOESSHOP.COM
Case No. 100278, ECCOSHOESUK.NET
Case No. 100311, UKECCOSHOES.NET
Case No. 100321, ECCOSKOUDSALG.COM
Case No. 100312, ECCOSALEONLINE.COM
Case No. 100305, ECCOONLINESALE.COM
Case No. 100327, ECCOONLINESALEUSA.COM

WIPO:
Case No. D2010-2038, ECCODISCOUNT.COM
(http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-2038)
Case No. D2010-1443, ECCOBRANDSHOP.COM, ECOOSHOP.COM
http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1443)
Case No. D2010-1113, 51ECCO.COM
(http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1113)
Case No. D2010-0650, ECCOSHOESOUTLET.COM, ECCOSHOESOUTLETS.COM, ECCOSHOESOUTLETS.NET
(http://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0650.html)

B. RESPONDENT

The Respondent did not file a response, timely or otherwise, despite a reminder.

DISCUSSION AND FINDINGS

To succeed in its Complaint, the Complainant must show that the requirements of Article 21(1) of the Commission Regulation (EC) No. 874/2004 have been complied with. That paragraph reads as follows:

"A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it:

(a) has been registered by its holder without rights or legitimate interest in the name; or

(b) has been registered or is being used in bad faith."

In addition, Article 22(10) of the Regulation and Paragraph B10(a) of the ADR rules provide that:

“In the event that a Party does not comply with any of the time periods established by these ADR Rules or the Panel, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other Party”.

The Complainant has provided sufficient evidence that it is the proprietor of numerous trade mark registrations for the ECCO, covering,

among other things, “shoes”, and which were registered before the contested domain name. Further, the Complainant has enforceable rights based on the company name “ECCO SKO A/S”, which translates “ECCO SHOES A/S” The “A/S” element is an abbreviation of “Aktieselskab”, a type of Danish company, similar to “Inc.”.

The domain name ECCOSKO.EU is a combination of the ECCO trademark and the generic word SKO, which is Danish and Swedish for the word “shoes”.

This Panel is of the opinion that, as previously considered in numerous decisions, the addition in a domain name of a generic, descriptive and/or geographic term to a trademark, is not sufficient to avoid confusion. See, e.g. ADR Case No. 05546 Alkostore.eu: “Adding a generic and non-distinctive element to a protected name does not remove or indeed even lessen the confusing similarity between the disputed domain name and the Complainant’s registered rights, but rather informs the internet user that the website where the disputed domain name points is a place where the products […] are for sale”. Further, the domain name is identical to the Complainant’s company name, but for the functional “A/S” suffix. The Complainant has, therefore, satisfied the requirements of the first paragraph of Article 21(1).

The Complainant has asserted that the Respondent is not known by the name and does not hold any exclusive rights or rights of any nature to the Domain name. Complainant has further asserted that Respondent is neither an authorized dealer of Complainant’s products, nor has the trademark ECCO otherwise been licensed to Respondent. The domain name is being used for a website which allegedly is selling counterfeit shoes.

These assertions are not contradicted by the Respondent. Should the Respondent have rights or legitimate interests in the domain name, the Panel assumes that it would have advised the Panel of the same. As no response was filed, the Panel therefore accepts that the Respondent does not have rights or legitimate interests in the contested domain name.

In the absence of any submission on the issue from the Respondent, the Complainant has satisfied the requirements of Article 21(1)(a). It is not necessary to make an assessment of bad faith under Article 21(1)(b).

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name ECCOSKO be transferred to the Complainant.

PANELISTS

Name	Peter Gustav Olson

DATE OF PANEL DECISION 2012-05-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: ECCOSKO.EU

II. Country of the Complainant: Denmark, country of the Respondent: U.K.

III. Date of registration of the domain name: 29 December 2011

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. Community Trademark Reg. No. 001149871, reg. date 06/02/2003, and Community Trademark Reg. No. 002967040, reg. date 02/05/2007, among many other registered rights.
2. Company name: ECCO Sko A/S

V. Response submitted: No

VI. Domain name is both identical and confusingly similar to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to lack the rights and legitimate interests: Respondent is neither an authorized dealer

of Complainant's products, nor has the trademark ECCO otherwise been licensed to Respondent.
2. Rights or legitimate interests the Respondent claims to have: No response submitted
3. Does the Panel consider the Respondent to have no rights or legitimate interests: No, the website is being used for counterfeit.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to have registered or use the domain name/s in bad faith: The Respondent's website is being used for counterfeit.
2. How the Respondent rebuts the statements of the Complainant: None filed
3. Does the Panel consider the Respondent to have registered or use the domain name/s in bad faith: not necessary for ruling

IX. Other substantial facts the Panel considers relevant: Respondent's website looks remarkably like the one of the Complainant.

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: None