Panel Decision for dispute CAC-ADREU-007390

Case number	CAC-ADREU-007390
Time of filing	2017-03-29 22:20:28
Domain names	ggdbsneakers.eu

Case administrator

	Aneta Jelenová (Case admin)

Complainant

Organization	Golden Goose S.p.A.

Respondent

Organization	li dazhou

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 Complainant submitted that on 1.12.2016 filed a complaint with the Guardia di Finanza (Italian anti-counterfeit authority) against the use of the Respondent's website. However the Panel is not aware that this complaint resulted in legal proceedings. Anyway, even if this were the case, according to Paragraph A4 and A5 of the ADR Rules, an ADR .eu proceeding shall not be prejudiced by any court proceeding, and as long as court proceedings are pending, panels can proceed to a decision.

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

On 1.10.2016 li dazhou (hereinafter, the "Respondent") registered the domain name <ggdbsneakers.eu> (hereinafter "the Domain Name" or the "disputed domain name").

On 12.12.2016 the company Golden Goose S.p.A. (hereinafter, the "Complainant") filed a complaint before the ADR Center for .eu of the Czech Arbitration Court, requesting the transfer of the disputed Domain Name to Golden Goose S.p.A.

On 15.12.2016 the EURid verified that the Respondent is the registrant of the disputed Domain Name.

The Respondent was duly notified of the ADR proceedings by email and by registered mail to the addresses he provided to the EURid. The registered mail communication went undelivered and the Respondent failed to file a response to the complaint. Therefore, the Center issued a notification of Respondent's default.

A. COMPLAINANT

The Complainant submitted a list of trademarks claiming these trademarks over the years have become well known in the field of the fashion industry, especially for shoes, clothing and accessories:
1. International Trademark for GGDB (word mark) No. 1242358, registered on January 17, 2014, in classes 18, 25;
2. Italian Trademark for GGDB (word mark) No. 0001608971, registered on January 17, 2014, in classes 18, 25, 35;
3. Italian Trademark for GOLDEN GOOSE DELUXE BRAND (word mark) No. 0001608972, registered on January 17, 2014, in classes 09, 35;
4. Italian Trademark for GOLDEN GOOSE DELUXE BRAND (word mark) No. 0000983654, registered on September 8, 2005, in classes 03, 14, 18, 25;
5. International Trademark for GOLDEN GOOSE DELUXE BRAND (word mark) No. 881244, registered on December 12, 2005, in classes 3, 14, 25;
6. International Trademark for GOLDEN GOOSE DELUXE BRAND (word mark) No. 1141624, registered on September 17, 2012, in class

18;

Moreover, the Complainant contends that he is the owner of the domain name <goldengoosedeluxebrand.com>, has a strong presence in online stores and on social networks and operates a vast sales network in hundreds of retail stores worldwide and several directly owned mono-brand shops in Europe and Asia.

The Complainant contends that several celebrities of the international show and music business are often photographed while wearing their products, which are covered and "endorsed" in several international magazines, as per the documentation he attaches.

For all the above, the Complainant contends that the Trademarks GGDB and GOLDEN GOOSE DELUXE BRAND are well-known worldwide.

The Complainant bases its complaint on the following grounds:

A.
The Complainant submits that the domain name “ggdbsneakers.eu” is confusingly similar to the trademark GGDB. The use of the descriptive term “sneakers” together with the heart of the Complainant’s trademark “GGDB” would not affect confusing similarity with the trademark as the term refers to the Complainant’s products. The Complainant points out that the Respondent has provided no company name or clear contact information on its website. Since no disclaimers are posted on the website, and the website displays the GOLDEN GOOSE trademarks, it give customers an impression of being Complainant’s website.
As a matter of fact, the Respondent’s website is an online store selling counterfeit GGDB products and reproducing, without permission, images taken from the Complainant’s website which the Complainant submits are protected by copyright.

B.
The Complainant submits that the Respondent lacks any right or legitimate interest in the disputed domain name, as the Respondent is not a licensee, distributor or authorized agent of the Complainant. There are no demonstrable preparations to use the disputed domain name for a bona fide offering of goods or services, but the Respondent uses it for selling counterfeit goods.
The prices for the goods offered for sale on the Website are significantly lower than the average retail price offered by the Complainant which makes it likely that the goods are counterfeit. No rights or legitimate interests can exist for the sale of counterfeit goods and such use is clearly not a bona fide use, fair use, or noncommercial use of the disputed domain names.

C.
The Complainant states that the disputed domain name was registered and is being used in bad faith. The very incorporation of the trademark in the domain name and the display of the Complainant’s trademarks and images on the Website confirm the Respondent’s awareness of the trademark. The Respondent offers counterfeit goods under the Complainant's trademarks GGDB and GOLDEN GOOSE DELUXE BRAND, and thus is misleading customers as to the source of the products, since it displays the Complainant's trademarks without any authorization. Moreover, incomplete or inaccurate contact information has been given, which indicates the Respondent's bad faith.

Finally, the Complainant points out that it was awarded with a number of transfer decision following previous complaints submitted to the WIPO Arbitration and Mediation Center, bearing strong similarities with the case at hand.

B. RESPONDENT

The Respondent was declared in default and did not file any Response nor further reply.

DISCUSSION AND FINDINGS

According to Article 21(1) of the Commission Regulation (EC) 874/2004 and to Paragraph B11(d)(1) of the ADR Rules, the Complainant must show that: the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or EU law (point A below); and has been registered by its holder without rights or legitimate interest in the name (B); or has been registered or is being used in bad faith (C).

A. Identity or confusing similarity

The Panel found out that the Complainant has provided evidence of being the owner of at least one trademark registration for the GGDB word mark (as listed above, from now on "the Trademark") registered for goods in classes 18 and 25 as an International Registration

covering several jurisdictions, including the European Union.

In comparing the domain name <ggdbsneakers.eu> to the Trademark, it should be taken into account that the suffixes, including the .eu top level domain, may be excluded from consideration as being merely a functional component of a domain name.

The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant's Trademark, as it begins with and incorporates the Trademark in its entirety, and the sole additional element -sneakers- is a descriptive term widely used in the fashion industry (also by non-English public) to describe some of the goods for which the marks are registered.

The first requirement of Article 21(1) of the Commission Regulation (EC) 874/2004 and of § B11(d)(1) of the ADR Rules is therefore met.

B. Rights or legitimate interest to the Domain Name

The Panel found out that, according to the evidence filed by the Complainant, prior to notice of the present dispute and still today the Respondent had been using <ggdbsneakers.eu> domain name in connection with offering of goods of the same type and actually very similar to the ones produced and marketed by the Complainant.
In fact the Domain Name's homepage is an e-commerce webpage, selling sneakers at a discount price.

The Complainant states that the Respondent has no rights in the disputed domain name, as the Respondent is not a licensee, distributor or authorised agent of the Complainant.

It is well-established that the burden of proof of the above lies on the Complainant; however, satisfying the burden of proof which lies in a lack of the Respondent's rights or legitimate interests is potentially quite onerous (almost a probatio diabolica), as it's always the case when proving a negative circumstance instead of a positive one. Accordingly, it is sufficient that the Complainant shows prima facie evidence in order to shift the burden on the Respondent (see e.g. CAC 5235 <jackwolfskin.eu> or CAC 1827 <mueller.eu>).
In case the Respondent had rights or legitimate interests, the Panel assumes that it would have advised the Panel of these. However, by not filing a response (a circumstance which in itself could be considered as a ground to accept the Complainants' claim, according to § B10(a) of the ADR Rules), the Respondent failed to prove its rights and legitimate interest in the Domain Name (see e.g. CAC 2235 <palmerscocoabutter.eu> or CAC 5903 <manako.eu>).

Furthermore the Panel observes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. Lastly there is no indication before the Panel that the Respondent is commonly known as GGDB, and the Respondent's name is completely different from the disputed domain name.

The Panel therefore concludes that, on the balance of probabilities, the Domain Name was registered by the Respondent without rights or legitimate interest in accordance with Article 21(1) of the Commission Regulation (EC) 874/2004 and of § B11(d)(1) of the ADR Rules.

C. Bad faith

Although the literal text of the Commission Regulation (EC) 874/2004 and of the ADR Rules does not mandate to examine the Respondent's bad faith requirement once the lack of rights or legitimate interests requirement is satisfied, the Panel will now also examine the requirement of bad faith, in order to make a complete assessment and in line with the best practices in the matter.

As far as the bad faith in the use of the disputed domain name is concerned, the Panel took into consideration evidence submitted by the Complainant which shows that the Respondent in setting up an e-commerce website selling sneakers branded with the Complainant's trademark wants to create the false impression that he is affiliated with the Complainant and wants to profit of the confusion of the products (see e.g. CAC 7202, <otokar.eu> or CAC 6458, <ekash.eu>).
The Panel considers that, on the balance of the probabilities, such set-up was intentionally used to make a profit out of the Complainant's name and goodwill and therefore constitutes a finding of Respondent's bad faith.

As far as the bad faith in the registration of the disputed domain name is concerned, the Panel considered the following.
Given the widespread and longstanding presence of the Complainants' trademarks and products both online, in several publications and with actual retail shops in many European countries, it is likely that the Respondent was aware of the Complainants' trademarks and other domain names registrations as well of the Complainant's business, and thus proceeded to registration in bad faith.

Finally, and even more decisively, as noted in the WhoIs of the disputed domain name, the Respondent provided the Registrar with false contact details when he registered the domain name. The Respondent indicated France as his country of residence, while the city was recorded as HongKong, a city actually located in Asia. Also the submitted telephone/fax number begins with +86, which is the international phone code for China.
It appears that the Respondent's purpose, in supplying false address and contact details, was to hide his true business address when registering the Domain Name. Several decisions establish that supplying false information for a domain name registration, in order to hide the registrant's identity, can be considered evidence of bad faith (see e.g. CAC 6813 <divxstage.eu> or CAC 6585 <jack-wolfskinsjacket.eu>).

The third requirement of Article 21(1) of the Commission Regulation (EC) 874/2004 and of § B11(d)(1) of the ADR Rules is therefore, on the balance of probabilities, also met.

For Golden Goose S.p.A. is a company with registered offices in Italy as evidenced in the extract obtained by the Panel with a Chamber of Commerce enquiry, the Complainant satisfies the eligibility criteria as set out in Article 4(2)(b) of Regulation (EC) 733/2002.

DECISION

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

PANELISTS

Name	**Avv. Giovanni Orsoni, LLM**

DATE OF PANEL DECISION 2017-03-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: GGDBSNEAKERS.EU

II. Country of the Complainant: ITALY, country of the Respondent: FRANCE

III. Date of registration of the domain name: 01 October 2016

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word trademark registered in European Union, reg. No. IR 1242358, for the term GGDB, filed on 11 July 2014, registered on 11 July 2014 in respect of goods and services in classes 18, 25

V. Response submitted: No

VI. Domain name is confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: no relation between the Respondent and the Complainant; no evidence that the Respondent has been commonly know by the Domain Name.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: website used for an e-commerce website which wants to profit from the confusion of the products and from the Complainant's name and goodwill; likely knowledge by the Respondent of the Complainant's trademarks and domain names; false address provided by the Respondent to the Registrar.

IX. Other substantial facts the Panel considers relevant: none

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: none

XII. Is Complainant eligible? Yes