Panel Decision for dispute CAC-ADREU-008037

Case number	CAC-ADREU-008037
Time of filing	2020-09-08 00:00:00
Domain names	havaianas-shop.eu

Case administrator

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

Complainant

Organization	ALPARGATAS EUROPE, S.L.U

Respondent

Name	Eleonora Jorge Alves

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

To the knowledge of the Panel, there are no other legal proceedings pending or decided that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, Alpargatas Europe, S.L.U., is a Spanish company and the exclusive licensee of Havaianas' trademarks in Europe. Havaianas is a Brazilian brand of flip-flop sandals created and patented in 1962. It is currently owned by Brazilian manufacturing company Alpargatas S.A.

The trademark "Havaianas" is unique in that there are no other identical or similar marks or names which are registered or in use by third parties.

The Complainant is the licensee of inter alia the following registered trademarks that it uses in connection to its business:

- EUTM No. 007156128 "HAVAIANAS" (word) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear;
- EUTM No. 008664096 "HAVAIANAS" (figurative) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear;
- EUTM No. 003772431 "HAVAIANAS" (figurative) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear.

In addition, the Complainant has been owning the registration for domain names comprising the mark "Havaianas" among which <havaianas-store.com> through which the Complainant promotes its products bearing the trademark "Havaianas".

The Respondent's name is Eleonora Jorge Alves. The Respondent holds the disputed domain name <HAVAIANAS-SHOP.EU> (the "Domain Name") which was registered on 24 July 2012. Until recently, the Domain Name directed to a webpage with a background image of a Havaianas flip-flop sandal, the Havaianas logo, text in the Havaianas font style and the mention "coming soon" in six European languages. Today, the Domain Name directs to a page of registrar STRATO with mention "This domain is now reserved. As of now, no content has been uploaded."

The Respondent did not reply to the Complainant's contentions. The Respondent sent an e-mail on 27 September 2020 and a letter on 8 December 2020 to the CAC in which she alleged she was not able to log in to the CAC's system and in which she provided some background on the registration of the Domain Name, including the statement that she would like to be compensated. The Respondent did not comply with the CAC's request to file a Response within the specified timelines, as required by the ADR Rules.

A. COMPLAINANT

The Complainant considers the Domain Name to be confusingly similar to several marks it holds in the “Havaianas” name. The Complainant considers the Respondent not to have any rights or legitimate interest in the Domain Name and asserts that the Respondent registered and is using the Domain Name in bad faith.

B. RESPONDENT

The Respondent did not reply to the Complainant’s contentions and did not comply with the CAC’s request to file a Response within the specified timelines, as required by the ADR Rules.

DISCUSSION AND FINDINGS

The ADR Procedure relates to the domain name <HAVAIANAS-SHOP.EU> (the “Domain Name”). The Respondent registered the Domain Name on 24 July 2012 and is the holder of the Domain Name.

1. In accordance with Article 21.1 of the Regulation (EC) No 874/2004 (the “Regulation 874/2004”), it should be established whether the Domain 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 (i.e., the rights mentioned in Article 10.1 of Regulation 874/2004).

The Complainant has sought to protect its rights in and to the trademark “Havaianas”.

The Complainant is the licensee of inter alia the following registered trademarks that it uses in connection to its business:

- EUTM No. 007156128 "HAVAIANAS" (word) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear;
- EUTM No. 008664096 "HAVAIANAS" (figurative) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear;
- EUTM No. 003772431 "HAVAIANAS" (figurative) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear.

In addition, the Complainant has been owning the registration for domain names comprising the mark “Havaianas” among which <havaianas-store.com> through which the Complainant promotes its products bearing the trademark “Havaianas”.

The Domain Name is, obviously, confusingly similar to the Complainant’s “Havaianas” trademark. The Domain Name only differentiates itself from the Complainant’s mark:

(a) for the format required of Internet domain names, i.e., the inclusion of the .eu suffix; and
(b) for the descriptive component “shop”.

The term “Havaianas-shop” is phonetically, graphically and conceptually similar since the Complainant’s mark is entirely comprised in the Domain Name as its initial part. In addition, “shop” is a common term, the meaning of which is easily understood even by consumers whose primary language is not English. The semantic content of the term “shop” is totally descriptive, so that the differences between “Havaianas” and “Havaianas-shop” are neglectable. Consequently, the presence of the .eu suffix and the addition of the suffix -shop to the Complainant’s trademark “Havaianas” in the Domain Name are not sufficient to differentiate the Domain Name from Complainant’s “Havaianas” trademark.

2. Further, the Panel needs to assess whether at least one of the other two elements of Article 21.1 of the Regulation 874/2004 are met. It should be established whether the Respondent registered the Domain Name without rights or legitimate interest in the name “Havaianas” or whether the Respondent registered or used the Domain Name in bad faith (Article 21.1 (a) and (b) of the Regulation 874/2004).

a) The Panel is of the opinion that it is significantly demonstrated that the Respondent registered the Domain Name without rights or legitimate interest in the Domain Name.

It appears that:

The Respondent is not affiliated in any way with the Complainant and appears not to own or hold any trademark applications or registrations for “Havaianas” or any similar marks in connection with any goods or services.

In addition, the Complainant has not licensed or otherwise authorized the Respondent to use the Complainant's "Havaianas" trademark or to apply for any domain name incorporating such mark.

Moreover, the Respondent is not commonly known by the Domain Name and does not trade under the name "Havaianas" and does not make any legitimate commercial use thereof.

The Complainant has been using its "Havaianas" trademark in commerce since long and, as such, Complainant has established rights throughout the world in the "Havaianas" trademark. The Respondent chose and registered the Domain Name which consists of the Complainant's mark and of the descriptive term "shop", thereby intentionally violating the Complainant's rights.

b) The Panel is of the opinion that it is sufficiently demonstrated that the Respondent registered or used the Domain Name in bad faith.

First, the Respondent appeared to try to offer for sale, through a website to which the Domain Name refers, clothing bearing the Complainant's marks, with a potential intent for commercial gain. The Respondent appeared to do so by using logo and pictures taken from Havaianas's official advertising campaigns and by including the term "shop" in the Domain Name.

It seems obvious that the Respondent registered the Domain Name with a view to take unfair advantage of the reputation of the Complainant's mark "Havaianas". Not only the use of the Domain Name appeared to be in bad faith, but also its registration. The Respondent's registration of the Domain Name may have confused potential customers as to the Respondent's affiliation.

Furthermore, the Domain Name discouraged Internet users and thus potential customers of the Complainant from locating the Complainant's true website, thereby diluting the value of the Complainant's "Havaianas" trademark.

3. The Complainant has requested the transfer of the Domain Name. According to Article 22.11 of the Regulation 874/2004, the Panel shall, in the case of a procedure against a domain name holder, decide that the Domain Name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, the Domain Name shall be transferred to the Complainant if the Complainant applies for this Domain Name and satisfies the general eligibility criteria set out in Article 4(2)(b) of the Regulation (EC) No 733/2002.

To satisfy those general eligibility criteria the Complainant must be one of the following:

1. an undertaking having its registered office, central administration or principal place of business within the European Community; or
2. an organisation established within the European Community without prejudice to the application of national law; or
3. a natural person resident within the European Community.

In this case, the Complainant is an undertaking with registered offices within the Community. As a result the Complainant satisfies the eligibility criteria. The Panel may order to transfer to this Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the disputed domain name <HAVAIANAS-SHOP.EU> be transferred to the Complainant within thirty calendar days of the notification of the decision to the Complainant and to the Respondent, unless the Respondent initiates court proceedings in a mutual jurisdiction as meant in Paragraph B 12 (a) of the ADR Rules.

PANELISTS

Name	**GODDYN BV, Bart G. GODDYN**

DATE OF PANEL DECISION 2021-03-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <HAVAIANAS-SHOP.EU>

II. Country of the Complainant: Spain, country of the Respondent: Germany

III. Date of registration of the domain name: 24 July 2012

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

- EUTM No. 007156128 "HAVAIANAS" (word) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear;
- EUTM No. 008664096 "HAVAIANAS" (figurative) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear;
- EUTM No. 003772431 "HAVAIANAS" (figurative) registered and in force for the following goods and services: Class 25: Clothing, footwear, headgear;
- domain names comprising the mark “Havaianas” among which <havaianas-store.com>.

V. Response submitted: No

VI. Domain name/s is/are [identical/confusingly similar/neither identical nor 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. No rights or legitimate interests
2. Why: the Respondent is not affiliated with the Complainant, has no license, is not commonly known by the domain name, does not trade under it and does not make any legitimate use thereof

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: offer for sale of items bearing the Complainant’s marks, through the website to which the domain name refers. Registration and use in bad faith to take unfair advantage of the reputation of the Complainant's mark

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