

ADMINISTRATIVE PANEL DECISION

Aldo Group International AG v. Charlie Brennan

Case No. D2023-1457

1. The Parties

The Complainant is Aldo Group International AG, Switzerland, represented by Kirker & Cie SA, Switzerland.

The Respondent is Charlie Brennan, Germany.

2. The Domain Name and Registrar

The disputed domain name <aldocipele.com> is registered with Gransy, s.r.o. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 4, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Unknown / Domain Admin, Whois protection, this company does not own this domain name s.r.o.) in the Complaint. The Center sent an email communication to the Complainant on April 6, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on April 6, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 12, 2023.

The Center appointed Zoltán Takács as the sole panelist in this matter on June 5, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a Swiss company doing business in purchase, sale, import and export of ALDO branded leather goods, in particular of footwear, headgear, bags and other fashion accessories.

The Complainant's products are available in more than 100 countries of the world, inclusive of Croatia, where its products are sold at physical Aldo stores and the Complainant's local website "www.aldoshoes.com.hr". The corresponding domain name <aldoshoes.com> has been registered since February 3, 1996.

The Complainant among others owns the Croatian Trademark Registration No. Z20060779 for the word mark ALDO, registered on March 16, 2007 for variety of goods including footwear and bags as well as for services related to such products.

The disputed domain name was registered on November 14, 2022, and has been resolving to a Croatian language website that purports to sell the Complainant's ALDO branded products.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name, which incorporates the entirety of its ALDO trademark is confusingly similar to it because addition of the term "cipele" (meaning "shoes" in Croatian) to the trademark does not prevent the trademark from being recognizable in the disputed domain name.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. The Respondent's use of the Complainant's trademark and product images on the website at the disputed domain name shows the Respondent's awareness of the trademark at the time of registration of the disputed domain name and the Respondent's intent to mislead consumers into believing that it is a website operated or authorized by the Complainant.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

- (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.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced evidence of having registered rights in the ALDO trademark and for the purpose of this proceedings the Panel establishes that the Croatian Trademark Registration No. Z20060779 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Complainant's trademark is fully incorporated into and is evidently recognizable in the disputed domain name. The Respondent's addition of the term "cipele" (meaning "shoes" in Croatian) to the Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity.

The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant's trademark and that the first ground of the Policy is established.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice of the dispute, its use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent.

As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with the relevant evidence demonstrating its rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established prior rights in the ALDO trademark.

The Complainant has not authorized the Respondent to use its ALDO trademark, in a domain name, or otherwise.

There is no evidence that the Respondent is commonly known by the disputed domain name.

As shown by the Complainant, the Respondent has been using the disputed domain name to confuse Internet users presumably looking for the Complainant through directing them to its own website, at which it is using the Complainant’s trademark, its logo, product images, and is purportedly offering goods of the Complainant’s exact business. This cannot constitute fair use because it effectively impersonates or falsely suggests sponsorship or endorsement by the Complainant.

UDRP panels have categorically held that the use of a domain name for illegal activity, such as impersonation/passing of, or other types of fraud can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

Moreover, the inherently misleading nature of the disputed domain name, incorporating the Complainant’s trademark and a descriptive term affiliated with the Complainant’s business, carries risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)).

The Respondent failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter to the Complainant’s *prima facie* case and the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant's ALDO trademark is inherently distinctive for the corresponding goods, namely shoes, bags and fashion accessories and predates the registration of the disputed domain name by years.

The Respondent is using the Complainant's trademark in the disputed domain name as well as the Complainant's logo and product images on the website at the disputed domain name, thus it is clear that the Respondent knew of the Complainant's business and trademark at the time of registration of the disputed domain name and had registered it in order to take unfair advantage of it.

The Respondent's use of the disputed domain name to direct Internet traffic intended for the Complainant to its website through impersonation or false association in order to gain illegitimate profit in view of the Panel amounts to bad faith registration and use within the meaning of paragraph 4(b)(iv) of the Policy.

The Respondent chose not to respond to the Complaint and rebut the Complainant's credible assertions and evidence, which the Panel accepts and finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <aldocipele.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: June 19, 2023