

ADMINISTRATIVE PANEL DECISION

Aldo Group International AG v. Client Care, Web Commerce Communications Limited

Case No. D2023-1459

1. The Parties

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

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <aldoslovenija.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (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 6, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 2023, 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 12, 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 9, 2023.

The Center appointed Mladen Vukmir as the sole panelist in this matter on May 25, 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

- (i) The Complainant is Aldo Group International AG, a company incorporated on February 26, 1985 in canton Zug, Switzerland. The Complainant is in a business of international trade, purchase, sale, import, export, etc. of leather goods and, in particular, footwear;
- (ii) The Complainant offers its products through the website “www.aldoshoes.com”, through partners’ websites and/or in physical department stores;
- (iii) The Complainant is the owner of a portfolio of trademark registrations for the ALDO mark in respect of various goods including footwear, leather goods and fashion accessories, including Slovenian national trademark registration no. 200470677 registered on March 30, 2004 (“ALDO trademark”);
- (iv) The disputed domain name was registered on June 20, 2022, and resolves to a website that contains images and descriptions of the Complainant’s products, as well as the Complainant’s ALDO logo.

5. Parties’ Contentions

A. Complainant

The Complainant, asserts the following:

- (i) it is a Swiss company incorporated in 1985. Aldo was founded by Mr. Aldo Bensadoun in Montreal, Quebec in 1972. The Complainant purchases, sells, imports and exports Aldo branded products that are now available in more than one hundred countries throughout the website “www.aldoshoes.com”, through partners’ websites and/or in physical department stores. In Slovenia, Aldo shoes, bags and other accessories are sold through Slovenian Zalando website “www.zalando.si/aldo-online-shop/”, and Sport Direct website <sl.sportsdirect.com/aldo> in agreement with the Complainant. A physical Aldo store was opened in March 2023 by the Complainant in the Supernova shopping mall in Ljubljana;
- (ii) the Complainant is the owner of a number of registered ALDO trademarks that precede the registration of the disputed domain name;
- (iii) the disputed domain name comprises the Complainant’s name and registered ALDO trademark with the addition of the country name Slovenija, which is the Slovenian spelling of Slovenia. The Complainant states that the incorporation of the country name Slovenia into the disputed domain name does not add the distinctiveness, and that the combination of a trademark with the name of a country to form a domain name does not avoid a likelihood of confusion;
- (iv) the Respondent is not licensed to use the Complainant’s ALDO trademark. The Respondent is not associated with or affiliated with the Complainant. There is no evidence that the Respondent has any rights or legitimate interests in ALDO trademark or trade name;
- (v) the Complainant has established ALDO trademark rights in multiple jurisdictions, including in Slovenia- the country named in the disputed domain name. The website content of the disputed domain name confirms that the Respondent is aware of the Complainant while the website featured on the disputed domain name contain images and descriptions of the Complainant’s products and incorporate the Complainant’s ALDO logo. The consumers accessing the Respondent’s website will believe that the

content is sponsored, endorsed or authorized by the Complainant. The Complainant states that the consumers will believe that the disputed domain name serves as the Complainant's Slovenian website.

B. Respondent

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

6. Discussion and Findings

The Panel now proceeds to consider this matter on the merits in light of the Complaint, the lack of the Response, the Policy, the Rules, the Supplemental Rules, and other applicable legal authority pursuant to paragraph 15(a) of the Rules.

Paragraph 4(a) of the Policy provides that the Complainant must prove, with respect to the disputed domain name, each of the following:

- (i) the disputed domain name is confusingly similar to a trademark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") provides that it is generally accepted that ownership of a registered trademark by a complainant is sufficient to satisfy the threshold requirement of having the trademark rights for purposes of standing to file a UDRP case.

The Complainant has proven that it is the holder of ALDO trademark which is registered before the Slovenian Intellectual Property Office in 2004. As such, this trademark provides to the Complainant all the exclusive rights that are granted with such trademark registration.

It is well established that the threshold test for confusing similarity under the UDRP involves a reasoned but relatively straightforward comparison between the textual components of the relevant trademark and the disputed domain name. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see section 1.7 of the [WIPO Overview 3.0](#)).

After performing a side-by side comparison of the disputed domain name and the Complainant's ALDO trademark, it is evident to this Panel that the disputed domain name incorporates the Complainant's ALDO trademark in its entirety. The only difference between the disputed domain name and the Complainant's ALDO trademark is the addition of the geographical term "Slovenija" in the disputed domain name.

Prior UDRP Panels have found confusing similarity in a number of cases based on the circumstances involving domain names comprised of a well-known trademark and a geographical term (section 1.8. of [WIPO Overview 3.0](#)). Where the trademark in question is recognizable within the disputed domain name, the addition of other terms (whether geographical etc.) does not prevent a finding of confusing similarity between the disputed domain name and trademark in question. In this specific case, the added term "Slovenija" is a geographical term, and following earlier UDRP panels decisions, it does not prevent a finding

of confusing similarity between the disputed domain name and the Complainant's ALDO trademark. Regarding the generic Top-Level Domain ("gTLD"), ".com" in the disputed domain name, as a standard registration requirement, should be disregarded under the confusing similarity test (section 1.11.1 of [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's ALDO trademark under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a number of circumstances which, without limitation, may be effective for the Respondent to demonstrate that it has the rights to, or legitimate interests in, the disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy. Those circumstances are:

- "(i) Before any notice to [the respondent] of the dispute, [use by the respondent] of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) [Where the respondent] (as an individual, business, or other organization) [has] been commonly known by the domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [Where the respondent is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

As noted by the previous UDRP panels on the onus of proof under paragraph 4(a)(ii) of the Policy, and as summarized in 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 relevant evidence demonstrating 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 made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, with the Respondent failing to provide any substantive response to the Complaint which would prove its rights or legitimate interests in the disputed domain name.

The Panel observes that there is neither any relation, disclosed to the Panel, nor otherwise apparent from the records, between the Respondent and the Complainant, nor does it arise that the Complainant has ever licensed or otherwise permitted the Respondent to use its ALDO trademark or to apply for or use any domain name incorporating the same trademarks.

The Respondent has failed to provide any substantive reply to the Complaint and accordingly failed to rebut the Complainant's *prima facie* showing that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the requirements set forth in paragraph 4(a)(ii) of the Policy have been fulfilled by the Complainant's making the *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and by the Respondent's failing to produce any arguments or evidence to the contrary.

C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

- (i) circumstances indicating that the holder has registered or has 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 the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) the holder has 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 the holder has engaged in a pattern of such conduct; or
- (iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 the holder's website or location or of a product or service on the holder's website or location.

According to [WIPO Overview 3.0](#), section 3.1, bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. The Panel accepts that the Complainant's arguments have been substantiated on the basis that the Respondent has registered and used the disputed domain name in bad faith.

The Complainant has established trademark rights in ALDO in multiple jurisdictions (including Slovenia) and commences its business activities under ALDO trademark worldwide. Considering all the facts and circumstances of this case, this Panel's view is that the Complainant's ALDO trademark is well-known and distinctive, and it is highly unlikely that the Respondent was unaware of the Complainant and its ALDO trademark when it registered the disputed domain name.

From evidence submitted by the Complainant it can be concluded that the Respondent improperly targeted the Complainant and its distinctive ALDO trademark when registering the disputed domain name. The Respondent incorporated the Complainant's ALDO trademark entirely into the disputed domain name, the Respondent's website contain images and descriptions of the Complainant's products, and ALDO trademark is placed on the top of the Respondent's website. Beside the Complainant's ALDO trademark, the disputed domain name contain the geographical term (country) Slovenija. Considering the stated facts, this Panel's view is that the Respondent tried to mislead the consumers that the website created under the disputed domain name is registered and used by the Complainant, and that it serves as the Complainant's Slovenian website. This Panel is of opinion that the Respondent's motive in relation to the registration and use of the disputed domain name was to take advantage from the Complainant, its reputation and well-known trademark rights.

Given the above, the Panel finds that the Respondent has registered and is using the disputed domain name to intentionally attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant and its ALDO trademark.

In this Panel's view, the Respondent registered and used the disputed domain name in bad faith, and that the Complainant has fulfilled the third element under 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 <aldoslovenija.com> be transferred to the Complainant.

/Mladen Vukmir/

Mladen Vukmir

Sole Panelist

Date: June 7, 2023