

## **ADMINISTRATIVE PANEL DECISION**

Alpargatas S.A., and Alpargatas Europe, S.L.U. v. Client Care, Web  
Commerce Communications Limited  
Case No. D2022-0328

### **1. The Parties**

The Complainants are Alpargatas S.A., Brazil, and Alpargatas Europe, S.L.U., Spain, represented by PADIMA, Spain.

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

### **2. The Domain Names and Registrar**

The disputed domain names <havaianasindirim.com>, <havaianasirelandsale.com>, <havaianasonlineaustralia.com>, <havaianassaleindia.com>, <havaianassandalsuk.com>, and <havaianas-schweiz.com> (the “Domain Names”) are 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 January 31, 2022. On January 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On February 7, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on February 7, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on February 10, 2022.

The Center verified that the Complaint together with the amended 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 February 16, 2022. In accordance with the Rules,

paragraph 5, the due date for Response was March 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 9, 2021.

The Center appointed Geert Glas as the sole panelist in this matter on March 24, 2022. 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 Complainants are Alpargatas S.A., Brazil ("Alpargatas"), and Alpargatas Europe, S.L.U., Spain ("Alpargatas Europe"). The Complainants are active in the commercialisation of beach apparel and especially flip-flop shoes.

Alpargatas owns a substantial portfolio of HAVAIANAS trademarks. Among others, Alpargatas has registered the following European Union ("EU") trademarks:

- Havaianas (filing no 007156128, registered on March 23, 2009 in class 25);
- **havaianas** (filing no 003772431, registered on September 20, 2005 in class 25);
-  (filing no 008664096, registered on April 23, 2010 in class 25).

Alpargatas Europe is the exclusive licensee of Alpargatas in Europe. In this context, Alpargatas has granted an exclusive license on a series of HAVAIANAS trademarks (including the above listed trademarks) to Alpargatas Europe.

Alpargatas Europe also owns the domain name <havaianas-store.com>, which directs to a website on which it commercialises HAVAIANAS branded goods.

The Registrar's Whois database shows the following with respect to the Domain Names:

- <havaianasindirim.com> was registered on November 17, 2021;
- <havaianasirelandsale.com> was registered on November 17, 2021;
- <havaianasonlineaustralia.com> was registered on November 17, 2021;
- <havaianassaleindia.com> was registered on December 27, 2021;
- <havaianassandalsuk.com> was registered on November 17, 2021; and
- <havaianas-schweiz.com> was registered on November 17, 2021.

The Registrar's public Whois does not indicate the identity of the Respondent. Upon request from the Center, the Registrar identified the Respondent as being Client Care, Web Commerce Communications Limited, Malaysia.

It appears from the screenshots attached as an exhibit to the Complaint that all Domain Names resolved to websites on which the Respondent was commercialising HAVAIANAS branded goods and which reproduced the look and feel of the Complainant's official website. The following logo is reproduced on all websites:



#### 5. Parties' Contentions

##### A. Complainants

The following is a summary of the Complainants' contentions.

The Complainants request that the Domain Names be cancelled on the following grounds:

(i) the Domain Names are confusingly similar to a trademark or service mark in which the Complainants have rights

The Complainants contend that the Domain Names contain their well-known HAVAIANAS trademark and thereby refer to the specific EU trademarks listed in the Factual Background section above.

(ii) The Respondent has no rights or legitimate interests in respect of the Domain Names

The Complainants contend that the Respondent has no rights or legitimate interests in respect of the Domain Names since the Respondent (i) has not been authorised by the Complainants to use the HAVAIANAS trademark, and (ii) does not seem to be commonly known by the Domain Names. The Complainants add that the Respondent is using the Domain Names to deliberately create confusion with the Complainants' business.

(iii) The Domain Names were registered and are being used in bad faith

The Complainants contend that the HAVAIANAS trademark is a well-known trademark and that the Respondent has registered the Domain Names with the intention to refer to the Complainants' trademarks.

The Complainants add that the websites to which the Domain Names resolve are used to sell HAVAIANAS branded goods, without any mention on these websites as to the fact that there is no relationship between these websites and the Complainants. According to the Complainants, this shows the Respondent's purpose to capitalise on their reputation by diverting, for financial gain, Internet users looking for HAVAIANAS branded products and confusing said Internet users as to the source, sponsorship, affiliation or endorsement of the websites and or the goods offered on the websites.

## **B. Respondent**

The Respondent did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainants have demonstrated that they are the owners of several European Union trademarks, which satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2).

The Domain Names incorporate the Complainants HAVAIANAS trademark in its entirety followed by one or two terms (*i.e.* terms related to countries, e-commerce or goods). More particularly:

- <havaianasindirim.com> contains the HAVAIANAS trademark and the term "indirim" which means discount in Turkish;
  - <havaianasirelandsale.com> contains the HAVAIANAS trademark, the term "ireland" and the term "sale";
  - <havaianasonlineaustralia.com> contains the HAVAIANAS trademark, the term "online" and the term "australia";
  - <havaianassaleindia.com> contains the HAVAIANAS trademark, the term "sale" and the term "india";
  - <havaianassandalsuk.com> contains the HAVAIANAS trademark, the term "sandals" and the term "uk";
- and

- <havaianas-schweiz.com> contains the HAVAIANAS trademark followed by an hyphen and the term "schweiz" which means Switzerland in German.

Several UDRP panel decisions have stated that wholly incorporating a complainant's registered trademark in a domain name may be sufficient to establish confusing similarity even when another term is added to the trademark (see, e.g., *GA Modeline S.A v. Mark O'Flynn*, WIPO Case No. [D2000-1424](#); *Viacom International Inc. v. Erwin Tan*, WIPO Case No. [D2001-1440](#); and *eBay Inc. v. ebayMoving / Izik Apo*, WIPO Case No. [D2006-1307](#)).

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) do indeed not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements (see [WIPO Overview 3.0](#), section 1.8).

Accordingly, the Panel finds that the first element under paragraph 4(a)(i) of the Policy has been established in respect of all Domain Names.

## **B. Rights or Legitimate Interests**

Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, the consensus view is that, once the complainant has made a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Dow Jones & Company, Inc., (First Complainant) and Dow Jones LP (Second Complainant) v. The Hephzibah Intro-Net Project Limited (Respondent)*, WIPO Case No. [D2000-0704](#) and the [WIPO Overview 3.0](#), section 2.1).

The Panel finds that the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Names.

Indeed, based on the evidence submitted by the Complainants, the Panel finds that it does not appear that the Respondent (i) has made a legitimate noncommercial use of the Domain Names, (ii) has used the Domain Names in relation with a *bona fide* offering of goods and services or (iii) has been authorised by the Complainants to use the HAVAIANAS trademark or (iv) has been commonly known by the Domain Names.

Given that the Respondent did not reply to the Complainants' contentions and did not present any plausible explanation for its use of the Complainants' HAVAIANAS trademark, the Panel considers that the Complainants have satisfied their burden of proof under this element of the Policy.

Accordingly, the Panel finds that the second element under paragraph 4(a) (ii) of the Policy has been established in respect of all Domain Names.

## **C. Registered and Used in Bad Faith**

The Panel turns to the question of whether the Domain Names have been registered and are being used in bad faith. Paragraph 4(b) of the Policy describes some circumstances which, if found to exist, will be evidence of the registration and use of the domain name in bad faith. They are presented in the alternative and consist of a not exhaustive list of circumstances of bad faith:

(i) circumstances indicating that the respondent 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 respondent documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the respondent 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 respondent has engaged in a pattern of such conduct; or

(iii) circumstances indicating that the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent'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 respondent's website or location or of a product or service on the respondent's website or location.

(a) Registered in bad faith

Previous UDRP panels have ruled that in appropriate circumstances, bad faith is established where a complainant's trademark has been shown to be well known or in wide use at the time of registering a domain name (see e.g. *Caesars World, Inc. v. Forum LLC.*, [WIPO Case No. D2005-0517](#); *The Gap, Inc. v. Deng Youqian*, [WIPO Case No. D2009-0113](#); *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. D2005-0556). In line with previous decisions (see e.g., *Alpargatas S.A. v. Whois agent (869611973)*, *Whois Privacy Protection Service, Inc. / Alan Vitor, Leite Santos*, WIPO Case No. [D2020-1325](#); *Alpargatas S.A. v. LeylaLeyla Leyla*, WIPO Case No. [DNL2015-0030](#); and *Alpargatas S.A. v. Domain Admin, Whoisprotection.cc / Rizky Fauzy, Busana/Pakaian -- PT Kanmo Retailindo Havaianas Indonesia*, WIPO Case No. [D2020-1111](#)), the Panel finds that the HAVAIANAS trademark has acquired an extensive and worldwide reputation and is to be regarded as being well known. As a result, the Panel finds it highly improbable that the Respondent was not aware of the registered trademarks at the time of the registration of the Domain Names.

This finding is reinforced by the fact that for one of the Domain Names, *i.e.* <havaianassandalsuk.com>, the Respondent chose to register a domain name composed of the HAVAIANAS trademark and the word "sandals", which cannot be a coincidence considering that the Complainant's flagship products are flip-flop sandals. The Panel finds that the Respondent registered the Domain Names to take unfair advantage of their confusing similarity with the HAVAIANAS trademark.

Moreover, the Panel notes that it is not the first time that the Respondent is a respondent in a UDRP case relating to the use of the HAVAIANAS trademark. Indeed, on respectively August 19, 2021, (*i.e.* approximately three months before the Respondent registered the Domain Names) and October 19, 2021, (*i.e.* approximately one month before the Respondent registered the Domain Names), two different panels found that the Respondent had registered and had been using several domain names which included the HAVAIANAS trademark in bad faith (see *Alpargatas S.A. , Alpargatas Europe, SLU v. Claudia Wirtz, Domain Admin, Whoisprotection.cc, Domain Administrator, See PrivacyGuardian.org / Sven Kaestner, and Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2021-1821](#); and *Alpargatas S.A, Alpargatas Europe, S.L.U v. Domain Admin, Whoisprotection.cc, Client Care, Web Commerce Communications Limited, Contact Privacy Inc. Customer 0161902546 / Anne-Laure Linval, Thehavaianasstore*, WIPO Case No. [D2021-2385](#)). This shows without a doubt that the Respondent was aware of the Complainants' HAVAIANAS trademark at the moment of registering the Domain Names.

Against this background, the Panel finds that the Domain Names were registered in bad faith.

(b) Used in bad faith

It appears from the screenshots attached as an exhibit to the Complaint that the Domain Names were used for websites offering HAVAIANAS branded goods and that these websites reproduced the look and feel of

the Complainants' official website. Considering that the Complainants maintain that they have not authorised the Respondent to use the HAVAIANAS trademark in any way (including by selling HAVAIANAS branded goods) and that the Respondent has failed to provide any explanation for its use of the Domain Names, the Panel finds that the Respondent intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites, by creating a likelihood of confusion with the Complainants' trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (see e.g., *Groupe Partouche v. Madarin Data LTD, Pousaz Raymond*, WIPO Case No. [D2010-1649](#); *Claudie Pierlot v. Yinglong Ma*, WIPO Case No. [D2018-2466](#); *Caterpillar, Inc. v. Dirk Dohmen*, WIPO Case No. [D2016-0138](#)).

In addition, the Panel notes that on the day of writing these lines, 17 other panels had already found that the Respondent had registered and used domain names in bad faith in circumstances extremely similar to the ones of this case. These 17 decisions show a clear pattern of conduct consisting in the Respondent registering domain names including well-known trademarks registered for shoes and or sport apparel and apparently offering for sale goods bearing these well-known trademarks, without having been authorised by the trademark owners to do so (see e.g. *Puma SE v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0015](#); *Skechers U.S.A., Inc. II v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2021-4182](#); and *NewBalance Athletics, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0215](#)).

Consequently, the Panel finds that the Respondent has been using the Domain Names in bad faith and that the third element under paragraph 4(a)(iii) of the Policy has been established in respect of all Domain Names.

## 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 Domain Names, <havaianasindirim.com>, <havaianasirelandsale.com>, <havaianasonlineaustralia.com>, <havaianassaleindia.com>, <havaianassandalsuk.com>, and <havaianas-schweiz.com> be cancelled.

/Geert Glas/

**Geert Glas**

Sole Panelist

Date: April 7, 2022