

## **ADMINISTRATIVE PANEL DECISION**

**NPS (Shoes) Limited v. Client Care, Web Commerce Communications Limited**

**Case No. D2022-3754**

### **1. The Parties**

Complainant is NPS (Shoes) Limited, United Kingdom, represented by Howes Percival LLP, United Kingdom.

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

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

The disputed domain names (1) <botassolovair.com>, (2) <solovairaustralia.com>, (3) <solovairbuty.com>, (4) <solovaircanada.com>, (5) <solovairfactoryshop.com>, (6) <solovairsuomi.com>, and (7) <solovairuk.com> 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 October 7, 2022. On October 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on October 17, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on October 18, 2022.

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 Respondent of the Complaint, and the proceedings commenced on October 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 8, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 9, 2022.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on November 17, 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**

Complainant is a company organized under the laws of England and Wales that is active in the shoes, shoe accessories, and leather goods industry.

Complainant has provided evidence that it is the registered owner of various trademarks relating to its brand SOLOVAIR, namely:

- word mark SOLOVAIR, United Kingdom registration number UK00001581740, registration date: June 23, 1995, status: active;
- word/device mark SOLOVAIR, International registration number: 1120647, registration date: January 5, 2012, status: active; and
- word mark SOLOVAIR, United States of America registration number: 6238126, registration date: January 5, 2021, status: active.

Respondent, according to the disclosed Whois information for the disputed domain names, is a company residing in Malaysia, who registered through the Registrar all seven disputed domain names as follows: (1) <botassolovair.com> on July 26, 2022, (2) <solovairaustralia.com> on July 21, 2022, (3) <solovairbuty.com> on July 25, 2022, (4) <solovaircanada.com> on July 23, 2022, (5) <solovairfactoryshop.com> on July 25, 2022, (6) <solovairsuomi.com> on July 22, 2022, and (7) <solovairuk.com> on July 19, 2022.

By the time of the rendering of this decision, the disputed domain name (5) <solovairfactoryshop.com> resolves to a website at "www.solovairfactoryshop.com" which purportedly offers men's and women's shoes under the SOLOVAIR trademark for online sale, while all other disputed domain names resolve to websites, the access to which is technically denied. Complainant, however, has demonstrated that at some point before the filing of the Complaint, each of the seven disputed domain names resolved to websites purportedly offering the sale of shoes and boots for men and women under the SOLOVAIR trademarks, thereby displaying Complainant's official SOLOVAIR logo and copying substantial parts (e.g., product pictures) from Complainant's official website under "uk.nps-solovair.com".

Complainant requests that the disputed domain names be transferred to Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant contends to be a leading manufacturer of shoes, shoe accessories, and leather goods, which has been trading under the SOLOVAIR brand since the 1950s worldwide via local stockists and which has meanwhile built up a significant reputation, both in the United Kingdom and worldwide, in respect of its services.

Complainant submits that the disputed domain names are confusingly similar to its SOLOVAIR trademark, as the latter is clearly recognizable in all of the disputed domain names, added by a geographical indicator or a descriptive term, which does nothing to differentiate the disputed domain names from Complainant's SOLOVAIR trademark. Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain names since (1) Complainant has no relationship with Respondent and has not licensed or otherwise authorized Respondent to make use of Complainant's SOLOVAIR trademark or related domain names, (2) there is no evidence that Respondent has traded under the SOLOVAIR

trademark prior to the registration of the disputed domain names, nor has Respondent been commonly known by the disputed domain names or any sign similar to the SOLOVAIR trademark, and (3) although full access to some of the websites under the disputed domain names is technically denied, it is still clear, e.g., from a review of the website at “www.solovairfactoryshop.com” that Respondent is using the disputed domain names to resolve the websites offering the same type of services as Complainant’s official website and is thereby taking advantage of the similarity between Complainant’s SOLOVAIR trademark and the disputed domain names for commercial and/or financial gain. Finally, Complainant argues that Respondent has registered and is using the disputed domain names in bad faith since (1) Complainant has used its SOLOVAIR trademark for over 28 years and, therefore, significantly prior to the registration of the disputed domain names by Respondent, (2) the disputed domain names contain Complainant’s SOLOVAIR trademark as their primary and dominant component, and the service being offered thereunder is the sale of shoes and boots for men and women, which is identical to the goods offered by Complainant, and (3) it is clear from the content of the websites under the disputed domain names that Respondent has the intention to actively mislead customers into thinking that the disputed domain names are somehow connected with Complainant’s business and, therefore, to attract said customers, for commercial gain, or to seek to defraud them.

## **B. Respondent**

Respondent did not reply to Complainant’s contentions.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

Respondent’s default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent’s failure to submit a Response as it considers appropriate.

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

The Panel concludes that the disputed domain names are confusingly similar to the SOLOVAIR trademark in which Complainant has rights.

The disputed domain names all incorporate Complainant’s SOLOVAIR trademark in its entirety. Numerous UDRP panels have recognized that where a domain name incorporates a trademark in its entirety, 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 trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7). Moreover, it has been held in many UDRP decisions and has become a consensus view among panels that the addition of other terms (whether, e.g., descriptive, geographical, or otherwise) would not prevent a finding of confusing similarity under the first element of the UDRP (see [WIPO Overview 3.0](#), section 1.8). Accordingly, the addition of the various terms “australia”, “botas” (“boots” in Spanish/Portuguese), “buty” (“shoes” in Polish), “canada”, “factoryshop”, “suomi” (“Finland” in Finnish) as well as “uk” does not dispel a finding of confusing similarity arising from the incorporation of Complainant’s entire SOLOVAIR trademark in the disputed domain names.

Therefore, Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

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

The Panel is further convinced on the basis of Complainant's undisputed contentions that Respondent has not made use of the disputed domain names in connection with a *bona fide* offering of goods or services, nor has Respondent been commonly known by the disputed domain names, nor can it be found that Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain.

Respondent has not been authorized to use Complainant's SOLOVAIR trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain names and Respondent does not appear to have any trademark rights associated with the term "solovair" on its own or the disputed domain names. To the contrary, Respondent is or has been running websites under the disputed domain names which purport to offer for sale Complainant's SOLOVAIR shoes and related products, thereby displaying Complainant's official SOLOVAIR trademark and logo as well as pictures of the SOLOVAIR shoes and boots, most likely obtained from Complainant's official website at "uk.nps-solovair.com" without any permission to do so. The Panel recognizes that the Case File leaves it somewhat open if the goods offered on the websites under the disputed domain names were original or fake SOLOVAIR products. But even if those products were originals, apart from imitating Complainant's official website, Respondent obviously does not disclose, neither accurately nor prominently, the non-existing relationship with Complainant, the SOLOVAIR trademark holder, and, therefore, may not claim any rights or legitimate interests in the disputed domain names (see the so-called "Oki Data test", [WIPO Overview 3.0](#), section 2.8.1). Moreover, the nature of the disputed domain names is inherently misleading and carries a risk of an implied affiliation as it effectively suggests sponsorship or endorsement by Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, Complainant has established a *prima facie* case that Respondent has no rights or legitimate interests in respect of the disputed domain names. Now, the burden of production shifts to Respondent to come forward with appropriate evidence demonstrating such rights or legitimate interests (see [WIPO Overview 3.0](#), section 2.1). Given that Respondent has defaulted, Respondent has not met that burden.

The Panel, therefore, finds that Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

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

The Panel finally holds that the disputed domain names were registered and are being used by Respondent in bad faith.

The circumstances to this case leave no reasonable doubt that Respondent was fully aware of Complainant's rights in the SOLOVAIR trademark (notwithstanding its claimed reputation) when registering the disputed domain names and that the latter are clearly directed thereto. Moreover, using the disputed domain names, which all are confusingly similar to Complainant's SOLOVAIR trademark, to run websites which purport to offer for sale Complainant's SOLOVAIR shoes and related products, thereby displaying Complainant's official SOLOVAIR trademark and logo as well as pictures of the SOLOVAIR shoes and boots, most likely obtained from Complainant's official website at "uk.nps-solovair.com" without any permission to do so, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own websites by creating a likelihood of confusion with Complainant's SOLOVAIR trademark as to the source, sponsorship, affiliation, or endorsement of Respondent's websites. Such circumstances are evidence of registration and use of the disputed domain names in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

In this context, it also carries weight in the eyes of the Panel that Respondent obviously provided false or incomplete contact information in the Whois register for the disputed domain names since, according to the Case File, the Written Notice on the Notification of Complaint dated October 19, 2022 could neither be sent

nor delivered to Respondent. This fact at least throws a light on Respondent's behavior which supports the Panel's bad faith finding.

Therefore, the Panel concludes that Complainant has also satisfied the third element under the Policy set forth by paragraph 4(a)(iii).

## **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 names <botassolovair.com>, <solovairaustralia.com>, <solovairbuty.com>, <solovaircanada.com>, <solovairfactoryshop.com>, <solovairsuomi.com>, and <solovairuk.com> be transferred to Complainant.

*/Stephanie G. Hartung/*

**Stephanie G. Hartung**

Sole Panelist

Date: December 1, 2022