



URS | DETERMINATION
(URS Procedure 9, URS Rules 13)

URS DISPUTE NO. 5238BD45

Determination DEFAULT

I. PARTIES

Complainant: Molicopi, SL (SP)

Complainant's authorized representative(s): Padima Team, SLP (SP)

Respondent: Privacy Guardian, See PrivacyGuardian.org (US)

II. THE DOMAIN NAME(S), REGISTRY OPERATOR AND REGISTRAR

Domain Name: PIKOLINOSAUSTRALIA.INFO

Registry Operator: Afilias Limited

Registrar: NameSilo, LLC

III. PROCEDURAL HISTORY

Complaint submitted: 2021-11-17 11:45

Lock of the domain name(s): 2021-11-17 20:51

Notice of Complaint: 2021-11-18 10:52

Default Date: 2021-12-03 00:00

Notice of Default: 2021-12-03 15:47

Panel Appointed: 2021-12-03 15:49

Default Determination issued: 2021-12-06 00:00

IV. EXAMINER

Examiner's Name: Gustavo Moser

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

V. RELIEF SOUGHT

The Complainant requests that the disputed domain name be suspended for the balance of the registration period.

The Respondent has not submitted a Response.

VI. STANDARD OF REVIEW

Clear and convincing evidence.

VII. DISCUSSIONS AND FINDINGS

Disputed domain name

The domain name <pikolinosaustralia.info> was registered on 13 October 2021 (*the disputed domain name*), and it resolves to an active website (*the Respondent's website*), the particulars of which are set out and discussed in the course of this determination.

A. Complainant:

Trade mark standing

For the purposes of this URS dispute, the Complainant relies on the following registered trade marks, amongst others:

- EU trade mark registration no. 009426776, dated 9 March 2012, for the figurative mark PIKOLINOS, in classes 3, 9, 10, 14, 18, 25, 26 and 35 of the Nice Classification;
- EU trade mark registration no. 017881462, dated 10 August 2018, for the figurative mark PIKOLINOS GET COMFY & SMILE, in classes 18, 25 and 35 of the Nice Classification; and
- EU trade mark registration no. 003813177, dated 27 August 2010, for the figurative mark PIKOLINOS, in classes 3, 35 and 39 of the Nice Classification.

(collectively or individually, *the Complainant's trade mark; the Complainant's trade mark PIKOLINOS; or the PIKOLINOS trade mark*).

The Complainant's contentions can be summarised as follows:

(i) The disputed domain name is identical or confusingly similar to a word mark

The Complainant states that it is domiciled in Spain and that it was founded 37 years ago. The Complainant further states that it has become a worldwide known trade mark owing to its high quality leather shoes and accessories.

The Complainant avers that the disputed domain name is confusingly similar to the Complainant's trade mark PIKOLINOS, in so far as the disputed domain name consists of two terms, namely "Pikolinos", which mimics the Complainant's trade mark PIKOLINOS, and "Australia", which merely identifies the name of a country.

(ii) Respondent has no rights or legitimate interests to the disputed domain name

The Complainant contends that the Respondent has no rights or legitimate interests in connection with the disputed domain name.

In order to lend further credence, the Complainant affirms that the Respondent uses the website to manufacture, distribute, export and/or offer PIKOLINOS products. In addition, the Complainant claims to own the photographs on the Respondent's website, and further argues that the Respondent is attempting to operate a fraudulent and unauthorised online commerce, the result of which being that the Complainant's consumers might be defrauded by the Respondent's website.

(iii) The disputed domain name was registered and is being used in bad faith

The Complainant avers that the Respondent's purpose is to capitalise on the reputation of the trade mark PIKOLINOS by diverting Internet users seeking PIKOLINOS products to the



Respondent's website, for financial gain, by intentionally creating a likelihood of confusion with the trade mark PIKOLINOS as to the source, sponsorship, affiliation, or endorsements of the Respondent's website and/or the goods offered or promoted through the Respondent's website.

The Complainant further states the disputed domain name will make consumers believe that the Respondent's website is an official website of PIKOLINOS. The Complainant therefore concludes that the disputed domain name was registered and is being used in bad faith.

B. Respondent:

The Respondent did not reply to the Complaint.

C. Procedural findings:

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under the URS Procedure paragraphs 3 and 4 and URS Rules paragraph 4.

In accordance with URS Procedure Paragraph 9(d), in absence of a Response, the language of the Determination shall be English.

D. Findings of fact:

The disputed domain name was registered on 13 October 2021.

The disputed domain name resolves to an online store on which PIKOLINOS products appear to be commercialised, notwithstanding the absence on the website of a disclaimer regarding the relationship with the Complainant, or the lack thereof.

The Complainant has, to the satisfaction of the Examiner, adduced proof that the Complainant has trade mark rights in the term "Pikolinos".

E. Reasoning:

Pursuant to paragraph 13 of the URS Rules, the Examiner shall make a Determination of a Complaint in accordance with the URS Procedure, the URS Rules and any rule and principles of law that the Examiner deems applicable.

Paragraph 1.2.6 of the URS Procedure provides the following threshold for the Complainant to meet in order to be entitled to relief:

1. The domain name is identical or confusingly similar to a word mark;
2. The Respondent has no rights or legitimate interests to the domain name; and
3. The domain name was registered and is being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the URS procedure is clear and convincing and, on that basis, the Examiner will now proceed to determine each of the three URS Procedure elements in turn.

1. The disputed domain name is identical or confusingly similar to a word mark

The URS test under the first element provides for a juxtaposing approach, according to which the textual components of the disputed domain name and the Complainant's trade mark are to be compared side by side.

Nonetheless, to achieve success under this ground, the Complainant must first of all provide evidence that it owns rights in a trade mark, following which the Examiner shall assess the degree of similarity between the trade mark and the disputed domain name.

The Examiner is satisfied that the Complainant owns trade mark rights in the term "PIKOLINOS" dating back to at least 2010, and that the Complainant is mostly known by its leather footwear.

The disputed domain name was registered on 13 October 2021, and it is composed of the terms "Pikolinos" and "Australia".

The Complainant's trade mark PIKOLINOS is wholly incorporated into the disputed domain name. The additional term "Australia" in the disputed domain name string merely identifies the country which carries this name. In fact, in the Examiner's view, the geographic term "Australia" enhances the visual and phonetic confusion with the PIKOLINOS trade mark, in so far as it may well trigger an inference of association with the Complainant.

The Examiner further notes that TLD suffixes (<.info> in this matter) are typically disregarded in the assessment of confusing similarity for being part of the anatomy of a domain name (see, for comparative analysis, WIPO Panel Views on Selected UDRP Questions, Third Edition, paragraph 1.11 ("WIPO Jurisprudential Overview 3.0")).

Accordingly, the Examiner finds that the disputed domain name is confusingly similar to the Complainant's trade mark, the result of which being that the Complainant has succeeded under paragraph 1.2.6.1 of the URS Procedure.

2. Respondent has no rights or legitimate interests to the disputed domain name

The second element of the URS Procedure provides that the Respondent shall demonstrate that it has rights or legitimate interests in the dispute domain name. It therefore falls on the Complainant the burden to refute any such allegations.

Nonetheless, the Respondent did not submit a Response in this URS dispute. Therefore, the Examiner will proceed to determine the dispute on the basis of the available evidence.

Having reviewed the case file, the Examiner notes that the Complainant claims not to have authorised the Respondent to reproduce the Complainant's official images on the Respondent's website nor to register the disputed domain name, let alone to commercialise any of the Complainant's products.

The Examiner further notes that the Respondent does not carry out any activity for, or has any business or relationship of any nature with, the Complainant. There is no contractual arrangement between the parties to that effect, nor has the Complainant otherwise authorised the Respondent to make any use of the Complainant's trade mark. Moreover, there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name.



The Examiner also notes that there is no evidence on the record to suggest that the Respondent is affiliated with, or endorsed by, the Complainant (and, in any event, any affiliation or endorsement has been denied by the Complainant).

On this particular point, the Examiner refers to the jurisprudential views brought about by domain name disputes under the UDRP Policy and UDRP Rules (see WIPO Jurisprudential Overview 3.0, paragraph 2.8), according to which resellers, distributors or service providers using a domain name containing a complainant's trade mark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services, and thus have a legitimate interest in such domain name. UDRP Panels have termed this as the "Oki Data test" (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

- The respondent must actually be offering the goods or services at issue;
- The respondent must use the site to sell only the trade marked goods or services;
- **The website must accurately and prominently disclose the registrant's relationship with a trade mark holder** (emphasis added); and
- The respondent must not try to "corner the market" in domain names that reflect the trademark.

The Respondent would fail to meet the Oki Data test, the Examiner being unable to locate any disclaimer regarding the relationship between the Respondent and the Complainant. The Examiner is furthermore unconvinced that, before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services.

In addition, the Examiner is of the view that the choice of a domain name which incorporates a complainant's trade mark wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for such coincidence, could further evidence a lack of rights or legitimate interests in the domain name.

Lastly, there is robust evidence on the available record suggesting that the Respondent has attempted to impersonate the Complainant, as discussed under item 3. below.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and evidence adduced by the Complainant in this URS dispute, the Examiner finds that the Complainant has made a *prima facie* showing of the Respondent's lack of rights or legitimate interests in the disputed domain name under paragraph 1.2.6.2 of the URS Procedure.

3. The disputed domain name was registered and is being used in bad faith

In order to meet the third requirement under the URS Procedure, the Complainant must provide evidence that the disputed domain name was registered and is being used in bad faith. The URS Procedure, in paragraph 1.2.6.3, enumerates non-exhaustive circumstances which would

evidence bad faith registration and use of the disputed domain name by the Respondent, as follows:

- a. Circumstances indicating that the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed 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's out-of-pocket costs directly related to the disputed domain name;
- b. The disputed domain name was registered in order to prevent the trademark holder or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct;
- c. The disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; and
- d. By using the domain name, the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's trade 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.

The Examiner has looked at the overall composite picture of events and finds it, collectively, to be sufficient to give rise to a finding of bad faith registration and use of the disputed domain name by the Respondent, for the following reasons:

- The disputed domain name <pikolinosaustralia.info> wholly incorporates the Complainant's trade mark PIKOLINOS. The addition of the geographical term "Australia" contributes to enhance the confusion, in so far as it may well trigger an inference of association with the Complainant;
- There is no credible explanation for the Respondent's choice of the disputed domain name, which was registered in 2021, bearing in mind that the Complainant has arguably been in operation since as far back as 2010. The Examiner does not view favourably the Respondent's behaviour at all, and finds that the Respondent was likely well aware of the Complainant given the numerous references to the Complainant and, most compellingly, the contents of the Respondent's website (as discussed further below);
- The Respondent has not provided a Response within the time prescribed under the URS Rules, or at all, and has thus failed to offer any explanation or justification of the matters raised by the Complainants in the context of this URS dispute. The Examiner is empowered to draw adverse inferences by such failure (URS Rules paragraph 12);
- There is nothing on the record suggesting that the Respondent is affiliated or otherwise connected with the Complainant, and the Complainant firmly denies any association;
- The Respondent's website appears to commercialise PIKOLINOS products in an unauthorised manner, and absent any disclosure as to the relationship between the Respondent and the Complainant. The Examiner finds that the Respondent has attempted to suggest an affiliation with, or a connection to, or an endorsement of the Complainants or, rather likely, to impersonate the Complainant through the use of the trade mark PIKOLINOS on the Respondent's website. The Respondent's behaviour would therefore fall into the remit of circumstance .d of paragraph 1.2.6.3 of the URS Procedure;



- The Respondent did not provide any evidence of actual or contemplated evidence good faith use of the disputed domain name; and
- Taken the above together, the overall unlikelihood of any good faith use of the disputed domain name.

In view of the above, the Examiner finds that the Complainant has met the requirement under paragraph 1.2.6.3 of the URS Procedure.

4. Abusive Complaint

For the avoidance of doubt, the Examiner finds that the Complaint was not brought by the Complainant abusively nor does the Complaint contain any deliberate material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Complaint and remedy

Complaint: Accepts

Domain Name: PIKOLINOSAUSTRALIA.INFO Suspends for the balance of the registration period

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Gustavo
Surname: Moser
Date: 2021-12-06