



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

URS DISPUTE NO. 76957FEB

Determination DEFAULT

I. PARTIES

Complainants: Alpargatas, S.A. (BR), Alpargatas Europe, S.L.U (ES)
Complainants' authorized representative(s): Padima Team, SLP (ES)

Respondent: Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf (IS)

II. THE DOMAIN NAME, REGISTRY OPERATOR AND REGISTRAR

Domain Name: HAVAISCONTO.ONLINE
Registry Operator: DotOnline, Inc.
Registrar: Namecheap, Inc.

III. PROCEDURAL HISTORY

Complaint submitted: 2021-09-21 11:34
Lock of the domain name(s): 2021-09-21 15:15
Notice of Complaint: 2021-09-21 15:23
Default Date: 2021-10-06 00:00
Notice of Default: 2021-10-06 09:45
Panel Appointed: 2021-10-06 09:52
Default Determination issued: 2021-10-10 18:45

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 Complainants request that the domain name <havaisconto.online> 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 <havaisconto.online> was registered on 19 June 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. Complainants:

Trade mark standing

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

- EU trade mark registration no. 007156128, dated 23 March 2009, for the word mark HAVAIANAS, in class 25 of the Nice Classification;
- EU trade mark registration no. 008664096, dated 23 April 2010, for the word mark HAVAIANAS, in class 25 of the Nice Classification; and
- EU trade mark registration no. 003772431, dated 20 September 2005, for the word mark havaianas, in class 25 of the Nice Classification.

(collectively or individually, *the HAVAIANAS trade mark or the Complainants' trade mark*).

The Complainants' contentions can be summarised as follows:

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

The Complainants assert that the First Complainant is the owner of registered trade marks for HAVAIANAS, whereas the Second Complainant is the licensee and exclusive distributor of HAVAIANAS trade mark in Europe.

The Complainants inform that the company was founded almost 60 years ago, and that it has since become well-known in the clothing and accessories industry worldwide, owing to the well-known HAVAIANAS flip-flops and other clothes and accessories "related to beach environments".

The Complainants aver that the disputed domain name consists of two terms, namely "hawai", which the Complainants argue to evoke, and be identified with, the HAVAIANAS trade mark; and the term "sconto", which has the meaning of "discount" in the Italian language. In the Complainants' view, "sconto" is a non-distinctive word which only indicates that the products offered on the Respondent's website are on sale.

The Complainants also reference the WIPO Panel Views on Selected UDRP Question, Third Edition (*WIPO Jurisprudential Overview 3.0*), paragraph 1.7, to support their claim of confusing similarity under the URS Procedure when comparing disputed domain names and trade marks.

In view of the above, the Complainants conclude that the disputed domain name is confusingly similar to the HAVAIANAS trade mark.

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

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



In order to lend further credence, the Complainants adduce that the Respondent's website appears to manufacture, distribute, export and/or offer HAVAIANAS products. In addition, the Complainants claim to own the images on the Respondent's website, and further argue that the Respondent is attempting to operate a fraudulent and unauthorised online commerce, the result of which being that the Complainants' consumers might be defrauded by the Respondent's website.

The Complainants also allude to the fact that the Respondent's website mirrors identically the website at the domain name <hanvciabatte.online>, which was subject to the MFSD URS dispute no. 58A22572. The domain names in both URS disputes had the same registrar and the Respondents were located in the same country (Iceland). The Complainants are of the view that the Respondents in both URS disputes are possibly the same person.

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

Under this prong, the Complainants aver that the Respondent's purpose is to capitalise on the reputation of the HAVAIANAS trade mark by diverting Internet users seeking HAVAIANAS products to the Respondent's website, for financial gain, by intentionally creating a likelihood of confusion with the HAVAIANAS trade mark 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 state the disputed domain name will make consumers believe that the Respondent's website is an official website of HAVAIANAS. The Complainant therefore conclude 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 <havaisconto.online> was registered on 19 June 2021.

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

The Complainants have, to the satisfaction of the Examiner, adduced proof that that the First Complainant has trade mark rights over the term "Havaianas".

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 work 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 Complainants 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 Complainants' trade mark are to be compared side by side.

Nonetheless, to achieve success under this ground, the Complainants must provide evidence that they have rights in a trade mark, following the Examiner shall assess the degree of similarity between the trade mark and the disputed domain name.

Having consulted the case file, the Examiner is satisfied that the First Complainant owns trade mark rights in the term "HAVAIANAS" dating back to at least 2005, and is mostly known by the footwear HAVAIANAS world-famous for their flip-flops.

The disputed domain name <havaisconto.online> was registered on 19 June 2021, and it is composed of the terms "havai" and "sconto".

The Complainants' trade mark is HAVAIANAS.

The term "havai" is present in the HAVAIANAS trade mark and, in the Examiner's view, represents the most distinguishing identifier of the HAVAIANAS trade mark, particularly as "havai" is identical to the first part of the Complainants' trade mark.

The term "sconto", on the other hand, has the meaning of "discount" in the Italian language.

The Examiner takes the view that the juxtaposition of the terms "havai" and "sconto" in the domain name string is rather immaterial to produce any distinctive character and, therefore, insufficient overall to dispel the visual and phonetic confusion with the HAVAIANAS trade mark.

The Examiner further notes that TLD suffixes are typically disregarded in the assessment of confusing similarity for being part of the anatomy of a domain name (see, for comparative analysis, WIPO Jurisprudential Overview 3.0, paragraph 1.11).

In the present dispute, however, the TLD suffix ".online" may actually enhance the confusion with the HAVAIANAS trade mark. This is because, taken together and side by side, the terms "havai",



“sconto” and “online” may cause Internet users to assume that the disputed domain name effectively operates a website on which HAVAIANAS products are commercialised on sale.

Accordingly, the Examiner finds that the disputed domain name is confusingly similar to the Complainants’ trade mark, the result of which being that the Complainants have succeed under the 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 Complainants 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 Complainants claim not to have authorised the Respondent to reproduce the Complainants’ official images on the Respondent’s website nor to register the disputed domain name, let alone to commercialise any of the Complainants’ 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 Complainants. There is no contractual arrangement between the parties to that effect, nor has the Complainants otherwise authorised the Respondent to make any use of the Complainants’ 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 Complainants (and, in any event, any affiliation or endorsement has been denied by the Complainants).

On this particular point, the Examiner alludes to the jurisprudential view formed by domain name disputes under the UDRP Policy and UDRP Rules (see WIPO Jurisprudential Overview 3.0, paragraph 2.8), according to which resellers and distributors using a domain name containing a complainant’s trade mark to undertake sales 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 Complainants. 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 or nearly 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.

Lastly, there is evidence on the available record suggesting that the Respondent has attempted to impersonate the Complainants, 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 Complainants in this URS dispute, the Examiner finds that the Complainants have 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 Complainants 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 domain name was registered or acquired 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's out-of-pocket costs directly related to the domain name;
- b. The 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 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 web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location.

The Examiner has considered the evidence put forward by the Complainants, which the Examiner deems sufficient to rule on the bad faith element.

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 <havaisconto.online> incorporates the most distinctive part of the Complainants' trade mark HAVAIANAS. The presence of the term "sconto" is insufficient



to dispel the visual and phonetic confusion established between the disputed domain name and the Complainants' trade mark HAVAIANAS;

- 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 Complainants have arguably been in operation since as far back as 2005. The Examiner does not look favourably upon the Respondent, and finds it that the Respondent was well aware of the Complainants given the specific references to the Complainants and, most compellingly, the use on 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 to 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 Complainants and the Complainants deny any association;
- The Respondent's website appears to commercialise HAVAINAS products in an unauthorised manner, and absent any disclosure as to the relationship between the Respondent and the Complainants. 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 Complainants through the use of the HAVAIANAS trade mark on the Respondent's website. The Respondent's behaviour would consequently fall in the realm 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 Complainants have 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 Complainants 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: HAVAISCONTO.ONLINE Suspends for the balance of the registration period.

C. Abuse of proceedings

Finding of abuse of proceedings: No such finding

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Gustavo

Surname: Moser

Date: 2021-10-10