



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

URS DISPUTE NO. A6416947

Determination DEFAULT

I. PARTIES

Complainant: MOLICOPI, S.L. (Spain)

Complainant's authorized representatives: PADIMA TEAM SLP, Maria Cristina Martinez-Tercero (Spain)

Respondent: WhoisGuard Protected - WhoisGuard, Inc. (Panama)

II. THE DOMAIN NAMES, REGISTRY OPERATOR AND REGISTRAR

Domain Names: PIKOLINOSTIENDA.ONLINE, PIKOLINOSVENTA.ONLINE,
PIKOLINOSZAPATO.ONLINE

Registry Operator: DotOnline Inc.

Registrar: Namecheap, Inc.

III. PROCEDURAL HISTORY

Complaint submitted: 2018-10-22 13:14

Lock of the domain names: 2018-10-22 16:47

Notice of Complaint: 2018-10-22 21:29

Default Date: 2018-11-06 00:01

Default Notice: 2018-11-06 10:58

Panel appointed: 2018-11-06 14:58

IV. EXAMINER

Examiner's Name: Reyes Campello Estebanz

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

V. RELIEF SOUGHT

The Complainant requests that the domain names 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

A. Complainant:

The Complainant says it owns various trademarks for the word “PIKOLINOS” which are used for manufacturing and commercializing shoes, bags and other accessories, as well as other goods and services, its trademark is protected in Spain, the European Union as well as in other jurisdictions, and it is currently in use.

The Complainant alleges the Complaint relates to the three domain names in dispute because they are connected, belonging to the same holder (although its identity is hidden due to Data Protection and Privacy rules) located in Panama, and have the same Registrant.

The Complainant further asserts the disputed domain names identify fraud Websites that reproduce without consent its trademark PIKOLINOS and illegally use Complainant’s photographs of its products. The Websites resolving from the disputes domain names are using the Complainant’s brand to distribute, export and/or offer PIKOLINOS shoes, bags and other accessories to Spain and in other countries, and the Complainant owns the photographs that appear on these Websites. These Websites try to appear as legal ecommerce sites, but the Complainant has not authorized either the disputed domain names or the content of these sites.

The Complainant contends that all this together with the unauthorized use of its trademark or confusedly variations of it, the offer of PIKOLINOS products and the use of photographs owned by the Complainant, is a clear infringement of its trademark rights, an abuse of the use of the disputed domain names and a fraud to the consumers.

B. Respondent:

Respondent did not submit a Response.

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 absence of a Response, the language of the Determination shall be English.

D. Findings of fact:

The Complainant is a Spanish limited liability company mainly operating in manufacturing, marketing and selling shoes, bags and other accessories, branded in Spain and internationally under the trademark PIKOLINOS. It owns various trademarks containing or consisting of the word “pikolinos” in Spain, the European Union and other jurisdictions, of which are sufficiently representative for the present proceeding:

- Spanish Trademark No. 3086158 PIKOLINOS, registered November 19, 2013, in classes 18, 25 and 35;



- Spanish Trademark No. 2833665 PIKOLINOS, figurative, registered February 12, 2009, in classes 3, 9, 10, 14, 16, 18, 25, 26, 27, 35, 39, 40 and 42;

- European Union Trademark No. 009426776 PIKOLINOS, figurative, registered March 9, 2012, in classes 3, 9, 10, 14, 16, 18, 25, 26, 35 and 39;

The Complainant also owns several domain names comprising or incorporating its trademark PIKOLINOS, of which is sufficiently representative for the present proceeding <pikolinos.com>, registered on October 23, 1998, which resolves to its corporate Website, used to promote and offer its products.

The disputed domain name <pikolinostienda.online> was registered on October 22, 2018, the disputed domain name <pikolinoszapato.online> was registered on October 9, 2018, and the disputed domain name <pikolinosventa.online> was registered on September 28, 2018. All these three domain names in dispute are linked to Websites provided in Spanish, with identical content and appearance, which offer PIKOLINOS branded shoes, bags and accessories, and show the Complainant's figurative trademark on the top left heading.

E. Reasoning:

For the Complainant to succeed, the Complainant must establish that each of the three conditions under the URS Procedure 1.2.6 are satisfied:

1. The registered domain name is identical or confusingly similar to a word or mark for which the Complainant holds a valid national or regional registration and that is in current use;
2. Registrant has no legitimate right or interest to the domain name;
3. The domain name was registered or is being used in bad faith.

Even though the Respondent has defaulted, URS Procedure 1.2.6 requires Complainant to make a *prima facie* case, proven by clear and convincing evidence, for each of the above-mentioned three elements to obtain an order that a domain name should be suspended.

The Examiner has made this Determination in accordance with the URS Procedure, URS Rules and any rules and principles of law that she deems applicable, taking into consideration all of the evidence, annexed material and submissions provided by the Parties.

1. The domain names are identical or confusingly similar to a word mark

The Complainant is the owner of several registered trademarks PIKOLINOS as mentioned above, in particular a word mark registration for "pikolinos", which appears to be currently in use, as per the record.

The Complainant's trademark PIKOLINOS is incorporated in its entirety in the disputed domain names, adding, respectively, the words "tienda", "zapato" and "venta" in Spanish, which are equivalent to the words "shop", "shoe" and "sale" in English. As these additional

words are descriptive to the goods branded under the Complainant's trademark or to the activity of selling, they do not add in this case any distinctive characteristic that would dispel a finding of confusingly similarity between the trademark PIKOLINOS and the disputed domain names.

It is widely established that the addition of the gTLD to a domain name does not generally avoid confusing similarity since the use of a TLD is only a technical requirement. Therefore, in this case, the addition of the gTLD ".online" to the disputed domain names does not add any distinctive characteristic.

The Complainant's trademark is clear and easily recognizable in the disputed domain names. Therefore, the Examiner finds that the disputed domain names are confusingly similar to the trademark PIKOLINOS.

Based on the above and the evidence on record, the Examiner finds that the first requirement set forth under Paragraph 1.2.6 (i) of the URS Procedure has been satisfied.

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

The Complainant provided evidence showing that it is the owner of the trademark PIKOLINOS, that it did not authorized the Respondent to use its trademark, and that there is no business relationship between the Parties. Furthermore, there is no evidence on record showing that the Respondent owns an identical trademark or it is commonly known by the word "pikolinos".

Since the Respondent provided no response to the Complaint, it has failed to justify any rights or legitimate interests in the disputed domain names producing evidence to rebut the Complainant's *prima facie* case.

Based on the above, the Examiner finds that the Complainant has met its burden pursuant to the second requirement set forth under Paragraph 1.2.6 (ii) of the URS Procedure.

3. The domain names were registered and are being used in bad faith

At the time of the disputed domain names' registration, the Examiner considers unlikely that the Respondent did not know about the PIKOLINOS trademark and did not have it in mind. Several factors in this case lead to this conclusion, namely i) the extensive presence of PIKOLINOS products over the Internet, verified by the Examiner, ii) the inherent distinctive character of this trademark not having any meaning in Spanish (language used by the Respondent in its Websites), and iii) its identical reproduction in the disputed domain names adding descriptive terms to the Complainant's goods or selling activity.

As per the evidence on record and looking at the broader context of the case, namely, the content of the Websites, it is further apparent that the Respondent must have known of the Complainant and its trademark, acting in bad faith when registering and using the disputed domain names.

This Conclusion is corroborated by the disputed domain names' immediate use after its registration identifying PIKOLINOS products' online stores, which contain the Complainant's trademark in a prominent position. The evidence on record indicates that the disputed domain names resolve to Websites that contain the Complainant's trademark in their top left heading, with identical figurative representation as the one used and registered by the



Complainant. These Websites reproduce as well photographs, other figurative elements and the general appearance of the Complainant's official Website, including the circumstance of providing the same products as the Complainant with no indication about the absence of relationship with it. These circumstances, in particular the use of official PIKOLINOS marketing material and photographs in the Respondent's Websites, and the absence of any reference in these Websites to its real owner, lead the Examiner to conclude that the disputed domain names were registered and are being used in bad faith.

In addition, the Examiner notes that the nature of the disputed domain names (incorporating the Complainant's mark plus descriptive terms related to PIKOLINOS goods or online selling activity) could cause confusion suggesting sponsorship, endorsement, affiliation or association with the Complainant and its trademark. Therefore, the Examiner considers highly probable the disputed domain names were registered and used with the intention of creating a likelihood of confusion as to the affiliation or association with the Complainant and its trademark, giving the impression of being Complainant's products' official dealers, misleadingly attracting Internet users to the Respondent's Websites, and disrupting the Complainant's business.

The case circumstances indicate that the Respondent has intentionally attempted to deceive consumers, attracting for commercial gain Internet users to its Websites by creating a likelihood of confusion with the Complainant's mark. These conduct is considered by the URS as a clear demonstration of bad faith registration and use, under Paragraph 1.2.6.3 (d) of the URS Procedure.

Further, by registering the disputed domain names the Respondent has prevented the Complainant from reflecting its trademark in the corresponding domain names, which may constitute a pattern of bad faith conduct considering the disputed domain names number (three), and this conduct disrupts the Complainant's business with whom the Respondent competes in selling the same goods. Therefore, the Examiner considers these circumstances a clear bad faith registration and use indication, as described under Paragraph 1.2.6.3 (b) and (c).

Other cumulative circumstances of this case may indicate the Respondent is acting in bad faith, in particular its absence of response not providing any evidence of actual or contemplated good faith use.

Based on all the above, the Examiner finds that the disputed domain names were registered and have been used in bad faith to attract for commercial gain, and that the Complainant has complied with the third requirement set forth under Paragraph 1.2.6 (ii) of the URS Procedure.

4. Abusive Complaint

The Examiner finds that the Complaint is not abusive and it did not contain deliberate material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Complaint and remedy

Complaint: Accepts

Domain Names: PIKOLINOSTIENDA.ONLINE Suspends for the balance of the registration period; PIKOLINOSVENTA.ONLINE Suspends for the balance of the registration period; PIKOLINOSZAPATO.ONLINE 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: Reyes

Surname: Campello Estebarez

Date: 9 November 2018