



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

URS DISPUTE NO. BE291CB8

Determination DEFAULT

I. PARTIES

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

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

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

Domain Name(s): HAVAIANASFR.SHOP
Registry Operator: GMO Registry, Inc.
Registrar: Namecheap, Inc.

III. PROCEDURAL HISTORY

Complaint submitted: 2021-08-18 11:07
Lock of the domain name(s): 2021-08-19 10:06
Notice of Complaint: 2021-08-19 12:27
Default Date: 2021-09-03 00:00
Notice of Default: 2021-09-03 10:10
Panel Appointed: 2021-09-03 12:30
Default Determination issued: 2021-09-07 10:47

IV. EXAMINER

Examiner's Name: Igor Motsnyi

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 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

A. Complainants:

The Complainants are:

- the Brazilian company ALPALGARTAS, SA, the owner of various EU “HAVAIANAS” trademarks (“the First Complainant”) and
 - the Spanish company ALPARGATAS EUROPE, S.L.U, the exclusive licensee of the “HAVAIANAS” trademarks (“the Second Complainant”).
1. The Complainants are the owner and the exclusive licensee of the following “HAVAIANAS” trademarks:
 - the European Union Trademark Registration no. 7156128 “HAVAIANAS” (word) registered on March 23, 2009, in class 25;
 - the European Union Trademark Registration no. 8664096 “HAVAIANAS” (device) registered on April 23, 2010, in class 25 and
 - the European Union Trademark Registration no. 3772431 “HAVAIANAS” (device) registered on September 20, 2005, in class 25.

The Complainants state that their trademarks are renowned all over the world, not only thanks to the well-known “HAVAIANAS” flip-flops, but also for the use of the trademarks to distinguish clothes and accessories related to summer or beach environments.

The disputed domain name was registered on August 13, 2021. The Complainants allege that the website by the disputed domain name is a fraud web page that reproduces the First Complainant’s trademarks and the Respondent uses the brand "HAVAIANAS" to manufacture, distribute, export and/or offer “HAVAIANAS” products. The photographs that appear on this website are owned by the Complainants.

2. The Complainants have not authorized the Respondent to use the "HAVAIANAS" trademarks for the activities described above.
3. The Complainants claim that the consumers wrongly believe that the website by the disputed domain name is an official “HAVAIANAS” website and, therefore, it is fraud. The offer of “HAVAIANAS” products and the use of photographs and trademark logo owned by the first Complainant is a clear infringement of its trademarks, an abuse of the use of the disputed domain name, a fraud of the consumers and shows bad faith of the Respondent. The Complainants contend that the Respondent's purpose is to capitalize on the reputation of their trademarks by diverting Internet users seeking “HAVAIANAS” products to his website for financial gain, by intentionally creating a likelihood of confusion with the Complainants' trademarks as to the source, sponsorship, affiliation, or endorsement of its website and/or the goods offered or promoted through said website.

B. Respondent:

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

The Examiner notes that under par. 1.1.3 of the URS “one Complaint is acceptable for multiple related companies against one Registrant, but only if the companies complaining are related”. Complainants in the present dispute are related (the First Complainant is the owner of trademarks and the Second Complainant is the exclusive licensee of the trademarks), so the Complaint submitted by two Complainants is acceptable.

C. Findings of fact:

The disputed domain name was registered on August 13, 2021. The disputed domain name resolves to a website in French language where various “HAVAIANAS” products are marketed and appear to be offered for sale.

The First Complainant has demonstrated that it is the owner of the “HAVAIANAS” EU trademarks cited above. The EU trademark no. 7156128 is the word mark and the two other trademarks contain the word element “HAVAIANAS”. The Complainants have provided evidence that the marks are in use by providing pictures from the official website of the Complainants where the marks are depicted. The Second Complainant is the exclusive licensee of the “HAVAIANAS” EU trademarks.

E. Reasoning:

1. The domain name(s) is(are) identical or confusingly similar to a word mark

The First Complainant is the owner of both a word mark and combined marks with both device and word elements. As noted by other Examiners *"the use of the words "word mark" in URS 1.2.6.1 does not specifically exclude trademarks which are combined of a word element and a graphical element, provided the word element is clear, and sufficiently distinct and separate from the graphical element...As is also acceptable under the UDRP body of law, and without derogating from the URS goals, the word element in the trademark should not have been disclaimed leaving the design element the only element having the source of distinctiveness"* (see URS appeal determination, Forum case FA1604001672049 where this question was analyzed in detail and MFSD URS DISPUTE No. 369B0FE1).

In the combined marks the "HAVAIANAS" word is a dominant element. Therefore, the Examiner finds that all three (3) trademarks relied on by the Complainants in this dispute shall be taken into account. The Complaints have also provided evidence of use of the trademarks. Therefore, the Examiner finds that the Complainants have trademark rights for the purpose of URS.

As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) *“where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”* (see par. 1.8).

The disputed domain name fully incorporates the "HAVAIANAS" mark with the addition of the "fr" element that can be seen as a geographic term referring to France. The trademarks are clearly recognizable in the disputed domain name. The "shop" gTLD shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name. It actually adds more to the confusion referring to an online place of sale of the products of the Complainants.

Therefore, the Examiner finds that the requirements set forth under Paragraph 1.2.6.1. of the URS Procedure have been satisfied.

2. Respondent has no rights or legitimate interests to the domain name(s)

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests; and once such prima facie case is made, the burden shifts to the Respondent who has to demonstrate his rights or legitimate interests.

The Complainants in this dispute have made a prima facie case and the Respondent failed to respond and explain any rights or interests in respect of the disputed domain name. The disputed domain name is used for a website that markets, promotes and offers for sale various Complainants' products under the "HAVAIANAS" marks. It also contains pictures of the products and prices. It appears to be an online shop targeting French speaking consumers.

It is unclear whether the products offered via the website by the disputed domain name are genuine or fake. The Respondent could potentially have been a reseller (even unauthorized one) of the Complainants' products and even unauthorized resellers can have rights or legitimate interests in the domain name under the "Oki data" test (see Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903 and par. 2.8.1 of the WIPO Overview 3.0). However, this is not the case here as the Respondent did not meet the requirements of the "Oki data" test by failing to "accurately and prominently disclose the registrant's relationship with the trademark holder". There is no information on the Respondent's website about the relationship with the Complainants. Moreover, there is a copyright notice as follows: "© 2021 Havaianas. Tous droits réservés" ("All rights reserved"). This notice only increases confusion and creates an impression that this website is approved by the Complainants and is affiliated with the First or the Second Complainant.

Based on the above, the Examiner finds that the Respondent lacks any rights or legitimate interests with respect to the disputed domain name as per the requirements set forth under Paragraph 1.2.6.2. of the URS Procedure.

3. The domain name(s) was(were) registered and is(are) being used in bad faith

The disputed domain name is used for an online shop promoting and offering products under the Complainants' trademarks.

The website by the disputed domain name also contains images from the Complainants' website, description of products and a copyright notice alleging connection and/or affiliation with the Complainants.

It appears that the Respondent attempts to impersonate the Complainants and their business by using the disputed domain name fully incorporating the trademarks of the First Complainant.

The trademarks of the First Complainant had been registered long before the registration of the disputed domain name.



Based on the arguments and evidence submitted by the Complainants, the Examiner finds that the Respondent has indeed intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the trademark “HAVAIANAS” as to the source, sponsorship, affiliation or endorsement of its website (see e.g. URS dispute No. 3B7F4FC3 and URS dispute NO. F306BC2E: “the Respondent, in having redirected Internet users to online stores depicting the Complainants’ trademarks and products and not disclosing the lack of relationship with the Complainants clearly confirms that he must be aware of the Complainants and the well-known HAVAIANAS trademark and products”).

The Examiner finds that the requirements set forth under Paragraph 1.2.6.3. of the URS Procedure have been satisfied by the Complainants.

4. Abusive Complaint

The Examiner finds that the Complaint was neither abusive nor contained material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Complaint and remedy

Complaint: Accepts

Domain Name(s): HAVAIANASFR.SHOP 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: Igor

Surname: Motsnyi

Date: 2021-09-07