

ADMINISTRATIVE PANEL DECISION

Hoboken Inversiones, S.L. v. Client Care, Web Commerce Communications Limited, and Joseph Graham
Case No. D2023-0286

1. The Parties

Complainant is Hoboken Inversiones, S.L., Spain, represented by PADIMA TEAM SLP, Spain.

Respondents are Client Care, Web Commerce Communications Limited, Malaysia, and Joseph Graham, United States of America.

2. The Domain Names and Registrar

The disputed domain names, <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <wondersshoesstockists.com>, <wonderszapatasmujer.com>, <zapatoswondersoutlet.com>, <wonder-shoesau.com>, <wondersbootsireland.com>, and <wondersshoesusa.com> (“Domain Names”), 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 January 23, 2023 in relation to eight disputed domain names <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <wondersshoesstockists.com>, <wonderszapatasmujer.com>, and <zapatoswondersoutlet.com>. On January 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the abovementioned eight disputed domain names. On January 28 and January 31, 2023, the Registrar transmitted by email to the Center its verification responses disclosing registrant and contact information for the abovementioned eight disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on January 31, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 3, 2023.

On February 6, 2023, Complainant submitted by email its request to add the domain name <wonder-shoesau.com> (“Additional Domain Name 1”) to the proceeding. On February 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Additional

Domain Name 1. On February 7, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Additional Domain Name 1 which is the same for seven of the eight disputed domain names (*i.e.*, <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <wondersshoesstockists.com>, and <zapatoswondersoutlet.com>). On February 7, 2023, the Center sent an email communication to Complainant providing the registrant and contact information disclosed by the Registrar in relation to the Additional Domain Name 1. Complainant filed the second amended Complaint on February 7, 2023 incorporating the registrant information for the Additional Domain Name 1.

The Center verified that the Complaint together with the two amended Complaints 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 Respondents of the Complaint, and the proceedings commenced on February 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. Respondents did not submit any response. Accordingly, the Center notified Respondents’ default on March 1, 2023.

On February 15, 2023, Complainant submitted by email its request to add another domain name <wondersbootsireland.com> (“Additional Domain Name 2”) to the proceeding.

The Center appointed Marina Perraki as the sole panelist in this matter on March 7, 2023. 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.

On March 13, 2023, Complainant submitted by email its request to add another domain name <wondersshoesusa.com> (“Additional Domain Name 3”) to the proceeding.

On March 21, 2023, the Center at the Panel’s instruction transmitted by email to the Registrar a request for registrar verification in connection with the Additional Domain Names 2 and 3. On March 23, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Additional Domain Names 2 and 3 which is the same as that for the other disputed domain names, except for the disputed domain name <wonderszapatosmujer.com>.

On March 24, 2023, the Center issued at the Panel’s instruction the Procedural Order No.1 to the Parties, requesting Complainant to further amended its Complaint to incorporate the Additional Domain Names 2 and 3, and inviting Respondents to comment on Complainant’s submission. On March 24, 2023, Complainant filed an amended Complaint incorporating the Additional Domain Names 2 and 3. Respondents did not submit any response.

4. Procedural Issues:

A. Addition of Domain Names

According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.12.2, “Requests for addition of domain names to a complaint after it has been notified to the respondent and the proceedings have formally commenced would be addressed by the panel on appointment”.

On February 15 and March 13, 2023, respectively, Complainant submitted by email its request to add the Additional Domain Name 2, <wondersbootsireland.com>, and the Additional Domain Name 3, <wondersshoesusa.com>, to the proceeding. Per Complainant and as confirmed by the Panel’s own

research¹, the Additional Domain Names 2 and 3 a) lead to the same website as the initial Domain Names, b) were registered on the same day as the disputed domain names <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <zapatoswondersoutlet.com> and <wondersbootsireland.com>, namely September 20, 2022, and c) share the same Registrar as all the other disputed domain names.

In view of the above, the Panel finds that the proposed Additional Domain Names 2 and 3 are *prima facie* registered by the same or related Respondent and it would be practical and efficient to address them in the present proceeding. The request for addition of the Additional Domain Names 2 and 3 is therefore accepted.

Per the Registrar's verification response regarding the Additional Domain Names 2 and 3, it was confirmed that they were registered by the same Respondent who is the registrant for ten of the 11 disputed domain names <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <wondersshoesstockists.com>, <zapatoswondersoutlet.com>, <wonder-shoesau.com>, <wondersbootsireland.com>, and <wondersshoesusa.com>.

Therefore, the Panel accepts Complainant's request to add the Additional Domain Names 2 and 3 to the proceeding and would address the Domain Names all together in this Decision.

B. Consolidation of Respondents

The Panel has considered the possible consolidation of the Complaint for the Domain Names at issue. According to [WIPO Overview 3.0](#), section 4.11.2, "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario".

The Domain Names <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <wondersshoesstockists.com>, <zapatoswondersoutlet.com>, <wonder-shoesau.com>, <wondersbootsireland.com> and <wondersshoesusa.com> share the same Respondent (Client Care, Web Commerce Communications Limited), while <wonderszapatosmujer.com> is registered in the name of a different Respondent (Joseph Graham).

The Panel notes the following features of the Domain Name <wonderszapatosmujer.com> and the other Domain Names and arguments submitted by Complainant in favor of the consolidation:

- they all share the same pattern, namely incorporating fully Complainant's brand WONDERS (singular in the case of the Domain Name <wonder-shoesau.com>) plus other words;
- they all lead at least at the time of filing of the Complaint to the same websites;
- they all have the same Registrar; and
- the Domain Names <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <zapatoswondersoutlet.com>, <wondersbootsireland.com>, and <wondersshoesusa.com> were registered on the same day, namely September 20, 2022, while the Domain Name <wondersshoesstockists.com> was registered three days thereafter, and the Domain Names

¹ Noting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8.

<wonderszapatasmujer.com> and <wonder-shoesau.com> were registered within less than two months thereafter.

Considering all the above, the Panel also notes that the contact details including the postal addresses for both Respondents are apparently fake, and thus finds that, as Complainant has argued, there appears *prima facie* to be one single Respondent, providing possibly fake contact details, or at least both Respondents are under the common control. Furthermore, named Respondents did not submit any arguments to rebut this inference.

The Panel finds that consolidation is fair to both Parties, and Respondents have been given an opportunity to object to consolidation through the submission of pleadings to the Complaint (if indeed there are more than one Respondent) but have chosen not to respond (see [WIPO Overview 3.0](#), section 4.11.2; *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#)). Based on the file, the Panel finds that it is more likely than not that the Domain Names are in common control of one entity, and hence the Panel grants the consolidation (and will refer to these Respondents as “Respondent”).

5. Factual Background

Complainant offers its goods under the WONDERS trademark through its official webpage “www.wonders.com”.

Complainant is the owner of trademark registrations for WONDERS including:

- the European Union Trademark Registration no. 017923926, WONDERS (word), filed on June 26, 2018, and registered on November 3, 2018, for goods and services in international classes 18, 25, and 35; and
- the European Union Trademark Registration no. 017923377, WONDERS (figurative), filed on June 26, 2018, and registered on November 22, 2018, for goods and services in international classes 18, 25, and 35.

The Domain Names <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <zapatoswondersoutlet.com>, <wondersshoesusa.com>, and <wondersbootsireland.com> were registered on September 20, 2022, the Domain Name <wondersshoesstockists.com> was registered on September 23, 2022, the Domain Name <wonder-shoesau.com> was registered on November 9, 2022, and the Domain Name <wonderszapatasmujer.com> was registered on November 11, 2022.

The Domain Names <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <zapatoswondersoutlet.com>, <wondersshoesstockists.com>, <wondersshoesusa.com>, and <wondersbootsireland.com> lead to the same website prominently displaying Complainant’s WONDERS trademark and showing screenshots of Complainant’s official webpage (the “Websites”). The Domain Names <wonderszapatasmujer.com> and <wonder-shoesau.com> led, per Complaint, at the time of filing of the Complaint to a website similar to the Websites and currently lead to inactive pages showing an error and “access denied” message.

6. Parties’ Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a cancellation of the Domain Names.

B. Respondent

Respondent did not reply to Complainant's contentions.

7. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements, which Complainant must satisfy with respect to the Domain Names:

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

A. Identical or Confusingly Similar

The Domain Names incorporate Complainant's WONDERS trademark in its entirety. This is sufficient to establish confusing similarity (*Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#)). The omission of the letter "s" from the WONDERS trademark in the Domain Name <wonder-shoesau.com> does not prevent a finding of confusing similarity ([WIPO Overview 3.0](#), section 1.9).

The additional words "scarpe" ("shoes" in Italian), "zapatos" ("shoes" in Spanish), "mujer" ("woman" in Spanish), "outlet", "shoes", "sale", "stockists", "boots", and/or country names such as "ireland", "canada", and "australia", or abbreviations thereof such as "au" and "usa", as the case may be, do not avoid a finding of confusing similarity ([WIPO Overview 3.0](#), section 1.8).

The Panel also notes the content of the Websites, which reproduce or at some point reproduced Complainant's trademark and website product photographs. [WIPO Overview 3.0](#), section 1.15.

The generic Top-Level Domain ("gTLD") ".com" is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Names are confusingly similar to Complainant's trademark.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Names, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the Domain Names or a name corresponding to the Domain Names in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Names, even if Respondent has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Names.

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Names. As per Complainant, Respondent was not authorized to register the Domain Names.

Respondent has not demonstrated any preparations to use, or has not used the Domain Names or a trademark corresponding to the Domain Names in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Names were used to host the Websites to impersonate Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the Websites originate from Complainant. Such use demonstrates neither a *bona fide* offering of goods nor a legitimate interest of Respondent (*Arkema France v. Aaron Blaine*, WIPO Case No. [D2015-0502](#)).

A distributor or reseller can be making a *bona fide* offering of goods and thus have rights or legitimate interests in a domain name only if the following cumulative requirements are met (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), section 2.8.1: (i) respondent must actually be offering the goods at issue; (ii) respondent must use the site to sell only the trademarked goods; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) respondent must not try to "corner the market" in domain names that reflect the trademark.)

These requirements are not fulfilled in the present case.

The Domain Names all falsely suggest that the Websites are official sites of Complainant or of an entity affiliated to or endorsed by Complainant. The Websites extensively reproduce, without authorization by Complainant, Complainant's trademarks and product photos without any disclaimer of association (or lack thereof) with Complainant.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Names.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Names in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Domain Names registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Names; or
- (ii) that Respondent has registered the Domain Names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Names primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of

confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Names in bad faith.

Because Complainant's mark had been used and registered by Complainant before the Domain Names registrations, and noting the content of the corresponding websites, it is clear that Respondent had Complainant's mark in mind when registering the Domain Names (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

Furthermore, the content of the Websites gives the impression that they originate from Complainant, prominently displaying Complainant's trademarks and product photographs on the Websites, thereby giving the false impression that the Websites emanate from or are endorsed by Complainant. This further supports registration in bad faith reinforcing the likelihood of confusion, as Internet users are likely to consider the Domain Names as in some way endorsed by or connected with Complainant ([WIPO Overview 3.0](#), section 3.1.4).

The Domain Names incorporate entirely Complainant's trademark (or a misspelt version thereof) plus additional words most of which concern "shoes" in different languages. This further indicates that Respondent knew of Complainant and chose the Domain Names with knowledge of Complainant and its industry (*Safepay Malta Limited v. ICS Inc.*, WIPO Case No. [D2015-0403](#)).

As regards bad faith use, Complainant demonstrated that the Domain Names are employed to host the Websites which appear falsely to be those of or endorsed by Complainant.

Furthermore, the Domain Names have been operated by intentionally creating a likelihood of confusion with Complainant's trademark and business. This further supports the finding of bad faith use (*Arkema France v. Aaron Blaine, supra*; *Aktiebolaget Electrolux v. Priscilla Quaiotti Passos*, WIPO Case No. [D2011-0388](#); and [WIPO Overview 3.0](#), sections 3.1.4 and 3.2.1).

The Panel notes that some of the Domain Names currently lead to inactive websites. The non-use of a domain name does not prevent a finding of bad faith under the circumstances of this proceeding (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Under these circumstances and on this record, the Panel finds that Respondent registered and is using the Domain Names in bad faith.

Complainant has established Policy, paragraph 4(a)(iii).

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names, <scarpewondersoutlet.com>, <wondersshoescanada.com>, <wondersshoesireland.com>, <wondersshoesoutlet.com>, <wondersshoessaleaustralia.com>, <wondersshoesstockists.com>, <wonderszapatasmujer.com>, <zapatoswondersoutlet.com>, <wonder-shoesau.com>, <wondersbootsireland.com>, and <wondersshoesusa.com>, be cancelled.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: April 13, 2023