

## **ADMINISTRATIVE PANEL DECISION**

**Aku Italia S.R.L. v. Christin Dietrich, Client Care, Web Commerce Communications Limited, Leah Probst, Jonas Glockner**  
Case No. D2023-1482

### **1. The Parties**

The Complainant is Aku Italia S.R.L., Italy, represented by Modiano & Partners, Italy.

The Respondents are Christin Dietrich, Germany, Client Care, Web Commerce Communications Limited, Malaysia, Leah Probst, Germany, and Jonas Glockner, Germany.

### **2. The Domain Names and Registrar**

The disputed domain names <akuaustralia.com>, <akubakancs.com>, <akubootsaustralia.com>, <akubootsuk.com>, <akubotturkiye.com>, <akuespana.com>, <akugreece.com>, <akuitalia.com>, <akujapan.com>, <akuoutlets.com>, <akuromania.com>, <akuschoenen.com>, <akuschuhedeutschland.com>, and <chaussuresakusoldes.com> 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 April 5, 2023. On April 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registrants N/A) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 12, 2023 providing the registrants and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 13, 2023.

The Center verified that the Complaint together with the amended Complaint 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 the Respondents of the Complaint, and the proceedings commenced on April 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 7, 2023. The Respondents did not submit any response. Accordingly,

the Center notified the Respondents' default on May 8, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on May 30, 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.

#### 4. Factual Background

The Complainant is a company incorporated on March 3, 2009 under the laws of Italy, exploiting the footwear industry, particularly trekking shoes. Counting with three production plants in Europe, the Complainant's products are exported to over 50 countries.

The Complainant holds, amongst others, the domain names <aku.it> (registered on January 4, 1999), <akutactical.com> (registered on August 9, 2017), and <akuoutdoor.com> (registered on February 12, 2019) incorporating the AKU trademark subject of following, amongst others, trademark registrations:

- Italian trademark registration No. 598540 for the word mark AKU, registered on May 26, 1993, subsequently renewed, in classes 25 and 28;
- United Kingdom trademark registration No. UK00002039183 for the word mark AKU, filed on September 28, 1995, registered on November 8, 1996, subsequently renewed, in classes 25 and 28; and
- International trademark registration No. 838137 for the word mark AKU, registered on November 3, 2004, subsequently renewed, in classes 25 and 28.

The disputed domain names were registered on and are presently used in connection with:

Disputed Domain Name	Registration Date	Present Use
<akuaustralia.com>	January 11, 2023	No active webpage.
<akubakancs.com>	September 18, 2021	No active webpage.
<akubootsaustralia.com>	September 16, 2021	No active webpage.
<akubootsuk.com>	September 15, 2021	Online shop displaying the Complainant's products and logo.
<akubotturkiye.com>	September 22, 2021	No active webpage.
<akuespana.com>	September 17, 2021	No active webpage.
<akugreece.com>	September 18, 2021	No active webpage.
<akuitalia.com>	January 11, 2023	No active webpage.
<akujapan.com>	January 12, 2023	No active webpage.
<akuoutlets.com>	February 11, 2023	Online shop displaying the Complainant's products and logo.
<akuromania.com>	September 22, 2021	Online shop displaying the Complainant's products and logo.
<akuschoenen.com>	September 17, 2021	No active webpage.
<akuschuhedeutschland.com>	January 11, 2023	No active webpage.
<chaussuresakusoldes.com>	September 17, 2021	No active webpage.

## 5. Parties' Contentions

### A. Complainant

The Complainant asserts to be the successor of AKU SRL which registered the AKU trademark in 1990, having the AKU trademark been transferred to the Complainant in 2009, when then the Complainant started using it. As a consequence, the AKU trademark has been used since 1983 and became well known, having achieved substantial goodwill and repute.

The Complainant asserts to be a leading company in the field of footwear, particularly trekking shoes, having become a benchmark in that industry, producing 280,000 pairs of shoes (on the year 2021), 70% of which are exported to over 50 countries around the world including Europe, North America, Asia and Australia (Annex 5a to the Complaint). The Complainant further asserts to be the official supplier of the Danish Army, the United Kingdom Army and the Swiss Army, amongst other international special forces units.

The Complainant submits that the disputed domain names are subject to common control by either the same person or connected parties and for reasons of fairness, equity and efficiency, the Complainant requests consolidation of the multiple Respondents to the same Complaint, given that: i. all of the disputed domain names share a similar naming pattern (*i.e.* all contain in its entirety the AKU trademark, mostly combined with geographic identifiers such as "UK" (United Kingdom), "Australia", "Espana" (Spain), "Greece", "Turkiye" (Türkiye), "Romania", "Italia", "Deutschland" (Germany), "Japan", and generic terms related to the Complainant's business: "boot/boots", "chaussures" (shoes in French), "bakancs" (boots in Hungarian), "shoenen" (shoes in Dutch), "shuhe" (shoes in German), "bot" (boots in Turkish), "outlets" and "soldes" (sales in French); ii. all of the disputed domain names are registered with the same Registrar; iii. the disputed domain names are either not reachable or linked to websites presenting a number of the Complainant's copyright-protected official product images and marketing materials, and offering purported AKU goods for sale whose contents are basically the same yet presented in different languages (*e.g.* <akuoutlets.com> in Turkish, <akuitalia.com> in Italian, <akujapan.com> in Japanese); iv. all the websites connected to the disputed domain names display the Complainant's AKU trademark and logo, and similar images; v. all of the disputed domain names have been registered within two short periods of time (9 were registered between September 15, 2021 and September 22, 2021, while the remaining five were registered between January 11, 2023 and February 11, 2023); and vi. several of the disputed domain names share the same IP address.

Moreover, the Complainant submits that all of the disputed domain names incorporate the Complainant's renowned AKU trademark with the addition of either geographical and or generic terms related to the Complainant's business: "UK", "Australia", "Espana", "Greece", "Turkiye", "Romania", "Italia", "Deutschland", "Japan", "boot/boots", "chaussures" (shoes in French), "bakancs" (boots in Hungarian), "shoenen" (shoes in Dutch), "shuhe" (shoes in German), "bot" (boots in Turkish), "outlets" and "soldes" (sales in French), and are therefore confusingly similar therewith.

As to the Respondents' lack of rights or legitimate interests in respect of the disputed domain names, the Complainant contends that:

- (a) no agreements, authorisations or licenses have been granted to the Respondents to use the AKU trademarks;
- (b) the registration and/or use of the disputed domain names containing the AKU trademark makes it difficult to infer a legitimate use of the disputed domain names by the Respondents;
- (c) upon information and belief, there is no evidence that the Respondents have trademarks under the AKU Brand;
- (d) the disputed domain names were registered decades after the registration of the Complainant's AKU Trademark;

- (e) eight of the disputed domain names are/were linked to websites where purportedly offering AKU products for sale (Annex 10 to the Complaint), reproducing the Complainant's copyright-protected official product images and marketing materials as well as the AKU trademark and logo, being the remaining disputed domain names not reachable;
- (f) based on information and belief, since the registration of the disputed domain names the Respondents have never made any *bona fide* use of the disputed domain names; and
- (g) the Respondents have never been known under the AKU trademark and/or similar name.

As to the registration of the disputed domain names in bad faith, the Complainant asserts that the Respondents knew or should have known of the Complainant's trademark rights at the time of the registration of the disputed domain names in view of the strong reputation and international renown of the Complainant's trademark.

Further, the Respondents' intent to target the Complainant can easily be inferred from the use made of part of the disputed domain names in connection with online shops purportedly offering AKU products, reproducing the Complainant's copyright-protected official product images and marketing materials as well as the AKU trademark and logo; being the remaining disputed domain names passively held.

Lastly, the Complainant contends that the Respondents' choice to retain privacy protection services and to register so many domain names incorporating the Complainant's trademark are further evidence of the Respondents' bad faith registration and use of the disputed domain names.

## **B. Respondents**

The Respondents did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth three requirements, which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

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

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain names.

Before turning to these questions, however, the Panel needs to address the issue of the consolidation of the multiple Respondents.

### **A. Consolidation of Multiple Respondents**

The Complainant requests this Panel to accept the consolidation of multiple Respondents in a single proceeding in view of the facts enumerated at the section 5.A. above.

Section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) establishes that "[w]here 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”.

All of the aforementioned criteria are present in this case and therefore this Panel accepts such request considering that it would be more procedurally efficient to have all of the disputed domain names dealt with at the same procedure, given that all of the disputed domain names: (a) share the same Registrar; (b) are either inactive, or linked to websites presenting the Complainant’s copyright-protected official product images and marketing materials, and offering purported AKU goods for sale; (c) were registered at similar intervals of time; and (d) share a similar naming pattern incorporating the Complainant’s trademark and geographic and or descriptive terms related to the Complainant’s products.

This Panel is satisfied, in view of the evidence submitted and on the balance of probabilities that the disputed domain names are indeed subject to a common control and that consolidation would be fair and equitable to all Parties.

### **B. Identical or Confusingly Similar**

The Complainant has established its rights in the AKU trademark duly registered in several jurisdictions.

The Panel finds that the disputed domain names reproduce the Complainant’s trademark in its entirety. As recognized by past UDRP panels, this test involves a “comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name” and the disputed domain names are thus confusingly similar to the Complainant’s trademark ([WIPO Overview 3.0](#), section 1.7.)

The first element of the Policy has therefore been established.

### **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondents’ rights to or legitimate interests in the disputed domain names. These circumstances are:

- (i) before any notice of the dispute, the Respondents’ use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondents (as individuals, businesses, or other organizations) have been commonly known by the disputed domain names, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondents are making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel notes that the Complainant has made out a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names. The burden of production has therefore shifted to the Respondents to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests.

The Respondents, in not responding to the Complaint, have failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names. This entitles the Panel to draw any such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules.

As seen above, part of the disputed domain names are being used in connection with online shops purportedly offering the Complainant's products without the Complainant's authorization. Indeed such use cannot be considered here a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use under the Policy.

Furthermore, the composition of the disputed domain names, wholly incorporating the Complainant's well-known trademark with additional terms carries a risk of implied affiliation. See section 2.5.1, [WIPO Overview 3.0](#). Also, the lack of evidence on record showing that the Respondents have been commonly known by the disputed domain names, is a further indication that the Respondents lack rights or legitimate interests in the disputed domain names.

The second element of the Policy has also been met.

#### **D. Registered and Used in Bad Faith**

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of the disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain names:

- a) the Complainant's trademark is well-known;
- b) the use of part of the disputed domain names in connection with online shops purportedly offering the Complainant's products, reproducing the Complainant's logo and copyrighted promotional materials without authorization;
- c) the Respondents have provided no evidence whatsoever of any actual or contemplated good faith use by them of the disputed domain names; and
- d) the indication of what appears to be false contact details, not being the Center fully able to deliver written communications to the Respondents.

Considering the totality of the circumstances in case, the Panel finds the present inactive use of part of the disputed domain names does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3.

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondents' conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain names.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names, <akuaustralia.com>, <akubakancs.com>, <akubootsaustralia.com>, <akubootsuk.com>, <akubotturkiye.com>, <akuespana.com>, <akugreece.com>, <akuitalia.com>, <akujapan.com>, <akuoutlets.com>, <akuromania.com>, <akuschoenen.com>, <akuschuhedeutschland.com> and <chaussuresakusoldes.com>, be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: June 13, 2023