

ADMINISTRATIVE PANEL DECISION

Alpargatas S.A., Alpargatas Europe, S.L.U v. Sabrina Diederich / Web
Commerce Communications Limited
Case No. D2022-0942

1. The Parties

The Complainants are Alpargatas S.A., Brazil, (“First Complainant”), and Alpargatas Europe, S.L.U, Spain, (“Second Complainant”), represented by PADIMA, Spain.

The Respondents are Sabrina Diederich, Germany, and Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain names <havaianas-belgie.com>, <havaianascipo.com>, <havaianas-italia.com>, <havaianasklipklappersalg.com>, <havaianasnewzealand.com>, <havaianas-romania.com>, <havaianassalecanada.com>, <sandaliahavaianasbrasil.com>, and <tiendashavaianasespana.com> are registered with the registrar Alibaba.com Singapore E-Commerce Private Limited.

The disputed domain name <havaianasitalia.cc> is registered with the registrar PDR Ltd. d/b/a PublicDomainRegistry.com.

The two registrars above are jointly referred to as the “Registrars”.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 17, 2022. On March 17, 2022, the Center transmitted by email to the Registrars requests for registrar verification in connection with nine disputed domain names. On March 18, 2022, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the nine disputed domain names which differed from the named Respondent and contact information in the Complaint.

On March 28, 2022, the Complainant requested the addition of the disputed domain name <havaianassalecanada.com> to the Complaint. On March 28, 2022, the Center transmitted by email to the Registrar Alibaba.com Singapore E-Commerce Private Limited a request for registrar verification in connection with the disputed domain name <havaianassalecanada.com>. On March 29, 2022, the Registrar Alibaba.com Singapore E-Commerce Private Limited transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name

<havaianassalecanada.com> which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 29, 2022, providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 30, 2022.

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 March 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on April 21, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on May 3, 2022. 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 First Complainant is a Brazilian company producing flip-flop sandals. It was established in 1962, and is the owner of the following trademark registrations for HAVAIANAS (the "HAVAIANAS trademark"):

- the European Union trademark HAVAIANAS with registration No. 003772431, registered on September 20, 2005, for goods in International Class 25;
- the European Union trademark HAVAIANAS with registration No. 007156128, registered on March 23, 2009, for goods in International Class 25; and
- the European Union trademark HAVAIANAS with registration No. 008664096, registered on April 23, 2010, for goods in International Class 25.

The Second Complainant is an exclusive licensee of the First Complainant for the HAVAIANAS trademark.

The Second Complainant is also the owner of the domain name <havaianas-store.com> registered on February 17, 2010, which resolves to the Complainants' main website.

The disputed domain names are the following:

Disputed domain name	Date of registration	Registrant
<havaianasitalia.cc>	August 13, 2021	Sabrina Diederich
<havaianasklipklappersalg.com>	August 31, 2021	Web Commerce Communications Limited
<sandaliahavaianasbrasil.com>	September 1, 2021	Web Commerce Communications Limited
<havaianascipo.com>	September 13, 2021	Web Commerce Communications Limited
<havaianas-belgie.com>	September 16, 2021	Web Commerce Communications Limited
<havaianas-italia.com>	September 16, 2021	Web Commerce Communications Limited
<havaianas-romania.com>	September 16, 2021	Web Commerce Communications Limited
<havaianassalecanada.com>	September 16, 2021	Web Commerce Communications Limited
<havaianasnewzealand.com>	September 22, 2021	Web Commerce Communications Limited
<tiendashavaianasespana.com>	February 19, 2022	Web Commerce Communications Limited

The disputed domain names <havaianasitalia.cc>, <sandaliahavaianasbrasil.com>, <havaianas-belgie.com>, <havaianas-italia.com>, and <havaianas-romania.com> are inactive. The disputed domain names <havaianasklipklappersalg.com>, <havaianascipo.com>, <havaianassalecanada.com>, <havaianasnewzealand.com>, and <tiendashavaianasespana.com> resolve to active websites that allegedly sell the products of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainants state that the disputed domain names are confusingly similar to their HAVAIANAS trademark, because they contain this trademark. They add that the use of the HAVAIANAS trademark in the disputed domain names joined to other words as "klipklappers" ("flip-flops" in Danish), "cipo" ("shoes" in Hungarian), "sale", and country names shows the aim of the disputed domain names owner to induce confusion among Internet users searching for the Complainants' products to create a link between HAVAIANAS and the disputed domain names.

According to the Complainant, the Respondents have no rights or legitimate interests in respect of the disputed domain names, because they contain the Complainants' HAVAIANAS trademark without authorization by the Complainants, and the Respondents are not commonly known by the disputed domain names.

The Complainants contend that the disputed domain names were registered and are being used in bad faith. According to them, the HAVAIANAS trademark is known worldwide, and the Respondents were aware of it and registered the disputed domain names with the intention to refer to the Complainants and their trademark. The Complainants submit that the disputed domain names are being used for commercial websites that contain the Complainants' branded items, trademark, and images without any disclaimer informing about the lack of relationship with the Complainants. The Complainants point out that the Respondents' purpose is to capitalize on the reputation of the Complainants' trademark by diverting Internet users seeking HAVAIANAS products to the Respondents' websites for financial gain, by intentionally creating a likelihood of confusion with the Complainants' registered trademark as to the source, sponsorship, affiliation, or endorsement of their websites and the goods offered or promoted through these websites.

The Complainants request that the disputed domain names be cancelled.

B. Respondents

The Respondents did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Procedural issue – Consolidation of the Respondents

The Complainants request the consolidation of the proceedings in respect of the disputed domain names, maintaining that all of them belong to the same owner, because they have the same registrant data (except the disputed domain name <havaianasitalia.cc>), their website contents are almost the same, and they have all been registered within a short period of time.

Paragraph 10(e) of the Rules grants a panel the power to consolidate multiple domain name disputes, and paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. As discussed in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), where a complaint is filed against multiple respondents, UDRP panels look at whether the domain

names or corresponding websites are subject to common control, and whether the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. UDRP panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in the content or layout of websites corresponding to the disputed domain names, any naming patterns in the disputed domain names, or other arguments made by the complainant.

The Center has discharged its duties to notify the persons listed as registrants of the disputed domain names. None of the listed registrants of the disputed domain names has submitted a formal Response or objected to the consolidation request of the Complainants.

The disputed domain names were registered within a period of several months, and all of them follow the same pattern – a combination of the distinctive HAVAIANAS trademark with a geographic term and/or a term describing the Complainants' products. These circumstances show that it is more likely than not that the disputed domain names are under common control.

None of the Respondents have advanced any reasons why it may not be equitable to allow the consolidation of the disputes. It appears that the consolidation would lead to greater procedural efficiency, and the Panel is not aware of any reasons why the consolidation would not be fair and equitable to all parties.

The above satisfies the Panel that the consolidation of the Respondents and the disputes related to the disputed domain names in a single proceeding is justified and appropriate in the circumstances.

Therefore, the Panel decides to allow the consolidation of the disputes in relation to all of the disputed domain names in the present proceeding.

6.2. Substantive issues

Pursuant to the Policy, paragraph 4(a), the Complainants must prove each of the following to justify the transfer of the disputed domain names:

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

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]”

None of the Respondents has however submitted a formal Response or disputed the Complainants' contentions and evidence in this proceeding.

A. Identical or Confusingly Similar

The First Complainant has provided evidence that it is the owner of the HAVAIANAS trademark. The Second Complainant is the exclusive licensee of the First Complainant for Europe. As discussed in section 1.4.1 of the [WIPO Overview 3.0](#), a trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint. In view of this, the Panel accepts that the Complainants have established their rights in the HAVAIANAS trademark for the purposes of the present proceeding.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the [WIPO Overview 3.0](#). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” and “.cc” TLDs of the disputed domain names.

Each of the disputed domain names represents a combination of the easily recognizable HAVAIANAS trademark with a geographic term such as “belgie”, “italia”, “newzealand”, “romania”, “canada”, “brasil” or “espana”, and/or with a dictionary word such as “sale”, “klipklappers” (meaning “flip-flops” in Danish), “cipo” (meaning “shoe” in Hungarian), or “tiendas” (meaning “shops” in Spanish). As discussed in section 1.8 of the [WIPO Overview 3.0](#), in cases where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element.

In view of the above, the Panel finds that the disputed domain names are confusingly similar to the HAVAIANAS trademark in which the Complainants have rights.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainants contend that the Respondents have no rights or legitimate interests in the disputed domain names, because they have not been authorized to use the HAVAIANAS trademark, and use the disputed domain names to host websites that offer the Complainants’ products for sale without disclosing the lack of relationship with the Complainants. Thus, the Complainants have established a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names.

None of the Respondents has submitted a formal Response or alleged the existence of rights or legitimate interests in the disputed domain names.

As discussed in section 2.8.1 of the [WIPO Overview 3.0](#), panels acting under the Policy have recognized that resellers or distributors using a domain name containing the complainant’s trademark to undertake sales related to the complainant’s goods may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the “Oki Data test”), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder;
and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

In view of the circumstances of the present case, the Panel accepts that the requirements of the Oki Data test have not been complied with by the registrants of the disputed domain names. All of the disputed domain names follow the same naming pattern incorporating the HAVAIANAS trademark in combination with

geographic indications and/or dictionary words related to the products of the Complainants or to sales, and many of them resolve to similar websites that offer the Complainants' products without providing any information about their owners and without containing any disclaimer for the lack of affiliation to the Complainant.

The other disputed domain names are inactive, but they reflect the same naming pattern and were registered in a short period of time. Therefore, and in the lack of any plausible explanation for their registration, they appear as part of an attempt to "corner the market" in domain names that reflect the HAVAIANAS trademark.

Therefore, the Panel finds that the Respondents do not have rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The disputed domain names all incorporate the HAVAIANAS trademark, which was registered many years prior to their registration, in combination with geographic terms and/or dictionary words related to the products of the Complainants or to sales activities. This makes them confusingly similar to the HAVAIANAS trademark, and Internet users may regard them as official online locations of the Complainant for the respective territories. As discussed in section 6.1 above, it is more likely than not that all disputed domain names are under common control, and many of them resolve to similar websites that offer the Complainants' products without disclosing the lack of affiliation with the Complainant. The Complainants state that they have not authorized the registration and use of the disputed domain names, and none of the Respondents maintains the opposite or provides any plausible explanation for their registration and use.

Taking the above into account, the Panel concludes that it is more likely than not that the Respondents have registered the disputed domain names with knowledge of the Complainants and targeting the HAVAIANAS trademark in an attempt to attract traffic to the disputed domain names by confusing Internet users that they are reaching official online locations where the Complainants' products are provided.

In view of the above, the Panel accepts that by registering and using the disputed domain names, the Respondents have intentionally attempted to attract, for commercial gain, Internet users to the websites at the disputed domain names, by creating a likelihood of confusion with the Complainant and its LA SPORTIVA trademark, which supports a finding of bad faith under paragraph 4(b)(iv) of the Policy.

The disputed domain names <havaianasitalia.cc>, <sandaliahavaianasbrasil.com>, <havaianas-belgie.com>, <havaianas-italia.com>, and <havaianas-romania.com>, are inactive. However, as discussed in section 3.3 of the [WIPO Overview 3.0](#), from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

The Panel finds that some of these factors are present here. The Respondents have failed to submit a Response and to provide any evidence of actual or contemplated good-faith use of these disputed domain names. The disputed domain names' confusing similarity to the Complainants' trademarks due to its combination with geographic terms creates the impression that these disputed domain names are the official domain name of the Complainants for the respective territories. Given their number, the identical naming pattern used for them, and their registration dates, the registration of the disputed domain names also appears as an attempt to "corner the market" in domain names that reflect the HAVAIANAS trademark. In view of this, the Panel is not aware of any good faith use to which these disputed domain names may be put without authorization by the Complainants.

Therefore, the Panel finds that the disputed domain names have been registered and used in bad faith.

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 <havaianas-belgie.com>, <havaianascipo.com>, <havaianasitalia.cc>, <havaianas-italia.com>, <havaianasklipklappersalg.com>, <havaianasnewzealand.com>, <havaianas-romania.com>, <havaianassalecanada.com>, <sandaliahavaianasbrasil.com>, and <tiendashavaianasespana.com> be cancelled.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: May 17, 2022