

ADMINISTRATIVE PANEL DECISION

Alpargatas S.A., Alpargatas Europe, S.L.U. v. Julius Bergman and Web
Commerce Communications Limited
Case No. D2022-1501

1. The Parties

The Complainants are Alpargatas S.A, Brazil and Alpargatas Europe, S.L.U, Spain, represented by PADIMA TEAM SLP, Spain.

The Respondents are Julius Bergman, France and Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrars

The disputed domain names <havaianasflipflopscanada.com>, <havaianasisrael.com>, <havaianasmalaysia.com>, <havaianassandalsusa.com>, <havaianassingapore.com> and <havaianasuk.com> are registered with Alibaba.com Singapore E-Commerce Private Limited.

The disputed domain names <havaianasflipflopsireland.com>, <havaianasoutletnz.com> and <havaianassouthafrica.com> are registered with 1API GmbH.

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 April 26, 2022. On April 27, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On April 28, 2022 and April 29, 2022, the Registrars transmitted by email to the Center its verification response disclosing registrants and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on May 2, 2022 providing the registrant and contact information disclosed by the Registrar, and requesting the Complainants to amend the Complaint adding the Registrar-disclosed registrants as formal Respondents and provide relevant arguments or evidence demonstrating that all named Respondents are, in fact, the same entity and/or that all domain names are under common control; and/or file a separate complaint for any domain name(s) for which it is not possible to demonstrate that all named Respondents are in fact the same entity and/or that all domain names are under common control and indicate (by short amendment or reply email) which domain name(s) will no longer be included in the current Complaint.

The Complainants filed an amended Complaint on May 5, 2022.

On May 9, 2022, the Center noted that there appears to be at least *prima facie* grounds sufficient to warrant accepting the Complaint for the Panel's final determination of the consolidation request on appointment.

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 Respondent of the Complaint, and the proceedings commenced on May 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 30, 2022.

The Center appointed John Swinson as the sole panelist in this matter on June 8, 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. The First Complainant was established in 1962. The First Complainant owns many trademark registrations for HAVAIANAS, including the following trademark registrations in the European Union:

- European Union trademark HAVAIANAS with registration No. 003772431, registered on September 20, 2005;
- European Union trademark HAVAIANAS with registration No. 007156128, registered on March 23, 2009; and
- European Union trademark HAVAIANAS with registration No. 008664096, registered on April 23, 2010.

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.

This decision refers to the First Complainant and the Second Complainant as the Complainant.

The disputed domain names were registered on the following dates:

- <havaianasflipflopscanada.com> – April 12, 2022
- <havaianasisrael.com> – April 19, 2022
- <havaianasmalaysia.com> – April 12, 2022
- <havaianassandalsusa.com> – April 18, 2022
- <havaianassingapore.com> – April 8, 2022
- <havaianasuk.com> – April 18, 2022
- <havaianasflipflopsireland.com> – April 12, 2022
- <havaianasoutletnz.com> – April 12, 2022
- <havaianassouthafrica.com> – April 12, 2022

Little information is known about the Respondents because no response was filed.

The First Respondent's address, according to the Registrar's records, is in the Normandy region of France.

The Second Respondent is a company from Malaysia.

The Second Respondent has been a respondent in many prior cases under the Policy, a number of which involve the advertising and sale of footwear products. See, for example, *New Balance Athletics, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0908](#), and *PUMA SE v. Dreher Barbara, Faerber Matthias, and Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0112](#).

This decision refers to the First Respondent and the Second Respondent as the Respondent. The screenshots as provided in the Complaint show that the disputed domain names resolve to websites that all have the same overall design with most identical structure and content (with pricing in a currency matching the geographical term used in the disputed domain name). On these websites, the Complainant's HAVAIANAS trademark is prominently used, and the websites create the impression that they all are operated by the Complainant. All the websites include the following text on the "About Us" page:

"We've been serving customers some of the best deals and discounted fashion online since 2012. We're unique in the marketplace, offering thousands of new styles, authentic brands and a huge variety of fashion for the whole family. Stock runs out quickly, so if you see something you like, buy it! We want to exceed your expectations by giving you great value from a trusted source."

At the time of this decision, <havaianassandalsusa.com> and <havaianasuk.com> do not resolve to an active website.

5. Parties' Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The HAVAIANAS trademark is well-known worldwide.

The disputed domain names include the HAVAIANAS trademark in full.

The disputed domain names were registered without the Complainant's permission. There is no evidence to show that the Respondent is commonly known by the disputed domain names.

The Respondent is using the disputed domain names to cause confusion when Internet users are searching for the Complainant's HAVAIANAS products.

The disputed domain names are being used as commercial websites, which contain the Complainant's branded items, trademarks and images without any disclaimer informing consumers about the lack of relationship with the Complainant.

The Respondent's purpose is to capitalize on the reputation of the Complainant's trademarks by diverting Internet users seeking HAVAIANAS products to its websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's registered trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and/or the goods offered or promoted through said websites.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

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

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Procedural Issue – Consolidation of Two 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 the websites to which the disputed domain names resolve are very similar, and the disputed domain names have all been registered within a short period of time and have the same or similar structure.

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. Where a complaint is filed against multiple respondents, UDRP panels typically will 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.

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 one week, 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. The websites at the disputed domain names are almost identical, and have the same information in "About Us" section of each of the websites. These circumstances show that it is more likely than not that the disputed domain names are under common control.

The Respondents have not advanced any reasons why it may not be equitable to allow the consolidation of the disputes. 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.

B. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

As set out above, the Complainant owns trademark registrations for the HAVAIANAS trademark. The Panel considers that on a side-by-side comparison, the disputed domain names are confusingly similar to the Complainant's HAVAIANAS trademark.

The disputed domain names include the entirety of the trademark HAVAIANAS, and add a geographical term or terms related to the Complainant's products (such as "flip flop" and "outlet").

When a domain name wholly incorporates a complainant's registered mark, that is sufficient to establish confusing similarity for purposes of the Policy. *Cox Enterprises, Inc. v. Miguel Delsel*, WIPO Case No. [D2020-2676](#).

The addition of terms in the disputed domain names does not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademark under the Policy. See also *Alpargatas S.A., Alpargatas Europe, S.L.U v. Sabrina Diederich / Web Commerce Communications Limited*, WIPO Case No. [D2022-0942](#).

The Complainant succeeds on the first element of the Policy in relation to the disputed domain names.

C. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

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

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant asserts that the disputed domain names were registered without the Complainant's permission, and that the Complainant possesses no evidence to show that the Respondent is commonly known by the disputed domain names. Further, the Complainant asserts that the Respondent is using the disputed domain names to cause confusion when Internet users are searching for the Complainant's HAVAIANAS products.

In a prior decision involving the same parties, the panels in that case considered whether the test set out in the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the "Oki Data test") applied. That panel found that the Oki Data test did not apply in that case. See *Alpargatas S.A., Alpargatas Europe, S.L.U v. Sabrina Diederich / Web Commerce Communications Limited*, WIPO Case No. [D2022-0942](#). The same result and rationale also apply in this case.

Two of the disputed domain names are inactive, but they reflect the same naming pattern and were registered generally at the same time as the other disputed domain names. Therefore, without 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. See also *Alpargatas S.A., Alpargatas Europe, S.L.U v. Sabrina Diederich / Web Commerce Communications Limited*, WIPO Case No. [D2022-0942](#).

The Panel finds that the Respondent has failed to produce any evidence to establish rights or legitimate interests in the disputed domain names. None of the circumstances listed in paragraph 4(c) apply in the present circumstances. Accordingly, the Panel finds the Respondent has not established rights or any legitimate interests in the disputed domain names.

The Complainant succeeds on the second element of the Policy in relation to the disputed domain names.

D. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent has registered and used the disputed domain name in bad faith.

In the present circumstances, the Panel concludes that the registration and use of the disputed domain names are in bad faith.

The Respondent’s conduct demonstrates the Respondent’s knowledge of the Complainant and its trademark. By registering many domain names that include the Complainant’s well-known trademark, and then by using the disputed domain names to impersonate the Complainant, demonstrates that the Respondent specifically knew of and targeted the Complainant.

On multiple occasions in 2021 and 2022 alone, the Respondent has been found by UDRP panels to have engaged in abusive domain name registrations. In the Panel’s view, such pattern of recent abusive conduct, repeatedly registering trademark-abusive domain names, constitutes further evidence of bad faith. See also *New Balance Athletics, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0908](#) where a similar finding was made against the present Respondent.

The current inactive status of two of the disputed domain names does not prevent a finding of bad faith, given the Respondent’s failure to participate in this proceeding, and the Respondent’s attempt to corner the market (as discussed above) in respect of domain names involving the HAVAIANAS trademark. See section 3.3 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0](#).

Based on the facts in the Complaint, which the Respondent does not rebut, the Panel finds that both paragraphs 4(b)(ii) and (iv) of the Policy apply in the present case.

The Complainant succeeds on the third element of the Policy in relation to 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 <havaianasflipflopscanada.com>, <havaianasflipflopsireland.com>, <havaianasisrael.com>, <havaianasmalaysia.com>, <havaianasoutletnz.com>, <havaianassandalsusa.com>, <havaianassingapore.com>, <havaianassouthafrica.com>, and <havaianasuk.com> be cancelled.

/John Swinson/

John Swinson

Sole Panelist

Date: June 22, 2022