

ADMINISTRATIVE PANEL DECISION

The Aldo Group Inc., and Aldo Group International AG v. Domain Admin,
Whoisprotection.cc

Case No. D2022-1718

1. The Parties

Complainants are The Aldo Group Inc., Canada, and Aldo Group International AG, Switzerland, represented by FRKelly, Ireland.

Respondent is Domain Admin, Whoisprotection.cc, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <aldo-ireland.com> (the “Domain Name”) is 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 May 11, 2022. On May 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 13, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainants on May 13, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on May 18, 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 Respondent of the Complaint, and the proceedings commenced on May 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 8, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 9, 2022.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on June 23, 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

Complainants are The Aldo Group Inc., the parent company of ALDO Group International AG, the trademark holder. The ALDO Group is a Canadian multinational corporation retailer that owns and operates a worldwide chain of shoe and accessories stores. The company was founded by Aldo Bensadoun in Montreal, Quebec, in 1972, where its corporate headquarters based in the Montreal borough of Saint-Laurent, Quebec remains today. It has grown to become a worldwide corporation, with nearly 3,000 stores across 100 countries. Stores in Canada, the United States of America, the United Kingdom, and Ireland are owned by the ALDO Group, while international stores are franchised. The corporate website has the domain name <aldogroup.com>. The Irish store was opened in 2005.

Complainants have registered rights in many countries in respect of trademarks including the word ALDO, which is also part of the corporate name. In addition, Complainants own the following registered trademarks:

- ALDO, European Union registered Trade Mark no. 009196742 in classes 3, 9, 14, and 26, application date June 23, 2010, and registered on February 10, 2015.
- ALDO, Irish registered trademark (device) no. 231683 in classes 18, 25, and 35, registered on July 19, 2000.

The Domain Name was registered on March 25, 2021. According to evidence in the Complainant, the Domain Name previously resolved to a website impersonating Complainants; however, at filing of the Complaint, the Domain Name resolves to an inactive website.

5. Parties' Contentions

A. Complainants

(i) Identical or confusingly similar

Complainants state they have goodwill and reputation in their ALDO trademark based on their registrations and widespread use of the mark in connection with a worldwide chain of shoe and accessories stores. Complainants have also submitted evidence, which supports the contention that the trademark is widely known and a distinctive identifier of Complainants' products and services. Complainants have therefore proven that they have requisite rights in the ALDO trademark. Complainants state that the application dates for their registered trademarks, noted in section 4 above, are more than sufficient to show that Complainants' rights in the ALDO mark pre-date the registration date of the Domain Name on March 25, 2021.

Complainants claim that many UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the domain name incorporates the complainant's trademark in its entirety. This is the case here, where Complainants' registered, fanciful and inherently distinctive ALDO trademark is fully included and is recognizable in the Domain Name.

Complainants submit that the Domain Name combines Complainants' registered trademark ALDO, as its distinctive element, with the geographic name "Ireland", which is descriptive of one of Complainants' places of business. The addition of this descriptive term to the distinctive trademark is insufficient in itself and does not serve to distinguish the Domain Name from the trademark, but rather, may reinforce the association of Complainants' trademark with the Domain Name. Complainants assert the similarity between their trademark and the Domain Name is incontestable, in view of the identity and the likelihood of confusion

among consumers. The mere existence of an additional word element would not exclude the risk of confusion and association of the two signs. Use of the distinctive elements of Complainants' trademarks incorporated in the Domain Name is causing or will continue to cause damage to Complainants' goodwill and reputation. Where trademarks are identical or virtually identical, likelihood of damage may be inferred. In particular, the Domain Name includes Complainants' trademark ALDO in its entirety, and the addition of the place name Ireland, which does not prevent a finding of confusing similarity between the Domain Name and the ALDO trademark.

(ii) Rights or legitimate interests

Complainants state that Respondent registered the Domain Name on March 25, 2021. The Domain Name is currently not active. Complainants have no affiliation with Respondent, nor have they authorized Respondent to register or use a domain name that includes Complainants' trademarks, and Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Complainants contend that Respondent has acted in bad faith in acquiring the Domain Name and setting up a corresponding website, when Respondent clearly knew of Complainants' rights. There is no commercial advantage in setting up such website other than to trade on Complainants' reputation or to sell the Domain Name to Complainants or to a competitor.

(iii) Registered and used in bad faith

Complainants submit that the Domain Name should be considered as having been registered and used in bad faith by Respondent. Complainants assert as follows:

- The Domain Name was registered 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;
- The Domain Name was registered primarily for the purpose of disrupting the business of a competitor; or
- Respondent intentionally attempted to attract for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainants' mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or of a product or service on Respondent's website.

Complainants state that the Domain Name is currently not active; however, Complainants have submitted evidence of a screenshot taken on April 8, 2022, of the website linked to the Domain Name, which shows a fake site purporting to be an ALDO site. As further evidence of this fraudulent use, Complainants submitted evidence that the Internet Archive Wayback Machine captured Respondent's fake website on two dates between November 25, 2021 and December 9, 2021. Complainants have received verbal complaints from customers about not receiving their merchandise after purchase on the fake website. Therefore, this site is being used for fraudulent purposes.

B. Respondent

Respondent did not reply to Complainants' contentions.

6. Discussion and Findings

In order to succeed on its Complaint, Complainants must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

A. Identical or Confusingly Similar

Complainants have demonstrated that they have well-established rights in its ALDO trademarks through registration and widespread use. The Panel finds that the Domain Name incorporates the ALDO mark in its entirety, while adding a hyphen and the geographic term “Ireland”. This combination in the Domain Name creates a confusing similarity with Complainants’ ALDO mark. Numerous UDRP decisions have found that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) and, e.g., *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#)); see also section 1.7 of the [WIPO Overview 3.0](#), which states, “where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing”.

Accordingly, the Panel finds that the Domain Name is confusingly similar to a trademark in which Complainants have rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#) states, “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”.

Here, the Panel determines that Complainants have made out a *prima facie* case, while Respondent has failed to respond to the Complaint. The Panel finds that Complainants have not authorized Respondent to use Complainants’ well-established ALDO trademark; that Respondent is not commonly known by the Domain Name; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Instead, the Domain Name has been used to connect to a fraudulent website to impersonate Complainants and purport to be one of Complainants’ websites. Moreover, Respondent has made no attempt to rebut any of Complainants’ allegations in the Complaint. See WIPO Overview, section 2.13.1 (Panels have categorically held that the use of a domain name for illegal activity [...] can never confer rights or legitimate interests on a respondent.”).

Accordingly, the Panel finds that Complainants have made a *prima facie* showing of Respondent’s lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainants have established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainants demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states that “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”.

Here, the Panel determines that the Domain Name was registered and has been used in bad faith. With respect to registration, the evidence submitted by Complainants demonstrates that Respondent improperly targeted Complainants and their distinctive ALDO trademark when registering the Domain Name.

Respondent used Complainants' trademark in full, while creating a fake website impersonating Complainants and their websites. In the face of these allegations made by Complainants, Respondent has provided no response at all to attempt to justify why Respondent chose to register the Domain Name corresponding to Complainants' ALDO mark.

This point is further confirmed by Respondent's use of the Domain Name. Complainants have submitted evidence to indicate that the Domain Name was being used by Respondent primarily for the illegal purpose of perpetrating a fraud, seeking to impersonate Complainants and their online commercial websites. As provided by [WIPO Overview 3.0](#), section 3.1.4, "use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith".

In conclusion, the Panel determines that, for all of the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainants have satisfied the third element of the Policy.

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 Domain Name, <aldo-ireland.com>, be transferred to Complainant, Aldo Group International AG.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: July 21, 2022