

ADMINISTRATIVE PANEL DECISION

Sorel Corporation v. Client Care, Web Commerce Communications Limited
Case No. D2022-4125

1. The Parties

Complainant is Sorel Corporation, United States of America, represented by Strategic IP Information Pte Ltd., Singapore.

Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <sorelshoes-australia.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 November 2, 2022. On November 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 3, 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 Complainant on November 3, 2022, 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 November 8, 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 November 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 7, 2022.

The Center appointed Dinant T. L. Oosterbaan as the sole panelist in this matter on December 27, 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

According to the information provided Complainant is a designer, manufacturer and distributor of footwear throughout the world. Complainant has used its SOREL trademark and brand name for over 60 years.

Complainant owns multiple trademarks for SOREL, including:

- European Union wordmark SOREL, registration number 000829515 and registration date October 29, 1999, and
- Australia wordmark SOREL, registration number 1690503 and registration date December 13, 2014.

In addition, Complainant runs a website using the domain name <sorel.com>.

The Domain Name was registered on May 7, 2022.

The Domain Name resolves to a website which claims to operate an online shop that uses identical content copied from Complainant's retail website, including brand, copyright images and photographs.

The trademark registrations of Complainant were issued prior to the registration of the Domain Name.

5. Parties' Contentions

A. Complainant

Complainant submits that the Domain Name is confusingly similar to its SOREL trademark. According to Complainant, the Domain Name reproduces the distinctive part of Complainant's well-known SOREL trademark. The addition of the words "shoes-australia" does not serve to distinguish the Domain Name from Complainant's SOREL trademark.

According to Complainant, Respondent has no rights or legitimate interests in the Domain Name, because the Domain Name incorporates the well-known SOREL trademark. Complainant submits that Complainant has not authorized Respondent to use the SOREL trademark in any manner whatsoever, including as the Domain Name. Complainant asserts that consumers are likely to deem the use of the Domain Name as a natural extension of Complainant's mark, and to believe that the website associated with the Domain Name offers legitimate products, which is clearly not the case. Complainant concludes by stating that the use of the SOREL trademark as part of the Domain Name is solely intended towards portraying the Domain Name as associated with or related to Complainant, its products and activity.

Complainant submits that Respondent registered and is using the Domain Name in bad faith. According to Complainant the fact that the Domain Name incorporates the well-known SOREL mark and that Respondent has no relationship to the mark, is evidence of bad faith. In addition, as the website to which the Domain Name resolves contains suggestive images of SOREL products, it is a clear evidence of Respondent's bad faith and attempt to pass off the website as being associated with or endorsed by Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to “decide a 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”.

Paragraph 4(a) of the Policy requires that a complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (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 Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, Complainant must first of all establish rights in a trademark or service mark and secondly that the Domain Name is identical or confusingly similar to that trademark or service mark.

Complainant has established that it is the owner of several trademark registrations for SOREL. The Domain Name incorporates the trademark SOREL in its entirety, with the addition of the generic term “shoes” and the geographical term “australia”. Many UDRP panels have found that a disputed domain name is confusingly similar where the relevant trademark is recognizable within the disputed domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The generic Top-Level Domain (“gTLD”) “.com” is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that Complainant has proven that the Domain Name is confusingly similar to Complainant’s trademarks under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In the opinion of the Panel, Complainant has made a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks or to register the Domain Name incorporating its trademarks. Respondent is not making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert Internet users or to tarnish the trademarks of Complainant.

Based on the undisputed submission and evidence provided by Complainant, the Domain Name resolves to a website which purports to operate an online shop that uses identical content taken from Complainant’s website, including copying of photographs. The Panel does not consider such obviously illegal use a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Name. Respondent is also not commonly known by the Domain Name nor has it acquired any trademark or service mark rights.

No Response to the Complaint was filed and Respondent has not rebutted Complainant’s *prima facie* case.

Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of a domain name in bad faith in the event Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service offered on Respondent's website or location.

The Panel finds that the Domain Name has been registered and is being used in bad faith. Noting the status of the SOREL mark and the overall circumstances of this case, the Panel finds it more likely than not that Respondent knew or should have known Complainant's SOREL mark. The registration of the Domain Name in awareness of the SOREL trademark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

The Panel notes that the Domain Name resolves to a website which incorporates Complainant's trademark in its entirety and which illegally copies photographs and other content of Complainant's website, which indicates, in the circumstances of this case, that Respondent registered and used the Domain Name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Panel finally notes that it would seem that Respondent is a systematic cybersquatter with a practice to select domain names incorporating trademarks of third parties. At the time of this decision Respondent Client Care, Web Commerce Communications Limited during the years 2021 and 2022 has been a respondent in a total of 50 UDRP proceedings.

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, <sorelshoes-australia.com>, be transferred to Complainant.

/Dinant T. L. Oosterbaan/

Dinant T. L. Oosterbaan

Sole Panelist

Date: January 10, 2023