

ADMINISTRATIVE PANEL DECISION

Alpargatas S.A and Alpargatas Europe, S.L.U v. Qiu Xiaofeng Case No. D2023-2640

1. The Parties

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

The Respondent is Qiu Xiaofeng, China.

2. The Domain Names and Registrar

The disputed domain names <havaianasathens.com>, <havaianasaustraliastore.com>, <havaianasbelgie.com>, <havaianasbelgique.com>, <havaianasbrasilonline.com>, <havaianasbudapest.com>, <havaianascanadasale.com>, <havaianasdanmark.com>, <havaianaseesti.com>, <havaianasespaña.com>, <havaianashrvatska.com>, <havaianasisraeleilat.com>, <havaianasjapan.com>, <havaianaskuwait.com>, <havaianasnorvege.com>, <havaianasonlinestore.com>, <havaianasportugallojas.com>, <havaianaspraha.com>, <havaianasriga.com>, <havaianasromania.com>, <havaianasslovenia.com>, <havaianassouthafrica.com>, <havaianassrbija.com>, <havaianassuisse.com>, <havaianassuomi.com>, <havaianastürkiye.com>, <havaianasuaeonline.com>, <havaianasuksale.com>, <havaianasuruguay.com> (“Domain Names”) are registered with Paknic (Private) Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in respect of the Domain Names <havaianasathens.com>, <havaianasaustraliastore.com>, <havaianasbelgie.com>, <havaianasbelgique.com>, <havaianasbrasilonline.com>, <havaianasbudapest.com>, <havaianascanadasale.com>, <havaianasdanmark.com>, <havaianaseesti.com>, <havaianashrvatska.com>, <havaianasisraeleilat.com>, <havaianaskuwait.com>, <havaianasnorvege.com>, <havaianasonlinestore.com>, <havaianasportugallojas.com>, <havaianaspraha.com>, <havaianasriga.com>, <havaianasromania.com>, <havaianasslovenia.com>, <havaianassouthafrica.com>, <havaianassrbija.com>, <havaianassuisse.com>, <havaianassuomi.com>, <havaianasuaeonline.com>, and <havaianasuruguay.com> on June 16, 2023. On June 20, 2023, the Center transmitted by email to the Registrar the first request for registrar verification in connection with the initial set of Domain Names. On June 20, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Names which differed from the named Respondent (HIDDEN / Whois Agent, Web Domains By Proxy) and contact information in the Complaint.

The Center sent an email communication to the Complainant on June 26, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed the first amended Complaint on June 30, 2023. On July 7, 2023 the Complainant filed the second amended Complaint, in which it added the Domain Name <havaianasjapan.com>. On July 31, 2023, the Complainant filed an amendment to the Complaint and amended Complaints, requesting that the Domain Names <havaianasespaña.com>, <havaianastürkiye.com>, and <havaianasuksale.com> be added to the Complaint. On August 1, 2023 and August 3, 2023, the Registrar confirmed that the Respondent is the registrant of the additional Domain Names and its contact details.

The Center verified that the Complaint together with the amendment to the Complaint and amended Complaints 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 August 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 25, 2023.

The Center appointed Nicholas Smith as the sole panelist in this matter on September 15, 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 Complainants are involved in the manufacture and retail of footwear, specifically sandals, under a trade mark consisting of the word HAVAIANAS (the “HAVAIANAS Mark”) including from the Complainants’ official website at “www.havaianas.com”.

The First Complainant is the owner of trade mark registrations in numerous jurisdictions for the HAVAIANAS Mark including European Union trade mark registration No. 005264148 registered on July 3, 2007 for goods in classes 14, 18 and 24. The Second Complainant is the exclusive licensee of the First Complainant in Europe and is therefore the primary user of the HAVAIANAS Mark in Europe.

Each of the Domain Names was registered in May 2023. The Domain Names resolve or have resolved to strikingly similar websites (collectively the “Respondent’s Websites”) prominently displaying the HAVAIANAS Mark. Each of the Respondent’s Websites displays images of the Complainants’ products, purports to offer for sale the Complainants’ products and indeed appears to compete directly with the Complainants’ online retail store. None of the Respondent’s Websites contain, on the evidence before the Panel, any disclosure or explanation as to their relationship with (or absence of relationship with) the Complainant.

5. Parties’ Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the Domain Names.

Notably, the Complainants contend that:

- a) The Complainants are the owners of the HAVAIANAS Mark, having registered the HAVAIANAS Mark in numerous jurisdictions including within the European Union. Each of Domain Names reproduces the HAVAIANAS Mark in its entirety, and then includes a geographic term, a generic Top-Level Domain (“gTLD”) and in some cases descriptive words, none of which distinguish any of the Domain Names from the HAVAIANAS Mark.
- b) There are no rights or legitimate interests held by the Respondent in respect of the Domain Names. The Respondent is not commonly known by the Domain Names, nor does the Respondent have any authorization from the Complainants to register the Domain Names. The Respondent is not making a legitimate noncommercial fair use of the Domain Names.
- c) The Domain Names were registered and are being used in bad faith. By using the Domain Names for websites that reproduce the Complainants’ copyrighted material and purport to sell the Complainants’ products, the Respondent is clearly aware of the HAVAIANAS Mark and is using it to deceive consumers as to its affiliation with the Complainants. Such conduct amounts to registration and use of the Domain Names in bad faith.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

6.1 Preliminary Matter – Consolidation of Multiple Complainants

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) provides at section 4.11.1, in respect of the issue “Multiple complainants filing against a single respondent” that:

“Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP 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.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.”

The present proceeding involves two Complainants bringing a single complaint against a single Respondent. The Complainants have made a request for consolidation and bear the onus of establishing that such a consolidation is justified.

The Panel is satisfied, based on the material filed, that the Complainants have a specific common grievance against the Respondent, in that the Complainants have a common legal interest as related entities that hold and use the HAVAIANAS Mark. The Panel has considered whether it would be equitable and procedurally efficient to permit the consolidation.

The Panel finds that it is equitable and procedurally efficient to grant the Complainants’ request for consolidation. As such, for the remainder of the decision, the Panel will refer to the entities bringing the Complaint as a single Complainant.

6.2. Substantive Matters

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the Domain Names. Accordingly, the Domain Names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here geographical terms or terms such as "sale", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the Domain Names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Names. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Names such as those enumerated in the Policy or otherwise.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the Domain Names or a name corresponding to the Domain Names in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2;
- the Respondent (as an individual, business, or other organization) has not been commonly known by the Domain Names. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3;
- the Respondent is not making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4;
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the Domain Names.

The Respondent has used the Domain Names to operate websites to sell footwear that purport to be legitimate HAVAIANAS products. If the footwear sold on the Respondent's Websites are not genuine products produced by the Complainant, the Respondent's use of the Domain Names does not grant it rights or legitimate interests since it is using the Complainant's HAVAIANAS Mark for a site selling counterfeit products.

Even if the Respondent is offering genuine HAVAIANAS products from the Respondent's Websites, such use does not automatically grant it rights and legitimate interests. The principles that govern whether a reseller of genuine goods has rights or legitimate interests have been set out in a variety of UDRP decisions, starting with the case of *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The [WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

"... Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Ok! 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.

The 'Ok! Data test' does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

In this case, the Respondent's Websites do not accurately or prominently disclose the Respondent's relationship with the Complainant, in particular that it is not an authorized dealer or has any particular connection with the Complainant. Rather, its prominent display of the HAVAIANAS Mark, its reproduction of the Complainant's official product images, the absence of a disclaimer or any explanation as to the identity of the operator of the Respondent's Websites results in the impression that the Respondent's Websites are official websites of the Complainant. Even in the event that the Respondent is reselling genuine HAVAIANAS products, its use of the Domain Names for the Respondent's Websites does not grant it rights or legitimate interests in the Domain Names.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites or other on-line location, by creating a likelihood of confusion with the Complainant's HAVAIANAS Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Websites or location or of a product on the Respondent's Websites. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4. The Respondent registered the Domain Names for the purposes of operating websites specifically to sell either the Complainant's products or counterfeit products that compete with the Complainant's HAVAIANAS footwear products.

The Respondent is using the Domain Names that are confusingly similar to the HAVAIANAS Mark to sell products, be they genuine or otherwise, in competition with the Complainant and without the Complainant's approval and without meeting the Oki Data test.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 Names <havaianasathens.com>, <havaianasaustraliastore.com>, <havaianasbelgie.com>, <havaianasbelgique.com>, <havaianasbrasilonline.com>, <havaianasbudapest.com>, <havaianascanadasale.com>, <havaianasdanmark.com>, <havaianaseesti.com>, <havaianasespaña.com>, <havaianashrvatska.com>, <havaianasisraeleilat.com>, <havaianasjapan.com>, <havaianaskuwait.com>, <havaianasnorge.com>, <havaianasonlinestore.com>, <havaianasportugallojas.com>, <havaianaspraha.com>, <havaianasriga.com>, <havaianasromania.com>, <havaianasslovenia.com>, <havaianassouthafrica.com>, <havaianassrbija.com>, <havaianassuisse.com>, <havaianassuomi.com>, <havaianastürkiye.com>, <havaianasuaeonline.com>, <havaianasuksale.com>, and <havaianasuruguay.com> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: September 29, 2023