

ADMINISTRATIVE PANEL DECISION

Aldo Group International GmbH v. Mirella Oliveira
Case No. D2024-1270

1. The Parties

The Complainant is Aldo Group International GmbH, Switzerland, represented by Markmonitor, United States of America.

The Respondent is Mirella Oliveira, Germany.

2. The Domain Name and Registrar

The disputed domain name <aldosapatospt.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 3, 2024. On April 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 2024, the Registrar transmitted by email to the Center its verification disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 8, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 12, 2024.¹

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 sent notification to the Respondent of the Complaint, and the proceedings commenced on April 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 13, 2024. The Respondent did not submit any response.

¹The Complainant removed one domain name from the proceeding upon receipt of the Center’s notice of multiple underlying registrants.

Accordingly, the Center sent notification of the Respondent's default on May 15, 2024.

The Center appointed Petra Pecar as the sole panelist in this matter on May 23, 2024. 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 Complainant, Aldo Group, established in 1972 in Montreal, Canada, engages in the international trade of leather goods, primarily footwear. The Complainant operates over 3000 stores in more than 100 countries, serving nearly 200 million customers annually. Products are sold via the domain name <aldoshoes.com>, partner websites, and physical stores. In 2023, the Complainant changed its legal form from AG to GmbH, though some trademark registries still list the former.

The Complainant holds numerous trademark registrations worldwide for ALDO, including the following:

- International Trademark Registration No. 1029684 for figurative mark **ALDO**, registered on December 8, 2009, covering goods and services in classes 18, 25, and 35;
- European Union Trademark Registration No. 009196742 for word mark ALDO, registered on February 10, 2015, covering goods in classes 3, 9, 14 and 26; and
- International Trademark Registration No. 1706452 for word mark ALDO, registered on November 1, 2022, covering goods and services in classes 9, 35 and 41 designated among other for European Union.

The Complainant and its affiliates have Internet presence and hold numerous domain names, including <aldoshoes.com> and <aldogroup.com>, both registered February 3, 1996. The Complainant's products are also available in Portugal through physical stores and the website <www.aldoshoes.pt>.

The disputed domain name <aldosapatospt.com> was registered on March 25, 2022, and at the time of the complaint filing it resolved to an active website purportedly offering ALDO-branded products at heavily discounted prices and prominently using the ALDO logo.

The Respondent is an individual from Germany.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to a mark in which the Complainant has rights. The disputed domain name includes the Complainant's mark ALDO in its entirety, along with the terms "sapatos" (Portuguese for shoes) and "pt" (abbreviation for Portugal), which are relevant to the Complainant's business. The addition of these terms does not negate the confusing similarity, as the ALDO mark is clearly recognizable within the disputed domain name.

The Complainant has used the ALDO mark for over 25 years, achieving global recognition. Previous panels have confirmed the distinctiveness and well-known status of the ALDO mark. Thus, the disputed domain name is likely to cause confusion, misleading users into believing it is associated with the Complainant.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with nor authorized by the Complainant to use the ALDO mark. The Respondent is not known by the name "Aldo" or "Aldosapatospt" and holds no registered marks for these

names. The associated website misleadingly suggests an affiliation with the Complainant, selling goods at discounted prices without authorization, and implying false endorsement.

The Complainant states that the Respondent registered and is using the disputed domain name in bad faith. Given the Complainant's global presence for over 30 years, it is improbable that the Respondent was unaware of the ALDO marks. The disputed domain name was registered long after the Complainant's mark and website.

The Complainant asserts that the Respondent aimed to gain commercially and disrupt the Complainant's business by misleadingly presenting the website as the Complainant's official store. The Respondent's actions, including the potential sale of counterfeit goods, indicate bad faith.

B. Respondent

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

6. Discussion and Findings

As the Respondent did not file a Response to the Complainant's contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

"A Panel shall 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", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (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 by the Respondent in bad faith.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a mark ALDO for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name as it is entirely included in the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms "sapatos" and "pt", 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 disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Furthermore, it is well accepted practice by UDRP panels that a gTLD, such as ".com", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1

of the [WIPO Overview 3.0](#)). For that reason, the Panel accepts not to take the gTLD “.com” into consideration when assessing confusing similarity of the disputed domain name.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 disputed domain name such as those enumerated in the Policy or otherwise. The disputed domain name incorporates the additional terms “sapatos” (which translates to “shoes” in Portuguese) and “pt” (an abbreviation for Portugal), which describe the Complainant’s business. Therefore, the Panel considers that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

According to the Complainant, the Respondent is not associated or connected with the Complainant in any way. The Complainant has not granted the Respondent any license or authorization to use or register any domain name that includes the Complainant’s mark. Furthermore, the Respondent has failed to provide a response to the Complaint, thereby not presenting any information or factors that could potentially justify prior rights or legitimate interests in the disputed domain name. Additionally, there is no evidence that the Respondent has engaged in any legitimate or genuine use of the disputed domain name for non-commercial or bona fide activities. At the time of the Complaint filing, the disputed domain name directed to a website prominently displaying the Complainant’s ALDO mark without any disclaimer as to the lack of relationship with the Complainant, and purportedly offering goods at discounted prices. Also, the Complainant has never authorized the Respondent to offer or sell the Complainant’s products, which strongly suggests that the Respondent had been offering and selling counterfeit products through the website under the disputed domain name. All products on the website were offered for sale at heavily discounted prices, further indicating Respondent’s illegal activity in the form of selling counterfeit goods. These circumstances clearly demonstrate that the Respondent is using the disputed domain name for commercial activity, confirming that the Respondent’s actions cannot be considered legitimate noncommercial use of the disputed domain name.

Panels have held that the use of a domain name for sale of counterfeit goods or/and impersonation can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

In the present case, the Panel notes that the Respondent registered and used the disputed domain name in bad faith. The Complainant, founded in 1972, is a recognized entity with the mark ALDO. The Complainant's ALDO mark should be observed as a mark that is sufficiently distinctive and that enjoys a certain level of reputation based on longstanding use. The Respondent has failed to provide any response to the Complaint and has therefore failed to provide any justification for the registration and use of the disputed domain name.

Given the global recognition of the ALDO brand before the disputed domain name registration, it is implausible that the Respondent was unaware of the Complainant when registering the disputed domain name. The Panel also notes the disputed domain name is similar to the Complainant's domain name <aldoshoes.pt>. The use of the ALDO mark, logo, and product images on the Respondent's website further indicates awareness and intent to confuse users for commercial gain.

At the time of the Complaint filing, the disputed domain name directed to a website prominently displaying the Complainant's mark and purportedly offering the Complainant's goods at discounted prices. The facts that the Complainant never authorized the Respondent to sell its products and the Complainant's branded products were sold at heavily discounted prices, suggesting the Respondent was selling counterfeit goods. Additionally, the Respondent was exploiting the Complainant's reputation to attract customers. These circumstances show that the Respondent's use is for commercial gain, constituting bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity such as sale of counterfeit goods and/or impersonation constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established 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 disputed domain name <aldosapatospt.com> be transferred to the Complainant.

/Petra Pecar/

Petra Pecar

Sole Panelist

Date: June 6, 2024