

ADMINISTRATIVE PANEL DECISION

Aldo Group International GmbH v. Client Care, Web Commerce
Communications Limited

Case No. D2024-1403

1. The Parties

The Complainant is Aldo Group International GmbH, Switzerland, represented by Markmonitor, United States of America ("U.S.).

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

2. The Domain Names and Registrar

The disputed domain names <aldoaustraliaonline.com>, <aldoitaly.com>, <aldoonlineportugal.com>, <aldooutletportugals.com>, <aldoportugalojas.com>, <aldoshoesireland.com>, <aldoshoesromania.com>, <aldosingaporeshoes.com> and <aldoukshoes.com> are 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 April 1, 2024. On April 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 7, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent ("Not disclosed") and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 10, 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 15, 2024.

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 April 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 7, 2024.

The Center appointed Warwick Smith as the sole panelist in this matter on May 13, 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 was established in 1972, in Montreal, Canada. It and its affiliated companies are leading retailers of footwear and fashion accessories, in numerous countries around the world. According to the Amended Complaint, the Aldo Group now has more than 3,000 points of sale in over 100 countries, serving almost 200 million customers and visitors to their stores each year. The Aldo Group's products are offered for sale through Aldo stores, through the website at "www.aldoshoes.com" and through partners' websites, and in physical department stores.

The Complainant is the owner of numerous trade mark registrations worldwide for the mark ALDO. It relies particularly on the following registrations:

- (i) International registration No. 1029684 of the following figurative ALDO mark ("the figurative mark"):

The logo consists of the word "ALDO" in a bold, black, sans-serif typeface. The letters are evenly spaced and have a clean, modern appearance.

This mark was registered on December 8, 2009, and covers goods and services in International Classes 18, 25, and 35.

- (ii) European Union registration No. 009196742 of the word mark ALDO. This mark was registered on February 10, 2015, and covers goods and services in International Classes 3, 9, 14, and 26.
- (iii) International registration No. 1706452 of the word mark ALDO. This mark was registered on November 1, 2022, and covers goods and services in International Classes 9, 35, and 41.
- (iv) Malaysia registration No. 96009590 of the word mark ALDO. This mark was registered on September 18, 2007, and covers goods and services in International Class 18.

The Complainant says that its first ALDO mark was registered more than 25 years ago, and the Complainant has been actively using its ALDO mark for more than 50 years.

The Complainant and its affiliated companies hold a large portfolio of generic Top-Level Domain ("gTLD") and country-code Top-Level Domain names ("ccTLD"), including the gTLDs <aldoshoes.com>, and <aldogroup.com>. Those domain names were registered on February 3, 1996, and they have been continuously used since then in association with the Complainant's ALDO marks. The ccTLDs owned by the Complainant include <aldoshoes.com.my> and <aldoshoes.my> (registered for the Malaysian market on June 30, 2022), <aldoshoes.sg> (registered for Singapore on October 2, 2007), <aldoshoes.it> (registered for Italy on February 8, 2011), <aldoshoes.pt> (registered for Portugal on November 5, 2013), <aldoshoes.ie> (registered for Ireland on January 7, 2016), and <aldoshoes.uk> (registered for the United Kingdom on February 13, 2017)

The disputed domain names were registered on the following dates:

- | | |
|-------------------------------|-----------------|
| (i) <aldooutletportugals.com> | March 14, 2022. |
| (ii) <aldoshoesromania.com> | March 17, 2022. |
| (iii) <aldoshoesireland.com> | March 25, 2022. |

(iv) <aldoaustraliaonline.com>	May 19, 2022.
(v) <aldosingaporeshoes.com>	August 20, 2022.
(vi) <aldoitaly.com>	September 22, 2022.
(vii) <aldoportugalojas.com>	October 14, 2022.
(viii) <aldoukshoes.com>	October 28, 2022.
(ix) <aldoonlineportugal.com>	December 22, 2022.

At the date of the Complaint, five of the disputed domain names resolved to inactive webpages. The record shows that of those five, it appears that two (<aldoshoesromania.com> and <aldoukshoes.com>) have never resolved to active webpages.

The other disputed domain names that now resolve to inactive websites are <aldoitaly.com>, <aldoportugalojas.com>, and <aldooutletportugals.com>. However, the Complainant produced historical webpages from the Wayback Machine showing that in February 2023 active websites were either operating or under construction at <aldoitaly.com> and <aldoportugalojas.com>, and that on March 18, 2023 an active website was operating at <aldooutletportugals.com>).

The website at <aldoitaly.com>, as it stood on February 23, 2023, prominently featured what appears to be the Complainant's ALDO word mark, in upper case black lettering near the top of the first webpage. The header at the top of each webpage was: "Vendita scarpe Aldo. Aldo Pompe I Aldo Italia", which may be broadly translated from Italian to English as: "Sale of Aldo shoes and pumps I Aldo Italy". Full page photographs of various items of footwear and accessories were displayed on the website, with list prices in Euros shown crossed out below the photographs and replaced with significantly reduced prices.

A copy of the website at <aldoportugalojas.com>, as it stood at 27 February 2023, was reproduced on the Wayback Machine only as a series of click-on links in the Portuguese language (but with a "translate to English" facility), and the Panel was unable to access individual webpages by clicking on these links. It may be that the website had not been fully built at the time of its capture on the Wayback Machine. However, it was possible to see fairly clearly the purpose to which the website was intended to be put. First, a Cambridge Dictionary translation provided by the Complainant shows that the expression "loja" in Portuguese means "shop", or "store" in English, so that Portuguese speakers would expect that any website at this disputed domain name would be an online store selling Aldo products, directed to Portuguese speakers. Consistent with that initial impression, the click-on links all appeared to be concerned with footwear (shoes, boots, sandals, etc.) for men and women, or with accessories such as wallets and handbags, and many of them consisted of the word "Aldo", followed by a description of the particular ALDO product that would be featured - for example, "Aldo Aurellane – Women's Ankle Boots...".

The Wayback Machine capture of the website at <aldooutletportugals.com> as at March 18, 2023 also featured on the first page a very prominent reproduction of what appears to be the Complainant's ALDO word mark, in upper case black lettering against a white background. The header on each webpage was "Sapato Aldo Portugal – Aldo shoes Lojas I Aldo PT". The website featured numerous large photographs of shoes and other footwear products, above list prices in Euros crossed out and replaced with significantly reduced Euro prices.

The disputed domain names <aldoonlineportugal.com>, <aldoaustraliaonline.com>, <aldosingaporeshoes.com>, and <aldoshoesireland.com>, all resolve to active websites which are materially similar to the previously-active websites at the disputed domain names that are described above. They all feature photographs of ALDO-branded footwear, accessories, jewellery and other products, and all prominently display on the first webpage, in black uppercase lettering, an ALDO mark that appears to be identical to the Complainant's ALDO word mark.

The page headers on each of these four (currently active) websites give the clear impression that the sites are genuine ALDO online stores, selling ALDO-branded goods. The webpage header on the site at <aldoonlineportugals.com> reads: "ALDO Outlet Online Portugal Sapatos ALDO SALDOs Lisboa", while the header on the site at <aldoaustraliaonline.com> reads: "Aldo Australia Online Store – Aldo Shoes Australia

Online Sale". The webpage on the site at <aldoshoesireland.com> has the page header "Aldo Ireland – Aldo Shoes, Bags On Sale | Aldo Outlet Online Store", and that message is reinforced by the prominent statement on the first page of the website: "'Aldo Shoes Ireland. Shop Clearance Sale ALDO Shoes & Bags Now!...". The webpage header on the site at <aldosingaporeshoes.com> reads: "Aldo Singapore | Buy Aldo Shoes, Boots, Sandals and Bags Online. These websites all consist substantially of pages of photographs of ALDO products, and with the exception of the site at <aldosingaporeshoes.com>, the websites appear to be "sale" websites, with marked down prices.

The website at <aldosingaporeshoes.com> is different in one other relevant respect. On one page of the website, the web designer appears to have copied the exact shape of the figurative mark, with the letters "d" and "o" in the copy appearing to be elongated, or "flattened", at the end of the mark. This reproduction appears, on one page of this website, in white lettering, superimposed over photographs of women wearing ALDO footwear or carrying an ALDO bag.

With the Amended Complaint, the Complainant produced a schedule listing almost 250 cases decided under the UDRP, in which the Respondent was named as a respondent. All of the listed complaints are said to have been decided in favor of the complainants. These complaints were initiated within a period of about three years, and many are said to have involved multiple domain names and the targeting of well-known footwear or apparel companies.

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 names.

Specifically, the Complainant contends that the disputed domain names are all confusingly similar to the ALDO mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of any of the disputed domain names, and that the Respondent registered, and has been using, the disputed domain names in bad faith.

The Respondent is not affiliated with the Complainant in any way, and has not been authorized by the Complainant to use its ALDO mark or logo, or to register a domain name incorporating that mark.

To the extent the Respondent may actually be offering goods or services for sale at the websites to which any of the disputed domain names have resolved, the Complainant says that the Respondent has not been acting bona fide. The Respondent has been using the Complainant's well-known ALDO mark and logo in the disputed domain names, and on the websites to which some of them resolve, without any license or other authorization from the Complainant, in an attempt to impersonate the Complainant and create the false impression that the websites to which the disputed domain names have resolved are the Complainant's websites. The heavily discounted prices offered on most of the active websites also raise strong doubts that the goods being sold may be counterfeit products.

Even if the goods offered on the websites to which some of the disputed domain names resolve offer genuine ALDO products, the Respondent could not claim any rights or legitimate interests as a reseller, repairer or distributor of those goods, as the websites at the disputed domain names do not accurately and prominently disclose the Respondent's relationship (none) with the Complainant as the owner of the ALDO mark¹. Furthermore, the Respondent has attempted to monopolize the market by registering domain names containing the Complainant's ALDO mark along with the country names Portugal, Australia, Italy, Singapore, Ireland, Romania, and the United Kingdom, with generic terms that describe the Complainant's field of

¹*Oki Data Americas, Inc. v ASD Inc.*, WIPO Case No. D2001-0903.

business – “online”, “shoes”, and “outlet”. As a result, the Complainant is prevented from registering the domain names to use its ALDO mark in those country markets for local web presentation in various combinations with the terms “online”, “shoes”, or “outlet”.

On the issue of registration and use of the disputed domain names in bad faith, the Complainant contends that the Respondent could not credibly claim that it was unaware of the Complainant and its ALDO marks when the disputed domain names were registered. The Complainant’s mark is well known, and has been used globally for over 50 years. And the registration of the disputed domain names occurred more than 25 years after the registration of the Complainant’s domain name, <aldoshoes.com>, at which it operates its official website. The use of the Complainant’s logo on the websites at the disputed domain names, and names and images of the Complainant’s products, also confirm that the Respondent had the Complainant in mind when the disputed domain names were registered. The Respondent deliberately chose the disputed domain names and registered them in bad faith, to facilitate the creation of online stores offering products under the ALDO trade mark, in order to make a commercial gain and to disrupt the activities of the legitimate trade mark rights holder.

The Complainant contends that the disputed domain names have also been used in bad faith. The Respondent’s previous actions demonstrate that the registrations of the disputed domain names were made primarily with the intention to attract, for commercial gain, Internet users to the websites at the disputed domain names by creating a likelihood of confusion with the Complainant’s ALDO mark as to the source, sponsorship, affiliation or endorsement of the website or a product or service on the website (the example of bad faith registration and use described at paragraph 4(b)(iv) of the Policy).

In respect of those of the disputed websites that do not resolve to an active website, the Complainant relies on the line of cases decided under the Policy² that have found that mere passive holding of a domain name may constitute bad faith use in certain circumstances. It contends that those circumstances are present in this case.

Overall, the clear inference from the Respondent’s operations, is that it has been trying to capitalize on, or take advantage of, the fame of the Complainant’s ALDO mark.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural issue - consolidation of claims for transfer of multiple domain names

The Complainant raised the issue of consolidation of its complaints relating to the nine individual disputed domain names. In the Panel’s view, no order for consolidation is necessary. Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. That is the case here, where the Respondent is registered as the owner of all of the disputed domain names.

² Starting with *Telstra Corporation Ltd v Nuclear Marshmallows*, WIPO Case No. D2000-003.

6.2. What the Complainant must establish

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

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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.

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 trade mark and the disputed domain name (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7).

In this case, the Complainant has shown rights in respect of trade marks or service marks (including in respect of the Complainant's ALDO word mark) for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.2.1).

The entirety of the ALDO word mark is reproduced within each of the disputed domain names, and the Panel finds that that mark is recognizable within each of them. Accordingly, the disputed domain names are confusingly similar to the Complainant's ALDO mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.7).

Although the addition of other terms in the disputed domain names (in this case, the countries Australia, Portugal, Italy, Singapore, Ireland, Romania and the United Kingdom (abbreviated to "uk"), and common English expressions such as "shoes", "outlet" and "online") may bear on the assessment of the second and third elements in some cases, the Panel finds the addition of those terms does not prevent a finding of confusing similarity between the disputed domain names and the Complainant's ALDO word mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.8).

The Panel finds the first element of the Policy has been established in respect of all of the disputed domain names.

B. Rights or Legitimate Interests

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, and for the reasons set out below, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed 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 disputed domain names such as those enumerated in the Policy or otherwise.

Paragraph 4(c) of the Policy provides a list of circumstances that may demonstrate that a respondent has rights or legitimate interests in a disputed domain name. None of those circumstances apply in this case.

First, there is nothing to suggest that the Respondent might be commonly known by any of the disputed domain names (the circumstance addressed at paragraph 4(c)(ii) of the Policy). Secondly, to the extent the disputed domain names have been used, they appear to have been used for commercial purposes. The Respondent therefore has no safe harbor under paragraph 4(c)(iii) of the Policy, which applies when a respondent is making a legitimate noncommercial or fair use of a domain name, without intent for commercial gain to misleadingly direct customers or to tarnish the complainant's mark.

Thirdly, the circumstances do not appear to come within paragraph 4(c)(i) of the Policy, under which a respondent may establish a right or legitimate interest by showing that, before it had notice of the dispute, it had used the domain name, or made demonstrable preparations to use it, in connection with some bona fide offering of goods or services. On the record in this case, it appears that the Respondent has deliberately selected the disputed domain names incorporating the Complainant's well-known ALDO mark with a view to creating websites at the disputed domain names that give the false impression that they are the Complainant's websites. That is apparent not only from the use of the Complainant's well-known ALDO word mark in all of the disputed domain names, but also from (i) the prominent use of what appears to be a reproduction of that mark on many of the active websites at the disputed domain names, (ii) the close reproduction of the figurative mark on the website at <aldosingaporeshoes.com>, (iii) the absence of any disclaimer on the active websites advising Internet users that the websites are not owned or authorized by the Complainant, (iv) the display on the active websites of copies of what appear to be the Complainant's ALDO-branded products, with the names of specific products often being preceded by the expression "Aldo", and (v) the use of the various country names in each of the disputed domain names to create the (false) impression that any website at that disputed domain names will be a genuine website of the Complainant, tailored for the market in the particular country named in the disputed domain name.

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 Complainant relies on Paragraph 4 (b) (iv) of the Policy, which provides:

Under paragraph 4(b) of the Policy, the following circumstances, without limitation, are deemed (if found by the Panel to be present) to be evidence of the registration and use of a domain name in bad faith.

- (iv) By using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the holder's website or location or of a product or service on the holder's website or location.

In the Panel's view, this paragraph of the Policy clearly applies to each of the disputed domain names that have been linked to active websites. For the reasons advanced by the Complainant, the Panel accepts that the Respondent could not credibly have contended that it was unaware of the Complainant and its well-known ALDO mark when the disputed domain names were registered, and the apparent reproduction of that mark on each of the websites at these disputed domain names, with what appear to be copies of the Complainant's products and frequent references to the word "Aldo" to describe the footwear purportedly offered for sale without any prominent or accurate disclaimer of the lack of the relationship with the Complainant, removes any doubt that the Respondent was targeting the Complainant's reputation in its ALDO footwear and accessories when it registered and later used these disputed domain names. Nor can there be any doubt that the Respondent did this with a view to commercial gain (whether from sales of the

products offered for sale on these websites, if the websites in fact offer the featured goods for sale, or from phishing or similar *mala fide* activities if there are no goods available for sale on these websites). The circumstances fall squarely within paragraph 4(b)(iv) of the Policy - in each case, the Respondent has attempted to attract, for commercial gain, Internet users to the website at the disputed domain name, by creating a likelihood of confusion with the Complainant's ALDO mark as to the source, sponsorship, affiliation or endorsement of the website, or of the products that appear to be offered for sale on the website.

This finding applies to the following disputed domain names, at all of which the Respondent created active websites:

- (i) <aldoitaly.com>
- (ii) <aldooutletportugals.com>
- (iii) <aldoonlineportugal.com>
- (iv) <aldoaustraliaonline.com>
- (v) <aldosingaporeshoes.com>
- (vi) <aldoshoesireland.com>

The position is different with the disputed domain names <aldoshoesromania.com> and <aldoshoesuk.com>, where the Respondent does not appear to have made any active use of the disputed domain names. It might be thought that there can be no bad faith use of a disputed domain name that has not been actively used.

However, panels have found in numerous cases that the non-use of a domain name (including a blank or "coming soon" page) may not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds that the non-use of the disputed domain names <aldoshoesromania.com> and <aldoshoesuk.com> does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement) [WIPO Overview 3.0](#), section 3.3.) Having reviewed the available record, the Panel is satisfied that a finding of bad faith passive holding of these two disputed domain names is appropriate. First, the Complainant's ALDO trade mark is distinctive of its footwear and accessories products, and is very well known around the world. Secondly, the Respondent has not submitted any response, and the composition of these two disputed domain names is such that it would be difficult to conceive of any use to which they might be put that would not result in confusion. Many Internet users would mistakenly assume that any websites established at these disputed domain names would be owned or authorized by the Complainant, and would purportedly sell the Complainant's ALDO shoes. Having regard to those factors, the Panel is satisfied that the "passive holding" doctrine applies, and that these two disputed domain names have been registered and used by the Respondent in bad faith.

The remaining disputed domain name is <aldoportugalojas.com>, where it is not clear whether an active website was fully built at the site (although it is clear from the February 2023 capture of the site on the Wayback Machine that this was intended to be another website on which the Respondent intended to impersonate the Complainant, thereby taking advantage of the Complainant's substantial reputation in its well-known ALDO mark). In the Panel's view, the partly constructed website is either a sufficient "use" of this disputed domain name to bring the circumstances within paragraph 4(b)(iv) of the Policy, or if it is not, the Respondent's registration of this disputed domain name is caught by the passive holding doctrine discussed above. Either way, the conclusion must be that this disputed domain name was also registered, and has been used by the Respondent, in bad faith.

In view of the findings made by the Panel as set out above, it is not necessary to refer to the various other submissions made by the Complainant.

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 names <aldoaustraliaonline.com>, <aldoitaly.com>, <aldoonlineportugal.com>, <aldooutletportugals.com>, <aldoportugalojas.com>, <aldoshoesireland.com>, <aldoshoesromania.com>, <aldosingaporeshoes.com> and <aldoukshoes.com> be transferred to the Complainant.

/Warwick Smith/

Warwick Smith

Sole Panelist

Date: May 27, 2024.