

WIPO Arbitration and Mediation Center  
Zaak-/rolnummer: DNL2015-0034  
Datum: 21 september 2015

### 1. The Parties

The Complainant is Hugo Boss Trade Mark Management GmbH & Co KG of Metzingen, Germany, represented by Annelot Sitsen and Lars Bakers of Bingham Law / Bingham Advocaten, the Netherlands.

The Respondent is [persoonsnaam] of Stadtbergen, Germany.

### 2. The Domain Name and Registrar

The disputed domain name <hugobossoutlet.nl> (hereafter the “Domain Name”) is registered with SIDN through Registrar.eu.

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 23, 2015. On June 23, 2015, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name. On June 25, 2015, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 30, 2015. In accordance with the Regulations, article 7.1, the due date for Response was July 20, 2015. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 21, 2015. On July 31, 2015, the Center sent an email communication to the Parties noting that the Notification of Complaint and Commencement of Proceedings was not notified to the Respondent at the correct email address. The Center re-notified the said documents and allowed the Respondent a period of seven days in which it may indicate whether it wishes to submit a Response. The Center did not receive any communication from the Respondent by the due date. Accordingly, the Center notified the Parties of the commencement of the Panel appointment process on August 10, 2015.

The Center appointed Wolter Wefers Bettink as the panelist in this matter on August 14, 2015. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

### 4. Factual Background

The Complainant has registered a number of trademarks, including:

- International trademark registration HUGO BOSS, registered on April 10, 1987 (No. 513257) designating 35 states, including Germany;
- International device mark registration BOSS HUGO BOSS, registered on October 3, 1987 (No. 516345) designating 43 states, including Germany;

- International device mark registration BOSS HUGO BOSS, registered on July 20, 1993 (No. 606620) with country of origin, designating 36 other states. These trademarks are hereafter together referred to as the Trademarks.

The Domain Name has been registered on November 7, 2014.

## 5. Parties' Contentions

### A. Complainant

The Complainant submits that the Trademarks are well-known both within and outside the Benelux. Furthermore, the Complainant states that it also uses the name Hugo Boss as a trade name in the Netherlands through the Dutch companies Hugo Boss Benelux Retail B.V., Hugo Boss Benelux B.V., Hugo Boss Holding Netherlands B.V. and Hugo Boss International B.V. According to the Complainant, the Domain Name is confusingly similar to the Trade Marks and the trade name Hugo Boss, since the words Hugo Boss are fully incorporated into the Domain Name, while the term "outlet" does not add anything to the distinctive element "Hugo Boss".

The Complainant submits that the website under the Domain Name has been blocked by the hosting provider upon request of the Complainant. Before such blocking, the Complainant alleges, the website prominently displayed the BOSS HUGO BOSS trademark, as well as pictures of clothing products which were offered for sale under the HUGO BOSS trademark.

According to the Complainant, the Respondent does not have a right or legitimate interest in respect of the Domain Name, since this prominent use of the Trademarks on the website in connection with the products offered for sale and the contact details at the bottom wrongly created the impression that the website was an online outlet store of or connected to the Complainant. Furthermore, the Complainant states that it has the strong suspicion – based on previous experience with similar websites – that the products offered for sale on the website under the Trade Marks are in fact counterfeit products.

According to the Complainant, based on the above the Respondent had no other goal with the registration and use of the Domain Name than to block the Domain Name, mislead the consumer and falsely create the impression that the corresponding website was an outlet of or connected to the Complainant offering genuine products of the Complainant. Therefore, the Complainant submits, the Respondent registered and used the Domain Name in bad faith.

### B. Respondent

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

## 6. Discussion and Findings

The burden of proof for the three elements under the Regulations is on the Complainant. The Respondent filed no Response, so that the Complainant's claims were uncontested as such. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or fact.

In this regard the Panel notes that under the UDRP, as set out in the WIPO Overview of WIPO Panel views on selected UDRP Questions, Second Edition ("WIPO Overview 2.0")<sup>1</sup> paragraph

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<sup>1</sup> The mechanism of the Regulations is in part comparable to the Uniform Domain Name Dispute Resolution Policy ("UDRP"). The Panel will refer to the [WIPO Overview 2.0](#) where applicable.

4.6, the Respondent's default does not automatically result in a decision in favor of the Complainant:

*"The complainant must establish each of the three elements required by paragraph 4(a) of the UDRP. Although a panel may draw appropriate inferences from a respondent's default (e.g., to regard factual allegations which are not inherently implausible as being true), paragraph 4 of the UDRP requires the complainant to support its assertions with actual evidence in order to succeed in a UDRP proceeding." In addition, as set out in paragraph 4.7 of WIPO Overview 2.0, the standard of proof under the UDRP requires that "an asserting party would typically need to establish that it is more likely than not that the claimed fact is true. Conclusory statements unsupported by evidence which merely repeat or paraphrase the criteria or scenarios under paragraphs 4(a), (b), or (c) of the UDRP would typically be insufficient."*

The evidence provided by the Complainant is limited. Supporting evidence of the Respondent's alleged lack of rights and legitimate interest and bad faith in registration or use of the Domain Name is limited to a one page screen print of (the home page of) a website that was allegedly at some stage connected to the Domain Name. The Panel notes that this screen print does not show the date on which it was made, nor has supporting evidence been provided, such as a sworn affidavit from a company official or an official statement from a bailiff, that this is a screen print of the (former) website of the Respondent. When the Panelist checked the website under the Domain Name, it found a parking page with hyperlinks, very different from the website on the screen print, which the Complainant did not discuss in the Complaint.

Furthermore, several assertions by the Complainant, which may be relevant for one or more of the elements it must prove, are not or insufficiently supported by evidence. In particular, the Complainant asserts that the screen print shows (a) pictures used in the banner on top of the website; (b) the use of "HUGO BOSS pictures" (c) that counterfeit products are sold; (d) contact details. According to the Complainant, these elements together create a false impression that the website is connected to or approved by the Complainant. However, the screen print in Annex 3 of the Complaint, to which the Complainant refers, contains no information to support any of these four points.

Therefore, the Panelist will decide this matter on the basis of the remaining allegations and the thin evidence provided, as well as UDRP case law which may serve as precedent.

#### *A. Identical or Confusingly Similar*

The Complainant has shown that it has rights in the Trade Marks. The Trade Marks consist of (or include) the name "Hugo Boss", which is incorporated in its entirety in the Domain Name. The addition of the country code Top-Level Domain ("ccTLD") ".nl" does not change the overall impression, as the applicable top-level suffix in the domain name is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see WIPO Overview 2.0, paragraph 1.2). The addition of the word "outlet" is descriptive and does not alter the overall impression, as HUGO BOSS clearly is the dominant element in the Domain Name. Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks.

#### *B. Rights or Legitimate Interests*

The Complainant has to make out a *prima facie* case that the Respondent does not have rights or legitimate interests in the Domain Name (WIPO Overview 2.0, paragraph 2.1).

The Complainant asserts that the website connected to the Domain Name prominently displayed the BOSS HUGO BOSS trademark, as well as pictures of clothing products which were offered for sale under the HUGO BOSS trademark, which wrongly creates the impression that the website is an online outlet store of or connected to the Complainant.

The Panel notes that the domain name <hugobossoutlet.nl> may indeed create the impression of being the website of a reseller or distributor of the Complainant.

As set out in paragraph 2.3 of the WIPO Overview 2.0, a reseller or distributor can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name at issue if certain requirements are met. The leading case on this point is *OKI Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903. Under *OKI Data* case in order for the offerings of the Respondent on its website under the Domain Name to be characterised as *bona fide*, the following requirements must be met:

- a) the Respondent must actually be offering the goods or services at issue;
- b) the Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods;
- c) the site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents;
- d) the Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

The Complaint does not expressly reflect upon this decision, and the Panelist will discuss this on the basis of the statements submitted and the evidence provided. On the basis of the screen print, it must be assumed that elements a, b and d of the *OKI Data* criteria are fulfilled, but element c is not, as the screen print of the website does not contain any information on the relationship with the Complainant. Moreover, in view of the prominent use of the Trademarks (including a device mark) in connection with the goods (fashion products) this may in the Panel's view create the impression that the website is that of an official distributor.

In view of all of the above, the Panel concludes that the Complainant on balance has made out the *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name. As no Response has been submitted, the Panel concludes that the Respondent has no rights or legitimate interests in the Domain Name.

### *C. Registered or Used in Bad Faith*

The Complainant has to show that the Domain Name was registered or is being used in bad faith.

The Complainant's case in this respect is based upon the same assertions and evidence referred to in paragraph 6B.

Based on the information and the documents provided by the Complainant, the Panel assumes that at the time of registration of the Domain Name the Respondent was or should have been aware of the Trademarks. First, the registration date of the Trademarks lie more than 37 years before the registration date of the Domain Name. Second, one of the designated states for the registration of the Trademarks is Germany, the state of domicile of the Respondent. Thirdly, the name "Hugo Boss", which is incorporated in its entirety in the Domain Name, is not a name that a person wishing to register a domain name would accidentally think of. In addition, if the Respondent had not actually been aware of the Complainant or the Trademarks, a small effort on its part would have revealed the Complainant's rights to the Trademarks. A simple online trade mark register search would have informed the Respondent of the existence of the Trademarks (and many other trademarks of the Complainant incorporating the name "Hugo Boss").

Taking into account that the Respondent has not filed a Response to counter the submissions of the Complainant, the Panel on balance concludes that the Domain Name has been registered and used in bad faith.

## 7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the disputed domain name, <hugobossoutlet.nl>, be transferred to the Complainant.

Wolter Wefers Bettink

Panelist

Date: September 21, 2015