Decision for dispute CAC-UDRP-100872

Case number	CAC-UDRP-100872
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Domain names	lorropiana.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Loro Piana S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Roma S.p.A.

Respondent

Organization	PAPA COULSON

IDENTIFICATION OF RIGHTS

Presently, Loro Piana owns more than 700 trademark registrations worldwide, including in the United Kingdom where the Respondent appears to be located, consisting of, or containing, the terms LORO PIANA and more that 300 domain names identical to LORO PIANA in all existing ccTLDs and in most of the available gTLDs.

The disputed Domain Name <lorropiana.com> was created on July 4, 2014 and is inactive.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Loro Piana S.p.A. (hereinafter “Loro Piana“ or the “Complainant“) is the world’s foremost cashmere manufacturer and the largest single buyer of the finest wool. Its products include sportswear/leisurewear for men, women, and children; knitwear, outerwear, blankets and cushions, shirts, ties, trousers and overcoats, silks, linens, carpets, accessories, bags, and small leather goods; and fabrics for furnishing and interiors. The Complainant also provides its clients with a unique service of Made to Measure Services.

Loro Piana was established in 1924 by Pietro Loro Piana, at Corso Rolandi, in Quarona (Italy), which is still the location of Group’s headquarter today.

Already in the 40’s, the Complainant acquired a reputation as a supplier of fine fabrics for the “haute couture” industry which was a growing sector in the post-war period. In the same decade the Group rapidly entered into the international market exporting its products in Europe, Japan and America. In the following years, the Group became well-known in the sector of luxury goods.

The Complainant sells its products all over the world in many different ways, i.e. through a network of directly operated stores, through points of sales in the most prestigious department stores, and inside luxury multi-branding clothing stores.

In United Kingdom, which is where the Respondent is located, the Complainant sells its products in London - at Harrods, and in its shops of Sloane Street, Royal Exchange, New Bond Street and in several stores located throughout the UK territory.

Moreover, LORO PIANA goods are conspicuously advertised on British distributors, designers and agencies’ websites, among which Fox Linton; Becket & Trobb.

Finally, LORO PIANA goods are sold on-line at, among others, Yoox.com , MyPorter.com, Shopstyle.com, Bergdofgoodman.com, Neimanmarcus.com.

Since the 80’s, Loro Piana began sponsoring several sport activities, particularly in the field of horseracing and sailing.

The Loro Piana Regatta is one of the most famous events organized and sponsored by the Complaint. This regatta involves different locations in different countries, such as the Caribbean Superyacht Regatta which is sanctioned by the Royal British Virgin Islands Yacht Club (RBVIYC) as the National Authority to ISAF. This event is well-known and is advertised on several British websites and worldwide.

It appears from the above, that the Complainant invested considerable resources (both economic and human) to build its reputation and that of its LORO PIANA trademark.

The reputation of the LORO PIANA trademarks has already been ascertained by previous UDRP Panelists (see for instance the WIPO Decisions in Cases No. D2011-1871, No. D2012-1114, No. D2011-1871, No. D2009-0085).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name <lorropiana.com> is almost identical to its trademarks and domain names since it reproduces the sign LORO PIANA entirely, with the mere addition of a second "r".

The visual and phonetic comparison between the trademark LORO PIANA and the disputed domain name <lorropiana.com> shows a clear likelihood of confusion.

According to the Complainant, the case at issue should clearly be considered a “typosquatting” case where the disputed domain name is a slight misspelling of a registered trademark. In fact, the <lorropiana.com> domain name comprises the Complainant’s trademark LORO PIANA with a single misspelling of an element of the mark: a double consonant “r” in the middle of the sign. Also, the disputed domain name is virtually identical to Complainant’s domain name <loropiana.com>. As a result, this is an example of confusing similarity and/or virtual identity brought about through easily made typing errors made by an Internet user: rather than typing the word “loropiana” to visit Complainant’s website, an Internet user could easily type a double “r” and be diverted to a different website.

The practice of “typosquatting” has been consistently regarded in previous UDRP decisions as creating domain names confusingly similar to the relevant mark.

The Complainant claims that the Respondent is not using the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services. More specifically, the domain name <lorropiana.com> does not lead to an active website.

Furthermore, to the best of the Complainant's knowledge, the Respondent did not make any demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

Moreover, the Complainant contends that the Respondent is not commonly known by the name LORO PIANA. A trademark search conducted on the Respondent's name (among the trademarks with effect in United Kingdom) did not reveal any trademark in the Respondent's name. On the contrary, the only LORO PIANA existing trademarks are those in the Complainant's name.

As a matter of fact, the name LORO PIANA corresponds to the surname of the founder of the Complainant.

Finally, the Complainant claims the Respondent is not making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. As mentioned above, the disputed domain name does not lead to an active website. The fact that the disputed domain name does not resolve to an active website cannot amount to a legitimate or fair use of the domain name, considering that the conflicting domain name is a misspelling of the Complainant's earlier well-known trademark.

For all reasons mentioned above, and in view of the fact that the Complainant never authorised the Respondent to register a domain name practically identical to its well-known trademarks, the Complainant believes to have sufficiently demonstrated that the Respondent lacks any rights or legitimate interests the domain name at issue, in compliance with Paragraph 4(a)(ii) of the Policy.

The Complainant contends that given the extensive and longstanding use of the LORO PIANA trademark in many jurisdictions, including in the United Kingdom, that is the country of the Respondent, and considering that LORO PIANA is a fanciful trademark corresponding to the surname of the founder of the Complainant, it is obvious that the Respondent was aware of the Complainant's well-known trademark prior to registering the disputed domain name.

Therefore the Respondent registered the <lorropiana.com> domain name in bad faith.

As far as use in bad faith is concerned, the Complainant points out that the <lorropiana.com> domain name does not resolve to an active website. However, the circumstance that a domain name is not currently used and is inactive does not exclude bad faith

The Complainant relies on Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 <telstra.org> to assert that it is not possible to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, as a proof of bad faith use.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

In view of the Respondent's failure to submit a Response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules.

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

(1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(2) the Respondent has no rights or legitimate interests in respect of the domain name; and

(3) the domain name has been registered and is being used in bad faith.

RIGHTS

The disputed Domain Name fully incorporates the LORO PIANO trademark and it is therefore confusingly similar to the trademark LORO PIANO in which the Complainant has long established and reputed rights based on a number of registrations valid throughout the world and in China.

The addition of a "r" does not have any impact on the likelihood of confusion. It constitutes typosquatting. There is a consensus view that a domain name which contains an obvious misspelling of a trademark normally will be found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principal component of the domain name.

Therefore, the Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Paragraph 4(c) of the Policy provides for the Respondent to establish rights or legitimate interests in a disputed domain name by demonstrating:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent did not submit a Response to the Complaint and has not provided any evidence or circumstances required to establish that it has rights or legitimate interests in the disputed domain name, according to Paragraph 4(c) of the Policy.

There is no evidence that the Respondent makes non-commercial and fair use of the domain name in dispute without intention to divert consumers, as addressed under paragraph 4(c) of the Policy.

Furthermore, the Respondent does not own any trademark in the United Kingdom and has no connection of affiliation with the Complainant, and the latter asserts it has not consented to the Respondent’s use of the trademark in the disputed domain name.

The evidences submitted by the Complainant adequately support its assertions.

Therefore, the Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by the Panel to be evidence of the bad faith registration and use of a domain name. It provides that:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or the Respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

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

The Respondent has registered the Infringing Domain Name in bad faith because it was registered with the knowledge of the Complainant’s rights in the LORO PIANO trademark. In the Panel’s view, the Respondent must have been aware of the rights on the prior trademark LORO PIANO when registering the disputed Domain Name.

Given the reputation of the trademark LORO PIANA, it is not conceivable that any plausible active use of the disputed Domain Name by the Respondent would not be illegitimate.

Therefore, the Complainant has, to the satisfaction of the Panel, shown that the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Respondent has registered and used a domain name that is identical to the Complainant’s trademarks, in respect of which the Respondent has no rights or legitimate interests and which is registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **LORROPIANA.COM**: Transferred

PANELLISTS

Name	**Marie Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2015-01-05