Decision for dispute CAC-UDRP-101583

Case number	CAC-UDRP-101583
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Domain names	philipppleint-shirt.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Name	Philipp Plein

Complainant representative

Organization	Barzano&Zanardo Milano S.p.A.

Respondent

Name	Yuriy Shi

OTHER LEGAL PROCEEDINGS

The panel is not aware of any other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

- EU Registration No. 012259503 PHILLIPP PLEIN (fig), filed on October 28, 2013 and registered on March 26, 2014, for goods in classes 3, 14, 18, 20, 21, 24, 25, 28;

- EU Registration No. 002966505 Philipp Plein, filed on December 6, 2002 and registered on January 21, 2005 for goods in classes 3, 14, 18, 20, 21, 24, 25, 28.

FACTUAL BACKGROUND

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

I. The Complainant

The Complainant is the German fashion designer Philipp Plein, founder of the eponymous brand. Currently, Philipp Plein is universally recognized as a leading brand in the luxury fashion industry (for more information on the Complainant’s activities,

please <world.philipp-plein.com>).

The Complainant participates to the most important fashion shows around the world (Milan, Paris, New York, among others) and its advertising campaigns are universally renowned to be unique and very impacting.

The market has applauded the Complainant's fashion collections, and the world of PHILIPP PLEIN is enjoying a phenomenal success today with showrooms all over the world: more than 36 mono-brand stores, over 500 retail clients worldwide, China and Honk Kong included.

Philipp Plein runs at a double digit rate of expansion, and currently has a turnover of over one hundred million Euro. According to Franca Sozzani, historic editor in Chief of Vogue Italia, "Philipp Plein is unique because he has a joy of life. He doesn't want to be a fashionista, he makes fashion because he loves women. This is a specific, special attitude because he is one of the few".

Philipp Plein has concluded several sponsorship agreements, with among others, AS Roma (one of the most important Italian soccer teams), Mauro Icardi, (Inter's Milan striker) and Nico Hulkenberg, the Formula one racer.
Due to its longstanding use, and the huge promotional and advertising investments, the PHILIPP PLEIN trademark is certainly well-known.

The Complainant is active on several social networks, such as Facebook, Twitter and Instagram.

II. The Respondent

The disputed domain name was registered on November 26th, 2016, in the name of Yuriy Shi and currently redirects to a website offering for sale alleged Philipp Plein items and displaying the Complainant's well known trademarks.

The Complainant challenged the disputed domain name, by addressing cease and desist letters to the Registrant of the domain name. It is significant noting that the Respondent did not reply to any of the above-mentioned letters.

III. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

Among the various Philipp Plein formative trademarks, the Complainant is the owner of the following:

- International Registration No. 1098038, extended, among others, to USA, of October 5t, 2011, for goods in classes 14, 18, 20, 21, 24, 25 and 28;

- EU Registration No. 012259503, filed on October 28, 2013 and registered on March 24, 2014, for goods in classes 3, 14, 18, 20, 21, 24, 25, 28;

-- Philipp Plein EU Registration No. 002966505, filed on December 6, 2002, and registered on January 21, 2005, for goods in classes 3, 14, 18, 20, 21, 24, 25, 28.

First, the mere fact that a domain name wholly incorporates the Complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy (see Six Continent Hotels, Inc. v. The Omnicorp, WIPO Case No. D2005-1249 and Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903).

Furthermore, the addition of generic and descriptive words, such as "t-shirt", rather than excluding a similarity with the earlier well-known Philipp Plein trademark, increases the likelihood of confusion, since the t-shirts are items generally sold through e-commerce platforms or through clothing shops. It is clear that the combination between the well-known Philipp Plein mark and such generic word, gives the idea that the disputed domain name is an on-line point of sale of Philipp Plein goods, in particular t-shirts.

In this regard, previous panels have established that domain names consisting of generic words, such as “clearance”, “store”, etc., combined with the well-known trademark Philipp Plein, are likely to increase confusion among customers.

Among the several decisions, we quote the most recent one, i.e., Case No. D2016-2617, Philipp Plein v. Li Ning.
Finally, the addition of a gTLD such as ".com" in a domain name is technically required. Thus, it is well established that such element may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see Proactiva Medio Ambiente, S.A. v. Proactiva, WIPO Case No. D2012-0182).

Therefore, the disputed domain name is confusingly similar to the earlier Philipp Plein well-known trademarks, and the first requirement under para. 4 (a)(i) of the Policy and of para. 3(b), (viii), (b)(ix)(1) of the Rules is satisfied.

B. The Respondent has no rights or legitimate interests in respect of the domain name;

According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent’s rights or legitimate interests in respect of the domain name lies with the Complainant. It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for Complainant to produce a prima facie evidence in order to shift the burden of production to Respondent. See, e.g., Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Audi AG v. Dr. Alireza Fahimipour, WIPO Case No. DIR2006-0003.

In the present case, the Complainant denies that the Respondent is an authorized dealer, agent, distributor, wholesaler or retailer of Philipp Plein. In fact, the Complainant has never authorized Mr. Yuriy Shi to include its well-known trademark in the disputed domain name, nor to make any other use of its trademark in any manner whatsoever. The Complainant also confirms that it is not in possession of, nor aware of the existence of, any evidence tending to demonstrate that the Respondent is commonly known by the disputed domain name, as individual, business, or other organization.

Moreover, to the best knowledge of the Complainant, Mr. Yuriy Shi does not own Philipp Plein formative trademarks, which would grant rights on the disputed domain name.

In light of these considerations, the Complainant excludes that the Respondent is commonly known by the disputed domain name under Art. 4(c)(ii) of the Policy.

Currently, the Respondent is using, without any authorization, the Philipp Plein wordmark and figurative trademark in order to offer for sale clothing, footwear and other items. It is very significant noting, that the Respondent is using the same Official Philipp Plein’s namings in order to distinguish the items (among others "BEAVER CREEK" and “PREDATOR”).

Furthermore, the pictures of the items displayed in the fake website are pictures of original Philipp Plein garments, which have been clearly taken from the official website; this of course is a clear violation of the Complainant copyright.

It is clear that the Respondent is using the disputed domain name to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant trademarks and official website.

We recall that the use of a renown third party’s trademark as part of a domain name in order to attract potential consumers to the Respondent’s misleading website is certainly not “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 at issue” as provided for by paragraph 4(c)(iii) of the Policy, neither “a bona fide offering of goods or services” as provided for by paragraph 4(c)(i) (see, among others, Farouk Systems, Inc. v. QYM, WIPO Case No. D2009-1572 (consolidated with other 10 precedents); Mattel, Inc. v. Magic 8 ball factory, WIPO Case No. D2013-0058; Cartier International, N.V. , Cartier International, B.V. v. David Lee, Caso WIPO Case No. D2009-1758, etc.).

For all reasons mentioned above the Complainant deems to have sufficiently proved that the Respondent lacks rights and

legitimate interests in respect of the disputed domain name.

III. The domain name was registered and is being used in bad faith.

In accordance with paragraph 4(a)(iii) of the Policy in order to succeed in a UDRP Proceeding, the Complainant must prove, as a third and last requirement, that the Respondent registered and used the disputed domain name in bad faith.

As far as registration in bad faith is concerned, the Respondent registered domain name contains a very well-known third party's trademark without authorization. The Respondent could not ignore the existence of the Philipp Plein trademark at the time of the registration of the disputed domain name, not only because Philipp Plein is a very well-known trademark all over the world, U.S.A. included, but also in consideration of the type of domain name registered (consisting of trademark + terms that potential consumers may very well associate with the Complainant's activity) and of the websites' contents, which reproduce the Complainant's trademark, as well as the same name and photos of the Complainant's official garments.

Furthermore, the disputed domain name has been registered long after the filing/registration of the Complainant's trademarks, having effects all over the world, and in particular in USA.

As far as use in bad faith is concerned, we note that the domain name conducts to a website offering alleged "Philipp Plein" goods, and unduly depicting copyrighted pictures taken from the Complainant's official website. The website also features the Complainant's figurative and verbal trademarks, in connection with conflicting goods, which are offered for sale.

This kind of use is certainly not a use in good faith. It may cause substantial damages not only to the Complainant, but also to consumers. On the one side, the Complainant's image and reputation are strongly affected by the website, very similar to the official one, offering for sale conflicting goods. On the other side, consumers share confidential information when they pay the purchased goods, with the concrete risk that this information is stolen and used fraudulently by the Respondent.

It appears from the above that the disputed domain name has been registered and is used to intentionally attract Internet users to the Respondent's web site for commercial gain, by creating a likelihood of confusion with the Complainant's official website, also creating the impression that the Respondent's website is sponsored/affiliated or endorsed by the Complainant.

A further evidence of the Respondent's bad faith can be inferred from its lack of reply to two cease and desist letters sent to the Respondent prior to the commencement of this proceeding. In prior UDRP cases it was found that "by operation of a common sense evidentiary principle, (…) Respondent's failure to counter the allegations of the cease and desist letter amounts to adoptive admission of the allegations" (see The Great Eastern Life Assurance Company Limited v. Unasi, Inc., WIPO Case No. D2005-1218).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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

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

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed 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

I. RIGHTS

The disputed domain name is confusingly similar to the Complainant’s registered trademarks since it reproduces the Complainant’s mark ‘PHILIPP PLEIN’, merely adding the generic expression "T-SHIRT"at the end.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the domain name in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D20020856:

“As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists.“ WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, apparently the Respondent did not reply to the C&D letters sent by the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant´s allegations and evidence with regard to the Respondent´s registration and use of the disputed domain name in bad faith.

Paragraph 4(b) (iiii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location.

The Complainant's PHILIPP PLEIN trademark is well-known in the luxury fashion industry, well before the registration of the disputed domain name. The Respondent's registration of the disputed domain name wholly incorporating a well-known third-party mark is, in the Panel´s view, indicative of bad faith.

As mentioned in Andrey Ternovskiy dba Chatroulette v. Alexander Ochki, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see AT&T Corp. v. Amjad Kausar, WIPO Case No. D2003-0327)."

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PHILIPPPLEINT-SHIRT.COM**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2017-08-18

Publish the Decision