# Decision for dispute CAC-UDRP-101584

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| Case number | **CAC-UDRP-101584** |
| Time of filing | **2017-07-25 11:57:10** |
| Domain names | **cheapphilipppleinsales.com,** |

## Case administrator

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| Organization | **Iveta Špiclová (Czech Arbitration Court) (Case admin)** |

## Complainant

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| Name | **philipp plein** |

## Complainant representative

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| Organization | **Barzano&Zanardo Milano S.p.A.** |

## Respondent

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| Name | **gueijuan xu** |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns the following trademark registrations:

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

-Philipp Plein, International Registration No. 794860, extended, among others, to China, of December 13th 2002, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28;

-Philipp Plein, Honk Kong national Registration n. 300960561, filed on September 24, 2007 and registered on March 18, 2008, for goods in classes 18, 20 and 25;

- PP device , Hong Kong national Registration n. 303054276, filed on July 3, 2014 and registered on March 23, 2015 for goods in classes 3, 14, 18, 20, 21, 24, 25, 28;

- PP PHILIPP PLEIN device, 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.

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FACTUAL BACKGROUND

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

I. The Complainant

The Complainant is the German fashion designer, founder of the eponymous brand. Currently, Philipp Plein is universally recognized as a leading brand in the luxury fashion industry (more information on the Complainant's activities are to be found at <world.philipp-plein.com>) .

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

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

The Complainant further asserts that Philipp Plein runs at a double digit rate of expansion, and currently has a turnover of over one hundred million Euro.

The Complainant is active on several social networks, such as facebook, twitter or Instagram.

Due to its longstanding use, and the huge promotional and advertising investments, the PHILIPP PLEIN trademark is according to the Complainant certainly well-known.

II. The Respondent

The disputed domain name was registered on April 27th, 2017 in the name of Gueijuan Xu and currently leads to a website offering for sale alleged Philipp Plein items and displaying the Complainant's verbal and figurative trademarks.

The Complaint is based on the following grounds:

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; Policy, paragraph 4(a)(i); Rules, paragraphs 3(b)(viii), (b)(ix)(1)

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

First, the mere fact that a domain name wholly incorporates a 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).

In this regard, the Complainant notes that the addition of generic and descriptive words, such as "sales" and "cheap", rather than excluding a similarity with the earlier well-known Philipp Plein trademark, increases the likelihood of confusion, since these words refer to the kind of activity generally performed through a website, i.e. a store selling discounted clothing. It is clear that the combination between the well-known Philipp Plein mark and such generic words, gives the idea that the disputed domain name is an on-line point of sale of discounted Philipp Plein goods.

Previous Panels have established that domain names consisting of generic words, such as “clearance”, “store”, “cheap” etc., combined with the well-known trademark Philipp Plein, are likely to increase confusion among customers. Among the several decisions, we quote Case No. D2016-2617 and Case No. D2015-1050.

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 paragraph 3(b), (viii), (b)(ix)(1) of the Rules is satisfied.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name; Policy, Paragraph 4(a)(ii); Rules, paragraph 3(b)(ix)(2)

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 disputed domain name lies with 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 Gueijuan Xu 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, Gueijuan Xu, 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 paragraph 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.

Furthermore, the pictures of the items displayed in the fake website are pictures of original Philipp Plein garments distinguished by the original namings of the Complainant’s items, 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 present his website as an official outlet of the Complainant, offering for sale discounted "alleged" Philipp Plein goods, and this use certainly does not amount to 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 to “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 all the Domain Name.

C. The domain name was registered and is being used in bad faith; Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3)

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 names containing a very well-known third party's trademark without authorization, as well as the name and surname of the stylist, that is the owner of all trademarks PHILIPP PLEIN. 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 also in China and Honk Kong, but also in consideration of the type of Domain Names registered (consisting of trademark + terms that potential consumers may very well associate with the Complainant's activity) and of the website' 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' trademarks, having effects all over the world, and in particular in China and Hong Kong.

As far as use in bad faith is concerned, we note that the disputed domain name links 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 for commercial gain Internet users to the Respondent's website, 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.

In view of the above, the Complainant respectfully submits that the disputed domain name was registered and is being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) of the Policy.

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the Disputed disputed domain name should be transferred or cancelled:

(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 in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CHEAPPHILIPPPLEINSALES.COM**: Transferred

## PANELLISTS

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| Name | **Mr. E.J.V.T. van den Broek** |

DATE OF PANEL DECISION 2017-08-22

Publish the Decision