Decision for dispute CAC-UDRP-101747

Case number	CAC-UDRP-101747
Time of filing	2017-12-28 09:57:35
Domain names	philipppleins.com

Case administrator

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

Complainant

Name	Philipp Plein

Complainant representative

Organization	Barzano&Zanardo Milano S.p.A.

Respondent

Name	Dai ManJu

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 is the holder of trademark rights for the word mark PHILIPP PLEIN, registered in numerous jurisdictions, including China (e.g. international registration No. 794860 since December 13, 2002, duly renewed, and covering products in classes 3, 14, 18, 20, 21, 24, 25 and 28) and the EU (EUIPO registration No. 002966505 since January 21, 2005, duly renewed, and covering products in classes 3, 14, 18, 20, 21, 24, 25 and 28).

FACTUAL BACKGROUND

Philipp Plein (hereinafter referred to as the Complainant) is a German fashion designer and owner of the PHILIPP PLEIN trademark. The Complainant commercializes clothing, shoes and fashion accessories around the world, including China.

The Complainant is the owner of the registered word mark PHILIPP PLEIN in several classes in numerous countries all over the world, including China.

The Disputed domain name has been registered on November 23, 2017 by the Respondent.

The Disputed domain name resolves to a website offering for sale various heavily discounted products carrying the PHILIPP PLEIN brand.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant considers the Disputed domain name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the Disputed domain name. According to the Complainant, the Respondent does not use the Disputed domain name in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been commonly known by the Disputed domain name. Finally, the Complainant considers that the Disputed domain name was registered and is being used in bad faith, as the website connected to the Disputed domain name offers for sale alleged "Philipp Plein" goods that are likely counterfeit products and it unduly depicts copyrighted pictures taken from the Complainant's official website.

RESPONDENT:

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

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

A. Language of the proceedings

The Complainant asserts that it was not able to find a copy of the applicable Registration Agreement, but that it is likely that the language of this Registration Agreement is Chinese. As the Complaint was not filed in the language of the Registration Agreement and the Parties did not agree on the language of the administrative proceeding, the Panel may decide on the language of the administrative proceeding, having regard to the circumstances of the administrative proceeding. Indeed, paragraph 11(a) of the Rules reads: “Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”.

In cases where the use of the English language in the proceedings would not be prejudicial to the interests of the Respondent, whereas it would be a disadvantage for the Complainant to be forced to translate the Complaint, panels often

decide to use the English language in the UDRP proceedings (see e.g., The Dow Chemical Company v. Hwang Yiyi, WIPO Case No. D2008-1276, decision according to which, where a respondent can clearly understand the language of the complaint, and the complainant would be disadvantaged by being forced to translate, the language of proceedings can remain the language of the complaint, even though it is different to the language of the Registration Agreement).

The Panel is satisfied that both parties have sufficient command of English. The Respondent's website connected to the Disputed domain name is completely written in English, including product descriptions, terms and conditions, shipping information, etc. Therefore, the Panel finds that these elements show that Respondent has a sufficient understanding of English.

Accordingly, the use of the English language in the proceedings would not be prejudicial to the interests of the Respondent, whereas it would be a disadvantage for Complainant to be forced to translate the Complaint. Therefore, the Panel decides to use the English language in the present proceedings (see e.g., The Dow Chemical Company v. Hwang Yiyi, WIPO Case No. D2008-1276, decision according to which, "where [a] respondent can clearly understand the language of the complaint, and the complainant would be disadvantaged by being forced to translate, the language of proceedings can remain the language of the complaint, even it is different to the language of the registration agreement").

B. Substantive elements of the policy

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name 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.

The Panel has therefore dealt with each of these requirements in turn.

1. Confusing similarity of the Disputed domain name with existing rights

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant is the holder of the registered PHILIPP PLEIN trademark, which is used in connection with its business, it is established that there is a trademark in which the Complainant has rights.

The Disputed domain name reproduces the Complainant's PHILIPP PLEIN trademark in its entirety, with the addition of the letter "s". Merely adding the generic letter "s" as a suffix does not avoid confusing similarity between the Disputed domain name and the Complainant's marks.

Additionally, it is well established that the generic top level suffix ".com" may be disregarded when considering whether the Disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

Therefore, the Panel finds that the Disputed domain name is confusingly similar to the Complainant's trademarks.

Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the Disputed domain name in order to shift the burden of proof to the Respondent (Please see Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 (<championinnovation.com>); Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 (<croatiaairlines.com>); Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 (<belupo.com>)).

The Panel notes that the Respondent has not been commonly known by the Disputed domain name and that the Respondent has not acquired trademark or service mark rights. The Respondent's use and registration of the Disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

In addition, the Respondent does not show to be an authorized reseller of the Complainant. Nevertheless, the Respondent uses the Disputed domain name to refer to a website offering various kinds of clothing, shoes and fashion accessories displaying the Complainant's PHILIPP PLEIN trademark. The Complainant suspects that the Respondent is offering counterfeit goods on the website. The Respondent did not reply.

Based on the available record, the Panel finds that the Complainant has established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the disputed domain name, under paragraph 4(a)(ii) of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the Disputed domain name was registered in bad faith and that it is being used in bad faith (see e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of the Disputed domain name to intentionally attempted to attract, for commercial gain, Internet users to a 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 web site or location or of a product or service on the web site or location.

According to the Panel, the awareness of the respondent of the Complainant and/or the Complainant's trademark rights at the time of registration can be evidence of bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070, where POKÉMON was held to be a well-known mark of which the use by someone without any connection or legal relationship with the Complainant suggested opportunistic bad faith). In the present case, the Panel finds that the Respondent must have had knowledge of Complainant's rights in the PHILIPP PLEIN trademark at the moment it registered the Disputed domain name, since the Complainant's trademark is a widely known trademark and

the Respondent specifically uses the Complainant's trademark, pictures and products on its web site connected to the Disputed domain name.

In the present case, the Respondent is using the Complainant’s trademark and copyright protected images without the Complainant’s authorization and without disclosing its relationship with the Complainant. Doing so, consumers are likely misled into believing that the Respondent’s website is operated by the Complainant itself or a company affiliated to the Complainant. The likelihood of confusion with the Complainant’s mark is clearly with the intention of attracting Internet users for commercial gain, since the purpose of the website is to sell various kinds of clothing, shoes and fashion accessories carrying the Complainant's PHILIPP PLEIN trademark, which are likely counterfeit products. Finally, the Respondent did not formally take part in the administrative proceedings. According to the Panel, this serves as an additional indication of the Respondent’s bad faith.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being 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. **PHILIPPPLEINS.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2018-01-29

Publish the Decision