Decision for dispute CAC-UDRP-101746

Case number	CAC-UDRP-101746
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Domain names	plein2018.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Name	Philipp Plein

Complainant representative

Organization	Barzano & Zanardo Milano S.p.A.

Respondent

Name	Ylliass Aaziz

OTHER LEGAL PROCEEDINGS

None that the Panel has been made aware of.

IDENTIFICATION OF RIGHTS

The Complainant has supplied evidence that he is the owner of the following trade mark rights:

- PP (device), US Registration No. 4181456, filed on 5 October 2011 and registered on 31 July 2012, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28;

- Philipp Plein, US Registration No. 4918695, filed on 3 March 2014 and registered on 15 March 2016, for goods in classes 3, 14, 21, 24 and 28; and

- Plein, EU Registration No. 010744837, filed on 21 March 2012 and registered on 1 August 2012, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28.

FACTUAL BACKGROUND

The Complainant is the German fashion designer Philipp Plein. He is the founder of the eponymous brand, which is well-known in the luxury fashion industry.

The Respondent is an individual based in France.

The disputed domain name was registered on 20 November 2017 through a privacy protection service. It is currently not resolving, but was previously used to point to a website offering alleged Philipp Plein goods for sale and featuring the Complainant's trade marks in a prominent position.

The Complainant amended the Complaint following the disclosure of the Respondent's contact details.

The Respondent did not respond to the Complaint.

PARTIES CONTENTIONS

Complainant

Identical or confusingly similar

The Complainant evidences the three trade mark rights listed in the "Identification of Rights" section above. The Complainant submits that the disputed domain name is confusingly similar to his trade mark, incorporating the Complainant's trade mark in its entirety with the addition of the generic term "2018". The Complainant also contends that the use of the .COM generic Top Level Domain (gTLD) does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trade mark.

The Complainant argues that the use of the descriptive term "2018" in fact reinforces the confusion with the Complainant's trade mark, as it could be easily perceived as the year of the Complainant's collection.

No rights or legitimate interests

The Complainant underlines that it is required to make out prima-facie case that a respondent lacks rights or legitimate interests and the burden of proof then shifts to the respondent to rebut the complainant's prima-facie case.

The Complainant submits that the Respondent is not an authorized dealer, agent, distributor, wholesaler or retailer of the Complainant. To the best of the Complainant's knowledge, the Respondent is not commonly known by the disputed domain name, nor does it own any Philipp Plein formative trade marks.

Since the disputed domain name previously used to resolve to a website offering discounted alleged Philipp Plein goods for sale, the Complainant contends that the Respondent was using the disputed domain name to promote his own website as an official online point of sale of the Complainant, which should not be considered as a legitimate non-commercial or fair use of the domain name, nor a bona fide offering of goods or services.

Registered and used in bad faith

As far as registration in bad faith is concerned, the Complainant contends that the Respondent could not ignore the existence of the Philipp Plein trade mark at the time of the registration of the disputed domain name, notably given the Complainant's reputation in France (where the Respondent is based) as well as the nature of the disputed domain name (consisting of the Complainant's trade mark plus the addition of the generic term "2018") and of the website content (reproducing the Complainant's trade mark and the names of official Philipp Plein garments). Furthermore, the Complainant submits that the disputed domain name was registered long after the filing/registration of the Complainant's trade marks.

With regard to use in bad faith, the Complainant argues that the current passive holding of the disputed domain name constitutes use in bad faith, and also cites the following circumstances:

i. The Complainant has a distinctive trade mark which is well-known worldwide;

ii. The Complainant's trade marks are registered worldwide, including in France;

iii. The nature of the disputed domain name (PLEIN combined with the date "2018") is indicative of the Respondent's intent to mislead internet users to think that the domain name is somehow connected to the next Philipp Plein collection;

iv. The previous pointing of the disputed domain name to a website offering for sale alleged Philipp Plein items using the original names of the relevant garments and featuring the Complainant's trade marks in a prominent position strongly indicates the Respondent's intention to mislead internet users and exploit the Complainant's trade marks for commercial gain; and

v. The confidential information shared by consumers when purchasing the goods offered for sale may be stolen and used fraudulently by the Respondent.

Respondent

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has shown, to the satisfaction of the Panel, that the disputed domain name is confusingly similar to a trade 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 shown, to the satisfaction of the Panel, that the Respondent has 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 shown, to the satisfaction of the Panel, that 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

Paragraph 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In this case the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel is therefore obliged to make its decision on the basis of the factual statements contained in the Complaint and the documents made available by the Complainant to support its contentions.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following for a panel to order a transfer of the domain name at issue:

(i) the domain name registered by the respondent is identical or confusingly similar to a trade mark or service mark in which Complainant has rights; and

(ii) the respondent has no rights or legitimate interests in the domain name; and

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

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has trade mark rights in the term PLEIN.

The Panel notes that the disputed domain name incorporates the Complainant's PLEIN trade mark in its entirety. Moreover, the addition of the descriptive term "2018" reinforces the likelihood of confusion as it could be considered by internet users as being connected to the year of the Complainant's collection.

In addition, it is widely accepted that the .COM generic Top-Level Domain (gTLD) is generally irrelevant for the purpose of assessing identity or confusing similarity between a trade mark and a domain name.

On the basis of these considerations, the Panel finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element that the Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the disputed domain name (Policy, paragraph 4(a)(ii)).

Paragraph 4(c) of the Policy sets out various ways in which a respondent may demonstrate rights or legitimate interests in the domain name at issue, as follows:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(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 trade mark 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 trade mark or service mark at issue."

The Panel has considered the evidence put forward by the Complainant and is of the view that the Complainant has presented a prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name. As a result of his default, the Respondent has failed to rebut that showing.

The fact that the disputed domain name was previously used to point to a website offering for sale discounted alleged Philipp Plein products and displaying the Complainant's trade marks without the latter's prior authorisation cannot be considered as a bona fide offering of goods and services within the meaning of paragraph 4(c)(i) of the Policy, and neither can the Respondent's current passive holding.

Likewise, both the previous and current use of the disputed domain name cannot constitute a legitimate non-commercial or fair use within the meaning of paragraph 4(c)(iii), in particular because the previous use of the disputed domain name

demonstrated that the Respondent was clearly seeking to unfairly exploit the goodwill of the Complainant for his own profit.

Finally, no evidence has been supplied that the Respondent is commonly known by the disputed domain name, as per paragraph 4(c)(ii).

Given the above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The third element that the Complainant must prove on the balance of probabilities is that the disputed domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)).

Paragraph 4(b) of the Policy sets out various non-exhaustive circumstances that may be treated by the Panel as evidence of the registration and use of a domain name in bad faith, as follows:

"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 you have registered or you have 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 trade mark 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) you have registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website 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 your website or location or of a product or service on your website or location."

Given the Complainant's goodwill and renown, it would be inconceivable for the Respondent to argue that he did not have knowledge of the Complainant's PLEIN trade mark at the time of registration of the disputed domain name, particularly as the Complainant's trade mark rights predate the registration date of the disputed domain name by a number of years. The fact that the disputed domain name was then used to point to a website selling the Complainant's alleged products also constitutes a strong indication of the Respondent's prior knowledge of the Complainant. The Panel therefore finds that the disputed domain name was registered in bad faith.

Turning to use in bad faith, it is clear that the disputed domain name was previously used in bad faith by the Respondent to intentionally attract, for commercial gain, internet users to his website by creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation or endorsement of his website, in accordance with paragraph 4(b)(iv). In addition, it has long been established that passive holding of a domain name does not prevent a finding of bad faith use.

The Panel therefore finds that the disputed domain name was registered and used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PLEIN2018.COM**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2018-02-12

Publish the Decision