Decision for dispute CAC-UDRP-101845

Case number	CAC-UDRP-101845
Time of filing	2018-01-19 08:42:57
Domain names	ppleinoutlet.com

Case administrator

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

Complainant

Name	Philipp Plein

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	Philipp Plein

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings of which the panel is aware that are pending or decided and that are related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of different trademarks consisting in whole or in part of the word "PLEIN", "PHILIPP PLEIN" and "PP", notably:

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

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

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

FACTUAL BACKGROUND

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

The Complainant is a German fashion designer named Philipp Plein, founder of the eponymous brand. Currently, Philipp Plein is universally recognised as a leading brand in the luxury fashion industry.

The Complainant participates to the most important fashion shows around the world (Milan, Paris, NewYork, among others) and it's 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 certainly well-known.

The disputed domain name <ppleinoutlet.com> was registered on December 2, 2017. The Complainant states that to the date of filing the Complaint, no website had been operated from the disputed domain name <ppleinoutlet.com>.

The Complainant assumes that the disputed domain name is confusingly similar to its registered trademarks. The Complainant further states that the mere fact that a domain name wholly incorporates a Complainant's registered trademark is sufficient to establish identity or confusing similarity for purposes of the Policy. As the Complainant assumes, the disputed domain name contains the Complainant's trademark entirely and this is sufficient to conclude that the first requirement under the Policy is met. Moreover, the initial double letters "PP" in the disputed domain name <ppleinoutlet.com> are a clear reference to the Complainant's device trademark (US Registration No. 4181456).

Furthermore, the Complainant assumes that the addition of generic and descriptive words, such as "outlet", rather than exclude a similarity with the earlier well-known PHILIPP PLEIN trademark, increases the likelihood of confusion, since the combination between the PLEIN trademark and such word gives the idea that the disputed domain name will be used to host an online point of sale of discontinued Philipp Plein goods.

Finally, as the Complainant states, the addition of a gTLD such as "com" in a domain name is technically required and it is well established that such element may be disregarded when assessing whether a domain name is identical or confusingly similar.

Furthermore, the Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

At the time of filing the Complaint, the Registrant's contact details were shielded by a Privacy Protection service. After filing the Complaint, the Registrar disclosed the WHOIS contact details of the Respondent as stated above.

The WHOIS record provided by the Registrar appears to indicate that the disputed domain name was registered or transferred to the current Complainant (Philipp Plein). However, as the Complainant claims, it neither has registered nor obtained the ownership of <ppleinoutlet.com>. The Complainant assumes that the WHOIS record provides false information and the disputed domain name is controlled by an unidentified third party. This - to the Complaint's opinion - is also proven by the fact that the WHOIS record provides the e-mail address msrshop100@yahoo.com as "Registrant E-mail", which has no relation to Philipp Plein's nor to its Counsels.

The Complainant denies that the Respondent could have any right or legitimate interest in registering the disputed domain name. In particular, the Complainant's internal policies with respect to dealers, agents, distributers, wholesalers or retailers are very strict on the use of the PHILIPP PLEIN's trademarks as they do not authorise any of the above-mentioned subjects to register a domain name containing the Complainant's trademark.

The Complainant assumes that the Respondent has registered the disputed domain name in bad faith and has used the disputed domain name to attract Internet users on its website by creating a likelihood of confusion with the Complainant's trademark.

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 UDRP Policy the Complainant must prove for the requested transfer of the disputed domain name that:

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

There is no reasonable doubt that the Complaint complies with all these requirements:

(i)

The Complainant has established that it has rights in the trademark(s) corresponding "PHILLIP PLEIN", "PLEIN" and "PP" at least since 2014. The Complainant's trademarks were registered prior to the registration of the disputed domain name (December 2, 2017) and are widely well-known.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks "PHILIPP PLEIN", "PLEIN" and "PP" as it includes the trademarks "PLEIN" and "PP" in its entirety as well as the "PHILLIPP PLEIN" trademark partially with the mere addition of the generic term "outlet" and the Top-Level domain ".com", which is not sufficient to exclude the likelihood of confusion (see PHILIPP PLEIN v. Ylliass Aaziz, CAC Case No. 101746; PHILIPP PLEIN v. JOHN SMITH, CAC Case No. 101819; Valero Energy Corporation and Valero Marketing and Supply Company v. Valero Energy, WIPO

Case No. D2017 0075; M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts, WIPO Case No. D2015 1384).

(ii)

Furthermore the Complainant provided prima facie evidence that the Respondent has no rights or legitimate interests in the disputed domain name. As asserted by the Complainant (and unchallenged by the Respondent), the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. The Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the domain name.

(iii)

For a Complaint to succeed, a panel must be satisfied that a domain name has been registered and is being used in bad faith [Policy, paragraph 4(a)(iii)].

The Complainant's “PHILIPP PLEIN“, “PLEIN“ and “PP“ trademarks are well-known in the luxury fashion industry. The Panel finds it hard to believe that the Respondent would have chosen and registered the disputed domain name in good faith, without having been aware of the Complainant´s before-mentioned trademarks. The fact that the Respondent provided data for the Registrar's WHOIS record that are nearly identical to the Complainant's data leaves no other conclusion, than that the Respondent has registered the domain in bad faith.

As it ensues from the evidence provided by the Complainant, no website is operated under the disputed domain name ("passive holding"). Previous Panelists recognised that passive holding of a domain name can, in certain circumstances, constitute use in bad faith (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). In Telstra, the Panel noted that the question as to which circumstances of "passive holding" may constitute use in bad faith cannot be answered in the abstract. This question may only be determined on the basis of the particular facts of each case. One should give close attention to all the circumstances of the Respondent's behaviour and a remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith. The Complainant points out the following circumstances as material to determine the Respondent’s bad faith in the use of the disputed domain name:

- the Complainant’s trademark has a strong reputation, is highly distinctive and is widely known on a global basis;

- the Complainant’s trademark is registered worldwide, and in particular in European Union and USA;

- the Complainant never authorised the Respondent to reproduce its trademark in the disputed domain name and the available evidence does not show whatsoever actual or contemplated good faith use of the domain names;

- taking into account the nature of the disputed domain name, namely the combination of the Complainant's figurative trademark (PP) and PLEIN with the mere addition of "outlet" excludes any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be in bad faith;

- the Whois record provides false and inaccurate information.

For the reasons mentioned above the Panel finds, that the disputed domain name has been registered and is being used in bad faith under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PPLEINOUTLET.COM**: Transferred

PANELLISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2018-02-23

Publish the Decision