Decision for dispute CAC-UDRP-101848

Case number	**CAC-UDRP-101848**
Time of filing	**2018-01-26 09:09:36**
Domain names	**Philipppleinoutletcheap.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	**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 <philipppleinoutletcheap.com>.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following trademark registrations relating to "PHILIPP PLEIN" which enjoy protection in numerous countries and, inter alia, in China:

- Word mark PHILIPP PLEIN, World Intellectual Property Organization (WIPO), Registration No. 794860, registered on December 13, 2002 and duly renewed.

- Word / Design mark PP PHILIPP PLEIN, European Union Intellectual Property Office (EUIPO), Registration No. 12259503, registered on March 24, 2014.

- Word mark PHILIPP PLEIN, EUIPO, Registration No. 2966505, registered on January 21, 2005.

FACTUAL BACKGROUND

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

1) The Complainant (Philipp Plein) declares to be a German fashion designer and the founder of the eponymous brand "PHILIPP PLEIN". Furthermore, the Complainant informs that "PHILIPP PLEIN" is universally recognized as a leading brand in the luxury fashion industry and that the same Complainant participates to the most important fashion shows around the world. According to the Complainant assertions the market has applauded the PHILIPP PLEIN's fashion collections, and the world of PHILIPP PLEIN is enjoying a phenomenal success today with showrooms all over the world. The Complainant declares that PHILIPP PLEIN has a turnover of over one hundred milion Euro.

2) According to Franca Sozzani, historic editor in Chief of Vogue Italia, "Philipp Plein is unique because he has a joy of life. He does not 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". The Complainant informs that "PHILIPP PLEIN" has concluded several sponsorship agreements, with among others, AS Roma (one of the most important Italian soccer teams), Mauro Icardi, (one of the most important footballers in the world) and Nico Hulkenberg, the Formula one racer. In the Complainant's view due to its longstanding use, and the huge promotional and advertising investments, the "PHILIPP PLEIN" trademark is certainly well-known.

3) The Complainant contends to be very active in the defense of its IP rights against abusive registration of domain names. Among the numerous UDRP favorable decisions, the Complainant cites CAC No. 101583 (Yuriy Shi/ Philipp Plein PHILIPPPLEINTSHIRT.COM) and No. 101584 (Gueijuan Xu/ philipp plein- CHEAPPHILIPPPLEINSALES.COM), which both recognized the fame of the "PHILPP PLEIN" trademark.

4) The Complainant outlines that the disputed domain name was registered on September 25, 2017, in the name of Mr. Gueijuan Xu and that the disputed domain name is connected to a website offering for sale alleged "PHILIPP PLEIN" goods and displaying the Complainant's verbal and figurative trademarks in clear evidence.

5) The Complainant notes that the "PHILIPP PLEIN" trademark is entirely contained in the disputed domain name and that the addition of generic and descriptive words, such as "outlet" and "cheap", rather than excluding a similarity with the earlier well-known "PHILIPP PLEIN" trademark, increase the likelihood of confusion, since these words are all related to the fashion field and to the selling of clothing.

6) The Complainant denies that the Respondent is an authorized dealer, agent, distributor, wholesaler or retailer of "PHILIPP PLEIN". The Complainant informs that it has never authorized Gueijuan Xu to include his well-known trademark in the disputed domain name, nor to make any other use of his trademark in any manner whatsoever. The Complainant also confirms that he is not in possession of, nor aware of the existence of, any evidence tending to demonstrate that the Respondent is commonly known by the 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.

7) The Complainant argues that the disputed domain name is being used to offer for sale alleged "PHILIPP PLEIN"'s clothing, footwear and other items and that the Respondent is also using the original images of "PHILIPP PLEIN"'s past and actual advertising campaigns. According to the Complainant's view this circumstance increases the likelihood of confusion for the relevant consumer and constitutes a clear violation of the Complainant's copyright.

8) The Complainant insists that the Respondent is using the disputed domain name to present its websites as official e-commerce platforms of the Complainant, offering for sale alleged "PHILIPP PLEIN" goods and that, in consideration of the above, the Respondent is taking unfair advantage from the distinctive character and reputation of the Complainant's trademark and unduly seeking to profit from the Complainant's goodwill for its own financial gain.

9) In the Complainant's view 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 Hong Kong, but also in consideration of the websites' contents, which contain the Complainant's verbal and figurative trademarks as well as images of the Complainant's advertising campaigns. The Complainant outlines that the

disputed domain name has been registered long after the registration of the Complainant's trademark, having effects all over the world, including China.

10) The Complainant believes that the "PHILIPP PLEIN" image and reputation are strongly affected by the website corresponding to the disputed domain name since said website is very similar to the official one and is offering for sale possible counterfeit goods. In the Complainant's view it is clear that the disputed domain name has been registered and is being 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.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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.

1) The Complainant has established that he has rights in the trademark "PHILLIP PLEIN" at least since December 2002. The Complainant's trademark is registered well before with respect to the registration of the disputed domain name (September 25, 2017) and is widely well-known. The Panel finds that the disputed domain name is confusingly similar to the Complainant trademark "PHILIPP PLEIN" as it includes the trademark "PHILIPP PLEIN" in its entirety with the mere addition of the generic terms "outlet" and "cheap" as well as of the Top-Level domain ".com". Actually, in the Panel's view the descriptive words "outlet" and "cheap" in the disputed domain name do not assist to distinguish said domain name from the trademark "PHILIPP PLEIN" (see HUGO BOSS Trade Mark Management GmbH & Co. KG and HUGO BOSS AG v. dsfgsdfgsdfgdsfg - WIPO Case No. D2015-0916; Golden Goose S.p.A. v. Martin Lee - WIPO Case No. D2017-1891; Lovehoney

Group Limited v. lovehoney-outlet-sale.com - CAC Case No. 101817; H. Lundbeck A/S v. Sergio Kilosen - CAC Case No. 100445). Furthermore, in accordance with the consensus view of past UDRP panels, the Panel finds that the Top-Level domain ".com" is not sufficient to exclude the likelihood of confusion. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant demonstrated that the website to which the disputed domain name is linked allegedly offers for sale authentic merchandise bearing the "PHILIPP PLEIN" mark. The Complainant clearly considered that Respondent has the hope and the expectation that Internet users looking for the brand "PHILIPP PLEIN" will be directed to the website corresponding to the disputed domain name. The Panel finds that said activity, of course, does not provide a legitimate interest in the disputed domain name under the Policy.

Furthermore, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

The Respondent registered the disputed domain name years after the use and registration of the "PHILIPP PLEIN" mark by the Complainant. In consideration of the reputation achieved by "PHILIPP PLEIN" it is clear that the Respondent was surely aware of the Complainant’s trademark when he registered <philipppleinoutletcheap.com>.

Moreover, the Respondent appears to have attempted to benefit commercially from the appropriation of the "PHILIPP PLEIN" mark in the disputed domain name. The use of the famous mark "PHILIPP PLEIN", which is well-known worldwide in the fashion sector, for selling fashion items, clearly indicates that the disputed domain name was chosen by the Respondent to take advantage of the Complainant’s mark reputation. This finding leads to the obvious conclusion that the disputed domain name has been registered in bad faith (Research In Motion Limited v. Privacy Locked LLC/Nat Collicot - WIPO Case No. D2009-0320; The Gap, Inc. v. Deng Youqian - WIPO Case No. D2009-0113; AXA S.A. v. P.A. van der Wees - WIPO Case No. D2009-0206; BHP Billiton Innovation v. Ravindra Bala - WIPO Case No. D2008-1059).

The Panel also finds that, by linking the disputed domain name to a website offering for sale alleged "PHILIPP PLEIN" items and publishing images taken from "PHILIPP PLEIN" advertising campaigns, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the trademark "PHILIPP

PLEIN" as to the source, sponsorship, affiliation or endorsement of its website and the products promoted therein.

As the conduct described above falls within paragraph 4(b)(iv) of the Policy (see Triumph International Vietnam Ltd v. Tran Quoc Huy - WIPO Case No. D2017-0340), the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PHILIPPPLEINOUTLETCHEAP.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2018-03-01

Publish the Decision