Decision for dispute CAC-UDRP-101335

Case number	CAC-UDRP-101335
Time of filing	2018-01-31 13:56:53
Domain names	loropiana.shop

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Loro Piana S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Roma S.p.A.

Respondent

Name	Y. v. Oostendorp

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

According to the evidence submitted by Complainant, Complainant is the owner of multiple trademarks including: European Union trademark LORO PIANA, with registration number 007383136, registration date 6 September 2009, and the international trademark LORO PIANA, with registration number 421431, date of registration 30 December 1975.

FACTUAL BACKGROUND

The disputed domain name, <loropiana.shop>, was registered on 26 September 2016.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

According to the information provided Complainant is the most important cashmere, vicuña and extra thin wool manufacturer in the world. Complainant was established in 1924. Complainant sells its goods worldwide with many direct points of sale in Europe, America and Asia. Furthermore, Complainant’s goods are also sold in prestigious department

stores, and inside luxury multi-branding clothing stores. Presently, Complainant owns more than 700 trademark registrations worldwide, consisting of, or containing, the term LORO PIANA and more that 300 domain names identical or comprising LORO PIANA in all existing ccTLDs and in most of the available gTLDs. Complainant submits that it invests considerable resources (both economic and human) to build its reputation and that of its LORO PIANA trademark.

On 13 October 2016 Complainant sent to Respondent a cease and desist letter. On 3 November 2016 Respondent's lawyer replied that its client's registration of the disputed domain name was legitimate, claiming: "Client doesn't use the domain to sell the goods of the trademark LORO PIANA, but client will use the domain in short-term and will not violate any of the Oki Data criteria. Client will use the website only for the sale of actual LORO PIANA products. No goods of other trademarks will be sold or mentioned on the website www.loropiana.shop. The website will make absolutely clear that <loropiana.shop> is operated by Calipseo B.V."

According to Complainant the disputed domain name is identical to Complainant's trademarks as it contains the trademark LOREO PIANA in its entirety, without any further addition, but for the new gTLD ".shop", which is a mere technical requirement and therefore does not affect the identity between the two signs. Complainant asserts that the addition of this gTLD enhances the similarity and likelihood of confusion between the disputed domain name and Complainant's trademarks. As a matter of fact, Complainant's activity is the manufacture and sale of its products, and therefore the extension ".shop" is clearly suitable to persuade users that the disputed domain name is Complainant's e-commerce platform.

According to the Complainant, the Respondent has no rights or legitimate interest in the disputed domain name. According to the submission and evidence provided by Complainant, Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services. More specifically, in 2016 the disputed domain name was used to give access to a parking page containing pay-per-click links; almost all pay-per-click links referred to Italian websites, making a clear reference to the origin of Complainant. Some of the links redirected to dating websites, others to an on-line streaming website, and others to competitors' websites. Subsequently, the disputed domain name led to a GoDaddy parking page, were it was possible to enquire about its purchase. Currently, the disputed domain name has been transferred to a different Registrar and redirects Internet users to an inactive website. Complainant submits that said use, along with the proposal to make an offer to purchase the disputed domain name, and the passive holding does not amount to a bona fide offering of goods or services, nor to a non-commercial or fair use of the disputed domain name under the Policy. Moreover, Respondent is not an authorised agent, licensee or distributor of Complainant's goods and has no relationship whatsoever with Complainant. Complainant only sells its products through its own stores and/or a network of exclusive and selected boutiques and distributors, of which Respondent is not part. Furthermore, it does not appear that the Respondent is commonly known by the disputed domain name. Complainant concludes by stating that Respondent lacks rights or legitimate interests in the disputed domain name.

According to Complainant the disputed domain name has been registered and is being used in bad faith. Respondent registered the disputed domain name containing a very well-known third party's trademark without authorization. Due to this wide reputation, the Respondent could not ignore the existence of the LORO PIANA trademark at the time of its registration. The knowledge of Complainant's trademark was also confirmed in the reply to Complainant's cease and desist letter, where Respondent explains that the disputed domain name was intended to be used "for the sale of actual LORO PIANA products. No goods or other trademarks will be sold or mentioned on the website loropiana.shop". Therefore, Respondent never denied to be aware of the existence of Complainant's trademark at the time of the registration of the disputed domain name, but affirmed the contrary. The unauthorized registration of a domain name which is identical to a third party's well-known trademark cannot amount to registration in good faith.

As far as use in bad faith is concerned, Complainant submits that Respondent used the disputed domain name to generate profits from pay-per-click links. This amounts to bad faith use. Respondent is now passively holding the disputed domain name being well aware that it corresponds to the famous trademark belonging to Complainant, as such, preventing the Complainant from reflecting its trademark in the new gTLD ".shop".

Finally, Complainant submits that Respondent is also the owner of at least two other domain names entirely reproducing a

well-known trademark belonging to a third party. This well-known trademark is being used to distinguish a beer; one domain name is currently being used to access a webpage containing pay-per-click links referring to related activities, such as restaurants, cafeterias, and the like, while the other domain name is being used to access a webpage containing pay-per-click links referring to unrelated activities. Both domain names are offered for sale through GoDaddy auctions.

In light of the foregoing, Complainant concludes by stating that also the third and last requirement under paragraph 4(a)(iii) of the Policy is met.

RESPONDENT:

According to Respondent the disputed domain name is neither identical nor confusingly similar to the protected mark of Complainant for the following reasons. Respondent invites the Panel to approach the disputed domain name under two models, whereby the first is the assessment of the disputed domain name as is and without the suffix. As provided under the former, the disputed domain name incorporates the terms as that of the registered trademark of Complainant; however, there is no chance that one would confuse the same, which is based on the grounds that Complainant does not use any of its multiple domains as separate domains to display or host its products but redirects the domain names to www.loropiana.com, therefore, even the domain names with the term “shop” cannot be regarded as having any relation to the trademark owned by Complainant as there is not establishment of continued use that can mean that the term “Shop” has become distinctive and part of Complainant’s trademark, hence, making the disputed domain name to coincide with the trademark Loro Piana. Owing to the fact that the gTLD “.shop” seem not to be distinctively related to Complainant’s Trademark as registered and not having any trademark protection on the term “Shop” as part of the Trademark by way of Common Law, Respondent requests the Panel to dismiss the submissions made by Complainant.

Therefore, while there has been consistency in disregarding the gTLD, ccTLD, or sTLD, Respondent requests the Panel to consider the relevance of the gTLD “.shop” as a key factor on rendering its decision.

Respondent submits that he has rights and/or legitimate interest in the disputed domain name. Respondent reiterates that the disputed domain name was not redirected to parking pages by himself or by any of his staff, or agents, but this was done at the site that was hosting the disputed domain name at that material time that Complainant took the screenshots. Respondent, therefore, requests the Panel to dismiss the view that there was parking of the domain and nonuse of the disputed domain name by Respondent. It is also of importance to note that Respondent does not have whatsoever intention to sell the disputed domain name, hence, an element of legitimate interest in the disputed domain name. Respondent submits that he has clearly demonstrated that he acquired rights in the disputed domain name by usage even if the usage has been limited to a “pay-per-click” links page. Such usage does not itself signal a lack of rights and legitimate interests and can constitute a bona fide offering of goods or services.

Respondent also submits that it is clear that he is commonly known by the name of the disputed domain.

According to Respondent, prior to receiving the notice concerning this dispute, he has been working out on how to proffer products on the platform after acquiring a go-head from Complainant. As proof Respondent submits a one page paper with the following text:

“Synopsis of the Business Idea: we humbly request that this should be considered on grounds that our idea is not yet in a form that can be protected under any Intellectual Property Law, hence, we cannot share as is. Therefore, we trust that this synopsis will be of helpful.

The Synopsis of the Business Plan

Not too long ago, the majority of luxury brands were resistant to e-commerce, believing that it could never replicate the personalised customer service and tactile shopping experience that brick-and-mortar stores provide.

In ten years of working in the field of high-end interior design, we have noticed a shift in consumer behaviour towards the world of internet. That is why we started investing in the online presence we work with.

There is strong growth potential in high-end e-commerce. We want to join forces and make use of these opportunities: focusing on in-store sales only will not be enough to remain competitive.
.
We have designed a way to present the story behind it's craftsmanship, and to offer their latest collections on the internet. We will set up online mono-brand stores and include customised story-telling, respecting your brand identity. A successful collaboration is based on setting goals, long-term commitments and a strong vision. To ensure our market position, we have to put effort in building a professional online community together. Web stores need daily maintenance and development on all levels to remain competitive in the fast-changing online world."

In particular Respondent asserts that he has rights and legitimate interest in the disputed domain name based on the fact that the website was to be developed by a certain company that Respondent had hired to develop the domain of its other business entity. However, there were legal challenges that came along, hence, halting the whole process. Respondent submits a document (in the Dutch language) which concerns the case against the developer. Therefore, were it not for the said challenges, Respondent would have already had a website in place.

In addition, Respondent is clear on the fact that he intends to work closely with Complainant for purposes of enhancing business relationship, thus, Respondent to purchase the products of Complainant with a view of putting the same on sale as a certified retailer of Complainant's products.

Considering the above, it is evident that Respondent has established that he has the relevant rights and legitimate interest in the disputed domain name.

According to Respondent the disputed domain name has not been registered and used in bad faith.

Respondent notes that Complainant is heavily relying on the without prejudice communication of 3 November 2016, which should not be the case, therefore, the Panel should disallow any contribution made by Complainant as based on the without prejudice communication.

According to Respondent Complainant in its final submission about Respondent being the owner of at least two other domain names entirely reproducing a well-known trademark belonging to a third party, is utilizing "Character Assassination" on a ground that does not have any merit. The only way the information of Complainant's statement would be admissible and influential, is if Respondent would have undergone this similar process and a decision rendered against Respondent. In light of that, the Panel should discard that set of evidence and arguments.

Respondent also submits that it has taken a total of 15 months prior to effecting this process by Complainant, and this is considering the fact that Complainant wrote a letter dated 13 October 2016 and received feedback on 3 November 2016. However, Complainant institutes this case in February 2018. It is Respondent's submission that Complainant should be estopped based on the doctrine of laches.

RIGHTS

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

Complainant has, to the satisfaction of the Panel, shown 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

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

In the opinion of the Panel the disputed domain name is identical to Complainant's trademarks (Policy, Par. 4 (a)(i)) as the disputed domain name incorporates the LORO PIANA trademark in its entirety. Many UDRP decisions have found that a disputed domain name is identical or confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark or the principal part thereof in its entirety. The generic Top-Level Domain ("gTLD") ".shop" and the deletion of the space between the two words of the trademark may be disregarded. The Panel does not accept the unclear and unspecific arguments of Respondent that the disputed domain name is not identical to the trademarks of Complainant. It is consistent case law under the UDRP Policy to disregard the gTLD. See in particular paragraphs 1.11.1 and 1.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"): "The applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. The practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to "new gTLDs"); the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element."

In the opinion of the Panel Complainant has made a prima facie case that Respondent lacks rights or legitimate interest in the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use the well-known LORO PIANA trademark or to register the disputed domain name incorporating its mark.

Based on the evidence provided by Complainant the disputed domain name currently resolves to a website which mentions that it is currently not available. At different times the disputed domain name resolved to a website displaying pay-per-click links in the Italian language, including to competitors of Complainant, and to a GoDaddy parking page where the disputed domain name was offered for sale. The argument of Respondent that it had and has no control of the websites to which the disputed domain name resolves is irrelevant. The three uses as mentioned above cannot be considered a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks of Complainant. In addition, the website does not accurately and prominently disclose the relationship between Respondent and Complainant as the holder of the famous LORO PIANA trademark, in particular as there has never been any business relationship between Complainant and Respondent. Respondent is also not commonly known by the disputed domain name nor has he acquired any trademark rights.

The argument of Respondent that he had been working on a business plan how to offer products of Complainant on a website to which the disputed domain name resolves is highly unconvincing. The "Synopsis of the Business Plan" as quoted above in its entirety does not have a date and could well have been prepared after receiving the complaint. The Synopsis also lacks any detail. The document (in Dutch) as submitted by Respondent about the alleged case against a developer is also unconvincing as it is a unsigned 2017 draft-settlement agreement about a generic e-commerce platform without any specific reference to the disputed domain name. The Panel does not consider the Synopsis and the document submitted (in Dutch) as demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services.

The argument of Respondent that it intends to work closely with Complainant is irrelevant in view of the fact that Complainant should also agree to such cooperation; this is unlikely in view of the selective distribution system used by Complainant for its high-end products, of which system Respondent is not part as mentioned by Complainant.

Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name (Policy, Par. 4 (a)(ii)).

The Panel finds that the disputed domain name has been registered and is being used in bad faith (Policy, Par. 4(a)(iii)). The trademarks of Complainant have been existing for a long time and are well-known. Respondent knew or should have known that the disputed domain name included Complainant's LORO PIANA trademarks. This is clearly demonstrated by the letter of the lawyer of Respondent of 3 November 2016 as quoted above. Contrary to the submission of Respondent this letter is not a "without prejudice" letter; the letter is also not covered by any rules of professional secrecy as the lawyer of Respondent is not admitted to the Netherlands bar association.

The Panel notes that Respondent's initial use of the website at the disputed domain name, which incorporates Complainant's trademark, indicates that Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location. This amounts to bad faith use for purposes of the Policy. Furthermore, the fact that the disputed domain name currently resolves to a website which mentions that it is unavailable does not prevent the Panel from finding registration and use in bad faith. Passive holding of a website does not prevent the Panel from finding registration and use in bad faith. The Panel notes that the undeveloped use of such website at the disputed domain name which incorporates Complainant's well-known trademark in its entirety is to be regarded as an additional indication in this case that Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, as per paragraph 4(b)(iv) of the Policy.

The Panel does not take into account and disregards the submission of Complainant about Respondent being the owner of at least two other domain names entirely reproducing a well-known trademark belonging to a third party as there is no proof of decisions under the Policy in respect of the acts alleged by Complainant.

Finally, the Panel's finding is not affected by any delay in filing the Complaint between 2016 (the registration date of the disputed domain name) and February 2018, as asserted by Respondent. Remedies under the UDRP Policy are injunctive and aim to avoid ongoing or future confusion as to the source of communications, goods or services, also in view of the fact that the international and European Union LORO PIANA trademarks of Complainant, which apply in the Netherlands, were already registered well before the registration date of the disputed domain name and known to Respondent. See paragraph 4.17 of the WIPO Overview 3.0 that "delay" in bringing a complaint does not bar a complainant from filing a case under the UDRP: "Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. Panels have noted that the UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. … Panels have therefore declined to specifically adopt concepts such as laches or its equivalent in UDRP cases."

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LOROPIANA.SHOP**: Transferred

PANELLISTS

Name	**Dinant T.L. Oosterbaan**

DATE OF PANEL DECISION 2018-03-19

Publish the Decision