Decision for dispute CAC-UDRP-101953

Case number	CAC-UDRP-101953
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Domain names	PEUTEREYJAPAN.STORE

Case administrator

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

Complainant

Organization	G&P Net

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Name	zheng zhang

OTHER LEGAL PROCEEDINGS

None that the Panel has been made aware of.

IDENTIFICATION OF RIGHTS

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

- International trade mark number 646277 PEUTEREY, registered on 14 November 1995 in classes 24 and 25;
- International trade mark number 850742 PEUTEREY & device, registered on 9 May 2005 in classes 3, 9 and 25;
- EU trade mark number 7088867 PEUTEREY, registered on 4 February 2009 in class 18; and
- EU trade mark number 9604448 PEUTEREY & device, registered on 26 April 2011 in classes 3, 18 and 25.

FACTUAL BACKGROUND

The Complainant is an Italian clothing company with shops in many countries, including Italy, France, Germany and China. Its official website is available at www.peuterey.com.

The Respondent is an individual based in China.

The disputed domain name was registered on 14 September 2017. It is currently pointing to a website prominently featuring the Complainant's trade marks and supposedly selling PEUTEREY branded clothing.

Parties' Contentions

Complainant

Identical or confusingly similar

The Complainant evidences the four trade mark rights listed in the "Identification of Rights" section above. The Complainant submits that the disputed domain name is confusingly similar to its trade mark, incorporating the Complainant's trade mark in its entirety with the addition of the geographical term "Japan". The Complainant also contends that the use of the .STORE 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 geographical term "Japan" is not sufficient to prevent the disputed domain name from being confusingly similar to the trade mark PEUTEREY and to the domain names registered by the Complainant. The Complainant claims to be the owner of several domain names comprising the term PEUTEREY under various extensions such as .ORG, .NET, .EU, .IT, .FR, .ES and .US.

No rights or legitimate interests

The Complainant argues that the Respondent has no rights in the disputed domain name for the following reasons:

- the disputed domain name does not correspond to a trade mark registered in the name of the Respondent;

- the Complainant has not licensed or otherwise authorized the Respondent to use its trade marks, nor to apply for any domain name incorporating such trade marks; and

- to the best of the Complainant's knowledge, the Respondent is not commonly known as PEUTEREYJAPAN.

The Complainant is confident the above circumstances are adequate to demonstrate that the Respondent has no rights or legitimate interests in respect of the disputed domain name, especially given that it is currently used in connection with a website selling counterfeited PEUTEREY products.

Moreover, the Complainant states that a complainant 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.

Registered and used in bad faith

The Complainant contends that the disputed domain name was registered and is being used in bad faith.

The Complainant avers that its trade mark PEUTEREY is distinctive and well known all around the world. According to the Complainant, the fact that the Respondent has registered a domain name that is confusingly similar to it indicates that the Respondent had knowledge of the Complainant's trade mark at the time of registration of the disputed domain name. In addition, the Complainant states that if the Respondent had carried out even a basic Google search in respect of the word PEUTEREY, the same would have yielded obvious references to the Complainant.

Furthermore, the Complainant argues that the main aspect to take into consideration in order to establish the Respondent's bad faith is undoubtedly the fact that the disputed domain name is currently used in connection with a website selling counterfeit goods.

The Complainant contends that even a superficial overview of the website to which the disputed domain name is pointing

demonstrates that the e-shop operated is far from genuine.

In particular, the Complainant asserts that, regardless of the fact that the Complainant has never authorized such website:

- the e-shop is offering PEUTEREY branded products for sale at prices that are considerably lower than those of original PEUTEREY products;

- all the trade marks, images and photographs posted on the website related to the disputed domain name have been taken and awkwardly copied from the Complainant's official websites and catalogues without any previous authorization from the Complainant; and

- there is no privacy policy nor contact information explaining who is running the website and/or where the items for sale are currently located.

According to the Complainant, while it is clear that the sale of counterfeit goods under the Complainant's trade mark amounts to bad faith, the main consequence of such conduct is that customers may be led to believe that the website linked to the disputed domain name is somehow affiliated with the Complainant, or, even worse, that such website is owned by the Complainant, which is not the case.

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 the Policy have been 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 PEUTEREY.

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

In addition, it is widely accepted that the gTLD (in this case .STORE) 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 is used to point to a website offering for sale discounted alleged PEUTEREY

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.

Likewise, the 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 it demonstrates that the Respondent is 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 PEUTEREY 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 is 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 is being 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) of the Policy.

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. **PEUTEREYJAPAN.STORE**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2018-05-12

Publish the Decision