Decision for dispute CAC-UDRP-101957

Case number	CAC-UDRP-101957
Time of filing	2018-04-16 10:29:34
Domain names	philippplein.club

Case administrator

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

Complainant

Name	Philipp Plein

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Organization	LENBO

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.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks including the wording “PHILIPP PLEIN” in several countries, such as:

PHILIPP PLEIN, International Registration No. 794860, registered on December 13, 2002, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28;

PP PHILIPP PLEIN device, EU Registration No. 012259503, filed on October 28, 2013 and registered on March 24, 2014, for goods in classes 3, 14, 18, 20, 21, 24, 25, 28;

PHILIPP PLEIN EU Registration No. 002966505, filed on December 6, 2002 and registered on January 21, 2005 for goods in classes 3, 14, 18, 20, 21, 24, 25, 28.

FACTUAL BACKGROUND

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

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

The Complainant participates in the most important fashion shows around the world (Milan, Paris and New York, among others) and its advertising campaigns are universally renowned to be unique and very high-impact.

The world of Philipp Plein enjoys phenomenal success today with showrooms all over the world: more than 36 mono-brand stores and over 500 retail clients worldwide including Russia, as can be seen on http://world.philipp-plein.com/.

Philipp Plein currently has a turnover of over one hundred million euro.

Due to its longstanding use, and huge promotional and advertising investments, the PHILIPP PLEIN trademark is certainly well-known.

The Complainant is active on several social networks, including Facebook, Twitter and Instagram.

The Complainant is very active in the defense of its IP rights against abusive registration of domain names. Among the numerous UDRP favorable decisions, the Complainant wishes to cite CAC No. 101583 (Yuriy Shi/ Philipp Plein PHILIPPPLEINTSHIRT.COM) and 101584 (gueijuan xu/ philipp plein - CHEAPPHILIPPPLEINSALES.COM), which both recognized the fame of the Philipp Plein trademark.

Originally the Respondent's contact details were shielded by a Privacy Protection service, namely WhoisGuard Protected.

Following the filing of the Complaint, the Complainant was notified that the Respondent is LENBO.

Currently, the disputed domain name redirects to a web page, displaying the Complainant’s well-known trademarks and offering purported Philipp Plein items for sale.

The disputed domain name was registered on June 6, 2017.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that :

1. The disputed domain name is confusingly similar to the Complainant's trademarks

The Complainant states that the disputed domain name is confusingly similar to its trademarks PHILIPP PLEIN and PP PHILIPP PLEIN (device).

In support of this claim, the Complainant refers to prior UDRP cases and affirms that it is a well-established principle that when a domain name wholly incorporates the Complainant's registered mark, the first requirement under the UDRP shall be considered accomplished (see Six Continent Hotels, Inc. v. The Omnicorp, WIPO Case No. 2005-1249 and Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903).

Further, the complainant asserts that the addition of a gTLD such as ".club" in a domain name is a technical requirement and thus such element may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see Proactiva Medio Ambiente, S.A. v. Proactiva, WIPO Case No. D2012-0182).

2. The Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant contends that the Respondent is not commonly known by the disputed domain name and that the Respondent is not affiliated with or authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and is not related to the Complainant's business in any way. The Complainant does not carry out any activity for, nor does it have any business dealings with, the Respondent.

3. The disputed domain name has been registered and is being used in bad faith

The Complainant contends that the Respondent could not be unaware of 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, but also in consideration of the nature of the domain name (identical to the Complainant's trademark and name) and of the website contents.

The Complainant further states that the use of the disputed domain name, which links to a website offering purported "Philipp Plein" goods, and which unlawfully depicts copyright pictures taken from the Complainant's official website, is certainly not a use in good faith.

Finally, the Complainant states that a further indicator of bad faith may be inferred by the fact that the Respondent is using a privacy protection service in order to shield its contact information.

RESPONDENT:

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

A) Confusing similarity

The disputed domain name contains and perfectly corresponds to the Complainant's trademark PHILIPP PLEIN with the sole addition of the Top Level Domain ".club".

The “.club” is a technical element, and as such should be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark.

Consequently, the disputed domain name appears to be identical to and thus confusingly similar with the Complainant's trademark.

B) Lack of legitimate rights or interests

The disputed domain name is a distinctive, non-descriptive name. It is unlikely that the Respondent registered the disputed domain name without having the Complainant firmly in mind. The Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorized by the Complainant are sufficient to constitute a prima facie demonstration of the absence of rights or legitimate interests in the disputed domain name on the part of the Respondent. The burden of evidence therefore shifts to the Respondent to show, using tangible evidence, that it does have rights or legitimate interests in the disputed domain name. The Respondent has made no attempt to do so.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C) Registered or Used in Bad Faith

The Complainant gives sound bases for its contention that the disputed domain name was registered and has been used in bad faith.

Firstly, owing to the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademarks, and so the Panel finds on the balance of probabilities that the Respondent was aware of the Complainant’s trademark when registering the disputed domain name.

Secondly, the Panel accepts the Complainant’s unchallenged assertion that the Respondent registered the disputed domain name with the aim of creating a likelihood of confusion with the Complainant’s trademark.

Thirdly, it appears from the document provided by the Complainant that the Respondent is using the disputed domain name and the corresponding website for commercial gain, by redirecting to a website offering purported “Philipp Plein” goods, and unlawfully depicting copyright pictures taken from the Complainant’s official website.

Fourthly, the Respondent has not responded to nor denied any of the assertions made by the Complainant in this proceeding.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PHILIPPPLEIN.CLUB**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2018-05-18

Publish the Decision