Decision for dispute CAC-UDRP-102007

Case number	CAC-UDRP-102007
Time of filing	2018-05-21 11:52:48
Domain names	PHILIPPPLEIN-SHOP.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	Hines Anthony

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 is the owner of the following trademarks:

(i) Philipp Plein International Registration No. 794860, extended, among others, to China, of December 13, 2002, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28;

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

(iii) 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. Philipp Plein is universally recognized as a leading brand in the luxury fashion industry with showrooms all over the world: more than 36 mono-brand stores, over 500 retail clients worldwide and a turnover of over one hundred million Euro.

The Disputed domain name was registered on April 13, 2018 by Hines Anthony. Currently, the Disputed domain name redirects to a web page, displaying the Complainant's trademarks and offering for sale alleged Philipp Plein items.

The Complainant is of the opinion that the Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has right because the Disputed domain name wholly incorporates the Complainant's registered mark. The addition of the "-SHOP" element does not suffice to exclude the risk of confusion for an internet user. On the contrary, the word "SHOP" could be easily associated with Complainant's business, thus, increasing the risk of confusion for internet users. Further, the addition of a gTLD such as ".com" in a domain name is technically required.

The Complainant denies that Hines Anthony is an authorized dealer, agent, distributor, wholesaler or retailer of Philipp Plein's items. Furthermore, it is very improbable that the Respondent is commonly known by the Disputed domain name, as an individual, business, or other organization as the domain name is identical to the Complainant's trademarks and personal name.

Furthermore, Complainant states that the Respondent does not own "PHILIPP PLEIN" formative trademarks, which could legitimate the registration of the Disputed domain name.

The Disputed domain name is used to offer for sale alleged Philipp Plein's clothing, footwear, and other items. The website to which the Disputed domain name redirects displays in a prominent position the Philipp Plein wordmark and figurative mark.

It is very significant noting, that the Respondent is also using the original images of Philipp Plein's past and actual advertising campaigns. This circumstance increases the likelihood of confusion for the relevant consumer and constitutes a clear violation of the Complainant's copyright.

It is clear in the opinion of Complainant that the Respondent is using the Disputed domain name to present his website as an official e-commerce platform of the Complainant, offering for sale "alleged" Philipp Plein goods. Thus, the Respondent is taking unfair advantage of 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.

The Complainant states that the Respondent registered the Disputed domain name which contains a very well-known third party's trademark without any sort of authorization. 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, but also in consideration of the nature of the Disputed domain name (entirely containing the Complainant's trademark and name) and of the websites' contents.

As far as use in bad faith is concerned, the Complainant notes that the Disputed domain name links to a website offering alleged "Philipp Plein" goods, and unduly depicting copyright pictures taken from the Complainant's official website. The website also features the Complainant's figurative and verbal trademarks, in connection with conflicting goods. This kind of use is certainly not a use in good faith. It may cause substantial damages not only to the Complainant but also to consumers. On the one side, the Complainant's image and reputation are strongly affected by the website, very similar to the official one, offering for sale conflicting goods. On the other side, consumers share confidential information when they pay the purchased goods, with the concrete risk that this information is stolen and used fraudulently by the Respondent. It appears from the above that the Disputed domain name has been registered and is 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

A. Identical or Confusingly Similar

The Complainant has rights in the mark by virtue of its registered trademark Philipp Plein.

The Disputed domain name incorporates the whole of the Complainant’s Philipp Plein trademark, and adds the generic word “SHOP" as a suffix and the gTLD suffix “.com". Whilst the addition of the term “SHOP” is enough to preclude the Disputed domain name from being identical to the Complainant’s registered trademark, "Philipp Plein" is also the element that ensures that the Disputed domain name is confusingly similar to the "Philipp Plein" mark, and the Panel accepts the Complainant’s submissions in so finding.

The Panel agrees with the Complainant that the addition of the generic term "SHOP" separated by a hyphen at the end of the Disputed domain name and the gTLD “.com” is not sufficient to escape the finding that the Disputed domain name is confusingly similar to the Complainant's trademark and does not change the overall impression of the designation as being connected to the trademark "Philipp Plein", as the Philipp Plein trademark at the beginning of the Disputed domain name is the only distinctive part of the Disputed domain name. Therefore the Panel finds, that the Disputed domain name is confusingly similar to the Complainant’s trademark Philipp Plein.

B. Rights or Legitimate Interests

When a respondent remains completely silent in the face of a prima facie case that it lacks any rights or legitimate interests in respect of a domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. Here the Complainant has presented an abundance of evidence to show that the Respondent has no plausible right or legitimate interest in respect of the Disputed domain name and the Panel so finds.

C. Bad Faith

The Panel believes that Respondent registered the Disputed domain name with knowledge of Complainant's rights. The Disputed domain name was registered more than a decade after the registration of the trademarks of the Complainant and Complainant used it widely since then. Furthermore, the combination in the Disputed domain name of the Philipp Plein mark with the generic term "SHOP" and the offering of alleged “Philipp Plein” goods, and unduly depicting copyright pictures taken

from the Complainant’s official website and using the trademarks of Complainant on several places on the website of the Disputed domain name, shows that Respondent knows and has known Complainant´s trademark.

Moreover, the Panel agrees with Complainant that the Disputed domain name has also been registered in an effort to take advantage of the goodwill that Complainant had built up in its Philipp Plein trademark, and to unduly benefit from creating a diversion of the internet users of the Complainant by pretending to be an official online shop of the Complainant, because the Respondent is offering for sale the Complainant’s products and is displaying the trademarks of the Complainant.

Finally, the Respondent has, by prominently displaying the trademark of Complainant on the website, intentionally attempted to attract Internet users to the Respondent's website for commercial gain by offering (and probably selling) Complainant´s products and therefore creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of such websites.

On these grounds, the Panel concludes that the Respondent has registered and is using the Disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PHILIPPPLEIN-SHOP.COM**: Transferred

PANELLISTS

Name	**Jan Christian Schnedler, LL.M.**

DATE OF PANEL DECISION 2018-06-14

Publish the Decision