Decision for dispute CAC-UDRP-101973

Case number	CAC-UDRP-101973
Time of filing	2018-05-11 08:39:47
Domain names	pleinfrance.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	Ylliass Aaziz

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

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

PLEIN, EU Registration No. 10744837, filed on March 21st, 2012 and registered on August 1, 2012, 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:

I. The Complainant

The Complainant is the German fashion designer Philipp Plein, founder of a well-known brand. Plein is established in the luxury fashion branch (for more information on the Complainant's activities visit www.world.philipp-plein.com). The Complainant participates to the most important fashion shows around the world (Milan, Paris, New York, among others) and is advertising universally.

The market has applauded the Complainant's fashion collections which are presented with showrooms all over the world including France. Plein is expanding and currently has a turnover of over one hundred million Euro.

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

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.

II. The Respondent

The disputed domain name was registered on March 30, 2018 and, originally, the contact details were shielded by a Privacy Protection service, namely PERFECT PRIVACY, LLC.

Following the filing of the Complaint, and the disclosure of the contact details by the Registrar, the Complainant was informed that the disputed domain name was registered in the name of Ylliass Aaziz.

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

III. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

Relevant is here the trademark word "PLEIN", CTM - EU Registration No. 10744837, filed on March 21, 2012 and registered on August 1, 2012, for goods in classes 3, 14, 18, 20, 21, 24, 25, 28.

The disputed domain name is confusingly similar to the above-mentioned trademarks.

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). In this regard, we note that the addition of the element "FRANCE" increases, rather than excludes, the confusing similarity between the domain name and the prior trademarks: it is clear, that, in this way, the relevant public will perceive the domain name as an official Philipp Plein's online platform for the French public of for the French territory.

Further, the addition of a gTLD such as ".com" in a domain name is technically required. Thus, it is well established that 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).

Therefore, the disputed domain name is confusingly similar to the earlier Philipp Plein well-known trademarks, and the first requirement under para. 4 (a)(i) of the Policy and of para. 3(b), (viii), (b)(ix)(1) of the Rules is satisfied.

IV. The Respondent has no rights or legitimate interests in respect of the disputed domain name

According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent's rights or legitimate interests in respect of the disputed domain name lies with Complainant. It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for the Complainant to produce a prima facie evidence in order to shift the burden of production to Respondent. See, e.g., Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Audi AG v. Dr. Alireza Fahimipour, WIPO Case No. DIR2006-0003.

Mr. Ylliass Aaziz is not a dealer, agent, distributor, wholesaler or retailer of the Complainant, and never received an authorization to use the trademark PLEIN, in any manner whatsoever. Further, the Respondent is not commonly known by the disputed domain name, as individual, business, or other organization as the disputed domain name is identical to the Complainant's trademark and to the stylist's surname.

Finally, to the best knowledge of the Complainant, the Respondent does not own "PLEIN" formative trademarks which could grant him rights on the disputed domain name.

In light of these considerations, the Complainant excludes that the Respondent is commonly known by the disputed domain name under Art. 4(c)(ii) of the Policy.

Currently, the disputed domain name is used to offer for sale alleged Philipp Plein's clothing, footwear and other items. As said above, the website to which the disputed domain name redirect displays in a prominent position the Philipp Plein wordmark and figurative mark.

It is clear that the Respondent is using the disputed domain name to promote 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 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.

V. The disputed domain name is registered and used in bad faith

In accordance with paragraph 4(a)(iii) of the Policy in order to succeed in a UDRP Proceeding, the Complainant must prove, as a third and last requirement, that the Respondent registered and used the disputed domain name in bad faith.

As far as registration in bad faith is concerned, the Respondent's registered domain name contains a very well-known third party's trademark without any sort of authorization. The Respondent could not ignore the existence of the PLEIN and PHILIPP PLEIN trademarks at the time of the registration of the disputed domain name, not only because they are very well-known trademarks, but also in consideration of the nature of the domain name (containing the Complainant's trademark and surname) 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. 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.

A further index of bad faith could be inferred by the fact that the Respondent used a privacy protection service, in order to shield the contact information. It is clear that in this case, the privacy service was used to prevent the Complainant and the Panel from knowing the relevant information on the underlying registrant of the disputed domain name.

In view of the above, Complainant respectfully submits that the disputed domain name was registered and is being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) of the Policy.

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

I. RIGHTS

The disputed domain name is confusingly similar to the Complainant's registered trademarks because the disputed domain name wholly incorporates the Complainant's registered mark PLEIN (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)). The addition of the element "FRANCE" does not exclude the confusing similarity between the domain name and the prior trademark. Moreover, in this way, the relevant public will perceive the domain name as an official PLEIN's online platform for the French public and for the French territory.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the disputed domain name (see pointed out in UDRP case No. D20020856: "As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists."

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

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant´s allegations and evidence with regard to the Respondent´s registration and use of the disputed domain name in bad faith.

Paragraph 4(b) (iiii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the 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 its website or location or of a product or service on its website or location.

The Complainant's trademarks, e.g. PLEIN are well-known in the luxury fashion industry, well before the registration of the disputed domain name. The Respondent's registration of the disputed domain name wholly incorporating a well-known third-party mark is, in the Panel´s view, indicative of bad faith.

As mentioned in Andrey Ternovskiy dba Chatroulette v. Alexander Ochki, WIPO Case No. D2017-0334: "It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see AT&T Corp. v. Amjad Kausar, WIPO Case No. D2003-0327)."

Here is the use of the disputed domain name in bad faith too because its directed to a platform offering goods of the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PLEINFRANCE.COM**: Transferred

PANELLISTS

Name	**Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2018-07-01

Publish the Decision