Decision for dispute CAC-UDRP-102058

Case number	CAC-UDRP-102058
Time of filing	2018-09-25 12:15:15
Domain names	plein-factory.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 that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

(i) EU word trademark Plein, no. 010744837, filed on 21 March 2012 for goods and services in classes 3, 14, 18, 20, 21, 24, 25 and 28;

(ii) International word trademark Philipp Plein, no. 794860, filed on 13 December 2002, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28;

(iii) EU figurative trademark PP PHILIPP PLEIN and device, no. 012259503 filed on 28 October 2013, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28;

(iv) Philipp Plein EU Registration No. 002966505, filed on 6 December 2002, and registered for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28.

(“Complainant’s Trademarks”)

The disputed domain name was registered on 6 August 2018.

FACTUAL BACKGROUND

As the Respondent did not file any response to the complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) The Complainant is the German fashion designer Philipp Plein, founder of the eponymous brand. Currently, Philipp Plein is universally recognized as a leading brand in the luxury fashion industry;

(b) the Complainant is the owner of the Complainant's Trademarks;

(c) 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.

The Complainant seeks transfer of the disputed domain name to the Complainant.

PARTIES CONTENTIONS

THE COMPLAINANT:

In addition to the above stated factual assertions, the Complainant also contends the following:

(i) The disputed domain name is confusingly similar to Complainant's Trademarks as addition of a generic term "factory" to the disputed domain name does not create a new or different right to the mark or diminish confusing similarity;

(ii) The Complainant denies that the Respondent has any right or legitimate interest in registering the disputed domain name. Mr. Ylliass Aaziz is not a Complainant's dealer, agent, distributor, wholesaler or retailer and has never been authorized to register Philipp Plein and Plein as a domain name. Furthermore, the Respondent is not commonly known as "PLEIN-FACTORY", as Plein is the Complainant's surname and is registered as a trademark while the Respondent name is Ylliass Aaziz.

(iii) Currently, the disputed domain name is being used to offer for sale alleged Philipp Plein's clothing, footwear and other items. Considering the prices, it is very probable that the items offered for sale under the disputed domain name are counterfeit. Original Philipp Plein's t-shirt cost more than 300,00 Euro (as you see on www.plein.com much more than the 60,00 Euro indicated under the disputed domain name).

(iv) It is clear that the Respondent is using the disputed domain name to present his website as an official e-commerce platform owned, directly or indirectly, by the Complainant. Thus, the Respondent is taking unfair advantage from the distinctive character and reputation of the Complainant's Trademarks and unduly seeking to profit from the Complainant's goodwill for its own financial gain.

(v) The Respondent has registered and used the disputed domain name in bad faith, 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 also the fact that goods on sale on the website are counterfeit is a further evidence of bad faith use of the disputed domain name.

THE RESPONDENT:

The Respondent did not provide any response to the complaint.

RIGHTS

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

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements to obtain an order that the Disputed domain name should be transferred or cancelled:

(i) the Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

RIGHTS

The disputed domain name is confusingly similar to the Complainant’s Trademarks. It includes the distinctive element “plein” which is identical to the Complainant’s Trademarks. The Panel agrees with the Complainant that adding a generic term “factory” to the disputed domain name does not diminish confusing similarity of the disputed domain name to Complainant’s Trademarks.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTEREST

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (please see, for example, WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd. <croatiaairlines.com>).

At the time of filing of the Complaint, there was an e-shop where products of the Philipp Plein brand were being offered for sale operated under the Disputed domain name. Based on the screenshots provided by the Complainant there appears to be

no information on the website as to the identity of the Respondent or its relationship with the Complainant. In the opinion of the Panel, as both Complainant and Respondent appear to be domiciled in the EU, a general principle of EU law applies that reseller (even an unauthorized one) may generally use the trademark of the brand it sells to advertise genuine products of that brand provided that such use is customary for the industry in question and not damaging the reputation of the trademark (please see for example the ECJ case C-337/95 Christian Dior v. Evora). Having applied this principle to the field of domain names a conclusion can be made that a reseller selling genuine products of a brand could generally have legitimate interest to use the name of such brand also in a domain name. However, there are certain important obligations which such reseller has to meet. Such obligations were outlined in the WIPO Case No. D2001-0903 Oki Data Americas, Inc. v. ASD, Inc., <okidataparts.com> and are the following:

(i) the reseller must actually be offering the goods or services at issue;

(ii) the reseller must use the site to sell only the trademarked goods or services;

(iii) the site must accurately and prominently disclose the reseller's relationship with the trademark holder; and

(iv) the reseller must not try to "corner the market" in domain names that reflect the trademark.

Although no evidence of such fact has been presented, the Complainant believes that the products sold on the Respondent's website may be counterfeit (based on the apparent difference in prices at the website and prices in the official distribution channels of Complainant's brand). Whether this is true or not, the Respondent has not properly explained its relationship to the Complainant, in particular, there is no reference made to unofficial distributor status of the Respondent or origin of the products. Therefore, the Respondent failed to meet the requirement under point (iii) above.

At the time of the decision, there is no longer any website operated under the disputed domain name, which is also a fact which contradicts Respondent's rights or legitimate interest in the disputed domain name.

BAD FAITH

The Panel also finds that the Respondent must have registered the disputed domain name in the full knowledge of Complainant's Trademarks, as the Respondent's website sold Complainant's products. Therefore, the Respondent also must have been aware of the fact that it is not authorized reseller of Philipp Plein products. However, the Respondent failed to disclose such fact to consumers. Therefore, the Respondent apparently intended to conceal the fact that it is not authorized reseller of Philipp Plein brand and mislead the consumers to believe that, as a result of displaying the Complainant's Trademarks at Respondent's website, the products sold at such website come from the Complainant or its authorized distributor. Such conduct would be regarded as unfair competition (or passing off) in many EU jurisdictions and in the opinion of the Panel, it is also evidencing bad faith of the Respondent upon registration and use of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PLEIN-FACTORY.COM**: Transferred

PANELLISTS

Name	**Michal Matějka**

DATE OF PANEL DECISION 2018-11-11

Publish the Decision