Decision for dispute CAC-UDRP-102183

Case number	CAC-UDRP-102183
Time of filing	2018-10-10 14:50:22
Domain names	philipppleinoutlet.net

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Name	Philipp Plein

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Name	Ellis Jen

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:

(i) Plein, EU Registration no. 010744837, filed on March 21st, 2012 and registered on August 1st, 2012, for goods in classes 3, 14, 18, 20, 21, 24, 25, 28;

(ii) PP (device), EU Registration no. 9869777, filed on April 5th, 2011, and registered on March 3rd, 2013, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28;

(iii) Philipp Plein EU Registration No. 002966505, filed on December 6, 2002 and registered on January 21st 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:

I. The Complainant

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. For more information on the Complainant's activities, please visit http://world.philipp-plein.com/.

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

The market has applauded the Complainant's fashion collections, and the world of PHILIPP PLEIN is enjoying a phenomenal success today with showrooms all over the world: more than 36 mono-brand stores, over 500 retail clients worldwide, Russia included, please see http://world.philipp-plein.com/.

Philipp Plein runs at a double-digit rate of expansion, and currently has a turnover of over one hundred million Euro. According to Franca Sozzani, historic editor in Chief of Vogue Italia, "Philipp Plein is unique because he has a joy of life. He does not want to be a fashionista, he makes fashion because he loves women. This is a specific, special attitude because he is one of the few". Philipp 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 and PLEIN trademarks are certainly well known.

The Complainant is active on several social networks, such as 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. 101930, CAC No. 101848, CAC No. 101845, CAC No. 101819, CAC No. 101748, CAC No. 101747, CAC No. 101746, CAC No. 101584, CAC 101583. It is very significant to note that most of the mentioned decisions recognized the reputation of the PHILIPP PLEIN trademark.

II. The Respondent

The disputed domain name was registered on August 22nd, 2018. At the time of the filing, the whois contact details were not available. Following the filing of the Complaint, the Registrar disclosed the Respondent's identity informing the Complainant that the domain name is registered by Ellis Jen. 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 domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

Among the various Plein / Philipp Plein formative trademarks, the Complainant is the owner of the following:

(i) Plein, EU Registration no. 010744837, filed on March 21st, 2012 and registered on August 1st, 2012, for goods in classes 3, 14, 18, 20, 21, 24, 25, 28;

(ii) PP (device), EU Registration no. 9869777, filed on April 5th, 2011, and registered on March 3rd, 2013, for goods in classes 3, 14, 18, 20, 21, 24, 25 and 28;

(iii) Philipp Plein EU Registration No. 002966505, filed on December 6, 2002 and registered on January 21st 2005 for goods in classes 3, 14, 18, 20, 21, 24, 25, 28.

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 the present case, the disputed domain name entirely contains the Complainant's trademark PHILIPP PLEIN.

The addition of the "OUTLET" element is not sufficient to exclude the risk of confusion for an internet user. On the contrary, the word "OUTLET" could be easily associated to the Complainant's business, thus, increasing the risk of confusion for internet users as confirmed by previous decision (i.e. <philippplein-shop.com> CAC no. 102007; <philipppleinoutletcheap.com> CAC no. 101848).

Further, the addition of a gTLD such as ".net" 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 Plein / Philipp Plein well-known trademarks, and the first requirement under paragraph 4 (a)(i) of the Policy and of paragraph 3(b), (viii), (b)(ix)(1) of the Rules is satisfied.

IV. The Respondent has no rights or legitimate interests in respect of the 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 domain Name lies with the 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.

The Complainant denies that the Respondent could have any right or legitimate interest in registering the disputed domain name. Ellis Jen is not a dealer, agent, distributor, wholesaler or retailer of Philipp Plein and has never been authorized to register and use Philipp Plein as domain name. Furthermore, is very improbable that the Respondent could be commonly known as "PHILIPPPLEINOUTLET", as PHILIPP PLEIN is the fashion designer full name and trademark, while "outlet" is a descriptive term, strictly related to the Complainant's business, while the Respondent's name is Ellis Jen.

Additionally, the Respondent does not own any "PHILIPP PLEIN" formative rights which could grant him rights in the disputed domain name.

In light of these considerations, the Complainant excludes that the Respondent is commonly known by the disputed domain name under paragraph 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. Considering the prices, it is very probable that the items offered for sale on <philipppleinoutlet.net> 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 40,00-50,00 Euro distinguishing the items offered for sale through the disputed domain name.

As said above, the website to which the domain name redirects display in a prominent position the Philipp Plein wordmark and figurative mark as well as original images of Philipp Plein's past and actual advertising campaigns. These circumstances increase the likelihood of confusion for the relevant consumer and are a clear violation of the Complainant's copyright.

It is clear that the Respondent is using the disputed domain name to promote his website as an official ecommerce 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 trademark and unduly seeking to profit from the Complainant's goodwill for its own financial gain.

All above considered, the Complainant deems to have sufficiently proved the absence of rights or legitimate interests in the disputed domain name.

V. The domain name was registered and is being 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 domain name in bad faith.
As far as registration in bad faith is concerned, the Respondent registered a domain name containing 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 well-known trademark, but also in consideration of the nature of the domain name (entirely containing the Complainant's trademark associated with a descriptive term) and of the websites' contents.

As far as use in bad faith is concerned, we note that the disputed domain name links to a website offering for sale alleged "Philipp Plein" items, 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 goods which are very likely counterfeit. 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 web site, 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.

It is very significant to note that the website to which the disputed domain name redirects, is also selling items distinguished by other trademarks, i.e. KENZO. Therefore, the reputation of the PHILIPP PLEIN trademark is exploited to promote other brands, and this circumstance is a further index of use in bad faith.

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 since it reproduces the Complainant’s mark ‘PHILIPP PLEIN’, merely adding the generic expression "OUTLET" at the end.

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.

As the WIPO Arbitration and Mediation Center 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.“ WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, from the trademark search submitted by the Complainant can be seen that the Respondent does not own any trade mark registration with that name.

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) (iii) 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 PHILIPP PLEIN trademark is 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.

Furhermore, the Respondent´s website sells both products with the Complainant´s mark (for an unusually low price) or with third parties’ trademarks, thus taking advantage of the Complainant´s reputation.

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)."

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PHILIPPPLEINOUTLET.NET**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2018-11-19

Publish the Decision