Decision for dispute CAC-UDRP-102184

Case number	CAC-UDRP-102184
Time of filing	2018-10-10 13:53:40
Domain names	philipp-plein.club

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Name	Philipp Plein

Complainant representative

Organization	Barzanò & Zanardo Milano S.p.A.

Respondent

Organization	Leno Trade Company

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

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.

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 recognized as a leading brand in the luxury fashion industry. The Complainant owns <philipp-plein.com>.

The Complainant participates in the most important fashion shows around the world (Milan, Paris, New York, among others).

The Complainant owns showrooms all over the world: more than 36 mono-brand stores and has over 500 retail clients worldwide including Russia.

Philipp Plein runs at a double-digit rate of expansion, and currently has a turnover of over one hundred million Euro. 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 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. There have been numerous UDRP favorable decisions recognizing the reputation of the PHILIPP PLEIN trademark.

II. The Respondent

The disputed domain name was registered on August 16th, 2018. The disputed domain name redirects to a web page, displaying the Complainant’s well-known trademarks including its logo and offering for sale alleged Philipp Plein items.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

The Complainant’s contentions can be summarised as follows:

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

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.

Further, the addition of the new gTLD such as ".club" 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 para. 4 (a)(i) of the Policy and of para. 3(b), (viii), (b)(ix)(1) of the Rules is satisfied.

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 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 has any right or legitimate interest in registering the disputed domain name. As a matter of fact, neither Leno Trade Company nor Tan Smith are Complainant's dealers, agents, distributors, wholesalers or retailers and have never been authorized to register Philipp Plein and Plein as a domain name. Furthermore, the Respondent is not commonly known as "PHILIPP-PLEIN.CLUB", as Philipp Plein is the Complainant's name and is registered as a trademark while the Respondent name is Tim Smith and Leno Trade Company.

Additionally, the Respondent does not own "philipp plein" or "plein" formative trademarks which could grant him rights on the disputed domain name and is not 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. Considering the prices, it is very probable that the items offered for sale on <philipp-plein.club> 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 of the items offered for sale through the disputed domain name.

As said above, the website to which the disputed 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 e-commerce platform owned, directly or indirectly, by the Complainant. 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 Respondent does not have rights or legitimate interests in the disputed domain name.

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 disputed domain name in bad faith.
As far as registration in bad faith is concerned, the Respondent registered a domain name containing a 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 and of the websites' contents.

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 logo and verbal trademarks, in connection with conflicting goods. 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.

In addition, the disputed domain name is identical to the Complainant's trademarks. Generally, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation.

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

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

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark containing it in its entirety and adding only a hyphen and the gTLD.club which do not prevent this confusing similarity.

The Respondent is using the disputed domain name to offer suspected counterfeit goods using the Complainant's name, logo and copyright marketing materials to suggest the site attached to the disputed domain name is an official site of the Complainant. This is not a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name. The Respondent is not commonly known under the disputed domain name or authorised by the Complainant. In the light of the lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The disputed domain name has been attached to a site which is being passed off as an official site of the Complainant using the Complainant's word mark and official logo. Accordingly the Panel finds that the disputed domain name has been used to attract Internet consumers for commercial gain and to disrupt the Complainant's business and has been registered and used in bad faith within the meaning of para. 4 (b)(iii) and (iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PHILIPP-PLEIN.CLUB**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2018-11-19