Decision for dispute CAC-UDRP-101576

Case number	CAC-UDRP-101576
Time of filing	2019-02-18 09:19:55
Domain names	rogervivierhongkong.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	ROGER VIVIER S.P.A.

Complainant representative

Organization	Convey srl

Respondent

Name	Sun Cai Long

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 names.

IDENTIFICATION OF RIGHTS

The Complainant owns a number of trademarks, including the following relevant trademark registrations:

- the International trademark n° 348577 for the figurative mark “Roger Vivier Boutique”, registered on August 29, 1968 for goods in classes 3,18, 21 and 25;

- the International trademark extended in China n° 590402 for the figurative mark “ROGER VIVIER, registered on August 5, 1992 for goods and services in classes 3, 9, 14, 15, 18, 20, 21, 24, 25, 26, 34 and 42;

- the European Union trademark n° 006349138 for the word mark “Roger Vivier”, registered on October 17, 2008, for goods and service in classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 26, 34, 35 and 42;

- the International trademark n° 1022702 for the figurative mark “RV Roger Vivier”, registered on August 20, 2009 for goods and services in classes 3, 9, 14, 16, 18, 24, 25 and 35;

- the International trademark extended in China n° 1120203 for the word mark “VIVIER”, registered on May 14, 2012 for goods in classes 9, 14.

Such trademarks are hereinafter individually and jointly referred to as the "Rogier Vivier" trademarks.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENTS

1. The Respondents are one and the same person and the Complainant requests the matters to be consolidated.

2. Although the language of the registration agreements for the disputed domain names is Chinese, the Complainant requests the language of these proceedings to be English.

3. The Complainant is a company with headquarters in Italy which is known around the world as one of most prominent high-end fashion and luxury industry, which opened in 1937. Currently the Complainant actively designs a wide range of luxury products such as shoes, bags and women accessories distributed all around the world through more than 44 boutiques. In 2016 the Complainant had a worldwide turnover of 166,3 million euros. The trademark “Roger Vivier” is distinctive and well known all around the world ,which has been registered as trademark for the first time in 1968.

4. The disputed domain names were registered by the Respondents in 2013, except the disputed domain name <vivierroger.net>, which was registered in 2016, without authorization of Complainant. Before receiving the Complainant's cease and desist letters, the Respondents redirected the disputed domain names to websites in English which were very similar to each other and to the current websites, publishing the "Roger Vivier" trademarks and promoting and selling counterfeit products of the Complainant.

5. The disputed domain names are confusingly similar to the the "Roger Vivier" trademarks, because they incorporate the whole of the "Roger Vivier" trademarks and include non-distinctive elements such as a year (“2014”), a geographical indicator (“Hong Kong”), and hyphens.

6. The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondents are not licensees, authorized agents of the Complainant or in any other way authorized to use Complainant’s trademarks. Specifically, the Respondents are not authorized resellers of the Complainant and have not been authorized to register and use the disputed domain names. Upon the Complainant's information and belief, the Respondents are not commonly known by the disputed domain names as individuals, business or other organization and their family names do not correspond to "Roger Vivier" or the disputed domain names. It is apparent that the Respondents' use can be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names. Furthermore, such use of the disputed domain names cannot be considered a legitimate non-commercial or fair use without intent for commercial gain.

7. the disputed domain names were registered were being used in bad faith. The Complainant has been using the "Roger Vivier" trademark in China since 1992. Considering the advertising and sales of the Complainant’s products worldwide, the Respondents could not have possibly ignored the existence of "Roger Vivier" trademarks which enjoy worldwide reputation in the sector of luxury shoes and which are confusingly similar to the disputed domain names. The disputed domain names were registered between April 2013 and March 2016, years after the Complainant obtained its trademark registrations. Furthermore, the actual knowledge of "Roger Vivier" trademarks by Respondents at the time of the registration of the disputed domain names is demonstrated by the facts that the Respondents offer for sale replicas of Complainant’s shoes and that the Respondents reproduce also the "Roger Vivier" trademarks on the web sites corresponding to the disputed domain names. The fact that counterfeit "Roger Vivier" shoes have been offered for sale on the web sites corresponding to the disputed domain names indicate that the Respondents were fully aware of the Complainant’s trademarks' reputation and association with the Complainant and that their purpose in registering the disputed domain names was solely to capitalize on the reputation of "Roger Vivier" trademark by diverting Internet users seeking products under the "Roger Vivier" trademark to its own commercial web site.

PARTIES CONTENTIONS

On March 8, 2019 the Center received an email from a Mr. Fulvio Meconi, who stated that the disputed domain names "are domains that I registered very early. After registration, I rented them to a third-party advertising company for management. I just received your complaints. If I can, I can transfer these domains to you completely. As a trademark owner, I also hope you can buy these domain names". Further, no Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are confusingly similar to the "Roger Vivier" trademark 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 names 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 names have been registered and were being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

Consolidation of proceedings

The Complainant requested to the consolidate the cases against the two Respondents in these proceedings, because they would be one and the same. The Complainants have requested consolidation of the Complainants.The consensus view of UDRP panels is expressed in WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 4.11.2: "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario." The Panel is satisfied that the Complainant submitted convincing and adequate evidence showing that the disputed domain names are under common control. The Complainant's evidence is further supported by the email of March 8, 2019 where the sender identified himself as Fulvio Meconi and asserted that he registered all disputed domain names which he is willing to sell to the Complainant. As a result thereof consolidation of the Respondents is fair and equitable in absence of arguments from the Respondents, which profoundly lacking. The Panel therefore allows the consolidation of the Respondents.

Language of proceedings

Paragraph 11(a) of the Rules provides that “unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”. The purpose of Paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the parties’ level of comfort with each language, the expenses to be incurred and possibility of delay in the proceeding in the event translations are required and other relevant factors (e.g. Deutsche Messe AG v. Kim Hyungho, WIPO Case No. D2003-0679). In this respect, the Panel must take into account “all relevant circumstances” (e.g. SWX Swiss Exchange v. SWX Financial LTD, WIPO Case No. D2008-0400). In this case, the language of the Registration Agreement is Chinese. The Complainant has submitted a request that the language of the proceedings shall be English. The Complainant argues that the language of the proceedings should be English because the Respondent appears to be familiar with the English language as the disputed domain names resolve to a websites that contain English content, while the disputed domain names are written in Roman script. The Respondents did not respond to the Complainant’s request to change the language of proceedings, but rather sent the Center an email on March 8, 2019 in English. The Panel is therefore satisfied that the Respondents have a sufficient knowledge of English to understand the Complaint. Under these circumstances, ordering the Complainant to translate the Complaint into English would unnecessarily delay the proceedings. The Panel therefore decides that the language of the

proceedings shall be English.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain names are confusingly similar to the Complainant's "Rogier Vervier" trademarks as the difference between the disputed domain names and the Complainant's trademarks are insignificant to the overall impression.

2. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondents have made no use of, or demonstrable preparations to use, neither of the disputed domain names in connection with a bona fide offering of goods or services, nor were they making a legitimate non-commercial or fair use of the disputed domain names, nor are they commonly known under the disputed domain names. This prima facie evidence was not challenged by the Respondent.

3. In the absence of a Response, the Panel infers that the Respondent had the Complainant's "Rogier Vervier" trademarks in mind when they registered the disputed domain names,. It is further undisputed that the disputed domain names resolved to websites that offered counterfeit shoes under the Complainant's "Rogier Vervier" trademarks for sale, which constitutes use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ROGERVIVIERHONGKONG.COM**: Transferred
2. **ROGERVIVIER2014.NET**: Transferred
3. **VIVIERROGER.NET**: Transferred
4. **ROGER--VIVIER.NET**: Transferred
5. **ROGER--VIVIER.COM**: Transferred

PANELLISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2019-04-17

Publish the Decision