

Decision for dispute CAC-UDRP-103788

Case number	CAC-UDRP-103788
Time of filing	2021-05-14 08:36:22
Domain names	cheaprogervivieroutlet.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	ROGER VIVIER S.P.A.
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Complainant representative

Organization	Convey srl
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Respondent

Organization	linannan
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the ROGER VIVIER trademark since 1968, including but not limited to the followings:

- the International trademark n° 348577 for the figurative mark "Roger Vivier Boutique" (registered on 1968-08-29) designating goods in classes 3,18, 21, 25;
- the International trademark extended in China n° 590402 for the figurative mark "ROGER VIVIER" (registered on 1992-08-05) designating goods in classes 3, 9, 14, 15, 18, 20, 21, 24, 25, 26, 34, 42;
- the European Union trademark n° 006349138 for the word mark "Roger Vivier" (registered on 2008-10-17) designating goods in classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 26, 34, 35, 42;
- the International trademark n° 1022702 for the figurative mark "RV Roger Vivier" (registered on 2009-08-20) designating goods in classes 3, 9, 14, 16, 18,24, 25, 35;
- the International trademark extended in China n° 1120203 for the word mark "VIVIER" (registered on 2012-05-14) designating goods in classes 9, 14;

The Complainant claims that the trademark "Roger Vivier" is distinctive and well known all around the world, it has been

registered as trademark for the first time in 1968, although it had already been previously advertised since the early Fifties in numerous media, such as newspapers and specialized magazines. Furthermore, M. Roger Vivier was chosen on June 1953 to design the shoes that the future queen - Elizabeth II - would have worn during her solemn coronation. M. Roger Vivier created also a pair of shoes for Princess Soraya of Iran in 1962 which was sold in an auction in November 2011 for a record sum of 19.763,00 Euros.

In the last [few] years, the Complainant has been expanding its target to new eastern markets both by hiring renowned testimonials and by opening new sale points in Beijing, Shenyang, Taipei and Hong Kong in Fall 2012. Currently, there are nineteen Roger Vivier boutiques in China.

Furthermore, the Complainant has been extensively using the "ROGER VIVIER" denomination on all internet environments including and not limited to the company's official websites – among which are "www.rogervivier.com", "rogervivier.net", "rogervivier.org", "rogervivier.info", "rogervivier.biz", "rogervivier.it".

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, Roger Vivier S.p.A. is a company with headquarters in Sant'Elpidio al Mare, FM (ITALY). Roger Vivier S.p.A. is known around the world as one of most prominent high-end fashion and luxury industry. The first boutique of the brand was established in Paris, France, in 1937 by a young French fashion designer Monsieur Roger Henri Vivier (13 November 1903 - 3 October 1998) who specialized in shoes. Worldwide, he is known as the "Fabergé of footwear" or the "Fragonard of The Shoe".

Currently the company actively designs a wide range of luxury products such as shoes, bags and women accessories distributed all around the world via the official website and through more than 60 prestigious Boutiques. As of 2018 the company released a worldwide turnover of 179 million €.

Throughout the last decades ROGER VIVIER S.p.A. has designed and created the shoes of many celebrities, such as Cate Blanchett, Penelope Cruz, Scarlett Johansson, Charlize Theron, Sharon Stone, Marion Cotillard, Kate Winslet, Katie Holmes, Jessica Alba, Freida Pinto, Anne Hathaway, Shu Qi, Fan Bingbing and Jennifer Lawrence.

The Complainant has served a Cease and Desist letter on April 23, 2021 to Respondent's known email address indicated at that time in the website. The Respondent did not deem appropriate to answer.

The Registration Date of the disputed domain name is May 6, 2018.

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).

First, the Complainant claims rights in the ROGER VIVIER mark through its trademark registration. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

Second, the Complaint claims that the additional generic or descriptive terms "cheap" and "outlet" do not distinguish the domain name from Complainant's ROGER VIVIER trademark. In addition, the ".com" generic top-level domain ("gTLD") is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant claims that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the Domain Name. In addition, the Complainant further claims that the Respondent is not commonly known by the Domain Name as individuals, business or other organization and their family names do not correspond to ROGER VIVIER or the Domain Name.

Second, the Complainant argues that Respondent is using the disputed domain name to pass off as Complainant in order to offer what appear to be counterfeits of Complainant's goods. Using a confusingly similar domain name to pass off as a complainant and offer counterfeit products evince a failure to make a bona fide offering of goods or services or a legitimate noncommercial or fair use. See *Philipp Plein v. Leno Trade Company*, 102184 (CAC 2018-11-19). Complainant has provided a screenshot of the resolving website, which displays the ROGER VIVIER mark and various images of shoes for sale. The Complainant also provides a screenshot of its own website for comparison purposes. The Complainant alleges that the goods offered on Respondent's website are counterfeit given the heavily discounted prices. Accordingly, the Panel finds that Respondent attempts to pass off as Complainant to offer counterfeit goods, failing to use the domain name in connection with a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant argues that Respondent had actual knowledge of Complainant's rights in the ROGER VIVIER mark at the time of registering the disputed domain name. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name evinces bad faith under paragraph 4(a)(iii) of the Policy. See *ARCELORMITTAL (SA) v. acero*, 102399 (CAC 2019-04-22). Complainant contends that Respondent's knowledge can be inferred given the ROGER VIVIER mark was promoted and publicized in China where the Respondent is domiciled, and as shown by Respondent's attempts to pass off as Complainant on the resolving website. The Panel also notes that the disputed domain name was registered 50 years after the registration of Complainant's ROGER VIVIER trademark. The Panel agrees with Complainant and finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration under Policy ¶ 4(a)(iii).

Second, the Complainant asserts that the Respondent disrupts Complainant's business by diverting potential customers to

its site selling competing goods. Using a confusingly similar domain name in a manner disruptive of a complainant's business by trading upon the goodwill of a complainant for commercial gain evinces bad faith under paragraph 4(b)(iii) & (iv) of the Policy. See *Intesa Sanpaolo S.p.A. v. Abayomi Ajileye*, 102396 (CAC 2019-04-25). Complainant has provided a screenshot of the resolving website, which displays the ROGER VIVIER mark and various images of shoes for sale. Complainant also provides a screenshot of its own website for comparison purposes. Complainant alleges that the goods offered on Respondent's website are counterfeit given the heavily discounted prices. Accordingly, the Panel agree that Respondent disrupts Complainant's business and attempted to commercially benefit off Complainant's mark in bad faith under paragraph 4(b)(iii) & (iv) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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.

PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreement is Chinese as confirmed by the Registrar. The official Complaint was submitted in English and the no Response was received within the required period of time. Pursuant to paragraph 11 of the Rules, 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 Complainant requests to use English as the language of proceeding, with the arguments that the website resolved by the disputed domain name was in English and the currencies used to sell the products are USD, EUR, CAD AUD and GBP which show that the website is mainly targeting English-speaking Internet users.

The Panel is bilingual and is well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances, Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied, and decides that the language of proceeding to be English.

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CHEAPROGERVIVIEROUTLET.COM**: Transferred

PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION	2021-06-08
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Publish the Decision