Decision for dispute CAC-UDRP-101319

Case number	CAC-UDRP-101319
Time of filing	2021-05-31 09:36:15
Domain names	www-loropiana.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Loro Piana S.p.A.

Complainant representative

Organization	Barzanò & Zanardo Roma S.p.A.

Respondent

Name	Zokhirjon Mallaev

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

According to the evidence submitted by Complainant, Complainant is the owner of multiple trademarks including:

- European Union trademark LORO PIANA, with registration number 007383136, registration date 6 September 2009;

- International trademark LORO PIANA, with registration number 421431, date of registration 30 December 1975; and

- International trademark LORO PIANA (device mark), with registration number 617890, date of registration 23 March 1994.

FACTUAL BACKGROUND

FACTS ASSERTED BY COMPLAINANT AND NOT CONTESTED BY RESPONDENT:

The disputed domain name, <www-loropiana.com>, was registered on 6 January 2021.

According to the information provided Complainant is the most important cashmere, vicuña and extra thin wool manufacturer in the world. Complainant was established in 1924. Complainant sells its goods worldwide with many direct points of sale in Europe, America and Asia. Furthermore, Complainant's goods are also sold in prestigious department stores, and inside luxury multi-branding clothing stores. Presently, Complainant owns more than 700 trademark registrations worldwide, consisting of, or containing, the term LORO PIANA and more that 300 domain names identical to or comprising LORO PIANA in all existing ccTLDs and in most of the available gTLDs. Complainant submits that it invests considerable resources (both economic and human) to build its reputation and that of its LORO PIANA trademark.

According to Complainant the disputed domain name is confusingly similar to Complainant's trademarks as it contains the trademark LORO PIANA in its entirety.

The disputed domain name consists of Complainant's trademark preceded by the three letters "www" followed by a hyphen. These elements are insufficient to prevent a strong confusing similarity of the disputed domain name with Complainant's trademark. As a matter of fact, Complainant's LORO PIANA trademark is fully reproduced in the disputed domain name, while the three letters "www" would be perceived by the Internet user as the acronym for "world wide web", or at least as a typical used element when typing a URL in order to find a website. Also the fact that the three letters "www" and Complainant's trademark are separated by a hyphen cannot prevent a finding of high confusing similarity with the disputed domain name, considering that usually in a URL the acronym "www" is separated from the second level domain name by a full stop. Hence, Respondent has misspelt the usual way of writing a URL string replacing the full stop with a hyphen thus giving rise to a strong confusion between the disputed domain name and Complainant's mark LORO PIANA.

According to Complainant Respondent has no rights or legitimate interest in the disputed domain name. According to Complainant Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services.

When Complainant first detected the disputed domain name, it was used to access a website prominently displaying Complainant's LORO PIANA figurative trademark and pictures of LORO PIANA shoes offered for sale in Russia. On 2 April 2021 Complainant's lawyers sent a warning letter to the Registrar and the ISP of the disputed domain name as well as to the person at that time recorded as Registrant in the relevant Whois. The letter remained unanswered but a few days later the Registrant's information was redacted from the Whois, and the website associated with the disputed domain name suddenly became inactive. It results from the above that Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services, or in a non-commercial or fair manner. Rather, initially, Respondent was clearly using the disputed domain name to take advantage of the reputation of Complainant and of its LORO PIANA's trademark, in order to mislead potential customers and attract them to its website for commercial gain. The fact that upon receiving Complainant's warning letter Respondent changed the content of its website does not entail that now Respondent has gained rights or legitimate interests in the disputed domain name. Indeed, the Respondent is still holding the disputed domain name without any right or legitimate interest and the change of use is a mere attempt to through off Complainant hoping that no further actions will follow besides the sending of the warning letter.

At the time of the decision the disputed domain name does not resolve to an active website. Complainant submits that the prior use and the passive holding does not amount to a bona fide offering of goods or services, nor to a non commercial or fair use of the disputed domain name under the Policy.

Moreover, Respondent is not an authorized licensee of Complainant's trademark, nor one of its distributors, agents, resellers, etc. Complainant has no business relationship whatsoever with Respondent. Furthermore, to the best of Complainant's knowledge, Respondent is not commonly known by the name LORO PIANA. Respondent is not an authorized licensee of Complainant's trademark, nor one of its distributors, agents, resellers, etc. Furthermore, to the best of Complainant's knowledge, Respondent is not commonly known by the name LORO PIANA.

Complainant concludes by stating that Respondent lacks rights or legitimate interests in the disputed domain name.

According to Complainant the disputed domain name has been registered and is being used in bad faith. As far as registration in bad faith is concerned, Respondent registered a domain name containing a very well-known third party's trademark without authorization. Respondent could not ignore the existence of the LORO PIANA trademark at the time of the registration of the disputed domain name, not only because LORO PIANA is a very well-known trademark worldwide, including in China, Russia and Tajikistan, where the Complainant owns earlier trademark rights and where Respondent might be located, but also due to the type of use that the Respondent was making of the disputed domain name prior to receiving the warning letter. Indeed, Complainant submits that Respondent was using the disputed domain name to access a website depicting the identical figurative trademark LORO PIANA and displaying photographs of LORO PIANA shoes offering them for sale. It is therefore clear that Respondent was well aware of Complainant and of its trademark at the time of the registration of the disputed domain name and was trying to impersonate the Complainant to mislead potential customers. The fact that Respondent registered a domain name containing a well-known third party's trademark without authorization and without rights or legitimate interests amount to registration in bad faith.

As far as use in bad faith is concerned, Complainant submits that at first the disputed domain name led to a website prominently displaying Complainant's renowned trademark and offering for sale shoes allegedly originating from Complainant. Complainant has strong doubts about the fact that these goods are original. Most probably, they are counterfeited goods, or inexistent ones. Complainant is in the field of luxury goods and as such sells its goods only through official and exclusive channels, capable of preserving the good name and reputation of Complainant.

The fact that the disputed domain name currently resolves to an inactive website cannot prevent a finding of bad faith. Indeed, Respondent changed the use of the disputed domain name only after having received Complainant's warning letter, while at the same time redacting the Registrant's information listed in the relevant Whois.

In light of the foregoing, Complainant concludes by stating that also the third and last requirement under paragraph 4(a)(iii) of the Policy is met.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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 Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant has, to the satisfaction of the Panel, shown 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

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

In the opinion of the Panel the disputed domain name is confusingly similar to Complainant's trademarks (Policy, Par. 4 (a) (i)) as the disputed domain name incorporates the LORO PIANA trademark in its entirety. Many UDRP decisions have found that a disputed domain name is identical or confusingly similar to a complainant's trademark where the disputed domain

name incorporates the complainant's trademark or the principal part thereof in its entirety. The generic Top-Level Domain ("gTLD") ".com" and the addition of the sign "www" and the hyphen between the sign "www" and the trademark may be disregarded.

In the opinion of the Panel Complainant has made a prima facie case that Respondent lacks rights or legitimate interest in the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use the well-known LORO PIANA trademark or to register the disputed domain name incorporating its mark.

Based on the evidence provided by Complainant the disputed domain name at the time of the decision resolves to a website which mentions that it is currently not available.

At different times the disputed domain name resolved to a website prominently displaying Complainant's LORO PIANA figurative trademark and pictures of LORO PIANA shoes offered for sale.

The two uses as mentioned above cannot be considered a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks of Complainant. In addition, the website does not accurately and prominently disclose the relationship between Respondent and Complainant as the holder of the famous LORO PIANA trademark, in particular as there has never been any business relationship between Complainant and Respondent. Respondent is also not commonly known by the disputed domain name nor has it acquired any trademark rights.

Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name (Policy, Par. 4 (a)(ii)).

The Panel finds that the disputed domain name has been registered and is being used in bad faith (Policy, Par. 4(a)(iii)). The trademarks of Complainant have been existing for a long time and are well-known. Respondent knew or should have known that the disputed domain name included Complainant's LORO PIANA trademarks.

The Panel notes that Respondent's initial use of the website at the disputed domain name, which incorporated Complainant's figurative trademark, indicates that Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location. This amounts to bad faith registration and use for purposes of the Policy. Furthermore, the fact that the disputed domain name at the time of the decision resolves to a website which mentions that it is unavailable does not prevent the Panel from finding registration and use in bad faith. Passive holding of a website does not prevent the Panel from finding registration and use in bad faith. The Panel notes that the undeveloped use of such website at the disputed domain name which incorporates Complainant's well-known trademark in its entirety is to be regarded as an additional indication in this case that Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, as per paragraph 4(b)(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. **WWW-LOROPIANA.COM**: Transferred

PANELLISTS

Name	**Dinant T.L. Oosterbaan**

2021-07-12

DATE OF PANEL DECISION 2021-07-13

Publish the Decision