Decision for dispute CAC-UDRP-100419

Case number	CAC-UDRP-100419
Time of filing	2012-03-20 12:58:19
Domain names	alaiashoes.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	AATC Trading AG

Complainant representative

Organization	Rossbach & Beier

Respondent

Name	Zhang San

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant relies on the following trademarks under the Nice International Classification of Goods and Services, among others in its favour:

- ALAÏA
Community trademark 002613461 applied for on 13 March 2002 and registered on 9 September 2004 in classes 03, 09, 14, 18, 25, 35, inter alia for shoes

- ALAÏA
International registration 773126 registered on 6 December 2001 in classes 03, 09, 18, 24, 25, inter alia for shoes

- ALAÏA
Community trademark 003482395 applied for on 30 October 2003 and registered on 28 November 2007 in classes 16, 20, 24

The Complainant has licensed the ALAÏA trademarks to Azzedine Alaïa SAS, an operating company based in Paris. The

Licensee’s chief designer and creative director is Mr. Azzedine Alaïa, a Tunisian designer based in Paris who designs a wide range of high quality luxury apparel, including dresses, bags, shoes and accessories. The Complainant does not have a website.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT (TAKEN FROM THE COMPLAINT WITH ONLY MINOR CORRECTIONS):

According to the registrar Bizcn´s whois database the Respondent in this administrative proceeding is

Zhang San
San Zhang azzedinealaiaoutlet@gmail.com
+86.01012345678 fax: +86.01012345678
Beijing
Beijing Beijing 100011
cn

A copy of the printout of the database search conducted on 15 March 2012 was provided as Annex 1 to the Panel.

All information known to the Complainant regarding how to contact the Respondent is as follows:
Zhang San
San Zhang azzedinealaiaoutlet@gmail.com
+86.01012345678 fax: +86.01012345678
Beijing
Beijing Beijing 100011
cn

This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The registration agreement, pursuant to which the domain name that is the subject of this Complaint is registered, incorporates the Policy.

I. Procedural request:

Complainant requests to change the language of the proceedings. As many panelists have decided in equivalent cases, the language can be changed if the circumstances indicate that the Respondent can understand the complaint, as decided in the CAC cases 100357, 100352, 100344, 100331 and 100307 to name only a few. In the present case, the whois-information provided by the registrar is in English, the content of the website under the domain name in question was in English, Respondent´s email address contains the English word “outlet” and finally the domain name in question is in English as it can be seen from the descriptive element “shoes” in the domain name. All these circumstances show that the Respondent is actively using the English language. Accordingly, it should be allowed for the Complainant to use English as the language of this proceeding which has no relevant disadvantages for the Respondent.

II. Factual and Legal Grounds
(Policy, paras. 4(a), (b), (c); Rules, para. 3)

This Complaint is based on the following grounds:

Factual background of the Complainant

In accordance with the Rules, para. 3(b)(viii) printouts are provided as Annex 2 from the official databases of registered trademarks on which this Complaint is based. Complainant AATC Trading AG (hereinafter referred to as the Complainant), based in Switzerland, is the owner of, inter alia, the trademarks:

- ALAÏA
Community trademark 002613461 applied for on 13 March 2002 and registered on 9 September 2004 in classes 03, 09, 14, 18, 25, 35, inter alia for shoes

- ALAÏA
International registration 773126 registered on 6 December 2001 in classes 03, 09, 18, 24, 25, inter alia for shoes

- ALAÏA
Community trademark 003482395 applied for on 30 October 2003 and registered on 28 November 2007 in classes 16, 20, 24

The Complainant has licensed the ALAÏA trademarks to Azzedine Alaïa SAS, an operating company based in Paris. The chief designer and creative director of the Licensee is Mr. Azzedine Alaïa, a Tunisian designer based in Paris, France. He designs a wide range of high quality luxury apparel, including dresses, bags, shoes and accessories.

The Complainant does not have a website. However, the Complainant's products can be bought worldwide in boutiques, concessions and through e-commerce businesses that have express permission to sell the Complainant's products.

The Complainant's business has been in operation since 1983 and the Complainant is well established internationally, with a loyal and exclusive customer base around the world. In particular, the Complainant regularly features in a multitude of online and hardcopy publications including Elle France and Vogue.com (Annex 3).

As a result of promotion and widespread sales, the brand ALAÏA has acquired an exclusive reputation. Through this global reputation, the Complainant has built up significant goodwill in the Alaïa brand. The products under the ALAÏA trade-marks are sold worldwide, among many others by Net-A-Porter.com (Annex 4). They can also be purchased in the Azzedine Alaïa retail store in Paris.

In fact, the work and products of Mr. Azzedine Alaïa, sold under the trademarks of the Complainant, are known worldwide and famous. Customers of Mr. Alaïa and of the products sold under the ALAÏA trademarks are, among many others, Tina Turner, Raquel Welch, Madonna, Janet Jackson, Brigitte Nielsen, Naomi Campbell, but also Michelle Obama and Carla Bruni. Obviously, the fashion products under the trademark ALAÏA get related attention on the market. Further information on Mr. Azzedine Alaïa was provided from the English Wikipedia Encyclopedia, in Annex 5.

The Respondent registered the disputed domain name in May 2011, Annex 1, and offered immediately thereafter under the disputed domain name counterfeited shoes as the screenshots taken in 2011 show in accordance with Annex 6. In the meantime, this content was taken off the website under the disputed domain name.

A. The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (Policy, para. 4(a)(i) Rules, paras. 3(b)(viii), (b)(ix)(1))

The dominant part of the Domain Name alaiashoes.com (hereinafter referred to as the Domain Name) is the distinctive sign "alaia", which is identical to the registered trademarks ALAÏA, except that "ï" is a Latin letter for "i", with diaeresis, which is usually expressed in the form of "i" when typing a domain name. "Alaia" is a distinctive word not contained in ordinary dictionaries, and which has been registered by the Complainant as a trademark in numerous countries all over the world (Annex 2), whereas the element "shoes" is a descriptive term for shoes without any distinctiveness (cf. Vans Inc. v. Micheal, WIPO Case No. D2011-2266, vansshoesusa.com). As the panelist in Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service, WIPO Case No. D2011-1753, drmartinshoes.net, stated:

„As a general matter, “[t]he addition of merely generic, descriptive, or geographical wording to a trademark in a domain name would normally be insufficient in itself to avoid a finding of confusing similarity under the first element of the UDRP.” WIPO Overview 2.0, paragraph 1.9; see also Nintendo of Am. Inc. v. Marco Beijen, WIPO Case No. 2001-1070.)“

Summarizing this, the Complainant is the owner of a known trademark ALAïA. The Domain Name in question is confusingly similar to the Complainant´s registered trademark ALAïA and the Complainant askes for a finding to this effect.

B. The Respondent has no rights or legitimate interests in respect of the Domain Name;
(Policy, para. 4(a)(ii), Rules, para. 3(b)(ix)(2))

The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the Domain Name. The Complainant has also not found anything that would suggest that the Respondent has been using ALAIA in any other way that would give him any legitimate rights in the name. Consequently, the Respondent may not claim any rights established by common usage of the distinctive term ALAIA. Furthermore, no license or other authorization of any other kind has been given by the Complainant to the Respondent to use the trademark ALAïA.

In case D2000-0055 Guerlain S.A. v. Peikang the panel stated that:

“in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by Respondent.”

The Respondent is not an authorized dealer of the Complainant’s products and has never had a business relationship with the Complainant. This was stated by the panel as a factor in the finding of no legitimate interest on the part of the Respondent in Case No. D2004-0312 Dr. Ing. h.c. F. Porsche AG v. Ron Anderson.

C. The Domain Name was registered and is being used in bad faith.
(Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix)(3))

The domain name was registered by Respondent in 2011, see Annex 1. The mere registration of a domain name does not give the owner a right or a legitimate interest in respect of the domain name. Not only due to the immediate use of the domain name for exhibiting counterfeited shoes as shown in Annex 6, but also in light of the worldwide reputation of the trademark ALAïA, it is obvious that the Respondent knew of the Complainant’s legal rights in the name at the time of the registration. It is also obvious that it is the fame of the trademark that has motivated the Respondent to register the Domain Name. That is why the Respondent cannot claim to have been using ALAIA, without being aware of the Complainant’s rights to it.

The Respondent is also today not using the Domain Name in connection with a bona fide offering of goods or services. Instead the Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic to the web site and through this procedure generate income (Annex 6).

Temporarily deleting content from the website does not alter the assessment of having used the domain name in bad faith. The consensus view of WIPO panelists is summarized as follows:

„With comparative reference to the circumstances set out in paragraph 4(b) of the UDRP deemed to establish bad faith registration and use, panels have found that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the Complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's

concealment of its identity" (see http://www.wipo.int/amc/en/domains/search/overview2.0/index.html#32).

In the present case, the Respondent used the domain name for offering counterfeited shoes and hiding his identity by not providing a full address in the whois registry. All these circumstances are in light of previous panel decisions in favour of finding bad faith also in the present case.

As set forth in below, the Respondent's bad faith is established under paragraphs 4(b)(ii), (iii) and (iv) of the Policy, as well as by the other circumstances surrounding the Respondent's registration and use of the Disputed Domain Name.

The Respondent has deliberately registered the Disputed Domain Name, which is identical to the Complainant's famous trademark "ALAÏA", with the intention of causing confusion among the public to the effect that the Respondent and/or the Respondent's website is related to the Complainant (or authorized by it) and/or to the Complainant's website and of diverting the traffic of web-users.

As a result, members of the public will likely be confused into believing that the Respondent and/or the Respondent's website is related to or authorized by the Complainant. As mentioned above, due to extensive use and advertisement of the Complainant's ALAÏA Trade Mark, the public will associate the Disputed Domain Name exclusively with the Complainant's business.

Finally, the Respondent has committed bad faith under the provision of paragraph 4(b)(ii), (iii) & (iv). Given the distinctiveness and fame of the "ALAÏA" mark and the fame of the world-class designer Azzedine Alaïa, there is no plausible explanation for the Respondent's registration of the Disputed Domain Name other than to trade upon the goodwill the Complainant has developed in its Trade Marks. See Telstra Corp. v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding bad faith where "[g]iven the Complainant's numerous trademark registrations for, and its wide reputation in, [Complainant's mark], . . . it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name [at issue]").

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

Complainant represents the trademark-protected interests associated with the celebrated designer Azzedine Alaïa. The Panel finds these interests to have been violated through the registration and use of a domain name, alaiashoes.com, that is

confusingly similar to the designer’s name and in regard to which no legitimate interest or rights have been acquired by Respondent. To the contrary, the domain name has apparently been used by the Respondent to trade in counterfeit goods associated with the famous and protected Alaïa name. The Panel notes the absence of a Response and accepts the arguments put forward in the Complaint, as set forth in the Factual Background, above. With respect to the questions of legitimate interest and rights and of good faith, the Panel accords no weight to the circumstance that no website has been established by Complainant. This is not in itself a requirement to make out a Complainant's case of abusive registration.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALAIASHOES.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2012-04-24

Publish the Decision