

Decision for dispute CAC-UDRP-104932

Case number CAC-UDRP-104932

Time of filing 2022-10-25 10:17:14

Domain names isseymiyakebag.net

Case administrator

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

Complainant

Organization Kabushiki Kaisha Miyake Design Jimusho (also trading as Miyake Design Studio)

Complainant representative

Organization Coöperatie SNB-REACT U.A.

Respondent

Name Long Chen

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 numerous trademarks, including but not limited to the following:

- European Union Trademark Registration No. 000071175 for ISSEY MIYAKE, registered on November 18, 1998; and
- European Union Trademark Registration No. 009218983 for BAOBAO ISSEY MIYAKE (stylized), registered on February 7, 2011.

FACTUAL BACKGROUND

The Complainant, Kabushiki Kaisha Miyake Design Jimusho (trading as Miyake Design Studio) is a Japanese company whose main activity consists of manufacturing, marketing and selling clothing, accessories and fragrances. It was established by the founder Issey Miyake in 1970. In 1971, its subsidiary, ISSEY MIYAKE INC., was created to plan, manufacture, and sell clothes and related products. The Complainant is an internationally renowned fashion company which has regularly participated in Paris Fashion Week since 1973. The Complainant states that one of its most iconic product lines is its "BAO BAO" line of bags. The line was launched under PLEATS PLEASE ISSEY MIYAKE in 2000 before becoming its own brand in 2010.

The Complainant also registered the domain name <isseymiyake.com> on September 26, 1998 which is used in connection with its official online store.

The disputed domain name was registered on November 25, 2021, and according to the Complainant resolved to an active website displaying the marks ISSEY MIYAKE and BAO BAO and related content, in particular bags which look similar to the Complainant's goods.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the ISSEY MIYAKE mark on the basis that the disputed domain name which consist of the ISSEY MIYAKE mark and the addition of the generic word "bag" and the generic top-level domain name suffix ("gTLD") ".net" are insufficient to avoid the finding that the disputed domain name is confusingly similar to its ISSEY MIYAKE mark.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent has not acquired any rights in a trademark or trade name corresponding to the disputed domain name. In addition, the Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the ISSEY MIYAKE mark.

The Complainant further asserts that the disputed domain name has been registered and is being used in bad faith as the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a false impression with regard to a potential affiliation or connection with the Complainant without permission from the Complainant. The Complainant states that the Respondent is thereby using the disputed domain name to intentionally attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the website.

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

a. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns trademark registrations of the ISSEY MIYAKE mark and the BAO BAO mark.

The differences between the disputed domain name and the Complainant's ISSEY MIYAKE trademark are the addition of a generic term "bag" and the gTLD ".net" which in the Panel's view does not avoid confusing similarity with the Complainant's trademark.

It is established that where a trademark is recognizable within the disputed domain name, the addition of a descriptive term would not prevent a finding of confusing similarity under the first element. (See WIPO Overview 3.0, section 1.8). It is further established that the gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. (See WIPO Overview 3.0, section 1.11). The addition of a gTLD to a disputed domain name does not avoid confusing similarity as the use of a TLD is technically required to operate a domain name (see *Accor v. Noldc Inc.*, WIPO Case No. D2005-0016; *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. D2006-0451; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *L'Oréal v Tina Smith*, WIPO Case No. 2013-0820; *Titoni AG v Runxin Wang*, WIPO Case No. D2008-0820; and *Alstom v. Itete Peru S.A.*, WIPO Case No. D2009-0877).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the ISSEY MIYAKE mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

b. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, section 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant submitted evidence that it did not authorize or license the Respondent to use the ISSEY MIYAKE mark (see *OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. D2015-1149; *Sanofi-Aventis v. Abigail Wallace*, WIPO Case No. D2009-0735). The Complainant also submitted evidence that its registrations and use of the trademarks predate the registration of the disputed domain name by over twenty years.

In addition, the evidence submitted by the Complainant shows that the Respondent is not commonly known by the disputed domain name.

The Complainant further submitted evidence that the Respondent is not making a legitimate non-commercial or fair use of the domain name but is intending to use it for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. The Complainant's evidence also shows that the disputed domain name incorporates the Complainant's trademark in its entirety and displays the Complainant's "BAO BAO/ISSEY MIYAKE" trademarks at the top of each page of its website, falsely suggesting a commercial relationship with the Complainant.

The Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which is sufficient to rebut the Complainant's prima facie case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

c. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the Respondent registered the disputed domain name long after the Complainant registered its ISSEY MIYAKE trademark. Given that the Complainant's trademark has been registered for a long time, it is highly unlikely that the Respondent did not know of the Complainant and its marks prior to the registration of the disputed domain name. The disputed domain name incorporates the Complainant's mark in its entirety with the additional suffix "bag", which given the circumstances of this case, the Panel finds is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant's website. Previous UDRP panels have ruled that in such circumstances "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. D2006-1095).

The Complainant also submitted evidence that the disputed domain name resolved to an active website which appeared to impersonate and pass off as the Complainant including through the offering for sales of bags that appear to be similar to those offered by the Complainant. The evidence further shows that the Complainant's marks appear prominently on the website under the disputed domain name.

Based on the circumstances of the particular case, it is the Panel's view that it is unlikely that the Respondent registered the disputed domain name without sight and knowledge of the Complainant's marks and it is implausible that there is any good faith use to which the disputed domain name may be put to. It is clear to the Panel that the Respondent specifically targeted the

Complainant and its marks and registered the disputed domain name to divert Internet traffic and benefit commercially from unsuspecting Internet users seeking out the Complainant.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain name and the Complainant's ISSEY MIYAKE mark, the fact that the Respondent used the Complainant's mark on the disputed domain name website to offer goods similar to those of the Complainant's, and the fact that no Response was submitted by the Respondent, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **isseymiyakebag.net**: Transferred

PANELLISTS

Name	Jonathan Agmon
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DATE OF PANEL DECISION **2022-11-30**

Publish the Decision
