

Decision for dispute CAC-UDRP-105177

Case number **CAC-UDRP-105177**

Time of filing **2023-02-27 11:06:18**

Domain names **frettehome.com, frettehomes.com**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **Edmund Frette S.à r.l.**

Complainant representative

Organization **Barzanò & Zanardo Milano S.p.A.**

Respondent

Name **Michael Kotler**

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 refers to the following here relevant registrations:

The trademark FRETTE is protected as follows by its

- International Registration, 770138 of 7 March 2001 (renewal) in classes 03, 04, 08, 18, 21, 24, 25, 27, 35, 42, duly renewed;
- International Registration n. 415485, registered on date 30 April 1975 (duly renewal), in classes 24 and 25, duly renewed;
- Italian Registration n. 362022000145059, registered on date 1 July 2013 in classes 03, 04, 05, 06, 08, 09, 11, 14, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28, 34 and 35.

The Complainant is also widely promoted on most popular social media with channels and pages specifically dedicated to it, such as:

- Instagram account <https://www.instagram.com/fretteofficial> - 79.800 followers;
- Facebook account <https://www.facebook.com/frette> - 72.731 followers;
- Twitter account <https://twitter.com/frettehome> - over 3.100 followers;

The name chosen for all this accounts in all the social media is “FRETTE” or “FRETTE HOME”.

The Complainant’s domain name <frett.com> was registered on 17 July 2003.

The Respondent registered both disputed domain names <frettehome.com> and <frettehomes.com> on 8 December 2022.

FACTUAL BACKGROUND

Frette is the world's leading luxury linens and home furnishings brand: using artisans known for their creativity and technical skills, Frette products are renowned for trendsetting style and design, utilizing the finest materials available and exceptional quality.

The origins of Frette S.r.l. date back to 1860 when Edmond Frette, Alexandre Payre and Charles Chaboud decided to build a company for the trade of fabrics in Grenoble under the name "Frette, Payre & Chaboud"; subsequently Edmond Frette went to Italy settling in the Monza area and opening his first factory in Concorezzo: in the same years, he opened his first shop in Monza, now included in the "*Regional Register of Historic Places of Commerce*", and his first shop in Milan in Via Manzoni.

Frette's first clients included Queen Margherita of Savoy and more than 500 other noble European dynasties, but during the year client's roster expanded to include the best hotels, restaurants and travel enterprises, including the legendary Oriental Express. In 1881, the company won the gold medal at the National Exhibition in Milan thanks to an innovative product called "La Vega" and in that year Frette also became an official "Provider to the Royal House".

In the following years Edmond Frette dissolved the company with his old French partners and created the new one with Giuseppe Maggi and Carlo Antonietti: the new partners consolidate the business by opening a second factory – still in Concorezzo - and a bleaching factory in Monza.

In 1886, Frette began mail order, which was important at the time since most of Italy's population was agricultural, and a great part of the population lived far away from the big towns that had shops. Frette's mail catalogue business ran for 90 years, and the last mail-order catalogue was issued in 1976; already in 1889 it distinguished itself by being one of the first companies to create a collection of ready-to-wear garments for the home.

Over the years, Frette has specialized in the supply of luxury linens to large hotels: already in 1899 it became the supplier of the Danieli Hotel in Venice; then, the best hotels in the world have commissioned its linens to guarantee the most comfortable sleep to the most discerning clientele. Later, Frette began - and still has - partnership with other prestigious hotels such as the Ritz in Paris, the Savoy in London, the Plaza of New York and the Peninsula in Hong Kong. Other important customers are the large shipping and railway companies, such as Orient Express, Wagon-Lits, Costa, Flotta Lauro and Lloyd.

During the twentieth century, Frette opened numerous linen shops in almost all the large Italian cities.

FRETTE and FRETTE HOME are among the first trademarks in the world to deal with loungewear, clothing designed specifically to be worn at home and never outside the home, has giving life to a trend that still today constituted an important item in the catalogue available in boutiques.

Frette has reached 100 million euros in turnover in 2021. The company, now controlled by the Change Capital Partners LLP fund, has resumed its pre-pandemic growth trend thanks to the recovery in household consumption and the reopening of the travel sector, achieving double-digit profitability compared to the previous year.

More recently, Frette opened 8 new flagship stores around the world (Seoul, Singapore, Manila, St. Petersburg, Tashkent, Beijing, Shanghai and Jeddah), reaching a network of 33 countries with 42 flagship stores, 21 of which are directly managed. The foreign turnover, in fact, represents over 80% of the company's turnover.

Moreover, on the digital front investments in 2021 e-commerce generated around 15% of the company's sales.

During 2021 Frette has also expanded its network in the luxury hospitality sector (with global or niche partners) reaching a total of over 1,500 properties worldwide, including Ritz Carlton, Soho house and St. Regis, an increase for the Gritti palace in Venice and the Harrods suites on the Costa Smeralda. Different stories are related to FRETTE partnership with the most prestigious hotels all over the world in which is offered a search by name or country of location partners that use FRETTE products.

As might be seen from the official websites of important Luxury hotels such as Ritz Carlton and Hilton's Waldorf Astoria and Conrad Hotels & Resorts, Frette products are featured as distinctive luxury services.

PARTIES CONTENTIONS

COMPLAINANT:

FRETTE trademarks are certainly well-known all around the world.

Respondent registered – through the Privacy service provided by Withheld for Privacy ehf its disputed domain names <frettehome.com> and <frettehomes.com> on 8 December 2022.

Complainant did not authorize their registrations and the two disputed domain names at issue are currently redirected to parking page with sponsored links related to FRETTE products like the related WHOIS and screenshots can show.

The Complaint is based on the following grounds:

1. The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

The straightforward side-by-side comparison of the disputed domain names and the textual components of the marks on which this Complaint is based makes it evident that the FRETTE and FRETTE AT HOME Trademarks are recognizable within the disputed domain names and, thus, they are confusingly similar to the marks in which the Complainant has rights, since they incorporate the entirety of the distinctive part of the trademarks. The top level domain “.com” is merely instrumental to the use of the Internet so the Domain Names remain confusingly similar despite the inclusion of “.com”.

In particular, concerning the trademarks FRETTE, the two disputed domain names differ only for the addition – respectively of the terms HOME and HOMES: both clearly strictly connected with the semantic world of FRETTE products; this is even more evident if we compare the two disputed domain names to the trademark FRETTE AT HOME, from which they differ only for the elimination of the “AT”.

While each case is judged on its own merits, in UDRP cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark under the first element of the UDRP Policy (see paragraph 1.7 WIPO Overview 3.0 and the decisions mentioned thereto).

The Complainant recalls:

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name(s) (Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

The Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

The Complainant contends that the Respondent lacks rights or legitimate interests in the disputed domain names for the following reasons:

- The Complainant (or the other related parties) has no relationship with the Respondent whatsoever.
- The Respondent has never received any approval of the Complainant (or the other related parties), expressed or implied, to use its (their) trademarks or any other mark identical or confusingly similar to such marks, nor to register any domain name identical or confusingly similar to such marks.
- There is no evidence that the Respondent has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

The disputed domain names that consist of a trademark plus an additional term cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner: in this specific case, the additional term HOME/HOMES are clearly within FRETTE field of commerce: it is therefore clear that they by themselves trigger an inference of affiliation.

The disputed domain names are – also – redirected to parking page with pay-per-click links related to products identical to those offered with FRETTE trademarks and associated with Frette’s competitors such as Moncler, Caleffi and Bassetti. The use of a disputed domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users. Such use of the domain names are therefore clearly not a bona fide, legitimate or fair use under the UDRP Policy.

3. The disputed domain names were registered and are being used in bad faith (Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

The disputed domain names <frettehome.com> and <frettehomes.com> have been registered and are being used in bad faith.

As far as registration in bad faith is concerned, the Respondent registered disputed domain names that contain a well-known third party’s trademark without authorization. The Respondent could not ignore the existence of the FRETTE trademark at the time of the registration of the disputed domain names, because FRETTE is a well-known trademark, and because FRETTE is a fanciful word: given the distinctiveness and reputation of FRETTE trademarks worldwide, it is inconceivable that the Respondent could have registered the disputed domain names without actual knowledge of FRETTE and its rights in such marks. This assumption is further proved by the fact that the disputed domain names entirely contain Complainant’s trademark, moreover associated with the terms HOME/HOMES that are terms descriptive of FRETTE field of commerce. Noting the undoubtable near instantaneous and global reach of the Internet and search engines allows to infer that the Respondent knew, or should have known, that its registration would be identical or confusingly similar to a Complainant’s trade mark: in the present case, the association of the term HOME with the trademark FRETTE is a clear evidence of the fact that Respondent knew or should have known about FRETTE well-known and distinctive trademarks.

The misappropriation of a well-known trademark as disputed domain names by itself constitutes bad faith registration. In light above, it is inconceivable that Respondent was not well aware of Complainant’s trademark rights at the time of the registration of the disputed domain names. Indeed, Respondent’s purpose in registering the disputed domain names, incorporating FRETTE, was probably to capitalize on the reputation of Complainant’s trademark by diverting Internet users seeking information about this distinctive sign to its own website, where sponsored links are published.

With respect to the use in bad faith the disputed domain names have been redirected to webpages displaying several sponsored links to various third-party commercial websites, mainly related to Complainant and competitors' services. Such a conduct where Respondent sought or realized commercial gain, at least earning commission whenever an Internet user visits its website and clicks on one of the links published therein, indicates its bad faith.

Respondent is acting in bad where it sought or realized commercial gain from the use of the disputed domain names identical or confusingly similar to a Complainant's trademark. Finally, while there are recognized legitimate uses of privacy and proxy registration services; the circumstances in which such services are used, including whether the Respondent is operating a commercial and trademark-abusive website, can however impact an assessment of bad faith: in the present case the use of the proxy registration has not permitted to reach counterparty and notify the infringing of Frette's rights.

In light of the above, Complainant deems that paragraph 4 (b) (iv) of the Policy is applicable to the present case since Respondent is intentionally attracting Internet users for commercial gain to its website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website.

RESPONDENT:

MESSAGE/RESOLUTION

"I'm a Realtor in the US, and registered about 20 names for my real estate company, and they were all made up. I don't need to have a real estate brand that uses a textile company's name. That was never my intention. And honestly, if they sell home products, and they've been around forever, than why are these domains available? If they're that relevant to the Frette brand, why in the world wouldn't they own these domains already? The answer is because it's simply not important enough to them. That said, I have a proposal... a unique one... no joke. Rather than fight this, I'll drop it right now if they agree to send me a white sheet set (size - king) of their choice and a towel set of their choice."

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 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 are 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 order to succeed in its claim, the Complainant has to prove that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

A. THE DISPUTED DOMAIN NAMES ARE CONFUSINGLY SIMILAR TO A TRADEMARK IN WHICH THE COMPLAINANT HAS

RIGHTS

It is well established that the Complainant is among others the proprietor of the worldwide trademark FRETTE and FRETTE trademarks are well-known all around the world.

The Panel finds that Complainant's domain name was registered on 17 July 2003 and expires on 17 July 2024 after it has been updated on 24 August 2022. The Respondent registered its disputed domain names <frettehome.com> and <frettehomes.com> on 8 December 2022.

The Respondent confirms that he as a Realtor in the US registered about 20 names for his real estate company and did not need to have a real estate brand that uses a textile company's name. That was never his intention. Nevertheless, he is obvious of the opinion that the domains that uses a textile company's name "FRETTE" were available and even if relevant to the Frette brand the Complainant has not owned these domains already. At the same time the Respondent makes a unique proposal, i.e. rather than fight this, he will drop his right if they agree to send (him) a white sheet set (size - king) of their choice and a towel set of their choice.

The Panel concludes that even if the Respondent could have been of the opinion that the disputed domain names were available and eligible to the registration by a third person then only the comparison of the disputed domain names and the textual components of the Complainant's marks makes it evident that the FRETTE and FRETTE AT HOME Trademarks are recognizable within the disputed domain names and, thus, they are confusingly similar to the marks in which the Complainant has rights, since they incorporate the entirety of the distinctive part of the trademarks. In particular, concerning the trademarks FRETTE, the two disputed domain names differ only for the addition – respectively of the terms HOME and HOMES, both clearly strictly connected with the semantic world of FRETTE products. This is even more evident if the two disputed domain names are compared to the trademark FRETTE AT HOME, from which they differ only for the elimination of the "AT".

Where a domain name incorporates the entirety of a trademark the disputed domain name is considered confusingly similar to that mark. On the other hand, the top level domain ".com" is merely instrumental to the use of the Internet so the disputed domain names remain confusingly similar despite the inclusion of ".com". The presence of the generic Top-Level Domain ("gTLD") extension ".com" in the first level portion of each of the disputed domain names is a standard registration requirement and may be disregarded when assessing whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

The Panel therefore considers the disputed domain names to be confusingly similar to the trademark FRETTE in which the Complainant has rights and its conduct falls within the meaning of paragraph 4(a)(i) of the Policy.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Panel does not find that the Complainant and the Respondent have ever had any previous relationships, nor that the Complainant has ever granted the Respondent with any rights to use the FRETTE trademark in any forms, including the disputed domain names. The Panel does not find that the Respondent is commonly known by the disputed domain names or that it has legitimate interests over the disputed domain names nor the Respondent contends it. Respondent's personal name is "Michael Kotler".

The Panel concluded that the Respondent should have already performed a carefully search before registering the disputed domain names and should have quickly learnt that the trademark FRETTE are owned by the Complainant and that the Complainant has been using its trademark in many other countries worldwide. Nevertheless, the Panel finds that the evidence shows that the Respondent obviously knew about the Complainant and its trademark FRETTE when it registered the disputed domain names and chose to register them as such.

The Panel finds that the disputed domain names consist of a trademark plus an additional term that cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The Panel concludes that the additional term HOME/HOMES are clearly within FRETTE field of commerce. It is obvious that they by themselves trigger an inference of affiliation.

The Panel finds that the disputed domain names are redirected to parking page with pay-per-click links related to products identical to those offered with FRETTE trademarks and associated with Frette's competitors such as Moncler, Caleffi and Bassetti. The use of a disputed domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users. Such use of the disputed domain names are therefore clearly not a bona fide, legitimate or fair use.

The Panel therefore finds that the Respondent does not have rights or legitimate interests in the disputed domain names and its conduct falls within the meaning of paragraph 4(a)(ii) of the Policy.

C. THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE BEING USED IN BAD FAITH

1. Registration of the disputed domain names in bad faith

The Panel finds that the registration of the Complainant's trademark FRETTE pre-dates the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to use the FRETTE trademark nor to register the disputed domain names. The Panel finds that as far as registration in bad faith is concerned, the Respondent registered disputed domain names which contain a well-known third party's trademark without authorization.

The Panel finds that it is inconceivable that Respondent was not well aware of Complainant's trademark rights at the time of the registration of the disputed domain names. The Panel infers that Respondent's purpose in registering the disputed domain names, incorporating FRETTE, was probably to capitalize on the reputation of Complainant's trademark by diverting Internet users seeking

information about this distinctive sign to its own website, where sponsored links are published.

The Respondent could not ignore the existence of the FRETTE trademark at the time of the registration of the disputed domain names, because FRETTE is a well-known trademark, and because FRETTE is a fanciful word. Given the distinctiveness and reputation of FRETTE trademark worldwide, it is inconceivable that the Respondent could have registered the disputed domain names without actual knowledge of FRETTE and its rights in such marks. This assumption is further proved by the fact that the disputed domain names entirely contain Complainant's trademark, moreover associated with the terms HOME/HOMES that are terms descriptive of FRETTE field of commerce. Noting the undoubtable near instantaneous and global reach of the Internet and search engines allows to infer that the Respondent knew, or should have known, that its registration would be identical or confusingly similar to a Complainant's trademark. The association of the term HOME with the trademark FRETTE is clear evidence of the fact that Respondent know or should have known about FRETTE well-known and distinctive trademarks.

The misappropriation of a well-known trademark as disputed domain names by itself constitutes bad faith registration.

2. The disputed domain names are being used in bad faith

A conduct where Respondent sought or realized commercial gain, at least earning commission whenever an Internet user visits its website and clicks on one of the links published therein, indicates also its bad faith by using the disputed domain names.

While there are recognized legitimate uses of privacy and proxy registration services the circumstances in which such services are used, including whether the Respondent is operating a commercial and trademark-abusive website, impact a Panel's conclusion of bad faith. With respect to the use in bad faith the disputed domain names have been redirected to webpages displaying several sponsored links to various third-party commercial websites, mainly related to Complainant and competitors' services. The Panel concludes that the use of the proxy registration has not permitted to reach counterparty and notify the infringing of Frette's rights.

The Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. It was proven that after the Registrar Verification, the Respondent appears as "MICHAEL KOTLER", USA which is a different and personal name as the Complainant alike which leads to the conclusion of the Panel that the Respondent might provide false WHOIS data.

Moreover, the Panel concludes that the Respondent is acting in bad where it sought to a personal gain from the use of a disputed domain names by offering a unique proposal, no joke, that he will drop his "right" now if Respondent will send him "a white sheet set (size - king) of their choice and a towel set of their choice".

In view of the above, the Complainant registered and used the Disputed Domain Name in bad faith and its conduct falls within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **frettehome.com**: Transferred
- 2. **frettehomes.com**: Transferred

PANELLISTS

Name Vojtěch Trapl

DATE OF PANEL DECISION 2023-03-29

Publish the Decision