

## Decision for dispute CAC-UDRP-105353

Case number	CAC-UDRP-105353
Time of filing	2023-04-17 10:04:54
Domain names	esrogervivier.com, frrogervivier.com, rogerviviershop.com

### Case administrator

Name	Olga Dvořáková (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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### Respondents

Name	Pncdj Onxcwj
Name	Rgtgtt Qgrrd
Name	Rxsjn Yncjs

#### 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 (also "Domain Names").

#### IDENTIFICATION OF RIGHTS

The Complainant Roger Vivier S.p.A. is the owner of various trademark registrations such as:

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

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## FACTUAL BACKGROUND

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

Pursuant to the rules, the Complainant brings to the Panel's attention the evidences that the disputed domain names are subject to an evident common control, thus making the consolidation of the dispute equitable and procedurally efficient.

The elements establishing the existence of a common control are demonstrated from the following similarities:

- same Registrar, i.e. Name.com;
- the same Registrar: Name.com, Inc.;
- same extension of the Domain Names .com;
- similar lay-out of the websites;
- same footers of the websites: copyright disclaimer (Copyright 2023 © domain name), same ways of payment (Visa, PayPal, Stripe, Mastercard, Cash on delivery);
- same Hosting Provider: Cloudflare Inc.;
- same opening hours of the stores;
- same products offered for sale in the websites corresponding to the Domain Names (using the same images);

Following the Registrar's disclosure, it has been displayed a further evidences of the common control: the names of the Registrant (i.e. Pncdj Onxcwj, Rgtgtt Qgrrd, Rxsjn Yncjs) prima facie are not related to a real identities; the phone numbers are the same (i.e. +852.51234567) with CN prefix and, therefore, the country of the alleged owners of the Domain Names is prima facie China, precisely Hong Kong Region.

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".

In 1924, he began his sculpture studies at the Paris School of Fine Arts, which he abandoned two years later to learn the art of shoemaking and start an apprenticeship. Following the success of his footwear creations, in 1937 he opened his first boutique on rue Royale in Paris. Heels were his field of excellence - he was the father to the Aiguille stiletto, launched in 1954, and the sinuous Virgule heel, considered the manifesto of his namesake label since 1963.

On August 29th, 1968 the figurative mark "Roger Vivier Boutique" was given worldwide trademark protection through numerous national and international trademark registrations.

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 €.

Roger Vivier S.p.A. is the owner of various trademark registrations, mentioned above

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.

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.

In the last years, the Maison 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" (a list of Complainant's domain names could be provided upon request) - and its official accounts on the major social networks such as Facebook, Instagram and Twitter.

In light of the Respondent's registrations in 2022 and uses of the Domain Names, confusingly similar to its registered and well-

known trademark ROGER VIVIER, the Complainant instructed its representative to address to the Respondent a cease and desist letter in order to notify them of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer, of the Domain Names to the Complainant.

The cease and desist letter was therefore sent on January 25, 2023 to the domain names owner's known email addresses indicated at that time in the websites <https://www.esrogervivier.com/terminos-y-condiciones/> and <https://www.rogerviviershop.com/faq/>. The Respondent did not deem appropriate to answer.

In light of the absence of a reply and the failure to comply with the request for transfer of the Domain Names, the Complainant instructed its representative to file the present Complaint in order to obtain the transfer of the Domain Names under its ownership and control.

**The 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 Domain Names registered by the Respondent are confusingly similar to trademarks in which Complainant has rights, as per copies of trademark registrations provided.

The Disputed Domain Names incorporate the whole of the Complainant's trademark ROGER VIVIER and the fact that they include non-distinctive elements such as a geographical indicators ("ES" and "FR"), a generic word ("SHOP") and the generic Top Level Domain .com does not affect the confusing similarity.

It is a well-established principle that domain names that wholly incorporate trademarks, in particular ones as famous ROGER VIVIER, are found to be confusingly similar for the purposes of the Policy, despite the fact that the Disputed Domain Names may also contain descriptive or generic terms. See, among the decisions addressing situations where generic terms are used in combination with trademarks, Wal-Mart Stores, Inc. v. Henry Chan, WIPO Case No. D2004-0056 ("chase", "girlsof", "jobsat", "sams", "application", "blackfriday", "blitz", "books", "career(s)", "check", "flw", "foundation", "games", "mart", "photostudio", "pictures", "portrait", "portraitstudio(s)", "registry", "retailink" and "wire" added to WALMART mark).

It should be also noted that the geographical indications encompassed in the disputed Domain Names <esrogervivier.com> and <frrogervivier.com>, while cannot be considered as sufficient to distinguish Respondent's Domain Names from the Complainant's mark, is more apt to induce confusion among Internet users. ROGER VIVIER is, in fact, internationally well-known marks in the sector of luxury shoes and clothes, the Complainant's products are sold worldwide and, above all, the first boutique of the brand was established in Paris, France, in 1937 by a young French fashion designer Monsieur Roger Henri Vivier. See along these lines Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768.

Furthermore, the top level ".com" is merely instrumental to the use in Internet - as found in The Forward Association, Inc., v. Enterprises Unlimited (NAF case FA0008000095491, October 3, 2000) and numerous others - and not able to affect the confusing similarity of the Domain Names to the Complainant's trademark.

**The Respondent has no rights or legitimate interests in respect of the Domain Names:**

(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

The mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

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 Names.

Upon information and belief, the Respondent is not commonly known by the Domain Names as individuals, business or other organization and their family names do not correspond to ROGER VIVIER or the Domain Names.

The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the Domain Names in connection with a bona fide offering of goods or services before any notice of the dispute.

As better detailed in the paragraphs above and highlighted in the screenshots provided as the evidence, the disputed Domain Names are redirected by the Respondent to web sites where the Complainant's trademarks ROGER VIVIER are published and counterfeit ROGER VIVIER branded products are offered for sale. Moreover, there is no evident disclaimer as to the Respondent's lack of relationship with the Complainant.

It is apparent that the Respondent's use can be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed Domain Names. Such wilful conduct clearly demonstrates, to the contrary, that Respondent did not intend to use the disputed Domain Names in connection with any legitimate purpose.

Furthermore, such use of the Domain Names cannot be considered a legitimate non-commercial or fair use without intent for commercial gain, because the Respondent is undoubtedly attempting to gain from the sales of counterfeit products and it is clear that the Respondent's intention is to benefit from the Complainant's trademarks' reputation to disrupt the Complainant's business and to illegitimately trade on the Complainant's fame for commercial gain. See, along these lines, Guccio Gucci S.p.A. v. Zhang Jiawen / Zeng Aiqin / Zhou Honghai / Zhuhonghai / Zhou Hong Hai / Honghai Zhou / Liu Min / Jianghong Wang, supra, where the

Panel also stated that “the websites at the Disputed Domain Names offer for sale prima facie counterfeit GUCCI products, along with products of the Complainant’s competitors, which does not support a finding of rights or legitimate interests”.

In the Case No. D2015-1466 WIPO Prada S.A. v. Chen Mingjie, , where a counterparty of the Complainant was using its web site to offer for sale prima facie counterfeit PRADA products at prices significantly lower than those of the original products and published no disclaimer, the Panel found: “Given the high probability that the goods on offer through the disputed domain name are counterfeit, and the lack of disclosure on the site as to the Respondent’s lack of relationship to the Complainant, there is also no evidence of a bona fide offering of goods or services”.

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

**The domain names were registered and are being used in bad faith.**

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

As to the assessment of the Respondent’s bad faith at the time of registration, in light of the registration and intensive use of the trademark ROGER VIVIER since 1992 in China (where the Respondent appears to be based), the advertising and sales of the Complainant’s products worldwide, the Respondent could not have possibly ignored the existence of the Complainant’s trademark, confusingly similar to the Disputed Domain Names.

The aforesaid trade mark of the Complainant enjoys worldwide reputation in the sector of luxury shoes. The disputed domain names were registered in 2022, years after the Complainant obtained its trademark registrations.

Furthermore, the actual knowledge of ROGER VIVIER trademarks by Respondent at the time of the registration of the Domain Names is demonstrated by the facts that the Respondent has opted for “FR” in the Domain Name frogervivier.com as geographical indication and France, i.e. Paris, is the country where the first boutique of the brand was established in 1937. Furthermore, the knowledge of the Complainant’s trademark is established by the offer for sale of the replicas of Complainant’s shoes and by the reproduction of the trademarks ROGER VIVIER on the web sites corresponding to the Domain Names.

By virtue of its extensive worldwide use, the Complainant’s trademark ROGER VIVIER has become a well-known trade mark in the sector of luxury shoes and thus the Respondent knew or should have known of the Complainant’s rights in its ROGER VIVIER marks when registering the Disputed Domain Names. With reference to the well-known ROGER VIVIER trademark, see the decision Roger Vivier S.p.A. v. Domain Protection Services Inc. / Lee Rose / Watches Allen Case No. DCO2019-0040: “the Complainant’s ROGER VIVIER Marks are well known in the fashion industry and the Respondent registered the Disputed Domain Names decades after the Complainant first used and obtained its trademark registrations for the ROGER VIVIER Marks. Given the Complainants’ renown and goodwill worldwide, it strains credulity to believe that the Respondents had not known of the Complainant or the ROGER VIVIER Marks when registering the Disputed Domain Names. See Myer Stores Limited v. Mr. David John Singh, WIPO Case No. D2001-0763”.

Therefore, it is clear that the Respondent was well aware of the trademark ROGER VIVIER and registered the disputed Domain Names with the intention to refer to the Complainant and its trademarks. As noted in Ferrari S.p.A. v. Allen Ginsberg, WIPO Case No. D2002-0033, “Respondent has registered the domain name <maserati.org> corresponding to the well-known or even famous trademark MASERATI which he must have been aware of”. Considering the trademark’s distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant’s registered trademark at the time of the registration of the Domain Names, with which it is confusingly similar.

It has been stated in various decisions that the registration of a domain name with the knowledge of the complainant’s trademark is an evidence of bad faith, i.a. in Belstaff S.R.L. v. jiangzheng ying Case No. D2012-0793, “the Panel notices that the word “belstaff” is distinctive and the Complainant had expended substantial efforts to create and maintain the reputation of the mark BELSTAFF. Use of the Domain Names by the Respondent took place only long after the trademark BELSTAFF had become well known in the relevant public sector. Therefore, the Respondent should have been aware of the mark BELSTAFF when it applied to register the Domain Names. In this Panel’s view, the Respondent’s reproduction of the Complainant’s trademark BELSTAFF (both word and device trademarks) on the Websites, as well as its offering of purported Belstaff products is sufficient to show that it knew of the BELSTAFF mark when registering the Domain Names. Incorporation of the BELSTAFF mark in the Domain Names without any reasonable justification is sufficient evidence of bad faith by the Respondent”.

Indeed, the fact that replicas of ROGER VIVIER shoes have been offered for sale on the web sites corresponding to the Domain Names indicates that the Respondent was fully aware of the Complainant’s mark’s reputation and association with the Complainant and that his purpose in registering the Domain Names, which incorporates the Complainant’s trademark ROGER VIVIER, was solely to target the Complainant.

As highlighted in Swarovski Aktiengesellschaft v. Jun Qiao, WIPO Case No. D2013-1617, “the fact that purported Swarovski goods were offered at the relevant website indicates that the Respondent was fully aware of the Swarovski mark’s distinct reputation and association with the Complainant. There is no reason to choose such a distinctive mark, and also to include other terms in a domain name that are suggestive of the very business of the Complainant, other than a bad faith attempt to ride on the coattails of the trademark owner”.

The use of the disputed Domain Names in connection with commercial web sites where the Complainant’s trademark is misappropriated and counterfeit ROGER VIVIER branded shoes are offered for sale, clearly indicates that the Respondent’s purpose in registering the Domain Names was also to capitalize on the reputation of the Complainant’s trademark by diverting Internet users

seeking ROGER VIVIER products to his websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites, according to paragraph 4(b)(iv) of the Policy.

Such use of the Domain Names to promote and sell prima facie counterfeit products along with products of Complainant's competitors is also apt to disrupt Complainant's business. See along these lines Guccio Gucci S.p.A. v. zhang shao hua, WIPO Case No. D2010-0332: "The Respondent's website contains the Complainant's logo which is displayed prominently together and images used in its advertising campaigns with replica Gucci handbags being offered alongside the products of the Complainant's competitors. The Respondent has registered the disputed domain name and allowed the operator of the site, to which the disputed domain name resolves, to use it primarily for offering goods to Internet users in a way which disrupts the business of the Complainant. On the basis of the evidence adduced, the Panel finds that the presumption under paragraph 4(b)(iii) of the Policy has been invoked".

Moreover, on the web sites corresponding to the Domain Names there is no disclaimer informing the users as to the Respondent's lack of relationship with the Complainant and this increase the level of risk of confusion because an Internet user could deem that the websites corresponding to the Domain Names are sponsored by, affiliated with, or otherwise approved by the Complainant.

As anticipated, the Complainant's items, offered for sale on the web sites corresponding to the Domain Names, are counterfeit products as evidenced by the comparison among the Complainant's products offered for sale via his website <https://www.rogervivier.com> and the products offered for sale by the Respondent.

The same bag in the Complainant website is offered for sale to USD 1400,00 instead, in the Respondent's websites they are offered for sale for less than EUR 100,00. Such conduct constitutes a further evidence of bad faith registration and use of the Domain Names, as stated in several decisions, inter alia Karen Millen Fashions Limited v. Lily Rose Case No. D2012-0428 "the Panel finds Respondent's conduct in registering the disputed domain name and offering for sale counterfeit branded merchandise via Respondent's Website, all without the authorization, approval, or license of the Complainant, amounts to bad faith registration and use under paragraph 4(b)(iv) of the Policy. The Panel therefore finds the requisite element of bad faith has been satisfied, under paragraph 4(b)(iv) of the Policy."

As an additional circumstance demonstrating bad faith, prior Panels have also held that a failure to respond to a cease and desist letter can be evidence of bad faith. See, e.g.: HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062: "such bad faith is compounded when the domain name owner or its duly authorized privacy service, upon receipt of notice that the domain name is identical to a registered trademark, refuses to respond or even to disclose the domain name owner's identity to the trademark owner... Such conduct is not consistent with what one reasonably would expect from a good faith registrant accused of cybersquatting".

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#### PARTIES CONTENTIONS

Complainants contentions are provided above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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#### RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain name 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).

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#### 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).

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#### BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Name have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

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#### 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.

The Complainant has submitted evidence that the domain names in dispute are effectively controlled by the same person and/or entity. The disputed domain names in the present dispute are similarly constructed, share the same registrar, the domain names address websites that are substantially similar to each other, etc. Therefore, the domain names in dispute clearly appear to be under the same control.

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#### PRINCIPAL REASONS FOR THE DECISION

### 1. RIGHTS

The disputed domain names are confusingly similar to the Complainant's registered trademark since they reproduce the Complainant's mark 'ROGER VIVIER', merely adding SHOP or the country codes FR and ES.

As stated in *Crédit Industriel et Commercial v. Manager Builder, Builder Manager*, WIPO Case No. D2018-2230:

"The disputed domain name incorporates the CIC trademark in its entirety. Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the disputed domain name is at least confusingly similar to a registered trademark (see e.g., *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.)* and *EMS Computer Industry (a/k/a EMS)*, WIPO Case No. D2003-0696). Moreover, it has been held in many UDRP decisions and has become a consensus view among panelists (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.8), that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element of the UDRP. Accordingly, the addition of the term "banks", which even is the English translation of the French term "banques" as it is reflected in Complainant's CIC BANQUES trademark, does not avoid the confusing similarity arising from the incorporation of Complainant's CIC trademark in the disputed domain name."

### 2. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondents have not submitted any response. Therefore, they have submitted no information on possible rights or legitimate interests they might hold. On its part, the Complainant has submitted information and arguments which, prima facie, allow it to be reasonably assumed that the Respondents have no rights or legitimate interest in the domain names in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D2002-0856:

"As mentioned, [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed domain name, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists". WIPO Case No. D20020273 <sachsenhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, the Complainant has provided evidence that the Respondents' websites sell products that could be imitations or falsifications or the Complainant's luxury products. Obviously, this use cannot be considered as legitimate.

Finally, the Respondents apparently did not reply to the Complainant's C&D letter.

Accordingly, the Panel finds that the Respondents have no rights or legitimate interests in the disputed domain names.

### 3. BAD FAITH

The Respondents have, as a result of their default, not invoked any circumstances which could invalidate the Complainant's allegations and evidence with regard to the Respondents' registration and use of the disputed domain names in bad faith.

The Complainant has filed evidence of its relevant activity under the ROGER VIVIER trademark and that the Respondents' websites sell products under this trademark (probably imitations or falsifications). It seems clear that the Respondents are trying to impersonate the Complainant.

It is therefore clear that the Respondents registered the disputed domain names for this fraudulent purpose.

Paragraph 4(b) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of a product or service on its website or location.

As mentioned in *Andrey Ternovskiy dba Chatroulette v. Alexander Ochki*, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see *AT&T Corp. v. Amjad Kausar*, WIPO Case No. D2003-0327)."

It has, therefore, been satisfactorily demonstrated to the Panel that the disputed domain names have been registered and used in bad faith.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **esrogervivier.com**: Transferred
2. **frrogervivier.com**: Transferred
3. **rogerviviershop.com**: Transferred

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### PANELLISTS

Name	José Ignacio San Martín
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DATE OF PANEL DECISION 2023-05-18

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Publish the Decision

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