Decision for dispute CAC-UDRP-106497

Case number	CAC-UDRP-106497
Time of filing	2024-05-03 09:20:24
Domain names	monclerschweiz.net, monclerbuy.com, moncleroutletfactory.com, monclernz.net, moncler-india.com, monclerhungaryfactorys.com, factoryoutletmoncler.com, monclermontturkiye.com, moncler-thailand.com, monclersingaporesg.com, monclerjaknesrbija.com, moncler-peru.com, monclervestnorge.com, monclernederlands.com, monclerenmexico.com, moncler-outletjapan.com, monclerdublinireland.com, monclerie.com, moncler-indonesia.com, monclermagyarorszag.com, monclerjaknehrvatska.com, boutiquemonclerenfrance.com, moncler-suomi.com, moncler-chile.com, monclerschweizs.com, monclercoatcanada.com, moncler-brasil.com, moncler-aus.com, monclerfactoryhungary.com, moncleralbania.com, moncleraustraliaonline.com, moncler-belgium.com, monclerdanmarkbutik.com, moncleritaliaonlineshop.com, moncler-malaysia.com, moncler-philippines.com, moncler-romania.com, moncler-slovenija.com, monclersalgnorge.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	MONCLER S.P.A.

Complainant representative

Organization	Convey srl

Respondents

Name	Rebecca Stokes
Name	Burn Burn
Name	Michael Watson
Name	Phoebe Walton
Name	Client Care
Name	Zhang Fei

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 relies on its registered trademarks:

Mark	Territory	Registration No.	Application Date	Registration Date	Classes
MONCLER	WIPO Designations: AT, BA, CZ, DE, EG, ES, FR, HR, HU, IT, LI, MA, MC, MK, PT, RO, SI, SK, SM	383336	October 26, 1971	October 26, 1971	3
MONCLER	European Union	010165256	August 01, 2011	April 10, 2012	4, 20, 35
MONCLER	WIPO Designations: AU, EM, JP, KR, TR, US, BY, CN, KZ, RU, UA	1467902	December 17, 2018	December 17, 2018	9, 35, 36, 37, 38, 39, 41, 42
MONCLER	European Union	005796594	March 29, 2007	January 28, 2008	3, 9, 14, 16, 18, 22, 24, 25, 28
MONCLER (& Logo)	Malaysia	2012005442	April 03, 2012	March 11, 2013	28
MONCLER (& Logo)	Malaysia	2011019826	November 10, 2011	March 15, 2013	18
MONCLER	Malaysia	2012005438	April 03, 2012	March 08, 2013	9

Further, the Complainant operates its business using its domain names <moncler.com> registered since May 14, 2003, <moncler.cn> registered since February 15, 2006, <moncler.it> registered since April 09, 2002 and <moncler.eu>, registered since June 10, 2007.

FACTUAL BACKGROUND

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

Key aspects of the Complainant's contentions are summarized below.

Complainant's Background

The Complainant, Moncler S.p.A., is a well-known Italian company based in Milan. The Complainant makes luxury sports equipment and ready-to-wear outerwear. The Complainant's Moncler brand started in 1952 in a village called Monestier-de-Clermont, near Grenoble, France. The name Moncler is an abbreviation from this village. At first, the company made quilted jackets to keep workers warm. These jackets became popular when a French mountaineer named Lionel Terray saw them and helped create the "Moncler pour Lionel Terray" range. Moncler's down jackets were chosen for the Italian expedition to K2 in 1954. By 1968, Moncler was the official supplier for the French downhill ski team at the Grenoble Winter Olympics. In the 1980s, under designer Chantal Thomass, Moncler entered urban fashion, becoming iconic among youth with new features like buttons, fur linings, and satin. In the early 2000s, Italian entrepreneur Remo Ruffini acquired Moncler, driving its global expansion and leading to its listing on the Milan Stock Exchange in 2013. The Complainant became the official formalwear partner of the Italian football club Inter Milan in 2021. Through considerable promotional efforts, the Complainant has built substantial goodwill and prestige for its MONCLER trademark.

Registration of the disputed domain names

According to the registrar verifications included with the Complaint, the disputed domain names were registered according to the following dates:

monclerbuy.com	2023-10-28
moncleroutletfactory.com	2021-08-29
monclerschweiz.net	2023-07-04
monclernz.net	2023-11-24
moncler-india.com	2023-11-10
monclerhungaryfactorys.com	2024-2-20
factoryoutletmoncler.com	2023-11-09
monclermontturkiye.com	2023-11-09
moncler-thailand.com	2023-11-10
monclersingaporesg.com	2023-11-10
monclerjaknesrbija.com	2023-12-09
moncler-peru.com	2023-11-10
monclervestnorge.com	2024-02-08
monclernederlands.com	2023-11-09
monclerenmexico.com	2023-11-10

	moncler-outletjapan.com	2023-11-10
	monclerdublinireland.com	2023-11-09
	monclerie.com	2023-11-28
	moncler-indonesia.com	2023-11-10
	monclermagyarorszag.com	2023-11-09
	monclerjaknehrvatska.com	2023-11-09
	boutiquemonclerenfrance.com	2023-11-09
	moncler-suomi.com	2023-11-09
	moncler-chile.com	2023-11-10
	monclerschweizs.com	2023-11-09
	monclercoatcanada.com	2023-11-09
	moncler-brasil.com	2023-11-10
	moncler-aus.com	2023-11-09
	monclerfactoryhungary.com	2023-9-21
	moncleralbania.com	2023-7-26
	moncleraustraliaonline.com	2023-8-14
	moncler-belgium.com	2023-11-09
	monclerdanmarkbutik.com	2023-11-09
	moncleritaliaonlineshop.com	2023-11-09
	moncler-malaysia.com	2023-11-10
	moncler-philippines.com	2023-11-10
	moncler-romania.com	2023-7-26
	moncler-slovenija.com	2023-11-09
	monclersalgnorge.com	2023-7-25

Consolidation Request

The Complainant contends that the disputed domain names should be consolidated into a single complaint because they are subject to common control for the following reasons: 1) same extension of the domain names: .com (except for <monclernz.net> and <monclerschweiz.net>); 2) same registrar: ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED (except for <monclerschweiz.net>, <monclerbuy.com> and <moncleroutletfactory.com>); 3) same lay-out of the websites corresponding to the domain names; 4) presence of geographical terms associated to the Complainant's trademark in the domain names.

First UDRP Element - disputed domain names are Confusingly Similar to the Complainant's Trademark

The Complainant asserts that the disputed domain names are confusingly similar to its trademark MONCLER by incorporating the entire trademark MONCLER, along with generic commercial and geographical terms. The combination of MONCLER with generic and geographical terms could suggest improperly to consumers that the disputed domain names and corresponding web sites might be directly controlled or authorized by the Complainant.

Further, the Complainant contends that the addition of the gTLD ".COM" is merely instrumental to the use in Internet and does not affect the confusing similarity of the disputed domain names to the Complainant's trademark.

Second UDRP Element – The Respondent has no Rights or Legitimate Interests in the disputed domain names

The Complainant asserts that the Respondent is not a licensee, authorized agent, or related in any way to the Complainant, nor is authorized in any way to use the Complainant's trademarks or to register or use the disputed domain names.

The Complainant claims there is no evidence of demonstrable preparations to use nor actual use of the disputed domain names in connection with a bona fide offering of goods or services. Rather, most of the disputed domain names redirect to websites with similar layouts where the Complainant's MONCLER trademarks are displayed, and prima facie counterfeit MONCLER branded products are offered for sale. The Complainant claims that it is evident the goods are counterfeit due to the following circumstances: the goods are sold at prices disproportionately below market value; the Respondent has used copyrighted images from the Complainant's website without permission; and the Respondent has concealed their identity in some of the WHOIS records and on the associated websites. Such wilful conduct demonstrates the Respondent did not intend to use the disputed domain names in connection with any legitimate purpose.

The Complainant also claims that the Respondent is not commonly known by the disputed domain names as an individual, business, or other organization and their family names do not correspond to MONCLER or the disputed domain names.

Third UDRP Element – The disputed domain names were Registered and are Being Used in Bad Faith

The Complainant asserts that its MONCLER trademarks enjoy worldwide reputation in the sector of manufacturing luxury apparels and that a past domain name dispute panel has confirmed the notoriety of the trademark MONCLER. Further, the actual knowledge of the MONCLER trademark by Respondent at the time of the registration of the disputed domain names is demonstrated by the intensive use of the MONCLER trademark since 1952 and by the fact that, in most of the disputed domain names, the Respondent offers replicas of the Complainant's goods for sale and reproduces the MONCLER trademarks on the corresponding websites.

Considering the trademarks' distinctiveness and well-known character, the Complainant claims it is inconceivable that the Respondent was unaware of the existence of the Complainant's MONCLER trademark at the time of the registration of the disputed domain names, with which they are confusingly similar.

Complainant claims that the use of the disputed domain names in connection with commercial websites, where the Complainant's trademark is misappropriated and prima facie counterfeit MONCLER products are offered for sale, clearly indicates that the Respondent's purpose in registering the domain names was to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking products under the MONCLER mark to the Respondent's own sites. The following factors demonstrate that the goods offered for sale are prima facie counterfeit: they are sold at prices disproportionately below market value, copyrighted images from the Complainant's website are used without permission, and the Respondent has concealed their identity in both the WHOIS records and on the associated websites. The use of these domain names to promote and sell counterfeit products disrupts the Complainant's business. Further, the websites corresponding to the domain names do not include disclaimers to inform users of the Respondent's lack of relationship with the Complainant, creating the false impression that they are authorized by the Complainant. By registering the disputed domain names at issue, confusingly similar to the trademark MONCLER, the Respondent has been engaged in a pattern of conduct preventing the Complainant from reflecting the mark in corresponding domain names. Further, the Respondent has targeted the Complainant through the registration of thirty-nine (39) domain names including the trademark MONCLER.

The above summarized facts and arguments asserted by the Complainant are not contested by the Respondent because no Response was filed.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

No administratively compliant Response has been filed.

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

LANGUAGE OF PROCEEDING

According to Rule 11 in the Rules for Uniform Domain Name Dispute Resolution Policy, (the “Rules”) “...the language of the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

According to the information on the case file, the Registrar confirmed that the Respondent is the current registrant of the disputed domain names, and that the language of the registration agreements is English.

As neither party has asked to deviate from the English language as per the registration agreements, the Panel finds that this proceeding may be properly conducted in English.

CONSOLIDATION OF MULTIPLE RESPONDENTS

Complainant alleges that all six Respondents included in the original Complaint are either alter egos of the same actor and/or subject to common control. Thus, Complainant seeks to consolidate six Respondents and thirty-nine disputed domain names into a single proceeding.

Paragraph 10(e) of the UDRP Rules grants the Panel authority to “decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.” Similarly, paragraph 3(c) of the UDRP Rules provides that a complaint “may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.” As stated in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), when considering consolidation requests panels should look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency underpins such consideration.

Section 4.1.2 of WIPO Overview 3.0 sets out eleven factors, typically present in some combination, that prior panels have found to warrant consolidation:

1. the registrants' identity(ies) including pseudonyms,
2. the registrants' contact information including e-mail address(es), postal address(es), or phone number(s), including any pattern of irregularities,
3. relevant IP addresses, name servers, or webhost(s),
4. the content or layout of websites corresponding to the disputed domain names,
5. the nature of the marks at issue (e.g., where a registrant targets a specific sector),
6. any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>),
7. the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue,
8. any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s),
9. any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s),
10. any (prior) pattern of similar respondent behavior, or
11. other arguments made by the complainant and/or disclosures by the respondent(s).

With consideration to the above factors, and the totality of circumstances of the case, the Panel has concluded that consolidation is warranted in part, denied in part.

According to the Registrar Verifications in the case file, the names and the addresses of the six named Respondents are different. However, this difference in registrant details is not wholly dispositive as to whether consolidation should be granted, since registrars are not typically required to verify the identity of registrants.

The Complainant has provided sufficient evidence of common control between two (2) of the Respondents only. These two Respondents are (i) the Respondent with the name "Web Commerce Communication Limited" according to the registrar verification and "Client Care" according to the Complaint which is the registrant of two disputed domain names: <www.moncler-india.com> and <www.monclerhungaryfactorys.com>, and (ii) the Respondent with the name "na" according to the registrar verification and "Zhang Fei" according to the Complaint which is the registrant of 33 disputed domain names: <www.factoryoutletmoncler.com>; <www.monclermontturkiye.com>; <www.moncler-thailand.com>; <www.monclersingaporesg.com>; <www.monclerjaknesrbija.com>; <www.moncler-peru.com>; <www.monclervestnorge.com>; <www.monclernederlands.com>; <www.monclerenmexico.com>; <www.moncler-outletjapan.com>; <www.monclerdublinireland.com>; <www.monclerie.com>; <www.moncler-indonesia.com>; <www.monclermagyarorszag.com>; <www.monclerjaknehrvatska.com>; <www.boutiquemonclerenfrance.com>; <www.moncler-suomi.com>; <www.moncler-chile.com>; <www.monclerschweizs.com>; <monclercoatcanada.com>; <www.moncler-brasil.com>; <www.moncler-aus.com>; <www.monclerfactoryhungary.com>; <www.moncleralbania.com>; <www.moncleraustraliaonline.com>; <www.moncler-belgium.com>; <www.monclerdanmarkbutik.com>; <www.moncleritaliaonlineshop.com>; <www.moncler-malaysia.com>; <www.moncler-philippines.com>; <www.moncler-romania.com>; <www.moncler-slovenija.com>; and <www.monclersalgnorge.com>. Such common control is sufficiently established the following relevant indicators:

1. These 35 domain names all share the registrar Alibaba Cloud Computing (Beijing) Co., Ltd according to the Complaint or ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED according to the Whois extracts.
2. The layout and content used in the websites corresponding to these disputed domain names is almost identical between the two Respondents. According to the screenshots filed, (i) the site associated with <www. monclerhungaryfactorys.com> registered to "Web Commence Communications Limited" has the same layout, color scheme, look and feel, as the site associated with < monclerfactoryhungary.com> registered to "Zhang Fei" and (ii) the site associated with <www. moncler-india.com> registered to "Web Commence Communications Limited" has the same layout as many of the sites registered to "Zhang Fei" included with this Complaint. Prior panels have found that common control may exist where the webpages associated with the disputed domain names are nearly identical (See, for example General Electric Company v. Marketing Total S.A. WIPO Case No 2007-1834, "...the domain names at issue point to nearly identical web pages "; (see WIPO Overview 3.0 s4.11.2(iv))).

Thus, the above two Respondents and associated thirty-five (35) disputed domain names shall be consolidated into a single proceeding.

On the other hand, there is insufficient evidence to establish common control with respect to the above-named Respondents Web Commerce Communications Limited/ Zhang Fei and the remaining four Respondents "Burn Burn", "Michael Watson", "Rebecca Stokes" and "Phoebe Walton" who are the registrants for the remaining four domain names, namely <www.monclerbuy.com>, <www.moncleroutletfactory.com>, <www.monclerschweiz.net>, and <www.monclernz.net>.

Evidence weighing against the consolidation of these four (4) domains names in the instant case includes:

- Screenshots submitted by the Complainant show a significantly different style, color scheme, and layout of the website associated with these four domain names, compared to the websites associated with the other 35 domain names mentioned

above.
- The Complainant has not shown sufficient evidence of common control according to factors such as the registration date, registrant name (i.e. respondent details), registrant organization or contact person, registrant address, registrant email, registrar, IP address, IP location, name server, or website layout of these four domain names compared to the 35 domain names mentioned above.
- These domain names have different Registrars, namely: <monclerbuy.com> and <moncleroutletfactory.com> = NameCheap, Inc.; <monclerschweiz.net> = Paknic (Private) Limited; and <monclernz.net> = Alibaba Cloud Computing (Beijing) Co., Ltd.

Accordingly, the minimal arguments submitted by the Complainant for consolidation of these four domain names with the other thirty-five domain names are not persuasive.

The fact that all four of these disputed domain names share the use of a Complainant's logo within the website associated with such domain names is not, without more, sufficient to show common control. Typically in consolidation requests, there are several factors are present pointing to consolidation, and the panel must weigh up the persuasiveness of each factor. The Panel, in accordance with its articulated powers under paragraphs 10 and 12 of the UDRP Rules, considered it useful to undertake limited additional research to assess the merits of the consolidation request. For this purpose, the Panel checked publicly available information concerning the IP Address and IP Location of these four disputed domain names. According to such publicly available information, there was no commonality regarding the IP Addresses and IP Locations of these four domain names and the other 35 domain names which are to be consolidated in this proceeding. Further, commonality in the use of the Complainant's logo on the websites is afforded low weight and does not, without more, warrant consolidation.

The Complaint asserts that all 39 domain names share the same layout (detailed in Annex 1 to the Complaint). However, in the screenshots provided by the Complainant, there are different types of layouts, which may be grouped as follows:

- G1: <monclerbuy.com>
- G2: <moncleroutletfactory.com
- G3: <monclerschweiz.net and monclernz.net
- G4: <monclerhungaryfactorys.com and monclerfactoryhungary.com
- G5: <moncleralbania.com; moncleraustraliaonline.com
- G7: <monclersalgnorge.com
- G8: <moncler-romania.com
- G9: <moncler-india.com>; <factoryoutletmoncler.com>; <monclermontturkiye.com>; <moncler-thailand.com>; <monclersingaporesg.com>; <monclerjaknesrbija.com>; <moncler-peru.com>; <monclervestnorge.com>; <monclernederlands.com>; <monclerenmexico.com>; <moncler-outletjapan.com>; <monclerdublinireland.com>; <monclerie.com>; <moncler-indonesia.com>; <monclermagyarorszag.com>; <monclerjaknehrvatska.com>; <boutiquemonclerenfrance.com>; <moncler-suomi.com>; <monclerschweizs.com>; <monclercoatcanada.com>; <moncler-aus.com>; <moncler-belgium.com>; <monclerdanmarkbutik.com>; <moncleritaliaonlineshop.com>; <moncler-malaysia.com>; <moncler-philippines.com>; <moncler-slovenija.com>.
- G10: <moncler-chile.com> and <moncler-brasil.com> - no screenshot of the content for these two websites was included in Annexes of the Complaint. The Panel, in accordance with its articulated powers under paragraphs 10 and 12 of the UDRP Rules, considered it useful to undertake limited additional research and found that neither of these disputed domain names resolved to active content at the time of preparing this decision. Therefore, it cannot be said that the non-existent websites for these two disputed domain names share the same layout as the others.

As an additional point, the Panel notes that not all of the 39 disputed domain names include a geographical term, specifically the three domain names <moncleroutletfactory.com>; <monclerbuy.com> and <factoryoutletmoncler.com> have no such term. These three domain names therefore do not follow the predominant naming pattern – the MONCLER mark plus variations of a geographic term – which is found in the remainder of the disputed domain names.

Accordingly, the four disputed domain names < monclerbuy.com>, < moncleroutletfactory.com>, < monclerschweiz.net>, and < monclernz.net> shall be excluded from this instant proceeding. Should the Complainant wish to take actions with respect to these disputed domain names, Complainant may do so in separate proceedings.

On the other hand, the above circumstances, taken together, lead the Panel to conclude that it is more likely than not that the disputed domain names < factoryoutletmoncler.com>; < monclermontturkiye.com>; < moncler-thailand.com>; < monclersingaporesg.com>; < monclerjaknesrbija.com>; < moncler-peru.com>; < monclervestnorge.com>; < monclernederlands.com>; < monclerenmexico.com>; < moncler-outletjapan.com>; < monclerdublinireland.com>; < monclerie.com>; < moncler-indonesia.com>; < monclermagyarorszag.com>; < monclerjaknehrvatska.com>; < boutiquemonclerenfrance.com>; < moncler-suomi.com>; < moncler-chile.com>; < monclerschweizs.com>; <monclercoatcanada.com>; < moncler-brasil.com>; < moncler-aus.com>; < monclerfactoryhungary.com>; < moncleralbania.com>; < moncleraustraliaonline.com>; < moncler-belgium.com>; < monclerdanmarkbutik.com>; < moncleritaliaonlineshop.com>; < moncler-malaysia.com>; < moncler-philippines.com>; < moncler-romania.com>; < moncler-slovenija.com>; and < monclersalgnorge.com> are under common control, and that consolidation of the cases against those two Respondents would be (i) fair and equitable to all parties and (ii) result in procedural efficiencies. Given such common control, hereinafter the two Respondents with the respective alter egos "Web Commerce Communications Limited", and "Zhang Fei " shall be referred to by the singular term "Respondent". The term "disputed domain names" shall hereinafter collectively refer only to the 35 disputed domain names listed in this paragraph.

PRINCIPAL REASONS FOR THE DECISION

THREE ELEMENTS THE COMPLAINANT MUST ESTABLISH UNDER THE POLICY

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a disputed domain name should be transferred or cancelled:

(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 in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term MONCLER in numerous classes and territories around the world. Such trademark rights were created and registered long prior to July 25, 2023, July 26, 2023, August 14, 2023, September 21, 2023, November 09, 2023, November 10, 2023, November 28, 2023, December 09, 2023, February 08, 2024, and February 20, 2024 , the respective creation dates of the disputed domain names. A nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Accordingly, the Panel finds that the Complainant possesses rights in its MONCLER trademark such that it has standing under the Policy.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) ("the mere addition of the words ‚Ninjago' and ‚Kai' is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant's trademark.").

In the present case, the disputed domain names consist of the MONCLER trademark reproduced in its entirety with the addition of the geographic terms "india", "hungary", "montturkiye", "thailand", "singapore", "sg", "jaknesrbija", ,'peru", ,'vestnorge", ,'nederlands" ,'mexico", ", ,'japan", "dublinireland ", " ie ", "indonesia", "magyarorszag ", "jaknehrvatska ", "france", "suomi", "chile", "schweizs", "canada", "brasil", "aus", "albania", "australia", "belgium", "danmark", "italia", "malaysia", "philippines", "romania", "slovenija" and " salgnorge" and the generic but related terms ,´ "factory", "outlet", "en", "boutique", "coat", "online", "butik", and "shop" . In assessing confusing similarity, the Panel finds the disputed domain names are confusingly similar to the Complainant's trademark, because they incorporate the entirety of the MONCLER trademark, and differ from such mark merely by respectively adding the aforementioned geographic and generic but related terms. These additions do not prevent a finding of confusing similarity in light of the prominence of the distinctive MONCLER mark within the disputed domain names.

The TLD – in this case .com - may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Accordingly, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain names are confusingly similar to the Complainant's mark.

(B) THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAMES

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the disputed domain names. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it; see, for example, WIPO Overview 3.0, section 2.1 ("While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."). However, the burden of proof still remains with the complainant to make out its prima facie case on a balance of probabilities. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

Paragraph 4(a)(ii) of the Policy contemplates an examination of the available facts to determine whether a respondent has rights or legitimate interest in the domain name. Paragraph 4(c) sets out a list of circumstances through which a respondent may demonstrate that it does have such rights or interests.

The first circumstance, under Paragraph 4(c)(i), is where "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of

goods or services". Here, according to screenshot evidence submitted by the Complainant, most of the disputed domain names resolve to copy-cat websites displaying Complainant's trademark and goods. Accordingly, the Panel finds no evidence of a bona fide offering or goods or services or demonstrable preparations to use per Policy 4(c)(i) and Respondent does not have rights or legitimate interests with respect to the disputed domain names thereunder.

The second circumstance, under Paragraph 4(c)(ii), concerns cases where the respondent is commonly known by the domain name. Here, according to the registrar verification, the Respondent names are ''Client Care" or "Web Commerce Communications Limited'', and "na" or "Zhang Fei"" and have no similarity or connection to the disputed domain names. There is no evidence that the Respondent is commonly known by the disputed domain names. As such, this second circumstance of legitimate rights or interests under the Policy is not applicable to the Respondent.

Regarding the third circumstance, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's MONCLER trademark. According to the evidence submitted, most of the disputed domain names redirect to websites with similar layouts, where the Complainant's MONCLER trademarks are displayed, and allegedly prima facie counterfeit MONCLER branded products are offered for sale. The Complainant claims that the goods therein are counterfeit because they are offered at prices disproportionately below market value. Evidence of the low pricing is included with the Complaint with respect to a pair of rain boots offered for sale on the Complainant's official website www.moncler.com for €410, while the same product is offered on the website corresponding to the disputed domain name www.moncleralbania.com for just $119.90. The Complaint included screenshots with two price comparison examples, however one of the examples referenced a website corresponding to a domain name not included in the Complaint, namely <monclerhungaryfactory.top> and therefore this example is disregarded by the Panel. Nevertheless, the Panel is prepared to accept - prima facie - that the goods offered through the websites associated with the disputed domain names could be counterfeit because the evidence on the record shows a MONCLER branded product offered for sale at less than half it's regular price.

Additionally, none of the accepted categories of fair use - such as news reporting, commentary, political speech, education etc. – are found to apply and the Panel concludes there is no legitimate non-commercial or fair use on the part of the Respondent.

Even if the goods sold via the websites associated with the disputed domain names are not counterfeit the present case fails the "Oki Data test" for establishing legitimate interest as set out in Oki Data Americas, Inc. v. ASD, Inc WIPO Case No. D2001-0903 because the screenshots submitted as evidence do not appear to contain any information about the Respondent nor do they disclose the Respondent's relationship with the Complainant. There is no clear and prominent disclaimer that could support a finding that the Respondent has taken reasonable steps to avoid confusing consumers about the provenance of the website. Further, cases applying the Oki Data test usually involve a domain name comprising the trademark plus a descriptive term such as "parts" or "repairs". In the instant case there is no such descriptive term, and the disputed domain names are identical to the Complainant's trademark, save for the addition of geographical and generic but related terms.

Lastly, the Complaint states that the Respondent is not licensed, nor has any relationship with or authority to represent the Complainant in any way.

Accordingly, the Complainant has sufficiently made out its prima-facie case on the second element of the Policy. Thus, the burden of proof is shifted to the Respondent to rebut the Complainant's case. Here, because the Respondent has not participated in these proceedings, there is no such rebuttal to consider, and the Complainant prevails.

The Panel therefore concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest in the disputed domain names. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES

The third element requires the Complainant to show that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g. Hallmark Licensing, LLC v. EWebMall, Inc., WIPO Case No. D2015-2202 ("The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.").

Further, Paragraph 4(b) of the Policy sets out a non-exhaustive list of four circumstances, any one of which may be evidence of the registration and use of a domain name in bad faith. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

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

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy for the reasons set out below.

1. There is no evidence that the Respondent is commonly known by the disputed domain names and the Complainant confirms that the Respondent has never been affiliated with nor authorized by the Complainant to use the Complainant's trademark(s) and/or register the disputed domain names. Nor is there any business or other association between the Complainant and the Respondent.
2. The Complainant's MONCLER trademark is distinctive and enjoys a considerable reputation in its industry as evidenced by its substantial presence on social media sites with around 5.3 million Instagram followers, 3 million Facebook followers and around 50,000 subscribers to its YouTube channel. The Complainant's reputation was also confirmed by a previous panel in CAC Case No. 105522 MONCLER S.P.A. v. Qiu Xiaofeng et al ("the Complainant's trademark MONCLER has become a well-known trademark in the sector of manufacturing luxury outwear"). The same logic applies in this instant case, and this Panel finds that because of the well-established status of the Complainant, it is more probable than not that the Respondent either knew, or should have known, that the disputed domain names would be confusingly similar to the Complainant's trademarks and thus they registered the disputed domain names with the Complainant in mind.
3. The Respondent's subsequent use of 33 of the 35 disputed domain names for lookalike sites demonstrates that Respondent had actual notice of the Complainant's trademark when registering the disputed domain names. It has regularly been held that to copy a trademark in a domain name, or use it with a slight variation, knowing that the disputed domain name is based on the trademark of another party, constitutes bad faith registration and use of the disputed domain name according to the Policy. The Panel makes that finding in the present case.
4. The evidence of targeting by the Respondent is compelling. The disputed domain names comprise Complainant's distinctive MONCLER mark, with the addition of the geographic terms 'india'', ''hungary'', ''montturkiye'', ''thailand'', ''singapore'', ''sg'', ''jaknesrbija'', ,'peru'', ,'vestnorge'', ,'nederlands'' ,'mexico'', '', ,'japan'', ''dublinireland '', '' ie '', ''indonesia'', ''magyarorszag '', ''jaknehrvatska '', ''france'', ''suomi'', ''chile'', ''schweizs'', ''canada'', ''brasil'', ''aus'', ''albania'', ''australia'', ''belgium'', ''danmark'', ''italia'', ''malaysia'', ''philippines'', ''romania'', ''slovenija'' and '' salgnorge'' and the generic but related terms ,´ ''factory'', ''outlet'', ''en'', ''boutique'', ''coat'', ''online'', ''butik'', and ''shop'', apparently meant to represent countries and online stores where Complainant offers its goods and with which the Complainant can therefore be closely and relevantly associated.
5. According to the evidence submitted, 33 of the 35 disputed domain names resolve to active content purporting to offer goods for sale bearing the Complainant's MONCLER trademark. Complainant asserts that these goods are prima facie counterfeit because they are sold at prices disproportionately below market value, copyrighted images from the Complainant's website are used without permission, and the Respondent has concealed their identity in both the WHOIS records and on the associated websites. The use of a disputed domain name to pass off as a complainant and offer competing or counterfeited goods may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv). Here, absent any rebuttal from the Respondent, the Panel accepts - prima facie – the claim by the Complainant that the goods on the active sites are likely counterfeit.
6. By using the disputed domain names for lookalike websites as noted above, the Respondent is clearly intending to attract internet users for commercial gain, in a manner which would generate confusion as to the legitimacy of any site to which the disputed domain name resolves. This brings the case within the provisions of paragraph 4(b) (iv) of the Policy.
7. Despite assertions to the contrary, the Complainant did not include screen shots of the two disputed domain names <moncler-chile.com> and <moncler-brasil.com>. The Panel, in accordance with its articulated powers under paragraphs 10 and 12 of the UDRP Rules, considered it useful to undertake limited additional research and found that neither of these domain names resolved to active content at the time of preparing this decision. The non-active use of these two disputed domain names in this case satisfies the doctrine of passive holding as described in WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows considering all of the circumstances of the case because (i) the Complainant's trademark is distinctive and has a strong reputation in its sector, (ii) the Respondent failed to respond to these proceedings and thus has provided no evidence of actual or contemplated good-faith use, (iii) it is impossible to conceive of any plausible actual or contemplated good faith use of the disputed domain names by the Respondent in the circumstances of this case.
8. Further, there is a pattern of conduct indicating the Respondent registered the thirty-five (35) disputed domain names in order to prevent the Complainant from reflecting the mark in corresponding domain names.

9. As a final point, the Panel may draw a negative inference from Respondent's failure to reply to the Complainant's cease and desist letter and silence through these proceedings.

This present case has similarities to Prada S.A. v. Chen Minjie, WIPO Case No. D2015-1466, where it was held, "The Respondent's registration of a domain name which incorporates the whole trade mark, PRADA, the use thereof for the purpose of selling what appears to be counterfeit PRADA products, and the creation of a web site which is intended to pass off as the authentic or official web site of the Complainant, are obvious signs of bad faith registration and use. This is the very kind of cybersquatting and illegitimate activity that the Policy is intended to address and deal with."

In light of the above analysis, the Panel concludes that the Complainant has made out its case that the disputed domain names were registered and are being used in bad faith, and thus has satisfied the requirements under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **monclerschweiz.net**: Terminated (consolidation not granted)
2. **monclerbuy.com**: Terminated (consolidation not granted)
3. **moncleroutletfactory.com**: Terminated (consolidation not granted)
4. **monclernz.net**: Terminated (consolidation not granted)
5. **moncler-india.com**: Transferred
6. **monclerhungaryfactorys.com**: Transferred
7. **factoryoutletmoncler.com**: Transferred
8. **monclermontturkiye.com**: Transferred
9. **moncler-thailand.com**: Transferred
10. **monclersingaporesg.com**: Transferred
11. **monclerjaknesrbija.com**: Transferred
12. **moncler-peru.com**: Transferred
13. **monclervestnorge.com**: Transferred
14. **monclernederlands.com**: Transferred
15. **monclerenmexico.com**: Transferred
16. **moncler-outletjapan.com**: Transferred
17. **monclerdublinireland.com**: Transferred
18. **monclerie.com**: Transferred
19. **moncler-indonesia.com**: Transferred
20. **monclermagyarorszag.com**: Transferred
21. **monclerjaknehrvatska.com**: Transferred
22. **boutiquemonclerenfrance.com**: Transferred
23. **moncler-suomi.com**: Transferred
24. **moncler-chile.com**: Transferred
25. **monclerschweizs.com**: Transferred
26. **monclercoatcanada.com**: Transferred
27. **moncler-brasil.com**: Transferred
28. **moncler-aus.com**: Transferred
29. **monclerfactoryhungary.com**: Transferred
30. **moncleralbania.com**: Transferred
31. **moncleraustraliaonline.com**: Transferred
32. **moncler-belgium.com**: Transferred
33. **monclerdanmarkbutik.com**: Transferred
34. **moncleritaliaonlineshop.com**: Transferred
35. **moncler-malaysia.com**: Transferred
36. **moncler-philippines.com**: Transferred
37. **moncler-romania.com**: Transferred
38. **moncler-slovenija.com**: Transferred

39. **monclersalgnorge.com**: Transferred

PANELLISTS

Name	**Claire Kowarsky**

DATE OF PANEL DECISION 2024-06-16

Publish the Decision