Decision for dispute CAC-UDRP-107561

Case number	CAC-UDRP-107561
Time of filing	2025-05-14 10:09:22
Domain names	rogervivieronline.shop, rvivieronline.com, rv-online.shop, r-vivier.shop, roger-vivier.shop, rogervivierjapan.shop

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	ROGER VIVIER S.P.A.

Complainant representative

Organization	Convey srl

Respondents

Organization	LS
Name	Luke Shaw

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

In these proceedings, the Complainant relies on the following trademarks, all registered in its name and duly renewed:

- International Trademark n° 348577 - “Roger Vivier Boutique” (registered on August 29, 1968) in classes 3,18, 21, 25;

- International trademark n° 590402 (extended in China) - “ROGER VIVIER” - (registered on August 5, 1992) in classes 3, 9, 14, 15, 18, 20, 21, 24, 25, 26, 34, 42;

- European Union Trademark n° 006349138 - “ROGER VIVIER” - (registered on October 17, 2008) in classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 26, 34, 35, 42;

- International trademark n° 11022702 - “RV Roger Vivier” (registered on October 8, 2014) in classes 3, 9, 14, 16, 18,24, 25, 35;

- International trademark n° 1120203 (extended in China) - “VIVIER” - (registered on May 14, 2012) in classes 9, 14;

- Hong Kong trademark n° 200309543AA – “ROGER VIVIER” – (registered on December 27, 2002) in classes 3, 9, 14, 16, 18, 20, 21, 24, 26, 34, 35;

- Hong Kong trademark n° 199707248 – “ROGER VIVIER” – (registered on June 29, 1995) in class 25;

- Hong Kong trademark n° 200309547 – “ROGER VIVIER” – (registered on December 27, 2002) in class 26;

- Hong Kong trademark n° 200408165 – “ROGER VIVIER” – (registered on December 27, 2002) in class 35.

It is worth noting that, the Complainant owns many other trademark registrations for ROGER VIVIER or similar in various countries, which have not been cited in these proceedings. In addition, the Panel notes that the Complainant has also relied upon trademarks registered in Hong Kong, where the Respondent is apparently located.

FACTUAL BACKGROUND

According to evidence provided by the Complainant and not refuted by the Respondent, the Complainant is an Italian-based “prominent high-end fashion and luxury industry”, with a worldwide reputation, boasting more than 60 stores and millions of Euros in annual turnover. In particular, the Complainant owns the internationally famous "ROGER VIVIER" brand, which it has very successfully applied (amongst other things) to its range of shoes, bags and women's accessories, purchased by many celebrities. The Complainant's products are sold worldwide, also through its numerous official websites.

The Complainant owns a large-sized portfolio of trademarks around the world, including the wording "ROGER VIVIER", among which an International registration dating back to 1968. It also has a successful internet and social media presence, such as its Instagram, Facebook and Twitter/X accounts, while it owns a multitude of related domain names, like <rogervivier.com>, <rogervivier.net>, <rogervivier.org>, <rogervivier.info>, <rogervivier.biz> and <rogervivier.it>, since many years.

All six (6) disputed domain names, <rogervivieronline.shop>, <rvivieronline.com>, <rv-online.shop>, <r-vivier.shop>, <roger-vivier.shop> and <rogervivierjapan.shop> were registered between March 2024 and March 2025 by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain names are confusingly similar to its ROGER VIVIER trademark, as they are combinations of this wholly incorporated trademark and of descriptive or geographical terms. This last element is sufficient to support the finding that the disputed domain names are confusingly similar to the Complainant's trademark. The mere addition of the specific descriptive or geographical terms to the Complainant’s trademark does not change the overall impression of a most likely connection with the trademark ROGER VIVIER of the Complainant, since the Complainant is active both online and in Japan. As to the gTLDs “.shop” and “.com”, the Complainant suggests that they should be disregarded, as per usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain names because the Respondent is not known by the disputed domain names, the Complainant is neither affiliated with the Respondent nor has it ever authorised the Respondent to register its trademark as a domain name, and the Complainant has no business with the Respondent.

According to the Complainant, given the seniority, distinctiveness and worldwide reputation of the ROGER VIVIER trademark, the Respondent registered the disputed domain names with full knowledge of the Complainant's trademark in an intentionally designed way, with the aim to create a likelihood of confusion with the Complainant’s trademarks and domain names, and this is evidence of the fact that the disputed domain names were registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has used the disputed domain names to mirror the

Complainant’s own websites, so as to mislead users into believing that they are purchasing authentic ROGER VIVIER items, when they are not, a fact that -in combination with the incorporation of a famous trademark in a domain name - proves use in bad faith. The Complainant specifically claims that the Respondent has mainly sold counterfeit items of its ROGER VIVIER trademark through the disputed domain names´ websites.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain names in bad faith.

RESPONDENT

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).

The disputed domain names consist of the Complainant's whole trademark ROGER VIVIER or of abbreviations thereof such as RVIVIER or RV, in combination with descriptive or geographical terms (“online” or “Japan”). The addition of these specific descriptive or geographical words in the disputed domain names is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark of the Complainant. Such words actually reinforce the confusion, as they either relate to the online commercial activity of the Complainant or to its physical market presence in Japan.

As far as the gTLDs “.shop” and ".com" are concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy. Having said that, the gTLD “.shop” may reinforce the similarity in this case, as it invokes the extensive shopping character of the Complainant’s business.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the complainant to 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.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the ROGER VIVIER trademark in the disputed domain names, and that it had never licensed its trademarks to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain names in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain names.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has not filed any Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the seniority and reputation of the Complainant's trademark and the fact that the disputed domain names fully incorporate this trademark (even in combination with descriptive or geographical terms), it is quite evident that, at the respective times of the registrations of the disputed domain names, the Respondent was well aware of the Complainant's trademark. The registration as a domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain names correspond to commercial websites, which look like the Complainant's websites and, thus, may mislead the consumers into believing that they are buying original ROGER VIVIER products. This fact is to be combined with the full incorporation of the Complainant's reputable trademark in the disputed domain names. For this Panel, same as for many previous panels, such misleading behaviour clearly amounts to use in bad faith. Consequently, it is impossible to conceive any plausible active use of the disputed domain names that would be legitimate.

Further, from the evidence filed by the Complainant and not refuted by the Respondent, it seems that the Respondent has used the disputed domain names, in order to sell counterfeit goods of the Complainant's ROGER VIVIER trademark, by creating a likelihood of confusion with the latter, a fact that could disrupt Complainant's legitimate business.

Therefore, the Panel finds it clear that the disputed domain names were used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that the third requirement under the Policy is also satisfied.

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

The disputed domain names wholly incorporate the Complainant's trademark, written in combination with descriptive or geographical words. The disputed domain names are therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademarks in the disputed domain names, and the Complainant never licensed its trademark to the Respondent. The Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain names with full knowledge of the Complainant's reputable trademark. His use of the disputed domain names is in bad faith, as there is no conceivable use of the disputed domain names that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **rogervivieronline.shop**: Transferred
2. **rvivieronline.com**: Transferred
3. **rv-online.shop**: Transferred
4. **r-vivier.shop**: Transferred
5. **roger-vivier.shop**: Transferred
6. **rogervivierjapan.shop**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

2025-06-26

DATE OF PANEL DECISION 2023-06-20

Publish the Decision