Panel Decision for dispute CAC-ADREU-006590

Case number	CAC-ADREU-006590
Time of filing	2014-05-19 15:02:36
Domain names	liujooutlet.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	Liu.Jo S.p.A.

Respondent

Name	Martina Hamsikova

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

Decision of an Administrative Panel of WIPO Arbitration and Mediation Centre in case No. D2013-1261 regarding domain name <liujooutlet.com> delivered on September 9, 2013 involving the same parties and similar circumstances.

FACTUAL BACKGROUND

The Parties and the Disputed Domain Name

Complainant is an Italian company active in the business of manufacturing, marketing and selling high-end articles of clothing and accessories. Launched in 1995 in Carpi, near Modena, as a knitwear manufacturing company, nowadays the company is a luxury goods brand enjoying worldwide reputation.

Complainant's products can be found at flagship stores – more than 130 worldwide – and retail stores – more than 4,500 worldwide – as indicated in the Complainant's website www.liujo.com.

Complainant has sought to protect its rights in and to the trademark "Liu.Jo" and to maintain its exclusivity therein by obtaining, worldwide, more than 100 registrations for "Liu.Jo" and similar marks in more than 80 countries since the 1990s.

Complainant is the owner, inter alia, of Community Trademark Registration No. 000234351 "Liu.Jo", dating back to April 24, 1996 and covering goods in class 25 and Community Trademark Registration No. 000747923 "Liu.Jo", dating back to February 16, 1998 and covering goods in classes 9, 18 and 19.

Since 1997, Liu.Jo has owned registrations for several domain names comprising the mark "Liu.Jo" among which "liujo.it", "liujo.eu" and "liujo.com", whereon Complainant promotes its products bearing the trademark "Liu.Jo".

The disputed domain name <liujooutlet.eu> was created on February 25, 2013 and is registered by Respondent. Respondent is passively holding the disputed domain name.

Procedural History

On December 12, 2013, Complainant filed a Request to Change the Language of the ADR Proceedings from the Czech into English, pursuant to paragraph A3 (b) (1) of the ADR Rules.

On January 30, 2014, a Panel Decision was issued to change the language of the ADR Proceedings into English.

On February 10, 2014, the ADR Center issued Acknowledgement of Receipt of Complaint on 2014-02-10 (09:39:51). Time if Filing: 2013-12-16 (16:12:02).

On February 18, 2014, EURid's verification concerning the domain name LIUJOOUTLET.eu (case nr. 06590) was issued, Status: ON HOLD; Registered: February 25, 2013; Expired: February 28, 2014.

On February 19, 2014, ADR Center notified Complainant that the Respondent's address has had deficiencies.

On February 20, 2014, Complainant requested the Czech Arbitration Court to correct the entries regarding the respondent's address information as per the information provided by EURid.

On February 26, 2014, ADR proceedings formally commenced and Respondent was asked to submit a Response within working 30 days.

On March 5, 2014, the written notice of ADR Proceedings was delivered to Respondent by mail, receipt confirmed.

On April 7, 2014, ADR Center advised Respondent that the time to file Repondent's Response would expire on April 16, 2014.

On April 17, 2014, ADR Center issued a Notification of Respondent's Default.

On April 24, 2014, the ADR Center appointed Sylwester Pieckowski as a sole panelist and established a projected decision date on May 23, 2014 (Notification of Appointment of the ADR Panel and Projected Decision Date).

On May 19, 2014, EURid's advised that the current status of the domain name LIUJOOUTLET.eu is: QUARANTINE ON HOLD.

A. COMPLAINANT

Complainant considers the disputed domain name to be confusingly similar to trademarks and service marks in which it claims to have rights. Complainant further claims that Respondent has no rights or legitimate interests in respect of the disputed domain name. According to Complainant, Respondent has not used the disputed domain name in connection with a legitimate use. Also, according to Complainant, Respondent has not been commonly known by the disputed domain name. Complainant considers that the disputed domain name was registered and being used in bad faith.

B. RESPONDENT

Respondent did not reply to Complainant’s contentions.

DISCUSSION AND FINDINGS

GENERAL FINDING

The Panel concludes that Respondent did not file its Response to Complaint within due date of April 16, 2014, or after that date. Respondent is completely passive and does not respond to notifications of the ADR Center. Therefore, pursuant to Paragraph B (10) of the ADR Rules the Panel shall proceed to issue a Decision based upon the facts and evidence provided by the Complainant.

Having carefully reviewed the Complaint and attached exhibits the Panel finds that the Complaint is fully proven and justified.

SPECIFIC FINDINGS

Pursuant to Article 21, Speculative and abusive registrations of the Regulation (EC) No. 874/2004, for the Complainant in order to succeed it must prove that:

1. The disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law such as trademarks, trade names or service marks in which Complainant has rights or service mark in which Complainant has rights; and

2. Respondent has no rights or legitimate interests in respect of the disputed domain name;

or

3. The disputed domain name has been registered and is being used in bad faith.

The Panel will deal with each of these requirements in turn.

A. The domain name is identical or confusingly similar to a trademark in respect of which a right is recognized or established by the national law of a Member State and/or Community law

Respondent's "liujooutlet.eu" domain name is, obviously, confusingly similar to Complainant's "Liu.Jo" trademark. As a matter of fact, the domain name at issue only differentiates itself from Complainant's mark (a) for the format required of Internet domain names, i.e., the inclusion of the suffix .eu, and (b) for the descriptive component "outlet".

In this regard, the terms "Liu.Jo" and "Liujooutlet" are phonetically, graphically and conceptually similar since Complainant's mark is entirely comprised in Respondent's domain name as its initial part, and consumers tend to focus their attention on the initial part of a sign. In addition, "outlet" is a very common term, the meaning of which is easily understood even by consumers whose primary language is not English. Of course, the semantic content of the term "outlet" is totally descriptive, so that the differences between "Liu.Jo" and "Liujooutlet" are really negligible. Consequently, the addition of the suffix -outlet in the contested domain name and the presence of the .eu suffix are obviously not sufficient to differentiate Respondent's domain name from Complainant's "Liu.Jo" trademark.

Finally, in a case involving the same parties before a WIPO Panel (Case No. D2013-1261) regarding the domain name "liujooutlet.com", the Panel has clearly stated that "The Panel considers the disputed domain name <liujooutlet.com> to be composed of a name that is confusingly similar to the LIU.JO trademark and the non-distinctive generic term "outlet". The Panel is of the opinion that the mere addition of non-distinctive text to a complainant's trademark constitutes confusing similarity, as set out in paragraph 4(a)(i) of the Policy".

Accordingly, the Complainant has successfully established that the disputed domain name is identical or confusingly similar to a trademark in respect of which it has rights.

B. Respondent has no rights or legitimate interests in respect of the disputed domain name.

Respondent is not affiliated in any way with Complainant and, to the best of our knowledge, does not own any trademark applications or registrations for "Liujooutlet" or any similar marks in connection with any goods or services. This circumstance is confirmed by the results of a Saegis search.

Complainant has not licensed or otherwise authorized Respondent to use its "Liu.Jo" trademark, or to apply for any domain name incorporating such mark.

Respondent is not commonly known by the domain name and does not trade under the name "Liujooutlet" and does not make any legitimate commercial or non-commercial use thereof.

Complainant has been using its "Liu.Jo" trademark in commerce since long ago, and, as such, Complainant has established rights throughout the world in the "Liu.Jo" trademark.

Respondent chose a domain name which consists of Complainant's mark and of the descriptive term "outlet", thereby intentionally violating Complainant's rights.

Finally, Respondent did not reply to Complainant's arguments and decided not to take part in the ADR proceedings. This is a further indication of the absence of rights or legitimate interests in the disputed domain name.

Accordingly, Complainant has successfully established that the disputed domain name has been registered by Respondent without rights or legitimate interests in the name.

C. The disputed domain name has been registered and is being used in bad faith.

Respondent's bad faith in registering and using "liujooutlet.com" is evident for several reasons.

Since the contested domain name was created only a year ago, it is obvious that Respondent registered it with a view to take unfair

advantage of the reputation of the Complainant's mark "Liu.Jo". It is therefore evident that not only the use of the contested domain name is blatantly in bad faith, but also its registration considering the reputation enjoyed by the mark "Liu.Jo". In fact, when creating disputed domain name, Respondent knew or must have known that "Liu.Jo" is a well-known fashion brand.

Respondent's registration of "Liujooutlet.eu" obviously confuses potential customers as to Respondent's affiliation with Complainant since, it is absolutely plausible that, like all luxury brands, the Complainant has an outlet for its products.

Furthermore, Respondent's domain name discouraged Internet users from locating Complainant's true website, thereby diluting the value of Complainant's "Liu.Jo" trademark.

Currently, the website www.liujooutlet.eu appears to be in a clear state of passive holding.

The Respondent's bad faith is definitely proven by the fact that from the exchange of correspondence between Respondent and Complainant, it has come out that Respondent owns several domain names which correspond to well-known third parties' trademarks in the field of fashion including "calvinkleinoutlet.eu", "chaneloutlet.eu", "dioroutlet.eu"; all of these domain names are clearly registered with the only goal to be sold, which constitutes bad faith within the meaning of art. 21(3)(a) Regulation No 874/2004.

Also with regards to this profile, the WIPO Panel had no hesitation in establishing the bad faith of the Respondent for the very same arguments.

Accordingly, Complainant has successfully established that the disputed domain name has been registered or is being used in bad faith.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the ADR Rules, the Panel orders that the domain name LIUJOOUTLET be transferred to the Complainant.

PANELISTS

Name	Sylwester Pieckowski

DATE OF PANEL DECISION 2014-05-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: LIUJOOOUTLET

II. Country of the Complainant: Italy, country of the Respondent: Czech Republic.

III. Date of registration of the domain name: 25 February 2013

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. LIU.JO (figurative), trademark registered as a Community Trademark under No. 00023435 on August 17, 1999 in respect of goods in class 25.
2. LIU.JO (figurative), trademark registered as a Community Trademark under No. 000747923 on July 16, 1999 in respect of goods in classes 9, 18 and 19.

V. Response submitted: No.

VI. Domain name is identical or confusingly similar to the protected rights of the Complainant.

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No.
2. Why:

Respondent does not provide any evidence of rights or legitimate interest in disputed domain name. Complainant has provided evidence of a prima facie lack of rights or legitimate interest on the part of Respondent who did not challenge any of the Complainant's claims.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes.
2. Why:

Since the contested domain name was created only a year ago, it is obvious that Respondent registered it with a view to take unfair advantage of the reputation of the Complainant's mark "Liu.Jo". It is therefore evident that not only the use of the contested domain name is blatantly in bad faith, but also its registration considering the reputation enjoyed by the mark "Liu.Jo". In fact, it is indisputable that the Respondent is or should be perfectly aware of the fact that "Liu.Jo" is a well-known fashion brand.

Respondent's registration of "Liujooutlet.eu" obviously confuses potential customers as to Respondent's affiliation with Complainant since, it is absolutely plausible that, like all luxury brands, the Complainant has an outlet for its products.

Furthermore, Respondent's domain name discouraged Internet users from locating Complainant's true website, thereby diluting the value of Complainant's "Liu.Jo" trademark.

Currently, the website www.liujooutlet.eu appears to be in a clear state of passive holding.

The Respondent's bad faith is definitely proven by the fact that from the exchange of correspondence between Respondent and Complainant, it has come out that Respondent owns several domain names which correspond to well-known third parties' trademarks in the field of fashion including "calvinkleinoutlet.eu", "chaneloutlet.eu", "dioroutlet.eu"; all of these domain names are clearly registered with the only goal to be sold, which constitutes bad faith within the meaning of art. 21(3)(a) Regulation No 874/2004.

IX. Other substantial facts the Panel considers relevant: speculative, abusive, ill-motivated actions of Respondent.

X. Dispute Result: Transfer of the disputed domain name.

XI. Procedural factors the Panel considers relevant: Expiration of the disputed domain.

XII. Is transfer to Complainant] Is Complainant eligible? Yes