Panel Decision for dispute CAC-ADREU-006754

Case number	CAC-ADREU-006754
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Domain names	vanityfairlingerie.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	Vanity Fair, Inc

Respondent

Name	Liu Zhijun

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

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, a company specialising in the design, manufacture and marketing of apparel, in particular lingerie, is the proprietor of Community Trade Mark for „VANITY FAIR“ (no. 000161117 in class 25) and UK trade mark for „VANITY FAIR“ (no. UK00000064536 in class 25) („the Complainant’s Marks“). The Complainant's earliest Community Trade Mark registration for this mark is 1998 and its earliest UK registration for this mark is 1887.

Respondent has registered the domain VANITYFAIRLINGERIE.EU („the Domain Name“) on 21 November 2013.

The Complainant has submitted the complaint requesting transfer of the Domain Name. In the event that the transfer of the Domain cannot be granted, then the Complainant requests that the Domain Name be cancelled.

A. COMPLAINANT

The Complainant submits that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights – Paragraph B11(d)(1)(i) of the ADR Rules.

The Domain Name is in all material respects, identical to the Complainant's Marks as well as the Complainant’s pre-existing domain name vanityfairlingerie.com which was registered before August 1996. The Domain Name also includes the word „lingerie“, which is the main class of product sold by the Complainant under its brand VANITY FAIR. Members of the public will be confused as to the identity of the proprietor of the Domain Name because the Domain Name consists of the Complainant's distinctive trade mark VANITY FAIR. The trade mark is the only dominant element in the Domain Name. The public are therefore likely to be deceived into thinking that the Domain Name is owned by the Complainant, or one of its affiliated undertakings.

The Complainant contends that the Domain Name has been registered in bad faith – Paragraph B11(d)(1)(iii) of the ADR Rules.

The Respondent's pattern of behaviour is indicative of bad faith. The Respondent has registered a number of domain names which are confusingly similar to the trading names of large and successful corporations. The Complainant believes that the Respondent's sole objective in registering the Domain Name was to sell it for a substantial profit, and not to use it since the Domain Name has been for sale at $6,904. On 23 June 1014, the Complainant received an email from the purported owner of the Domain Name inviting the Complainant to make an offer to purchase the Domain Name. Furthermore, none of the domain names registered to the Respondent are connected to any sort of active websites and the vast majority have all been placed for sale. This shows a pattern of behaviour indicative

of bad faith registrations of domain names by the Respondent.

Furthermore, the Complainant has reasonable cause to believe that the Respondent has registered the Domain Name under a false name. The registered name of the Respondent "Liu Zhijun" is identical to that of the high profile Chinese politician that was recently toppled and sentenced to death following corruption allegations. The Complainant believes that it is unlikely that this is the Respondent's real name.

The Domain Name has been registered by the Respondent without rights or legitimate interest in the name – Paragraph B11(d)(1)(ii) of the ADR Rules.

The Respondent has no registered trade mark rights, European or otherwise in the name VANITY FAIR or VANITY FAIR LINGERIE. The Complainant believes that, save for the disputed Domain Name, the Respondent has no registered or unregistered rights in the name VANITY FAIR or VANITY FAIR LINGERIE. The Complainant has not been able to find any evidence that the Respondent is engaged in any lingerie business or is trading under the name Vanity Fair Lingerie – indeed even if the Respondent was engaged in such activities, they would be in breach of the Complainant's registered and unregistered rights in the name Vanity Fair.

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

In consideration of the Factual Background and the Parties' Contentions stated above, the Panel comes to the following conclusions:

Article 22 of the Regulation (EC) No. 874/2004 provides that an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21.

In accordance with Article 21 of the Regulation (EC) No. 874/2004, a registered domain name shall be subject to revocation where the name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or EU law and where:

(a) it has been registered by its holder without rights or legitimate interest in the name; or

(b) it has been registered or used in bad faith.

The Panel accepts that the Domain Name is, in material respect, identical to a name in respect of which the Complainant has rights recognised by national law of a member state and also by EU law by virtue of its Community Trade Mark and UK registrations for the name VANITY FAIR.

The Respondent has not filed a Response, and there is no evidence before the Panel of registration of the Domain Name in good faith or any legitimate interest of the Respondent in the Domain Name. According to Article 22(10) of the Regulation (EC) No. 874/2004, failure of any of the parties involved in an ADR proceeding to respond within the given deadlines may be considered grounds for accepting the claims of the other party. Further, Rule B10(a) of the ADR Rules states that in the event of a default, the Panel shall proceed to a decision and may consider the failure to comply as grounds to accept the claims of the other party. Under Rule B10(b) of the ADR Rules, unless otherwise provided, the Panel shall draw such inferences from a default as it considers appropriate. The Panel is obliged under Rule B11(a) of the ADR Rules to decide a Complaint on the basis of the statements and documents submitted and in accordance with the ADR Rules, the Supplemental ADR Rules and Regulations (EC) No. 733/2002 and No. 874/2004.

There is nothing on the face of the facts, statements and documents in this matter suggesting the Respondent has not registered the Domain Name in bad faith. There appears to be no use of the Domain Name other than the primary purpose to sell the same for profit. This is evident from the Respondent’s own lack of use of the Domain Name and offer to sell the Domain Name to the Complainant. Bad faith is also evidenced by the fact that the Respondent owns several other domain names which are identical or confusingly similar to third party trademarks, such as statoilhydro.co.uk, fluidradio.co.uk or haynes-fine-art.co.uk; all of these domain names appear to be registered with the primary goal of selling the same for profit to the respective right-holder, which constitutes bad faith within the meaning of Article 21(3)(a) Regulation No 874/2004. As the Respondent also appears to be acting under a false name, this further strengthens the conclusion that the Domain Name was registered in bad faith.

Once a Complainant makes out a prima facie case as to the existence of bad faith the burden of proof shifts to a Respondent. That

burden is obviously not discharged here and the Respondent has not come forward with any justification for his selection and registration of the disputed Domain Name.

In light of the Respondent's pattern of bad faith registrations of various domain names as well as the offer of sale of the Domain Name to the Complainant, and in the absence of a Response or any evidence disputing bad faith registration of the Domain Name by the Respondent, the Panel finds that the Respondent has registered the Domain Name in bad faith.

Because the Complainant needs to show either a lack of legitimate interests on the part of the Respondent or bad faith registration, and given the Panel's finding on bad faith set out above the Panel need not make a finding concerning lack of legitimate interests. In any case there is no evidence of the Respondent holding any rights or legitimate interest in the name VANITY FAIR.

Paragraph B11(b) of the ADR Rules states that if the complainant satisfies the general eligibility criteria (Article 4 (2) (b) of the Regulation (EC) No. 733/2002), the domain name may be transferred to the Complainant. Otherwise the remedies available shall be limited to the revocation of the disputed domain name.

General eligibility criteria in this case mean that the Complainant should be an undertaking having its registered office, central administration or principal place of business within the EU. However, the Complainant's registered office is in the USA, and there is no evidence of its central administration or principal place of business being in the EU. The fact that the Complainant's products are widely sold in the EU does not mean that the Complainant is established in the EU. Further, the fact that the Complainant's sister companies are established in the EU (in France and Spain, respectively) has no relevance as regards the Complainant's own eligibility since the sister companies are separate legal persons.

The Panel notes that panels in other ADR.eu proceedings have accepted joint complaints filed by non-EU right-holders and their EU subsidiaries or other related entities. Thus, if the transfer under a joint complaint was requested to the EU entity it would be granted. However, this is not the case here since the sister companies of the Complainant have not joined these proceedings as co-complainants.

In summary, although the Complainant has standing as a non-EU-entity in the current proceedings and the Panel finds in favour of the Complainant, it cannot request transfer of the disputed Domain Name but only revocation of the same.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name VANITYFAIRLINGERIE be revoked.

PANELISTS

Name	Triin Toomemets-Krasnitski

DATE OF PANEL DECISION 2014-10-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: VANITYFAIRLINGERIE.EU

II. Country of the Complainant: USA, country of the Respondent: SPAIN

III. Date of registration of the domain name: 21 November 2013

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word trademark VANITY FAIR, registered in United Kingdom, reg. No. UK00000064536, for the term 04 May 2019, filed on 04 May 1887, registered on 04 May 1887 in respect of goods and services in class 25
2. word CTM VANITY FAIR, reg. No. 000161117, for the term 01 April 2016, filed on 01 April 1996, registered on 08 October 1998 in respect of goods and services in class 25

V. Response submitted: No

VI. Domain name is identical 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: the Respondent holds no registered or unregistered rights in the name VANITY FAIR or VANITY FAIR LINGERIE. There is no evidence that the Respondent is engaged in any lingerie business or is trading under the name Vanity Fair Lingerie.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: the Complainant has made a prima facie showing that the Respondent had registered the domain name in bad faith (pattern of behaviour plus offer to sell the domain name to Complainant). As the Respondent did not dispute these assertions, the Panel accepted the Complainants' contention regarding bad faith registration.

IX. Other substantial facts the Panel considers relevant: N/A

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

XI. Procedural factors the Panel considers relevant: The Complainant had requested transfer of the disputed domain name by relying on the fact that its European headquarters are in Spain and France through its sister companies. However, since the sister companies are separate legal persons their establishment in the EU cannot cause the Complainant itself to be established in the EU in the meaning of Article 4 (2) (b) of the Regulation (EC) No 733/2002. Since the Complainant did not satisfy the general eligibility criteria, the Panel ordered that the disputed domain name be revoked.

XII. Is Complainant eligible? No.