Panel Decision for dispute CAC-ADREU-006886

Case number	CAC-ADREU-006886
Time of filing	2015-03-11 20:44:05
Domain names	OUTLET-PEUTEREY.EU

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Name	Rivano Leenen

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 legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

Peuterey Group S.p.A (hereinafter: the „Complainant") is an Italian legal entity active in the fashion business. The Complainant is the owner of several registered trademarks („Peuterey" and „Peuterey & device") in classes 3,9,18, 24,25.

• International trademark registration no. 646277 "PEUTEREY", granted on November 14, 1995 and duly renewed until November 14, 2015, in classes 24 and 25;
• International trademark registration no. 850742 "PEUTEREY & device", granted on May 9, 2005, in classes 3, 9 and 25;
• Community trademark registration no. 7088867 "PEUTEREY", filed on July 24, 2008 and granted on February 4, 2009, in class 18;
• Community trademark registration no. 9604448 "PEUTEREY & device", filed on December 16, 2010 and granted on April 26, 2011, in classes 3, 18 and 25.

The trademarks "PEUTEREY" and "PEUTEREY & device" are widely used by the Complainant to denote blazers, down jackets, coats, field jackets, knitwear, pants, dresses and relative accessories designed for man, woman and children.

"PEUTEREY" is the most successful Complainant's flagship brand (as well as its company name) and such trademark has become synonymous of design, innovation and quality for an elegant, yet relaxed style represented by contemporary "luxury casualwear" products.

Over the years, the above trademark registrations have become extremely well known in the worldwide fashion industry, thanks to the unquestionable high quality of the products bearing the brand "PEUTEREY".

The disputed domain name OUTLET-PEUTEREY.EU was registered on April 14, 2014, in the name of Rivano Leenen (hereinafter: the „Respondent") from the Netherlands.

The Respondent is passively holding the disputed domain name.

The Complainant's attorneys sent to the Respondent a cease and desist letter, asking for the voluntary transfer of the contested domain name to their client. Despite such communication, the Respondent never replied and the domain name at issue has not been disconnected from its current website.

A. COMPLAINANT

The Complainant's rights

The Complainant submitted evidence that „Peuterey" is registered as an international trademark (International trademark registration no. 850742 "PEUTEREY & device", granted on May 9, 2005, in classes 3, 9 and 25;) and community trademark (Community trademark registration no. 7088867 "PEUTEREY", filed on July 24, 2008 and granted on February 4, 2009, in class 18; Community trademark registration no. 9604448 "PEUTEREY & device", filed on December 16, 2010 and granted on April 26, 2011, in classes 3, 18 and 25.)

The Complainant submits that Peuterey Group S.p.A is also the owner of several domain names comprising the term „Peuterey", such as PEUTEREY.EU, PEUTEREY.COM, PEUTEREY.NET.

The Complainant states that the disputed domain name exactly reproduces the trademarks in which the Complainant has prior rights and it is also identical to the above mentioned domain names registered by Peuterey Group S.p.A. The only negligible difference is the addition of the descriptive term "Outlet", which may surely be ignored for the purpose of comparison. Such verbal portion, in fact, is not sufficient to prevent the disputed domain name from being confusingly similar to the trademark "PEUTEREY" and to the relative domain names registered by the Complainant.

Rights or legitimate interests of Respondent

According to the Complainant the Respondent has no rights or legitimate interests in respect of the disputed domain name. As the Complainant submitted, the Respondent has not used the disputed domain name in connection with a legitimate use. The Complainant submits that they have not licensed or otherwise authorized the Respondent to use the trademark.

The Complainant believes the Respondent has no rights on the domain name at issue, for the following reasons:
1) the contested domain name does not correspond to a trademark registered in the name of Rivano Leenen;
2) the Complainant has not licensed or otherwise authorized the Respondent to use the trademarks "PEUTEREY" and "PEUTEREY & device", nor to apply for any domain name incorporating such trademarks;
3) to the best of Complainant's knowledge, Rivano Leenen is not commonly known as "OUTLET-PEUTEREY".

The Complainant is confident the above circumstances are adequate to demonstrate that the Respondent has no rights or legitimate interests in respect of the disputed domain name, also considering the fact that the latter is currently used in connection with a website sponsoring counterfeited PEUTEREY products.

Bad faith

Furthermore the Complainant states that the disputed domain name has been registered and used in bad faith. In this regard, the Complainant submits that the Respondent was certainly aware of the existence and renown of the Trademarks considering that the same registered the Domain Name only recently and that the Trademarks, in fact, are currently used and widely known all around the world, even in the Netherlands (homeland of the Respondent) ; if the Respondent had researched the term "PEUTEREY" on Internet before registering the disputed domain name, through any search engine, he would inevitably have noted the existence of official website of the Complainant.

The Complainant referred to Paragraph B11(d)(1)(i) and Paragraph B11(d)(1)(i) of the ADR Rules, and several decisions of UDRP and .eu ADR practice.

B. RESPONDENT

The Respondent has failed to file a reply to the Complaint.

DISCUSSION AND FINDINGS

The Panel concludes that Respondent did not file its Response to Complaint. The 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.

According to Article 21(1) of the Commission Regulation (EC) 874/2004 and to Paragraph B11(d)(1) of the ADR Rules, the Complainant must show that: the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or EU law (point A below); and has been registered by its holder without rights or legitimate interest in the name (B); or has been registered or is being used in bad faith (C).

A. Identity or confusing similarity to the registered trademark owned by the Complainant

The Panel found out that the Complainant has provided evidence of being the exclusive licensee of the trademark registrations for PEUTEREY and PEUTEREY & device trademarks.

The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant's Trademark. The only difference (the term „OUTLET") is not sufficient to prevent the disputed domain name from being confusingly similar to the trademark "PEUTEREY" and to the relative domain names registered by the Complainant. The word „OUTLET" is a very common term, the meaning of which is easily understood even by consumers whose primary language is not English. Consequently, the addition of the prefix - 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 trademarks.

The first requirement of Article 21(1) of the Commission Regulation (EC) 874/2004 and of § B11(d)(1) of the ADR Rules is therefore met.

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

The Panel did not find any evidence or circumstances that may prove the Respondent having any rights or legitimate interests in the disputed domain name.

The contested domain name does not correspond to a trademark registered in the name of the Respondent.
The Respondent is not commonly known and does not trade under the name "OUTLET-PEUTEREY".

The Complainant has not licensed or otherwise authorized the Respondent to use the trademarks "PEUTEREY" and "PEUTEREY & device", nor to apply for any domain name incorporating such trademarks.

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

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

The Panel therefore concludes that the Domain Name was registered by the Respondent without rights or legitimate interest in accordance with Article 21(1) of the Commission Regulation (EC) 874/2004 and of § B11(d)(1) of the ADR Rules.

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

Respondent's bad faith in registering and using the disputed domain name is evident for several reasons.

Given the widespread and longstanding presence of the Complainants' trademarks and products both online, in several publications and with actual retail shops in many European countries, it is likely that the Respondent was aware of the Complainants' trademarks and other domain names registrations as well of the Complainants' business, and thus proceeded to registration in bad faith.

It is obvious that the Respondent registered the domain name with a view to take unfair advantage of the reputation of the Complainant's mark „Peuterey". 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.

Additionally, the Complainant tried unsuccessfully to contact the Respondent. The Respondent's failure to respond to the allegations of the Complainant is also an evidence of bad faith.

Furthermore, the website www.outlet-peuterey.eu appears to be in a clear state of passive holding.

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

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

Accordingly, the 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 Rules, the Panel orders that

the domain name OUTLET-PEUTEREY.EU be transferred to the Complainant

PANELISTS

Name	Dr. Erika Mayer

DATE OF PANEL DECISION 2015-03-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: OUTLET-PEUTEREY.EU

II. Country of the Complainant: Italy, country of the Respondent: Netherlands

III. Date of registration of the domain name: April 14, 2014

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. • International trademark registration no. 646277 "PEUTEREY", granted on November 14, 1995 and duly renewed until November 14, 2015, in classes 24 and 25;
2. • International trademark registration no. 850742 "PEUTEREY & device", granted on May 9, 2005, in classes 3, 9 and 25;
3. • Community trademark registration no. 7088867 "PEUTEREY", filed on July 24, 2008 and granted on February 4, 2009, in class 18;
4. • Community trademark registration no. 9604448 "PEUTEREY & device", filed on December 16, 2010 and granted on April 26, 2011, in classes 3, 18 and 25.

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right/s of the Complainant

The disputed domain name is confusingly similar to the Complainant's Trademark.

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: Respondent's registration of OUTLET-PEUTEREY.EU obviously confuses potential customers. The Respondent registered the domain name with a view to take unfair advantage of the reputation of the Complainant's well known registered trademark.

IX. Other substantial facts the Panel considers relevant: No

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: No

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