Panel Decision for dispute CAC-ADREU-006917

Case number	CAC-ADREU-006917
Time of filing	2015-04-30 13:57:39
Domain names	PEUTEREYDONNA.EU

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Organization	WdS

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") owns the following registered trademarks:

• 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 has become well known in the fashion industry,

The Respondent (WdS from Poland) registered the domain name PEUTEREYDONNA.EU on October 31, 2014 and, at the moment of this decision, is passively holding it; however, the Complainant has proved that the website contained at least an explicit and meaningful photo concerning a sexual intercourse, as well as several other references to sexual capabilities

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

A. COMPLAINANT

1. Infringement of the Complainant's trademarks.
The Complainant submits that the contested domain name fulfils the requirements set forth in paragraph B11 (d) (1) (i) of the ADR Rules, the domain name being identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law.
The Complainant further submits that the only negligible difference is the addition of the descriptive term "donna", which should be ignored for the purpose of comparison as it is not sufficient to prevent the disputed domain name from being confusingly similar to the trademark PEUTEREY.

2. The Respondent's legitimate rights or interests in the domain name.
The Complainant contends that, as set forth in Paragraph B11 (d) (1) (ii) of the ADR Rules, the domain name has been registered by the Respondent without rights or legitimate interest in the name.
The Complainant states that the following reasons indicate that the Respondent has no rights in the disputed domain name:
- the disputed domain name does not correspond to a trademark registered in the name of the Respondent;
- the Complainant has not licensed or otherwise authorized the Respondent to use the trademarks PEUTEREY and PEUTEREY + device; and
- to the best of the Complainant's knowledge, the Respondent is not commonly known as "PEUTEREYDONNA".

3. Bad faith
The Complainant contends that the Respondent was certainly aware of the existence and renown of the trademarks "PEUTEREY" and "PEUTEREY & device", considering that the above trademark registrations are currently used and widely known all around the world, even in Poland (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 the Complainant's official website.

The Complainant contends that the Respondent's registration of the disputed domain name represents a commercial exploitation of the PEUTEREY mark that causes a tarnishment of the same, consisting in its weakening through unsavory and unflattering connections with sexual stimulation products such as the one promoted in the website connected to PEUTEREYDONNA.EU.

B. RESPONDENT

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

DISCUSSION AND FINDINGS

The Respondent did not file its Response to Complaint neither 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); and 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 Complainant has provided evidence of being the exclusive owner of the trademarks "PEUTEREY" and "PEUTEREY & device".

The Panel therefore finds that the contested domain name is confusingly similar to the trademarks "PEUTEREY" and "PEUTEREY & device", in which the Complainant has rights. The only difference (the term „DONNA") does not 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 „DONNA" is a common term in Italian language which means "woman". Its meaning is easily understood even by consumers whose primary language is not Italian and suggests that the site deals with the woman fashion line of products of the Complainant. Consequently, the addition of the suffix - donna - in the contested domain name and the presence of the .eu suffix are insufficient to distinguish Respondent's domain name from Complainant's trademarks.

The first requirement of Article 21(1) of the Commission Regulation (EC) 874/2004 and of Paragraph 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 "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 “DONNA”, 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.

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 Complainant's trademarks and products on the international market, as well of other Complainant's domain names on Internet, it is unlikely that the Respondent was not aware of them when he proceeded to registration of the disputed domain name.

The Panel therefore finds 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 in bad faith, but also its registration considering the reputation enjoyed by the mark.

Furthermore, the Respondent’s registration of the disputed domain name represents a commercial exploitation of the PEUTEREY mark that causes a tarnishment of the same, consisting in its weakening through unsavory and unflattering connections with sexual stimulation products such as the one promoted in the website connected to PEUTEREYDONNA.EU.

Accordingly, the Complainant has successfully established that the disputed domain name has been registered and is being used in bad faith, in accordance with Paragraph B11(d)(1)(iii) of the ADR Rules.

DECISION

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

PANELISTS

Name	**Enzo Fogliani**

DATE OF PANEL DECISION 2015-04-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: PEUTEREYDONNA.EU

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

III. Date of registration of the domain name: October 31, 2014

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 registered as a Community Trade Mark, reg. No. 007088867, for the term PEUTEREY, filed on July 24, 2008, registered on February 4, 2009 in respect of goods and services in class 18;
2. Word trademark registered as an International Tradmark, reg. No. 646277, for the term PEUTEREY, registered on November 14, 1995 in respect of goods and services in classes 24 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 rights of the Complainant.

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: No rights or legitimate interest on the part of the Respondent are evident and no reply was filed by the Respondent.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The domain name is used to intentionally attract Internet users by creating a likelihood of confusion.

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: None

XII. Is Complainant eligible? Yes