Panel Decision for dispute CAC-ADREU-007043

Case number	CAC-ADREU-007043
Time of filing	2016-01-11 12:52:23
Domain names	hugobossdk.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	HUGO BOSS AG

Respondent

Name	Petrisor LUPU

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant HUGO BOSS AG is a member of the HUGO BOSS Group, which was founded in 1924 and is one of the market leaders in the premium and luxury segment of the global apparel market. Headquartered in Metzingen, Germany, the group generated net sales of EUR 2.4 billion in fiscal year 2013, making it one of the most profitable listed apparel manufacturers in the world.

The company HUGO BOSS Trade Mark Management GmbH & Co. KG, an affiliated company of the Complainant HUGO BOSS AG, owns inter alia the following trademark registrations:

- Community Trademark HUGO BOSS n° 000049254, registered in classes 3, 9, 10, 12, 14, 16, 18, 20, 24, 25, 27, 28, 29, 30, 31, 32, 35, and 42;
- Community Trademark HUGO BOSS n° 006645204, registered in class 16;
- International Trademark Registration HUGO BOSS n° 513257, designating more than 35 countries in classes 9, 14, 16, 18, 25, 28, 34; and
- International Trademark Registration HUGO BOSS n° 637658, designating more than 40 countries in classes 29, 30, 31, 32, 33.

The Complainant HUGO BOSS AG is the beneficiary of a royalty free and exclusive license entered into force on 27 July 2011 for the use of these trademarks. All the above mentioned trademarks predate the dispute domain name registered on 17 September 2014.

The Complainant also owns and operates websites at numerous domain names incorporating the HUGO BOSS mark, including <hugoboss.com> and <hugoboss.co.uk>, both registered prior to the disputed domain name.

A. COMPLAINANT

The Complainant contends that the “HUGO BOSS” trademarks, its company name “HUGO BOSS AG” and its business identifier pursuant to § 5 German Trademark Act “HUGO BOSS” are all confusingly similar to the disputed domain name.

The Complainant also contends that the Respondent has no rights or legitimate interest in respect of the disputed domain name.

Specifically, the Complainant contends that the Complainant has not licensed or otherwise authorized the Respondent to use the “HUGO BOSS” trademark or to apply for any domain name incorporating the trademark. The Respondent is not making a legitimate non-

commercial or fair use of the domain name, since the domain name is being used for a website where both the trademarks of the Complainant as well as the design of the Complainant's own website are being reproduced without permission. The Complainant presumes that the Respondent uses this illegally copied website design for online sales of counterfeited products bearing the HUGO BOSS brand.

The Complainant further contends that the domain name has been registered to create confusion and mislead the internet user into believing that the Complainant and the Respondent are affiliated, or that the Complainant endorses the website to which the Respondent's domain name <hugobossdk.eu> resolves.

Based on these arguments, the Complainant requests transfer of the disputed domain name to itself.

B. RESPONDENT

No formal Response has been received from Respondent.

The only communication received by the CAC in respect of the Complaint was an email delivered to the CAC on 8 October 2015, which reads in its relevant part:

"My name is Petrisor Lupu. I want to notice that I have no domain name HUGOBOSSDK.eu. My identity was stolen and the person who stolen my identity use my personal details to open domains. Please close all domains that are opened with my personal details. The case number of the ADR Proceeding is 07043."

DISCUSSION AND FINDINGS

1. Respondent's reply

The Respondent has failed to submit a formal Response to the Complaint. The Respondent's email which the CAC has received does not dispute any of the Complainant's contentions, but rather seems to imply the additional aspect that an unknown third party has abused the Respondent's name and address to register the disputed domain name.

In Accordance with Paragraph B10 of the ADR Rules the Panel considers it adequate to proceed to a decision as follows.

2. Merits of the case

According to Article 21(1) of Regulation (EC) No 874/2004 and Paragraph B11(d)(1) ADR Rules the Respondent's registration of the disputed domain name is considered abusive and speculative if

(i) the domain name is 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; and either

(ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) the domain name has been registered or is being used in bad faith.

The domain name "HUGOBOSSDK" is confusingly similar to both the "HUGO BOSS" trademarks and business identifier and to the Complainant's company name "HUGO BOSS AG". The additional elements "DK" on the one hand and "AG" on the other hand are both purely descriptive indications of the country of Denmark (with the ISO country code "DK") and a German stock corporation ("Aktiengesellschaft", commonly abbreviated as "AG"), respectively. Both designations are therefore dominated by the identical element "HUGO BOSS".

On the evidence made available to the Panel and given the email Response from the Respondent the Panel is convinced that the "real" Respondent (i.e. the person who has actually registered and uses the disputed domain name, irrespective of whether this person is Mr Petrisor Lupu himself or an unknown third party who has abused his identity) has both registered and uses the domain name in bad faith pursuant to Article 21(3)(d) of Regulation (EC) No 874/2004, Paragraph B11(f)(4) ADR Rules. It is evident that the disputed domain name is intentionally being used to attract Internet users, for commercial gain, to the website operated under <hugobossdk.eu>, by creating a likelihood of confusion with the Complainant's "HUGO BOSS" brand as to the source, sponsorship, affiliation or endorsement of the website and of the products offered via this website.

As the disputed domain name has been registered and is being used in bad faith the requirements of Article 21(1)(b) of Regulation (EC) No 874/2004 are met. The requirements of Article 21(1)(a) and (b) are alternative and not cumulative, so that it is not necessary to analyse whether the disputed domain name has also been registered without rights or legitimate interest in the name.

Finally, it should be noted that the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of the of Regulation (EC) No 733/2002; being an undertaking having its registered office or principal place of business within the EU.

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 HUGOBOSSDK.eu be transferred to the Complainant.

This decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction (see Paragraphs B12(a) and B14 of the ADR Rules).

PANELISTS

Name	**AMPERSAND Rechtsanwaelte LLP, Dr. Thomas Schafft**

DATE OF PANEL DECISION 2015-12-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: HUGOBOSSDK.eu

II. Country of the Complainant: Germany; country of the Respondent: Great Britain (UK)

III. Date of registration of the domain name: 17 September 2014

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

1. Numerous trademarks, inter alia CTM reg. No. 49254, for the term HUGO BOSS, filed on 1 April 1996, registered on 26 March 2008 in respect of goods and services in classes 3, 9, 10, 12, 14, 16, 18, 20, 24, 25, 27, 28, 29, 30, 31, 32, 35, and 42
2. Business identifier: HUGO BOSS
3. Company name: HUGO BOSS AG

V. Response submitted: No formal response, but an email delivered to the CAC on 8 October 2015

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):

Not analysed

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

1. Yes
2. Why: Intentionally used to attract Internet users, for commercial gain, by creating a likelihood of confusion (Art. 21(3)(d) Regulation (EC) No 874/2004)

IX. Other substantial facts the Panel considers relevant: Possibly false contact information (identity theft)

X. Dispute result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: None

XII. Is Complainant eligible? Yes