Panel Decision for dispute CAC-ADREU-007414

Case number	CAC-ADREU-007414
Time of filing	2017-05-04 18:17:56
Domain names	coccinellemilano.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization

Respondent

Name	Erika Gabler

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

The Complainant is an Italian fashion company established in Parma (Italy) since year 1978. The Complainant is a worldwide well-known brand for women bags and accessories and uses the COCCINELLE trademark to identify its products on the European and worldwide market. The Complainant has a network of mono-brand stores located in the principal European cities (London, Paris, Rome, Milan, Cologne and many more) and resells its products worldwide also by means of corners and shop in shops within some of the best international department; finally, the Complainant makes strongly use of its online shops, as shown in the Complainant's website at "www.coccinelle.com". At the time of filing, the official Complainant shop on line www.coccinelle.com has been visited more than 10 million times in last six years.
The Complainant owns more than 70 trademark registrations worldwide for the denominative trademark on the term "Coccinelle", as well as several domain names bearing the trademark "Coccinelle". For example:
Coccinelle International Trademark reg. No. 712798, registered on 02.02.1999 in respect of goods and services in classes 3,9,14,16,18,24,25,26
Coccinelle trademark registered in EU, reg. No. 000969626, registered on 15.02.2000 in respect of goods and services in classes 3,9,14,16,18,24,25,26

The disputed domain name was registered by the Respondent on 11th October 2016 without the Complainant's consent and at the time of filing the Complaint, the disputed domain name resolved to a website selling products which appears to be identical to Complainant's products.

The Complaint was filed on 19 January 2017. The Czech Arbitration Court acknowledged receipt of the Complaint and issued a Request for EURid Verification for the Domain Name on 25 January 2017. On the same day, EURid replied in a non-standard communication confirming that the Domain Name <coccinellemilano.eu> was registered with PDR Ltd., that the current Registrant of the Domain Name was the Respondent, that the Domain Name would remain locked during the pending ADR Proceeding and that the specific language of the registration agreement as used by the Registrant for the Domain Name was English. It also provided the full details from the WHOIS database for the registrant and registrar technical contacts.

Following an invitation to serve on the Panel in this dispute, the Panel accepted the mandate and submitted the Declaration of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the parties of the identity of the appointed Panel on 4 April 2017, in accordance with paragraph B4(e) of the .eu Alternative Dispute Resolution Rules ("ADR Rules").

A. COMPLAINANT

The Complainant contends that the disputed domain name is confusingly similar to its trade marks and domain names.
The Complainant alleges that the disputed domain name <coccinellemilano.eu> combines the word COCCINELLE, protected by the above-mentioned trademarks, with the word MILANO, which is not only the well-known Italian fashion capital, but even a location of one of its mono-brand stores. Consequently, the general public would associate the disputed domain name with the genuine products sold under the COCCINELLE trademark.
The Complainant affirms that the disputed domain name was registered by the Respondent without any rights or legitimate interests in the name, and that the Respondent was never authorized by the Complainant to register such domain, as it has never been granted a licence or other rights to use its trademarks as part of any domain name or for any other purpose. The Complainant clarifies that it is in no way associated or affiliated with the Respondent.

The Complainant affirms that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. The Complainant observes that the Respondent website offers for sale the Complainant's products, pretending to be a Complainant's official website (where there have never been connection between Complainant and Respondent).

In light of the above, the Complainant requests the Panel to order the revocation and cancellation of the disputed domain name.

B. RESPONDENT

The Respondent did not file a Response to the Complaint.

DISCUSSION AND FINDINGS

According to Article 10 (a) of the ADR Rules in the event that a Party does not comply with any of the time periods established by these ADR Rules or the Panel, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other Party. In addition according to Article 10 (b) of the ADR Rules unless provided differently in these ADR Rules, if a Party does not comply with any provision of, or requirement under, these ADR Rules, the Supplemental ADR Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

Based on the foregoing, the Panel draws from absence of response by the Respondent that the factual allegations by the Complainant are true.

In accordance with Article 21 (1) of the Commission Regulation (EC) No 874/2004 (as well as, in substance, Article 11 of the ADR Rules), the Complainant, in order to succeed, is required to prove that the disputed domain name:
(a) is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1); and
(b) has been registered by its holder without rights or legitimate interest in the name; or
(c) has been registered or is being used in bad faith.

The Panel observes that the Complainant has rights under various national laws in the COCCINELLE name in the form of national, European Union and International registered trademarks.

The Panel further confirms that the disputed domain name is confusingly similar to the Complainant trademarks, from which it differs only in the addition of the word "MILANO",
that refers to the city where the Complainant's has one of its more notorious flagship store, in the same country of Complainant's place of business.
Numerous UDRP panels have considered that the addition of generic or descriptive words, such as a geographical indication, to an otherwise distinctive or well-known trademark does not serve to distinguish the domain name from a complainant's trademark.
On this matter, the following WIPO Cases can be mentioned:
- WIPO Case No. D2001-0171, Koninklijke Philips Electronics NV v. Gopan P.K., for the domain name <philipsindia.net>;
- WIPO Case No. D2012-2123, Suncor Energy Inc. v. Whois Privacy Protection Service, Inc. / andre bechamp, for the domain names, inter alia, <suncorcalgary.com> and <suncorenergycanada.com>;
- WIPO Case No. D2012-2346, Fendi Adele S.r.l. v. PrivacyProtect.org / Liao Yani, for the domain name <fendiitalia.com>;
- WIPO Case No. D2013-2164, Guccio Gucci S.p.A. v. Lin Shi Jiang, for numerous domain names containing the word GUCCI together with other generic words referring to the fashion field;
- WIPO Case No. D2014-1582, IM Production v. Taylor Rafael, for the domain name <isabelmarantnewyork.com>;
- WIPO Case No. D2015-1206, Moncler S.p.A. v. guoqiang zhang, for the domain name <italiamoncleroutlet.com>.

The Panel also finds that by directing the domain name to his website the Respondent is misleading Internet users into believing that his website and business are endorsed by the Complainant, when they are not. The website fails to make it clear that the Respondent is not endorsed by the Complainant.
The Panel is satisfied that the disputed domain name has been registered and used in bad faith: not only it contains the Complainant's trademark together with one of the most representative cities of the Complainant's country of origin, but it also has been used for a website which divert traffic offering high discounts on the Complainant's products.
Even if the goods on the disputed domain name are not counterfeit, the Respondent's conduct in registering the disputed domain name and setting up the website using the trademark and images of the Complainant's goods, and offering for sale products under the trademark, all without the express authorization, approval of license of the Complainant, amounts to bad faith registration and use, irrespective of whether the goods offered for sale on the website are indeed counterfeit.
Accordingly, in accordance with Article 21(3)(d) of the Regulation, the Panel finds that the disputed domain name is being used by the Respondent 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 COCCINELLEMILANO.EU be revoked.

PANELISTS

Name	**Davide Luigi Petraz**

DATE OF PANEL DECISION 2017-05-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: coccinellemilano.eu

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

III. Date of registration of the domain name: 11 October 2016

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

The Complainant owns more than 70 trademark registrations worldwide for the denominative trademark on the term “Coccinelle”, as well as several domain names bearing the trademark “Coccinelle”. For example:
Coccinelle International Trademark reg. No. 712798, registered on 02.02.1999 in respect of goods and services in classes 3,9,14,16,18,24,25,26
Coccinelle trademark registered in EU, reg. No. 000969626, registered on 15.02.2000 in respect of goods and services in classes 3,9,14,16,18,24,25,26

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

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Disputed domain linked to a website which divert traffic offering high discounts on Complainant’s products. The website fails to make it clear that the Respondent is not endorsed by the Complainant.

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant: None