Panel Decision for dispute CAC-ADREU-007500

Case number	CAC-ADREU-007500
Time of filing	2017-10-11 22:32:06
Domain names	liujouomo.eu

Case administrator

	Aneta Jelenová (Case admin)

Complainant

Organization	Liu.Jo S.p.A.

Respondent

Name	Daniel bungert

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

To the knowledge of the Panel, there are no other legal proceedings pending or decided that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, Liu.Jo S.p.A., is an Italian company active in the business of manufacturing, marketing and selling high-end articles of clothing and accessories for women and men. The Complainant has always used the trademark “Liu.Jo” to identify its products on the market. The Complainant’s products can be found at flagship stores and retail stores (more than 5,300 worldwide), as indicated on the Complainant’s website www.liujo.com.

The trademark “Liu.Jo” is unique in that there are no other identical or similar marks or names which are registered or in use by third parties.

The Complainant has sought to protect its rights in and to the trademark “Liu.Jo” and to maintain its exclusivity therein by obtaining, worldwide, more than 150 registrations for “Liu.Jo” and similar marks in more than 80 countries since the 1990’s.

The Complainant is the owner of inter alia the following registered trademarks that it uses in connection to its business:

- EUTM No. 000234351 “Liu.Jo”, dating back to 22 April 1996 and covering goods in class 25;
- EUTM No. 000747923 “Liu.Jo”, dating back to 16 February 1998 and covering goods in classes 9, 18 and 19.

In addition, since 1997, the Complainant has been owning registrations for several domain names comprising the mark “Liu.Jo” among which “liujo.it”, "liujo.eu" and “liujo.com” for websites through which the Complainant promotes its products bearing the trademark “Liu.Jo”.

The Respondent’s name is Daniel Bungert. The Respondent holds the disputed domain name LUIJOUOMO.EU (the “Domain Name”) which was registered on 25 November 2016. The Domain Name directs to a webpage where articles of clothing and accessories for women and men under the Complainant’s trademarks appear to be offered for sale.

The Respondent did not reply to the Complainant’s contentions and did not comply with the CAC’s request to file a Response within the specified timelines, as required by the ADR Rules.

A. COMPLAINANT

The Complainant considers the Domain Name to be confusingly similar to several marks it holds in the “Liu.Jo” name. The Complainant

considers the Respondent not to have any rights or legitimate interest in the Domain Name and asserts that the Respondent registered and is using the Domain Name in bad faith.

B. RESPONDENT

The Respondent did not reply to the Complainant's contentions and did not comply with the CAC's request to file a Response within the specified timelines, as required by the ADR Rules.

DISCUSSION AND FINDINGS

The ADR Procedure relates to the domain name LUIJOUOMO.EU (the "Domain Name"). The Respondent registered the Domain Name on 25 November 2016 and is the holder of the Domain Name.

1. In accordance with Article 21.1 of the Regulation (EC) No 874/2004 (the "Regulation 874/2004"), it should be established whether the Domain Name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law (i.e., the rights mentioned in Article 10.1 of Regulation 874/2004).

The Complainant has sought to protect its rights in and to the trademark "Liu.Jo" and to maintain its exclusivity therein by obtaining, worldwide, more than 150 registrations for "Liu.Jo" and similar marks in more than 80 countries since the 1990's.

The Complainant is the owner of inter alia the following registered trademarks that it uses in connection to its business:

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In addition, since 1997, the Complainant has been owning registrations for several domain names comprising the mark "Liu.Jo" among which "liujo.it", "liujo.eu" and "liujo.com" for websites through which the Complainant promotes its products bearing the trademark "Liu.Jo".

The Domain Name is, obviously, confusingly similar to the Complainant's "Liu.Jo" trademark. The Domain Name only differentiates itself from the Complainant's mark: (a) for the format required of Internet domain names, i.e., the inclusion of the .eu suffix; and (b) for the descriptive component "uomo".

The terms "Liu.Jo" and "Liujouomo" are phonetically, graphically and conceptually similar since the Complainant's mark is entirely comprised in the Domain Name as its initial part. In addition, "uomo" is a common term, the meaning of which is easily understood even by consumers whose primary language is not Italian. The semantic content of the term "uomo" is totally descriptive, so that the differences between "Liu.Jo" and "Liujouomo" are neglectable. Moreover, the Complainant markets a man collection called "Liu.Jo Uomo" (see: http://www.liujouomo.it/). Consequently, the presence of the .eu suffix and the addition of the suffix -uomo to the Complainant's trademark "Liu.Jo" in the Domain Name are not sufficient to differentiate the Domain Name from Complainant's "Liu.Jo" trademark.

2. Further, the Panel needs to assess whether at least one of the other two elements of Article 21.1 of the Regulation 874/2004 are met. It should be established whether the Respondent registered the Domain Name without rights or legitimate interest in the name "Liu.Jo" or whether the Respondent registered or used the Domain Name in bad faith (Article 21.1 (a) and (b) of the Regulation 874/2004).

a) The Panel is of the opinion that it is significantly demonstrated that the Respondent registered the Domain Name without rights or legitimate interest in the Domain Name.

It appears that:

The Respondent is not affiliated in any way with the Complainant and appears not to own any trademark applications or registrations for "Liujouomo" or any similar marks in connection with any goods or services, as also confirmed inter alia by the results of a Saegis Custom Search (search run using the term "Liujouomo" and the Respondent's name).

In addition, the Complainant has not licensed or otherwise authorized the Respondent to use the Complainant's "Liu.Jo" trademark or to apply for any domain name incorporating such mark.

Moreover, the Respondent is not commonly known by the Domain Name and does not trade under the name "Liujouomo" and does not

make any legitimate commercial use thereof.

Lastly, the Complainant asserts that, to the best of its knowledge, the goods offered for sale on the Respondent's website hosted on the Domain Name, are counterfeit. The Complainant actually tried to purchase goods through the Respondent website but never received the products.

In this regard, as ascertained by WIPO case-law, "there can be no legitimate interest in the sale of counterfeits" (see Lilly ICOS LLC v. Dan Eccles, WIPO Case No. D2004-0750) and "the Respondent lacks any rights or interests in the disputed Domain Name" (see Prada S.A. v. Ping Zhou, WIPO Case No. D2011-2020).

The Complainant has been using its "Liu.Jo" trademark in commerce since long and, as such, Complainant has established rights throughout the world in the "Liu.Jo" trademark. The Respondent chose and registered the Domain Name which consists of the Complainant's mark and of the descriptive term "uomo", thereby intentionally violating the Complainant's rights.

b) The Panel is of the opinion that it is sufficiently demonstrated that the Respondent registered or used the Domain Name in bad faith.

First, the Respondent appears to offer for sale, through a website to which the Domain Name refers, counterfeit items of clothing bearing the Complainant's marks, with a clear intent for commercial gain (see, e.g., Prada S.A. v. Domains for Life, WIPO Case No. D2004-1019; and Farouk Systems, Inc. v. QYM QYM, WIPO Case No. D2009-1572). The Respondent appears to do so by using pictures taken from Liu.Jo's official advertising campaigns.

It seems obvious that the Respondent registered the Domain Name with a view to take unfair advantage of the reputation of the Complainant's mark "Liu.Jo". Not only the use of the Domain Name appears to be in bad faith, but also its registration. The Respondent's registration of the Domain Name may confuse potential customers as to the Respondent's affiliation with the Complainant since the Complainant markets a man collection called "Liu.Jo Uomo".

Furthermore, the Domain Name discourages Internet users and thus potential customers of the Complainant from locating the Complainant's true website, thereby diluting the value of the Complainant's "Liu.Jo" trademark.

3. The Complainant has requested the transfer of the Domain Name. According to Article 22.11 of the Regulation 874/2004, the Panel shall, in the case of a procedure against a domain name holder, decide that the Domain Name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, the Domain Name shall be transferred to the Complainant if the Complainant applies for this Domain Name and satisfies the general eligibility criteria set out in Article 4(2)(b) of the Regulation (EC) No 733/2002.

To satisfy those general eligibility criteria the Complainant must be one of the following:

1. an undertaking having its registered office, central administration or principal place of business within the European Community; or
2. an organisation established within the European Community without prejudice to the application of national law; or
3. a natural person resident within the European Community.

In this case, the Complainant is an undertaking with registered offices within the Community. As a result the Complainant satisfies the eligibility criteria. The Panel may order to transfer to this Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name LUIJOUOMO.EU be transferred to the Complainant within thirty calendar days of the notification of the decision to the Complainant and to the Respondent, unless the Respondent initiates court proceedings in a mutual jurisdiction as meant in Paragraph B 12 (a) of the ADR Rules.

PANELISTS

Name	Bart G. GODDYN

DATE OF PANEL DECISION 2017-10-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: LUIJOUOMO.EU

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

III. Date of registration of the domain name: 25 November 2016

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
- EUTM No. 000234351 “Liu.Jo”, dating back to 22 April 1996 and covering goods in class 25;
- EUTM No. 000747923 “Liu.Jo”, dating back to 16 February 1998 and covering goods in classes 9, 18 and 19;
- company name of the Complainant, Liu.Jo S.p.A.;
- other domain names owned by the Complainant.

V. Response submitted: No

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

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No rights or legitimate interests
2. Why: the Respondent is not affiliated with the Complainant, has no license, is not commonly known by the domain name, does not trade under it and does not make any legitimate use thereof.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: offer for sale of counterfeit items bearing the Complainant’s marks, through the website to which the domain name refers. Registration and use in bad faith to take unfair advantage of the reputation of the Complainant's mark.

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