Panel Decision for dispute CAC-ADREU-004316

Case number	CAC-ADREU-004316
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Domain names	prada.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	PRADA S.A.

Respondent

Organization / Name	Maurizio Lussetti

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

Procedural History

The disputed domain name was the subject matter of Case No. 02928 (the first ADR). In that case, Complainant, Dr. Massimo Introvigne, filed a complaint alleging, interalia, the same allegations in the within proceeding. The first ADR proceeding was decided in favour of Respondent for the following reasons: 1) «Absence of Complainant's interest to the disputed domain name» and 2) «uncertainty as to the identity of the Prada group company on whose behalf Complainant is acting». Consequently, the first ADR never reached the substantive arguments of the parties.

Preliminary Issue

Regarding Respondent's arguments that a) no legal system permits to repeat two times the same lawsuit and b) that« Absolutely nothing has changed from the previous ADR, nothing new that allows a new ADR». The Panel notes that this is not true. In fact, the parties are different from those in the first ADR. Specifically, the Complainant in the present proceeding is a different legal entity.

Indeed, the main reason that led to the rejection of the previous complaint was Mr. Introvigne's lack of standing or other demonstrable rights to the PRADA name. It is, however, undisputable that Prada S.A., has valid rights to the PRADA name and trademarks.

The present Complaint was filed by Prada S.A., which has duly authorized Dr. Massimo Introvigne to act as its legal representative.

In view of the above, the Panel sees no impediment to proceed with a decision on the merits of the complaint.

FACTUAL BACKGROUND

Prada S.A. is the holding company of the Prada group (whose main manufacturing plants are located in Italy) and the owner of a number of trademarks PRADA on a global scale. Copies of these trademarks, including European Community Trademark 271163, are enclosed with the complaint. PRADA is one of the most renowned trademarks in the world in the fashion field.

The PRADA trademarks, the oldest of which date back to 1983, were originally owned by the Italian company, Prada S.p.A., and were subsequently transferred to the Luxembourg company, Prada S.A., the Complainant in this case.

The domain name prada.eu was registered by Mr. Lussetti, an Italian national, on July 11, 2006.

A. COMPLAINANT

The domain name prada.eu is identical to Complainant's PRADA trademarks.

Respondent is an Italian national who could not conceivably be unaware of the fame of PRADA both offline and on the Internet.

Respondent registered and is using the disputed domain name in bad faith.

Respondent has no valid trademark rights to the PRADA name. Respondent has never been and is not currently commonly known by the domain name and is not making a legitimate non-commercial or fair use of it.

Mr. Lussetti has never been and is not currently known for any association with PRADA or use of PRADA in the legitimate course of usual commerce, and does not appear to have a legitimate interest in or to the domain name.

There is no evidence of Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

The disputed domain name is used in bad faith, since Internet users who access www.prada.eu looking for information about PRADA products were originally, and for several months, offered php software which has no affiliation with Prada S.A.

The use of the domain name was for profit and cannot be justified as non-commercial fair use.

Following the Panel's decision in ADR Case no. 02928, Respondent not only claimed "damages" from Prada and Dr. Massimo Introvigne, but changed the website prada.eu, no doubt expecting a further challenge on the substance of the matter, into one celebrating his "victory" in the ADR proceedings.

Respondent changed its website by making it look like a website containing information about the town of Prades del Conflent (a French town in the Pyrénées mountains). Essentially, he copied content from other websites with some information and links about Prades. The website, www.prada.eu, now claims that "PRADA fashion company wants this Prada del Conflent Web site!!!" and seeks to convey the impression to the viewer that in the first ADR (Case no. 02928) the Complaint was rejected because of the "Prada del Conflent" connection.

Respondent's attempts, while creative, are nevertheless misguided. Respondent does not have any connection with the town of Prades, but he is clearly engaged in a cat-and-mouse game with Prada S.A. The prize in this game is, presumably, to compel Prada S.A. to settle at Respondent's preferred terms.

B. RESPONDENT

Respondent submissions are as follows:

The Respondent registered the domain name on 11 July 2006. The previous complaint was filed on 30 August 2006.

During the month and a half between registration of the domain name and the filing of the first complaint, the Respondent made a demonstrated preparation to use (see annex "Website www.prada.eu.pdf" provided by Complainant) despite the summer holidays.

The previous ADR terminated on 13 February 2007. On 19 March 2007 the Complainant filed a second complaint, with essentially the same arguments rejected in the first ADR. Respondent acknowledges that no legal system permits a party to file the same lawsuit more than once. This alone would suffice to reject the complaint.

The Complainant alleged that the Respondent has changed the website after 13 February 2007 but in the annex "Default page prada eu.pdf", provided by the Complainant, it is clearly visible the date when it was made, "27 October 2006", unequivocally/unmistakably that at that date the website was working perfectly in its present form. In the previous ADR, the Respondent did not mention that the website was changed because, in his opinion, this fact wasn't legally important.

This is a conclusion that existed a second demonstrated preparation for use of the domain name, the creation of a dynamic website with the Drupal Content Management System, different from the one used previously. It contains tourist information, data for those who live in the area, a downloadable map of the area, various meteorological information that is regularly updated, news, local events and much more.

The annex "Default page prada eu.pdf" submitted by the Complainant does not show the home page of the website, but rather one

banner notice appearing on the home page. That notice serves to inform people, associations, companies and public bodies that would be interested in participating in this project or otherwise contribute to the website, about the pending dispute.

The Respondent denies Complainant's allegations that he has "for several months, offered php software". First, because the time frame was barely two months and not "several months". Second, it asserts, it's impossible to sell something that its developer/producer makes available for free.

Regarding his own good faith, Respondent points out that in Italy there are at least 750.000 trademarks, consequentely nobody can remember every trademark. Respondent then argues that only a small portion of the population is interested in expensive female fashion and/or know, care or would be inclined to remember the trademark of the Complainant.

In response to Complainant's argument affirming the intention of the Respondent to sell the domain name to Prada S.A., Respondent offers that Complainant is mistaken. Assuming arguendo, that Complainant's hypothesis were valid, Respondent argues that given its current financial condition, Prada S.A., simply could not afford to purchase the disputed domain name.

In a similar way, Respondent seeks to undermine the assumption that he was attempting to sell the domain name to the Complainant. In this regard, Respondent offers that the fact that Complainant already owns many domains, such as www.prada.com, www.prada.net, www.prada.org, www.prada.info, www.prada.biz, www.prada.mobi, www.prada.it, www.pradaboutique.com, www.pradaboutique.net. Respondent suggests that, given these existing domain names, it's clear that Prada S.A. does not need the .eu one. Furthermore, Respondent argues Complainant is not in any way forced to buy the .eu domain, does not need a monopoly and does not have any legal right to a total monopoly over "PRADA".

Respondent requests a dismissal of the complaint and a finding that the complaint was filed in bad faith.

DISCUSSION AND FINDINGS

According to Article 22(11) of Commission Regulation (EC) 874/2004, the Panel must determine whether the registration of the disputed domain name is speculative or abusive as defined in Article 21 of that Regulation.

The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event the Complainant proves that:
1) The domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and /or Community law" and; either
2) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or
3) The domain name has been registered or is being used in bad faith.

Complainant has demonstrated to have valid trademark rights on the name PRADA which is identical to the disputed domain name. Accordingly, the Panel finds that the first requirement of the definition of speculative or abusive registration is satisfied.

Regarding the question of whether the Respondent has a legitimate interest in the domain name, Article 21(2) of Regulation 874/2004 states that "a legitimate interest within the meaning of the rules may be demonstrated where:

a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparations to do so;
b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law;
c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.

These circumstances are not exhaustive.

It is the Panel's opinion that Complainant has established prima facie that Respondent does not meet any of the above requirements. Furthermore, Respondent has not overcome Complainant's proofs nor has he proven to have any right or legitimate interest to the domain name for purposes of Paragraph B11(d)(1)(ii) of the Rules. While the Panel agrees with Respondent that it is practically impossible to know every Italian registered trademark, due to the undisputable fame of the PRADA name, Respondent's assertion that he was not aware of its existence is not credible. As well explained by the Panel in Modern Times Group (MTG) AB v. Stefan Häge, Kriströms Advokatbyrå AB WIPO Case No. DTV2000-0004 (domain name everyday.tv), "In these days when "cybersquatting" has become an important issue it falls naturally to assume that a purchaser of a domain name takes adequate actions in order to avoid a violation of

another persons trademark rights" and "One must assume that a company that decides to register a domain name with the intention of making real use of the domain name in its business activities on the Internet must have checked if the domain name in question is available for registration in the gTLD's at least. If there are competitors that use a similar domain name or if the domain name is registered in other TLD, it is reasonable to take precautions in order to avoid confusion or trademark infringement, at least if there is a bona fide intention to offer goods and services under the domain name".

Respondent has not provided any explanation regarding his choice of the name PRADA for the disputed domain name that was initialy used to publish information about the RavenNuke76. Indeed, Respondent in his response to the Complaint in ADR 02928 (which was incorporated as a part of Respondent's response to the present complaint), argued that the RavenNuke76 contents displayed on the default page for the web site www.prada.eu, was "the screen of the very famous PhpNuke, a Content Management System" and that "It shows like every newly installed software, the logo of the developer and links to ravenphpscripts.com". Namely Respondent explained that he was not linked to and that the RavenNuke76 contents were not his own. Respondent also affirms that he was not making any offer of goods or services since his web site was still in the development phases. In order to demonstrate that he made demonstrable preparations to use the domain name in connection with the offering of goods or services prior to receiving notice of an ADR, Respondent submits that «it has been experienced the use of a Content Management System, which is a complex server-database-browser interface». While, Respondent gave abundant and specific information about the PhpNuke and the RavenNuke softwares, he did not proffer any evidence or otherwise explain what kind of content would have been displayed on his intended website www.prada.eu. Nor did he provide any information regarding the future use of the domain name and why he chose the name PRADA. In fact, in his response to the first complaint, Respondent never mentioned the town of Prada /Prades and/or his intention to develop a web site about this town. This Panel thus finds that Respondent has not demonstrated to have used the domain name in connection with the offering of goods or services or to have made a credible showing of demonstrable preparation to do so prior to any notice of the dispute.

Respondent has made a great effort in order to contest the fame of the trademark PRADA and to discredit both PRADA S.A. and Mr. Introvigne. Nevertheless, using Respondent's own standards to judge about the fame of a name, i.e. Google entries, the Panel notes; the PRADA trademark which reaches now about 39 million entries is much more renowned than trademarks like ARMANI (27 million) and Louis Vuitton (15 million). It is disingenuous, at best, for Respondent to argue that PRADA (between 40 and 50 million entries at the time of Respondent's response) is not a renowned trademark, while, at the same time, describes the PhpNuke software as "very" famous (13 million entries) and RavenNuke76 as "famous" (raven + nuke about 650.000 entries and RavenNuke76 only 25.000 entries).

Respondent has not provided any evidence to prove any right or legitimate interest on the domain name prada.eu within the meaning of the Rules.

On the contrary, the Panel agrees with Complainant's assertion that Respondent changed its Web site by making it to look like a Web site for the town of Prades ex post facto (ADR 02928) as a mere defensive move for countering further action by Prada S.A.

The only reasonable inference to be made regarding Respondent's changes to its website is that same were made after Complainant filed the first complaint.

The actual use of the domain name prada.eu and of the related web site, cannot be considered a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law. On the contrary, Respondent published on the web site prada.eu the following sentences: «PRADA fashion company wants this Prada del Conflent Web site», «Notice that EURID the registry of .eu REJECTED the demand of PRADA fashion of 07-12-2005» and «5 years ago PRADA fashion maked 3 attempts to be quoted in the stock exchange (IPO): 3 times failed and never try again.», giving the impression that in Case no. 02928 the Complaint was rejected because of the "Prada del Conflent" connection. Prior attempts to register the disputed domain name prada.eu in the name of PRADA S.A. were rejected due to a lack of rights on the name PRADA and finally that PRADA has economic troubles. This is not a fair or a bona fide use of the domain name.

DECISION

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

PANELISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2007-05-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

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Regarding Respondent's arguments that a) no legal system permits to repeat two times the same lawsuit and b) that« Absolutely nothing has changed from the previous ADR, nothing new that allows a new ADR». The Panel notes that this is not true. In fact, the parties are different from those in the first ADR. Specifically, the Complainant in the present proceeding is a different legal entity.

The present Complaint was filed by PRADA S.A., which has duly authorized Dr. Massimo Introvigne to act as its legal representative.

Prada S.A. is the holding company of the Prada group and the owner of a number of trademarks PRADA on a global scale. PRADA is one of the most renowned trademarks in the world in the fashion field.

The domain name prada.eu was registered by Mr. Lussetti, an Italian national, on July 11, 2006.

Complainant has demonstrated to have valid trademark rights on the name PRADA which is identical to the disputed domain name. Accordingly, the Panel finds that the first requirement of the definition of speculative or abusive registration is satisfied.

Respondent has not provided any evidence to prove any right or legitimate interest on the domain name prada.eu within the meaning of the Rules.

The actual use of the domain name prada.eu and of the related web site, cannot be considered a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.

For all the foregoing reasons, in accordance with the Rules, the Panel orders that the domain name PRADA.EU be transferred to Complainant.