

Decision for dispute CAC-UDRP-103692

Case number	CAC-UDRP-103692
Time of filing	2021-04-29 09:57:35
Domain names	rogervivier-paris.com, rogervivierparis.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	ROGER VIVIER S.P.A.
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Complainant representative

Organization	Convey srl
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Respondent

Name	Wang junshan
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant, Roger Vivier S.p.A. is a company with headquarters in Sant'Elpidio al Mare, FM (ITALY). Roger Vivier S.p.A. is known around the world as one of most prominent high-end fashion and luxury industry.

The first boutique of the brand was established in Paris, France, in 1937 by a young French fashion designer Monsieur Roger Henri Vivier (13 November 1903 - 3 October 1998) who specialized in shoes. Worldwide, he is known as the "Fabergé of footwear" or the "Fragonard of The Shoe".

On August 29th, 1968 the figurative mark "Roger Vivier Boutique" was given worldwide trademark protection through numerous national and international trademark registrations. Currently the company actively designs a wide range of luxury products such as shoes, bags and women accessories distributed all around the world via the official website and through more than 60 prestigious Boutiques. As of 2018 the company released a worldwide turnover of 179 million €.

Now, Roger Vivier S.p.A. is the owner of various trademark registrations:

- the International trademark n° 348577 for the figurative mark "Roger Vivier Boutique" (registered on 1968-08-29) designating goods in classes 3, 18, 21, 25;

- the International trademark extended in China n° 590402 for the figurative mark “ROGER VIVIER” (registered on 1992-08-05) designating goods in classes 3, 9, 14, 15, 18, 20, 21, 24, 25, 26, 34, 42;
- the European Union trademark n° 006349138 for the word mark “Roger Vivier” (registered on 2008-10-17) designating goods in classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 26, 34, 35, 42;
- the International trademark n° 1022702 for the figurative mark “RV Roger Vivier” (registered on 2009-08-20) designating goods in classes 3, 9, 14, 16, 18, 24, 25, 35;
- the International trademark extended in China n° 1120203 for the word mark “VIVIER” (registered on 2012-05-14) designating goods in classes 9, 14;

Furthermore, the Complainant has been extensively using the “ROGER VIVIER” denomination on all internet environments including and not limited to the company’s official websites – among which are “www.rogervivier.com”, “rogervivier.net”, “rogervivier.org”, “rogervivier.info”, “rogervivier.biz”, “rogervivier.it” and its official accounts on the major social networks such as Facebook, Instagram and Twitter.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

In light of the Respondent’s registration in 2014 and use of the disputed domain names, confusingly similar to its registered and well-known trademark ROGER VIVIER, the Complainant instructed its representative to address to the Respondent a cease and desist letter in order to notify them of the infringement of the Complainant’s trademark rights, requesting the immediate cease of any use, and the transfer, of the disputed domain names to the Complainant.

The cease and desist letter was therefore sent on February 19, 2021 to the domain names’ owner’s known email addresses indicated at that time in the website and in the whois records retrieved in the whois history database. The domain name owners did not deem appropriate to answer.

In light of the absence of a reply and the failure to comply with the request for transfer of the disputed domain names, the Complainant instructed its representative to file the present Complaint in order to obtain the transfer of the disputed domain names under its ownership and control.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

Request for Change of Languages:

The Complainant requests that the language of this administrative proceeding be English pursuant to UDRP Rule 11(a): Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative

proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. Complainant makes this request in light of the potential Chinese language Registration Agreement of the disputed domain names involved in this Complaint.

Paragraph 10 of the UDRP Rules vests a Panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. UDRP Panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios were summarized into WIPO Jurisprudential Overview 3.0, 4.5.1. In this particular instance, the Complainant tried to request a change of languages of proceedings in light of the Chinese language Registration Agreement by showing that 1) disputed domain names <rogervivierparis.com> and <rogervivier-paris> are formed in Latin characters and the Roger Vivier trademark is a well-known international trademark; 2) websites corresponding to the domain names are in English; 3) conducting the proceeding in languages other than Chinese would entail significant additional costs for the Complainant and unnecessarily burden the Complainant. Relevant decisions have been cited to support the Complainant's positions.

In light of the scenarios and equity, the Panel is of the view that conducting the proceeding in English is unlikely to heavily burden the Respondent, and it is likely that the Respondent can understand the English language based on a preponderance of evidence test. Without further objection from the Respondent on the issue, the Panel will proceed to issue the decision in English.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or confusingly similar

The Complainant contends that the disputed domain names <www.rogervivierparis.com> and <rogervivier-paris.com> are confusingly similar to the Complaint's trademark and its company name

"Roger Vivier". The Complainant, Roger Vivier S.p.A. is a company with headquarters in Sant'Elpidio al Mare, Italy. Roger Vivier S.p.A. is known as one prominent high-end fashion and luxury industry. Now, Roger Vivier S.p.A. is the owner of various trademark registrations such as the figurative mark "Roger Vivier Boutique" and the European Union trademark for the word mark "Roger Vivier", among others. Furthermore, the Complainant has been extensively using the "Roger Vivier" denomination on all internet environments including and not limited to the company's official websites – among which are "www.rogervivier.com", "rogervivier.net", "rogervivier.org", "rogervivier.info", "rogervivier.biz", "rogervivier.it"

In this case, the disputed domain name incorporates the whole of the Complainant's trademark Roger Vivier and the generic top level domain ".com" does not affect the confusing similarity. It should be also noted that the added geographical indicators ("paris" and "-paris") encompassed in the disputed domain name has special meaning, and is more apt to induce confusion among Internet users or to attract internet users based on the Complainant's trademark and for commercial gains. The Panel therefore concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in the present case has not licensed or authorized the Respondent to register or use the disputed domain name. There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks including the terms "Roger Vivier" and/or "Roger Vivier-Paris".

In this case, because the Respondent has used a proxy service in registering the disputed domain name, additional information of the Respondent needed to be discovered. The uncovered identity of the registrant, an individual/entity named "Wang junshan" seems to have no connection with the Complainants' brand. The Complainant contends that no evidence suggests that the Respondent has been known in any way by the disputed domain names. The Complainant did not grant any license or authorization to the Respondent to register or use the disputed domain name, nor the use of the Complainant's trademark on every page of the disputed website. Before the dispute, the Respondent also has not used the disputed domain names or a name corresponding to the disputed domain names in connection with a bona fide offering of goods or services.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

Registration of the disputed domain names in bad faith - as far as registration goes, UDRP panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Complainant's first boutique brand was established as early as 1937 and the Roger Vivier brand is internationally well-known in the fashion industry. It used the trademark exclusively in the Chinese market as early as 1992 (where the Respondent appears to be based). The fact that the Respondent has registered a domain name long after (in 2014) the Complainant's trademark became known, implied that the Respondent may have had knowledge of the Complainant's trademark at the time of registration of the disputed domain names. The Complainant's brand "Roger Vivier" is not a common English term and a simple Google search reveals all results and references related to the Complainant's brand. Therefore, it is reasonable to conclude that the Respondent registered the disputed domain name with the knowledge of the Complainant's trademark and/or brand influence. In addition, the Respondent choose to register the disputed domain name to create a confusion with the Roger Vivier brand and products.

Use of the disputed domain name in bad faith – currently, the disputed domain names linked to websites selling fashion products including products of the Complainant's (Roger Vivier products). The use of the disputed domain names in connection with a commercial web site where the Complainant's trademark is misappropriated and counterfeit Roger Vivier branded shoes and accessories are offered for sale, these were evidence that the Respondent's purpose in registering the disputed domain names was partly to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking Roger Vivier products to his website for financial gain. According to paragraph 4(b)(iv) of the Policy, "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location", if found by the Panel, shall be considered evidence of registration and use of the domain name in bad faith.

In addition, Respondent offers for sale the Complainant's products on the websites for values disproportionately below the market value, giving rise to a prima facie claim that the products sold on those websites are counterfeits. Such conduct constitutes further evidence that the items offered for sale on the registrant's website are possibly counterfeited and that the disputed domain names have been registered and used in bad faith.

Moreover, a cease and desist letter was sent to the Respondent on February 19, 2021 and the Respondent never responded. Prior panels have also held that a failure to respond to a cease and desist letter can be evidence of bad faith (see e.g., HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062).

Therefore, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the Complainants has provided sufficient evidence that the disputed domain names were registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ROGERVIVIER-PARIS.COM**: Transferred
2. **ROGERVIVIERPARIS.COM**: Transferred

PANELLISTS

Name	Carrie Shang
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DATE OF PANEL DECISION	2021-07-05
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Publish the Decision
