

Decision for dispute CAC-UDRP-104618

Case number	CAC-UDRP-104618
Time of filing	2022-06-02 10:05:42
Domain names	FABRICLOROPIANA.COM

Case administrator

Name	Iveta Špiclová (Case admin)
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Complainant

Organization	Loro Piana S.p.A.
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Complainant representative

Organization	Andrea Mascetti (Barzanò & Zanardo Milano S.p.A.)
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Respondent

Organization	DOMAIN IS FOR SALE AT WWW.DYNADOT.COM ---- c/o Dynadot
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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 owns a portfolio comprising more than 700 trade mark registrations worldwide, consisting of or containing the name LORO PIANA. The Complainant's trade mark registrations include the international device trade mark registration No 1546962 LORO PIANA, designating the US, first registered on 22 May 2020 in international class 25; and the EU device trade mark registration No 7383136, first registered on 11 November 2008 in international classes 9, 14, and 35. These trade mark registrations predate the registration of the disputed domain name.

The Complainant also owns the EU device trade mark application No 018681412 FABRIC LORO PIANA, filed on 4 April 2022 in international classes 24 and 25. The date of the Complainant's trade mark application is the same date on which the disputed domain name was registered.

Furthermore, the Complainant owns a portfolio of more than 300 domain names consisting of or comprising the name LORO PIANA in many ccTLDs and available gTLDs, which connect to the Complainant's official websites.

FACTUAL BACKGROUND

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

The Complainant, Loro Piana S.p.A, is one of the largest suppliers worldwide of cashmere and luxury woolens. It was established in 1924 by Pietro Loro Piana at Corso Rolandi, in Quaronna (VC), which remains the Group's headquarters to the present day.

The Complainant is active worldwide with more than 170 flagship stores located in Europe, America and Asia. With particular reference to the US market, the Complainant opened its first dedicated store in 1993, in New York. Shortly thereafter, other dedicated locations were established in the United States such as in Boston, Chicago, Palm Beach, Bal Harbour, Coral Gables, Dallas, Denver, Aspen, Las Vegas, Costa Mesa, Beverly Hills, and San Francisco.

The Respondent registered the disputed domain name <fabricloropiana.com> on 4 April 2022. It resolves to a page advertising the disputed domain name for sale at a price of GBP 16,554.98. There is no evidence before the Panel that the disputed domain name has ever been used for an active website since it was registered.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trade mark 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 name (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 name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

With regard to the first UDRP element, the Panel finds that the disputed domain name <fabricloropiana.com> is confusingly similar to the Complainant's trade marks LORO PIANA. Indeed, the disputed domain name incorporates the Complainant's trade marks in their entirety but adds the generic term "fabric" as a prefix to the Complainant's trade marks. The Panel follows in this respect the view established by numerous other decisions that a domain name which wholly incorporates a Complainant's registered trade mark may be sufficient to establish confusing similarity for purposes of the UDRP (for example, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG -v- Vasiliy Terkin <porsche-autoparts.com>). The Panel further considers it to be well established that the addition of a generic term, such as the term "fabric", does not allow a domain name to avoid confusing similarity with a trade mark (see, for example, WIPO Case No. D2019-2294, Qantas Airways Limited -v- Quality Ads <qantaslink.com>). The addition of this generic term is not sufficient to alter the overall impression of the designation as being connected with the Complainant's trade marks and does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trade marks and associated domain names. To the contrary, the disputed domain rather adds to the likelihood of confusion because the term "fabric" denotes the Complainant's products and implies that it is linked to the Complainant and its business.

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent has made any

use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain name. Indeed, the disputed domain name is not being used for any active website but resolves to a page advertising the disputed domain name for sale. A lack of content at the disputed domain has in itself been regarded by other panels as supporting a finding that the Respondent lacked a bona fide offering of goods or services and did not make legitimate non-commercial or fair use of the disputed domain name (see, for example, Forum Case No. FA 1773444, *Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants*). The Panel further finds that the Respondent is not affiliated with or related to the Complainant in any way and is neither licensed nor otherwise authorised to make any use of the Complainant's trade marks or to apply for or use the disputed domain name. In addition, the Whois information does not suggest that the Respondent is commonly known by the disputed domain name <fabricloropiana.com>. Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

With regard to the third UDRP element, the Panel accepts that the Complainant's trade marks LORO PIANA are distinctive and well-known trade marks. Other Panels have confirmed the reputation of the Complainant's trade marks inter alia in the following cases: CAC Case No 101319, *Loro Piana S.p.A. -v- Zokhirjon Mallaev* ("As far as registration in bad faith is concerned, Respondent registered a domain name containing a very well-known third party's trademark without authorization. Respondent could not ignore the existence of the LORO PIANA trademark at the time of the registration of the disputed domain name, not only because LORO PIANA is a very well-known trademark worldwide"); and WIPO Case No D2011-1871, *Loro Piana S.p.A. v. Mr. Sun King* ("The Complainant's trademark was already known in the textile and luxury goods businesses when the disputed domain name was registered. Therefore, it is not feasible that the Respondent could ignore the Complainant's reputation and business when it registered the disputed domain name"). Given the distinctiveness of the Complainant's trade marks and their reputation, it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant's trade marks. Furthermore, the Panel considers that, if the Respondent had carried out a Google search for the name FABRIC LORO PIANA, the search results would have yielded immediate and obvious references to the Complainant. The Panel concludes that it is difficult in those circumstances to believe that the Respondent was unaware of the Complainant's trade marks. It is in fact inconceivable that the Respondent might have registered a domain name similar to or incorporating the Complainant's trade marks without knowing of them. Indeed, it is likely that the disputed domain would not have been registered if it were not for the Complainant's new trade mark application and his existing trade marks (see, for example, WIPO Case No D2004-0673, *Ferrari Spa -v- American Entertainment Group Inc*). It is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical with or confusingly similar to the Complainant's trade marks and that he registered the disputed domain name in full knowledge of the Complainant's trade mark. The Panel further notes that the disputed domain name is not linked to an active website. The Respondent has not demonstrated any activity in respect of the disputed domain name. First, it is difficult to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate on the grounds that it would constitute passing off, or an infringement of the Complainant's rights under trade mark law, under circumstances where that disputed domain name corresponds to the Complainant's trade marks used by the latter to promote its goods and services. Secondly, numerous other UDRP decisions have taken the view, which this Panel shares, that the passive holding of a domain name with knowledge that the domain name infringes another party's trade mark rights may in itself be regarded as evidence of bad faith registration and use (see, for example, WIPO Case No. D2000-0003, *Telstra Corporation Limited v. Nuclear Marshmallows*; and WIPO Case No. D2004-0615, *Comerica Inc. v. Horoshiy, Inc.*). Finally, the Panel notes that the disputed domain name was registered by the Respondent on the same day as the Complainant filed its application for registration of the trade mark FABRIC LORO PIANA as an EU device mark. It is reasonable to infer in the circumstances, and to consider as additional factors supporting the Complainant's arguments of bad faith, first, that the Respondent sought to prevent the Complainant from reflecting its new trade mark in the corresponding .com domain name; and, secondly, that the Respondent registered the disputed domain name primarily for the purpose of selling the domain name registration to the Complainant, the exclusive owner of the trade marks LORO PIANA and the trade mark application FABRIC LORO PIANA, for valuable consideration in excess of Respondent's documented out-of-pocket expenses directly related to the registration of the disputed domain name (see, for example, WIPO Case No D1999-0001, *World Wrestling Federation Entertainment, Inc. -v- Michael Bosman*, finding that "[b]ecause respondent offered to sell the domain name to complainant 'for valuable consideration in excess of any out-of-pocket costs directly related to the domain name, respondent has 'used' the domain name in bad faith as defined in the Policy"). The Panel does not consider that it matters for these purposes that the disputed domain name is offered for sale through a third party platform to the public at

large. Absent any response from the Respondent, or any information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **FABRICLOROPIANA.COM**: Transferred

PANELLISTS

Name	Gregor Kleinknecht, LLM MCI Arb
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DATE OF PANEL DECISION 2022-07-07

Publish the Decision