

Decision for dispute CAC-UDRP-105522

Case number	CAC-UDRP-105522
Time of filing	2023-06-14 09:09:42
Domain names	monclerisrael.net, moncleruae.net, monclerjapan.net, monclerkuwait.com, xn--monclerespaa-khb.net, monclerbelgique.com, monclerireland.com, monclerbrasil.com, moncleruksale.com, monclerbelgiekopen.com, monclersuissemagasin.com, moncleraustralia.net, monclercanadasale.com, monclerdanmark.net, monclernederland.net, monclernorge.net, monclerportugal.net, monclersouthafrica.net, monclersuomi.net, monclerbulgaria.com, monclereesti.com, monclerlatvija.com, moncleronlineshop.com, monclerperu.com, moncleruruguay.com, monclerargentina.net, monclerchile.net, monclercolombia.net, monclerslovenija.com, xn--monclermagyarorszg-fsb.com, xn--monclerromnia-reb.com, xn--monclertrkiye-3ob.com, monclergreece.net, monclerhrvatska.net, monclermexico.net, monclersrbija.net

Case administrator

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

Organization	MONCLER S.P.A.
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Complainant representative

Organization	Convey srl
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Respondents

Name	Qiu Xiaofeng
Name	Agayeva SEVINC
Name	Petrosyan YELENA
Name	Birzu GALINA
Name	Karapetyan IRINA

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 names.

IDENTIFICATION OF RIGHTS

The Complainant owns trademark registrations for the mark MONCLER, among others, the following:

International TM Reg. No. 383336 registered on October 26, 1971 for MONCLER in class 3;

International TM Reg. No. 010165256 registered on April 10, 2012 for MONCLER in classes 4, 20, 35;

International TM Reg. No. 1467902 registered on December 17, 2018 for MONCLER in classes 9, 35, 36, 37, 38, 39, 41, 42;

EUIPO TM Reg. No. 003554656 registered on February 11, 2005 for MONCLER in class 3; and

EUIPO TM Reg. No. 005796594 registered on January 28, 2008 for MONCLER in classes 3, 9, 14, 16, 18, 22, 24, 25, 28.

FACTUAL BACKGROUND

The Complainant Moncler S.p.A. is an Italian luxury sport equipment manufacturer active in the sector in ready-to-wear outerwear headquartered in Milan, Italy. The MONCLER brand was born in 1952. In the 1980's, MONCLER became the iconic garment of a generation of youth. Since December 2021 Moncler is the official formalwear partner of Italian football club Inter Milan. The Complainant has spent considerable effort in promoting this mark, thereby acquiring the goodwill in association with the MONCLER mark.

The Complainant registered domain names consisting of or comprising the trademark MONCLER under several different TLDs, including <moncler.com>, which was registered on May 14, 2003, <moncler.it> registered on April 9, 2002, <moncler.cn> registered on February 15, 2006, and <moncler.eu> registered on June 10, 2007. The Complainant's website and social media accounts generate a significant number of visits by Internet users every day and are used by the Complainant to promote, and sell online its products.

The disputed domain names were registered on April 12, 2023. The disputed domain names have been resolved to websites entirely dedicated to the sale of goods bearing the MONCLER mark and having identical layout for the disputed domain names.

The Complainant sent a cease-and-desist letter to the Respondent on April 12, 2023.

PARTIES CONTENTIONS

COMPLAINANT:

i) The Complainant has rights in the MONCLER mark as identified in section "Identification of rights" above. The disputed domain names are confusingly similar to the Complainant's MONCLER mark because they incorporate the Complainant's mark in their entirety and add non-distinctive elements such as geographical terms, generic commercial terms and the generic Top-Level Domains .com and .net.

ii) The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademarks. The Respondent is not commonly known by the disputed domain names. The Respondent has not provided a *bona fide* offering of goods or services in connection with the disputed domain names. The disputed domain names have been redirected by the Respondent to websites with identical layouts where the Complainant's MONCLER marks are published and *prima facie* counterfeit MONCLER branded products are offered for sale.

iii) The Respondent has registered and is using the disputed domain names in bad faith. The use of the disputed domain names in connection with commercial websites where the Complainant's trademark is misappropriated and *prima facie* counterfeit MONCLER branded products are offered for sale, clearly indicates that the Respondent's purpose for registering the disputed domain names was to capitalize on the reputation of the Complainant's trademark. The Respondent has been engaged in a pattern of conduct preventing the Complainant from reflecting the mark in the disputed domain names. The Respondent had knowledge of the Complainant's rights in the MONCLER mark before registering the disputed domain names, which constitutes bad faith registration.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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

PRELIMINARY ISSUE: MULTIPLE RESPONDENTS

The Complainant has alleged that it is likely that the disputed domain names are under the control of a single entity and consolidation is appropriate in this matter. Paragraph 3(c) of the Rules (the "Rules") for the Uniform Domain Name Dispute Resolution Policy (the "UDRP" or "Policy") provides that a "complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder." The Complainant contends that the disputed domain names are subject to an evident common control, thus making the consolidation of the dispute equitable and procedurally efficient. The elements establishing the existence of a common control are the following:

- same date of registration: April 12, 2023;
- identical websites corresponding to the disputed domain names;
- same products offered for sale; and
- presence of geographical terms associated to the Complainant's trademark in the disputed domain names (except for the domain name <moncleronlineshop.com>).

The Complainant provides exhibits showing the circumstances as listed above. The Panel finds that the circumstances indicated above are concrete and sufficient to prove that the disputed domain names are subject to a common control by a single entity. The Panel agrees and finds that the disputed domain names are commonly owned/controlled by a single Respondent who is using multiple aliases. Throughout the decision, the Respondents will be collectively referred to as "Respondent."

The Panel is satisfied that all other 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

Paragraph 15(a) of the Rules for the Policy instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (2) the respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights and Confusing Similarity

The Complainant claims rights in the MONCLER mark as identified in the section 'Identification of Rights' above. The Panel notes that

the international trademark registrations and the EUIPO trademark registrations are sufficient to establish rights in that mark. Since the Complainant provides evidence of the trademark registrations above, the Panel finds that the Complainant has established its rights in the mark MONCLER.

The Complainant contends that the disputed domain names are confusingly similar to the Complainant's mark because the disputed domain names incorporate the Complainant's mark MONCLER in their entirety with the addition of non-distinctive elements such as geographical terms, generic commercial terms and the generic Top-Level Domains .com and .net. The Panel notes that the disputed domain names incorporate the MONCLER mark in their entirety and add generic, geographic terms and/or non-distinctive elements, *i.e.*, Israel, UAE, Japan, Kuwait, xn--espaa-khb, Belgique, Ireland, Brasil, UKsale, Belgiekopen, Suissemagasin, Australia, Canadasale, Danmark, Nederland, Norge, Portugal, South Africa, Suomi, Bulgaria, Eesti, Latvija, Onlineshop, Peru, Uruguay, Argentina, Chile, Colombia, Slovenija, xn--magyarország-fsb, xn--romnia-reb, xn--trkiye-3ob, Greece, Hrvatska, Mexico, and Srbija. Adding a generic term and a gTLD to a mark fails to sufficiently distinguish a disputed domain name from a mark per Policy paragraph 4(a)(i). *See Dell Inc. v. pushpender chauhan*, FA 1784548 (Forum June 11, 2018) ("Respondent merely adds the term 'supports' and a '.org' gTLD to the DELL mark. Thus, the Panel finds Respondent's disputed domain name is confusingly similar to Complainant's DELL mark per Policy paragraph 4(a)(i)."); *see also Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Svensson Viljae*, FA 1784650 (Forum June 1, 2018) (finding confusing similarity where "[t]he disputed domain name <skechers-outlet.com> adds a hyphen and the generic term 'outlet' to Complainant's registered SKECHERS mark, and appends the '.com' top-level domain."). Therefore, the Panel finds the disputed domain names are confusingly similar to the Complainant's mark per Policy paragraph 4(a)(i).

No rights or legitimate interests

The Complainant must first make a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain names under Policy paragraph 4(a)(ii), then the burden shifts to the Respondent to show it does have rights or legitimate interests. *See Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the Complainant is 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). *See also Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy paragraph 4(a)(ii)).

The Complainant contends that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized for the registration and use of the disputed domain names. The Respondent is not commonly known by the disputed domain names as individual, business or other organization and their family names do not correspond to MONCLER or the disputed domain names. When a response is lacking, WHOIS information may be used to determine whether a respondent is commonly known by the disputed domain names under Policy paragraph 4(c)(ii). *See H-D U.S.A., LLC, v. Ilyas Aslan / uok / Domain Admin ContactID 5645550 / FBS INC / Whoisprotection biz*, FA 1785313 (Forum June 25, 2018) ("The publicly available WHOIS information identifies Respondent as 'Ilyas Aslan' and so there is no *prima facie* evidence that Respondent might be commonly known by either of the [<harleybot.bid> and <harleybot.com>] domain names."). Additionally, lack of authorization to use a complainant's mark may indicate that the respondent is not commonly known by the disputed domain names. *See Google LLC v. Bhawana Chandel / Admission Virus*, FA 1799694 (Forum Sep. 4, 2018) (concluding that Respondent was not commonly known by the disputed domain name where "the WHOIS of record identifies the Respondent as 'Bhawana Chandel,' and no information in the record shows that Respondent was authorized to use Complainant's mark in any way."). The WHOIS information for the disputed domain names lists the registrants as "Qiu Xiaofeng, Agayeva SEVINC, Petrosyan YELENA, Birzu GALINA, and Karapetyan IRINA." Nothing in the record suggests that the Respondent was authorized to use the MONCLER mark. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain names per Policy paragraph 4(c)(ii).

The Complainant also contends that the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services before any notice of the dispute. The disputed domain names have been redirected by the Respondent to websites with identical layouts where the Complainant's MONCLER marks are published and *prima facie* counterfeit MONCLER branded products are offered for sale. It is evident that the goods offered for sale at the disputed domain names' resolving websites are counterfeit given the circumstances: i) the goods are sold below market value; ii) the Respondent has misappropriated copyrighted images from the Complainant's website; the Respondent has concealed his identity both on the Whois and on the websites corresponding to the disputed domain names; and there is no evident disclaimer as to the Respondent's lack of relationship with the Complainant and the Respondent has registered thirty-six domain names confusingly similar to the Complainant's trademark cornering the market. The Panel agrees and finds that such use of the disputed domain names is not considered a legitimate non-commercial or fair use without intent for commercial gain, because the Respondent is attempting to gain profit from the sales of *prima facie* counterfeit products.

The Panel finds that the Complainant has made out a *prima facie* case that arises from the considerations above. All of these matters go to make out the *prima facie* case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

Bad faith

The Complainant contends that the Respondent registered and uses the disputed domain names in bad faith. The use of the disputed domain names in connection with commercial web sites where the Complainant's trademark is misappropriated and *prima facie* counterfeit MONCLER branded products are offered for sale, clearly indicates that the Respondent's purpose for registering the disputed domain names was to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking

MONCLER products to their websites for financial gain according to paragraph 4(b)(iv) of the Policy.

The Panel recalls that the disputed domain names have been redirected by the Respondent to websites with identical layouts where the Complainant's MONCLER marks are published and *prima facie* counterfeit MONCLER branded products are offered for sale. The Panel recalls that the Complainant provides screenshots of the disputed domain names' resolving websites which prominently display the MONCLER word mark. Furthermore, the Panel notes that i) the goods are sold below market value; ii) the Respondent has misappropriated copyrighted images from the Complainant's website; iii) the Respondent has concealed his identity both on the Whois and on the websites corresponding to the disputed domain names; and iv) there is no evident disclaimer as to the Respondent's lack of relationship with the Complainant.

The Panel observes that use of a disputed domain name to pass off as a complainant and offer competing or counterfeited goods may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv). *See Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund*, FA 1790949 (Forum July 9, 2018) (finding bad faith per Policy Paragraph 4(b)(iii) and (iv) where the respondent used the disputed domain name to resolve to a website upon which the respondent passes off as the complainant and offers online cryptocurrency services in direct competition with the complainant's business), *see also Guess? IP Holder L.P. and Guess?, Inc. v. LI FANGLIN*, FA 1610067 (Forum Apr. 25, 2015) (finding respondent registered and used the domain name in bad faith per Policy Paragraph 4(b)(iii) because the respondent used the resolving website to sell the complainant's products, using images copied directly from the complainant's website), *see also Bittrex, Inc. v. Wuxi Yilian LLC*, FA 1760517 (Forum Dec. 27, 2017) (finding bad faith per Policy Paragraph 4(b)(iv) where "Respondent registered and uses the <bittrex.com> domain name in bad faith by directing Internet users to a website that mimics Complainant's own website in order to confuse users into believing that Respondent is Complainant, or is otherwise affiliated or associated with Complainant."). Therefore, the Panel concludes that the Respondent registered and uses the disputed domain names in bad faith per Policy paragraph 4(b)(iii) and (iv).

Next, the Complainant contends that the Respondent has been engaged in a pattern of conduct, by way of registering thirty-six domain names, confusingly similar to the Complainant's MONCLER mark, preventing the Complainant from reflecting the mark in the disputed domain names. The Panel observes that a pattern of conduct as required in paragraph 4(b)(ii) of the Policy may involve multiple domain names directed against a single complainant. The Panel finds that the Respondent has registered as many as thirty-six domain names containing the Complainant's trademark. The Panel finds that the Respondent's registration of the disputed domain names thus indicates a pattern of bad faith registration and use pursuant to Policy paragraph 4(a)(ii). *See Ditec International AB / Global Preservation Systems, LLC v. ADAM FARRAR / HOSTGATOR / FRITS VERGOOSSEN / DITEC INTERNATIONAL CORPORATION / Christopher Alison*, FA 1763998 (Forum Feb. 1, 2018) ("Here, Respondent registered six domain names that all include Complainant's DITEC mark. Therefore, the Panel finds that Respondent's multiple registrations using the DITEC mark indicates bad faith registration and use per Policy paragraph 4(b)(ii).").

The Complainant further contends that the Respondent was fully aware of the reputation of the Complainant's mark and the Complainant company given the circumstances that the Complainant's trademark MONCLER has become a well-known trademark in the sector of manufacturing luxury outerwear and that replicas of MONCLER products are being offered for sale on the active websites corresponding to the disputed domain names. The Panel infers, due to the notoriety of the Complainant's mark; the manner of use of the disputed domain names; and the registration of thirty-six domain names incorporating the Complainant's mark that the Respondent had knowledge of Complainant's rights in the MONCLER mark before registering the disputed domain names which constitutes bad faith registration per Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **monclerisrael.net**: Transferred
2. **moncleruue.net**: Transferred
3. **monclerjapan.net**: Transferred
4. **monclerkuwait.com**: Transferred
5. **xn--monclerespaa-khb.net**: Transferred
6. **monclerbelgique.com**: Transferred
7. **monclerireland.com**: Transferred
8. **monclerbrasil.com**: Transferred
9. **moncleruksale.com**: Transferred
10. **monclerbelgiekopen.com**: Transferred
11. **monclersuissemagasin.com**: Transferred
12. **moncleraustralia.net**: Transferred
13. **monclercanadasale.com**: Transferred
14. **monclerdanmark.net**: Transferred
15. **monclernederland.net**: Transferred

16. **monclernorge.net**: Transferred
17. **monclerportugal.net**: Transferred
18. **monclersouthafrica.net**: Transferred
19. **monclersuomi.net**: Transferred
20. **monclerbulgaria.com**: Transferred
21. **monclereesti.com**: Transferred
22. **monclerlatvija.com**: Transferred
23. **moncleronlineshop.com**: Transferred
24. **monclerperu.com**: Transferred
25. **moncleruruguay.com**: Transferred
26. **monclerargentina.net**: Transferred
27. **monclerchile.net**: Transferred
28. **monclercolombia.net**: Transferred
29. **monclerslovenija.com**: Transferred
30. **xn--monclermagyarorszg-fsb.com**: Transferred
31. **xn--monclerromnia-reb.com**: Transferred
32. **xn--monclertrkiye-3ob.com**: Transferred
33. **monclergreece.net**: Transferred
34. **monclerhrvatska.net**: Transferred
35. **monclermexico.net**: Transferred
36. **monclersrbija.net**: Transferred

PANELLISTS

Name	Mr. Ho-Hyun Nahm Esq.
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DATE OF PANEL DECISION	2023-07-16
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Publish the Decision
