

DISPUTE RESOLUTION SERVICE

DRS 12819

Decision of Independent Expert

Moncler SrL

Complainant

and

Chen

Respondent

1 The Parties

Complainant:	Moncler SrL
Address:	Via Stendhal, 47 20144 Milano Italy

Respondent:	Chen
Address:	10 Wei Road Fujian AZ 857 United States of America

2 The Domain Name

Storemoncler.co.uk (the "Domain Name").

3 Procedural History

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as might be of a such a nature as to call into question my independence in the eyes of one or both of the parties.

10 May 2013 17:10 Dispute received
13 May 2013 11:34 Complaint validated
13 May 2013 11:39 Notification of complaint sent to parties
31 May 2013 02:30 Response reminder sent
05 June 2013 09:18 No Response Received
06 June 2013 12:12 Notification of no response sent to parties
14 June 2013 10:48 Expert decision payment received

4 Factual Background

- 4.1 The Complainant is a manufacturer of sportswear and other clothing, having started life in 1952 as a manufacturer of mountaineering and skiing clothing, in particular as pioneer of the quilted jacket. It is currently owned by an Italian entrepreneur named Remo Ruffini. The MONCLER name is an abbreviation of Monastier de Clermont, an Alpine village in France.
- 4.2 The Respondent has registered the Domain Name under the name of "Chen" at a purported address in the United States. Nothing is known about the Respondent.
- 4.3 The Domain Name was registered by the Respondent on 27 August 2012. At present, it is pointing to a website at the URL *www.oakleymen.org.uk* which appears to be offering for sale Oakley sunglasses. Whether or not the Respondent is authorised to do so is unclear.

5 Parties' Contentions

Complaint

- 5.1 The Complainant explains that it is a leading manufacturer of sportswear and outerwear. It has owned the MONCLER registered trade mark since 1963, and is currently the registered proprietor of 500 national and international registered trade marks comprising the MONCLER name. Numerous certificates evidencing such registrations are exhibited to the Complaint.
- 5.2 It has used the MONCLER trade mark in more than 100 countries in connection with the marketing and sale of its products. Its 2012 annual sales were €282 million, of which sales worth almost €18 million were in the United States where the Respondent is purportedly based.
- 5.3 The Complainant markets its products through its own branded stores managed directly by it and also through other retailers operated by third parties.
- 5.4 The MONCLER trade mark has been and is supported by extensive advertising on television and in other media, including magazines such as *Vogue*, *Vanity Fair* and *GQ*. By way of illustration, the Complainant's advertising spend during the autumn/winter season of 2012 was €6 million, of which almost €1.4 million was spent in the United States. Examples are provided of various advertisements over the years.
- 5.5 In addition, the Complainant has registered over 450 domain names identical to or including the MONCLER mark in a number of different TLDs. A full list is exhibited to the Complaint. It also carries out advertising and marketing activities on the main social media sites including Facebook, Twitter and YouTube.
- 5.6 Its principal website at *www.moncler.com*, to which most of its registered domain names point, enjoyed 3.5 million visits during the period September 2011 to March 2012. Further, its

products are advertised and offered for sale on that website at URL *www.store.moncler.com*, which itself received more than 3.8 million visits between September 2011 and March 2012.

- 5.7 For all these reasons, the Complainant asserts that the MONCLER trade mark is a famous global mark.
- 5.8 The Domain Name was registered without the permission of the Complainant. At the time the Complaint was filed, the Complainant explains that the Domain Name was not directed to an active website (though, as noted at paragraph 4.3 above, that position now appears to have changed). However, the Complainant submits that until shortly before the Complaint the Domain Name was pointing to a website at URL *www.2012monclervip.com*, which was giving the false impression that it was one of the Complainant's official websites and, without the consent of the Complainant, was using MONCLER trade marks, "*official images*" (presumably in breach of copyright) and "*offering for sale prima facie counterfeit products bearing the trade mark MONCLER*". The Complainant notes that nowhere on the website was it made clear that the website was not authorised by or otherwise affiliated with the Complainant, which it says is clear evidence of the Respondent's attempt to "*trade off the Complainant's reputation in [the] MONCLER well-known trade mark for its own commercial gain*".
- 5.9 For these reasons, the Complainant asserts that internet users were likely to be misled by the Respondent into thinking that his website was associated with the Complainant.
- 5.10 As soon as it became aware of the Respondent's conduct, on 10 December 2012 the Complainant sent a letter before action to him asking him to deactivate the website and transfer the Domain Name to the Complainant. In the absence of any response, a follow up letter was sent on 29 December 2012. The Complainant had established that the address given by the Respondent to Nominet is non-existent and accordingly corresponded with it solely by email.
- 5.11 The Complainant asserts that the Domain Name is an Abusive Registration, in the first place because it is confusingly similar to the MONCLER trade mark. The Complainant submits that the addition of the non-distinctive word "store" does not exculpate the Respondent in this regard, citing a number of DRS decisions in support of its position, including *Seiko UK Limited v Designer Time/Wanderweb* (DRS 248 *seiko-shop.co.uk*), *Fellows, Inc v Virtual System Management Limited* (DRS 8752 *fellowsstore.co.uk* and *fellows-store.co.uk*) and *Bowering v Murry* (DRS 4823 *monstersupplementstore.co.uk*).
- 5.12 Further, the Complainant contends that the use of the word "store" in conjunction with the Complainant's mark makes it even more damaging because of its similarity to the Complainant's official website (see paragraph 5.6 above). Accordingly, it contends that the Domain Name is confusingly similar to the Complainant's mark in which it has Rights pursuant to paragraph 2(a)(i) of the Policy.
- 5.13 It says that there is no evidence of any of the circumstances mentioned in paragraph 4 of the Policy which might indicate that the Domain Name is not an Abusive Registration. It points out that MONCLER is not a word with any meaning in any foreign language.
- 5.14 The Complainant asserts that the passive holding of the Domain Name by the Respondent (i.e. at the time the Complaint was filed) does not constitute legitimate non-commercial fair use of the Domain Name, absent evidence to the contrary from the Respondent. It also relies on the decisions in *The Gap v Cybernet Ventures Limited* (DRS 820 *gap-online.co.uk*) and in *Hanna-Barbera Productions Inc v Graeme Hay* (DRS 389 *scoobydoo.co.uk*) that, in deciding whether a Domain Name is an Abusive Registration, the Expert is entitled to consider the way in which it has been used not only at the time the Complaint is filed but "*from commencement*

of that use to date". For these reasons, the Complainant contends that account should be taken of the use made by the Respondent of the Domain Name since he first registered it, notwithstanding that at the time the Complaint was filed it had been deactivated.

- 5.15 The Complainant contends that the Respondent's use of the Domain Name to point to a website selling counterfeit products by reference to the Complainant's mark "*clearly demonstrates that the Respondent did not intend to use the disputed domain name in connection with any legitimate purpose and its use cannot be certainly considered a legitimate non-commercial or fair use without intent for commercial gain, because the Respondent has been undoubtedly gaining from the sales of products bearing MONCLER trade mark*".
- 5.16 It says that the Respondent must have known of the existence of the MONCLER mark at the time it registered the Domain Name, and that this is demonstrated by the manner in which he was using it. The Complainant cites *Lego v Ajay Ahuja t/a Webhosting UK Com* (DRS 8705 *businesslego.co.uk*) as authority for its proposition that it has been used to cause initial interest confusion. It also relies on *Chivas Brothers Limited v Plenderleith* (DRS 658 (not 292) *chivasbrothers.co.uk*) as authority for its proposition that where a domain name is exclusively referable to the complainant, there is no obvious justification for the respondent's adoption of that domain name, and (as here) he offers no explanation, it is reasonable for the Expert to infer that the domain name was registered for an abusive purpose. The Complainant points out that in a number of UDRP cases it has been accepted that the MONCLER mark is "*distinctive and very well known*".
- 5.17 In relation to its contention that the Respondent has been using the Domain Name to sell counterfeit products on its website, it relies on *Pfizer Inc v Pfizer-Viagra* (DRS 3244 *pfizer-viagra.co.uk*) in which the Expert held that the use of that domain name:
- "to draw in traffic on the strength of the Complainant's reputation and to attempt to sell goods that the Complainant says are counterfeit ... can only be regarded as taking unfair advantage of or being unfairly detrimental to the Complainant's rights."*
- 5.18 The Complainant therefore contends that the Domain Name was being used in a way which was likely to confuse people or businesses into believing that it was registered to, operated or authorised by or otherwise connected with the Complainant contrary to paragraph 3(a)(ii) of the Policy and also primarily for the purpose of unfairly disrupting the business of the Claimant in breach of paragraph 3(a)(i)(C) of the Policy. In addition, it relies on the failure of the Respondent to provide a genuine postal address to Nominet as a breach of paragraph 3(a)(iv) of the Policy.
- 5.19 Finally, the Complainant relies on the fact that the Respondent failed to reply to its letter before action and reminder. It relies on two UDRP cases: *Great Eastern Life Assurance Company Limited v Unasi Inc* (D2005-1218 *greateasternlife.com*), in which it was found that a failure to respond to a letter before action amounted to "*adoptive admission of the allegations*", and *Stanworth Development Limited v Mike Morgan* (D2006-0230 *riverbelleinfo.com*), in which a similar finding was made.

Response

- 5.20 No Response was filed.

6 Discussion and Findings

General

6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"Abusive Registration means a Domain Name which either:

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR

(ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

Complainant's rights

6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it *"has Rights in respect of a name or mark which is identical or similar to the Domain Name"*. "Rights" means *"rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"*.

6.4 The Complainant has claimed and evidenced numerous registered trade marks in the MONCLER name. Plainly, it has also acquired common law rights in the name.

6.5 It is now well established under the DRS that the addition of a generic or descriptive word, in this case "store", to a name or mark in which a complainant has Rights, does not mean that the domain name in question is so dissimilar that it falls outside paragraph 2(a)(i) (see *natwestloans.co.uk* (DRS 3390), *tescoestateagents.co.uk* (DRS 3962), *replicarolex.co.uk* (DRS 5764) and *veluxblind.co.uk* (DRS 6973), by way of examples).

6.6 The Complainant also relies on the fact that the addition to the mark of the word "store" corresponds precisely to the third level domain used by it at URL *www.store.moncler.com*, the part of its website from which it sells products online. While that may well be evidence which goes to the issue of the way in which the Respondent is using the Domain Name, it probably does not assist the Complainant in relation to the issue of similarity because the Complainant is not asserting rights in STORE MONCLER, but only in the MONCLER mark.

6.7 In any event, the point is moot because the Complainant plainly satisfies paragraph 2(a)(i) of the Policy for the reasons set out in 6.4 and 6.5 above.

Evidence of abusive registration

6.8 The Complainant relies primarily on paragraphs 3(a)(i)(C), 3(a)(ii), and 3(iv) of the Policy. It also asserts that none of the exculpatory circumstances identified in paragraph 4 of the Policy are present.

- 6.9 In this case, none of the contentions relied upon by the Complainant, and none of the evidence in support of those contentions, is contested by the Respondent, who did not file a Response. In those circumstances, unless it would clearly be unconscionable to do so, the Expert proceeds on the footing that the Respondent does not contest the veracity or the arguments of the Complainant.
- 6.10 The Complainant contends that, pursuant to paragraph 3(a)(i)(C) of the Policy, there are circumstances indicating that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. Proving that the domain name was registered (or otherwise acquired) primarily for a specific purpose (i.e. one of the three purposes set out at sub-paragraphs 3(a)(i)(A) to (C) inclusive) is not always straightforward.
- 6.11 However, in this case, having regard to the unchallenged facts, and in light of the Respondent's failure to make a positive case under paragraph 4, it is difficult to imagine that the Domain Name was registered for any purpose other than unfairly to disrupt the business of the Complainant, not least by using the Domain Name to piggyback on the trading goodwill owned by the Complainant to sell counterfeit versions of the Complainant's products. Indeed, it is difficult to think of a more egregious example of unfair disruption of a business. Accordingly, the Complaint succeeds on this ground.
- 6.12 The Complainant also contends that, pursuant to paragraph 3(a)(ii) of the Policy, there are circumstances indicating that the Domain Name was being used in a way which confused or was likely to confuse people or businesses into believing that the Domain Name was registered to, operated or authorised by, or otherwise connected with the Complainant. For the reasons set out in the Complaint and summarised at paragraphs 5.8, 5.9, 5.12, 5.15 and 5.16 above, the Complainant succeeds on that ground too.
- 6.13 The fact that the Respondent may have sought to mend his ways after receiving a letter before action does not assist him. As the Appeal Panel in the *Scoobydoo* case (ibid.) observed: "*Ordinarily, it may be that less weight will be given to any changes in that use made following intimation to the Respondent of the Complainant's objections*".
- 6.14 Finally, the Complainant relies on paragraph 3(a)(iv) of the Policy, which provides that if it is "*independently verified that the Respondent has given false contact details to*" Nominet, that may constitute evidence that it is an Abusive Registration. In this case, the address provided (as recorded at section 1 above) would not appear to be a genuine postal address. Whether the email or telephone contact details (*578660195@gg.com* and *+1.15454542*) are genuine is not clear (or pleaded). In any event, the Experts' Overview states that in order to satisfy the requirement for independent verification:
- "delivery service or Post Office certification will certainly suffice, but it is not necessary to obtain formal verification. Any authoritative letter, email or note from a third party explaining how the contact details are known to be false will usually suffice"*.
- 6.15 No such evidence has been provided by the Complainant, the letters having been sent by email only. Accordingly, in those circumstances, it is not possible to make a finding that this ground has been made out. In practice, however, the Complainant's failure to prove Abusive Registration under paragraph 3(a)(iv) is academic, because it has succeeded in doing so under paragraphs 3(a)(i)(C) and 3(a)(ii).

6.16 Accordingly, the Expert is satisfied, on the balance of probabilities, that the Domain Name was registered and/or has been used in a manner which took unfair advantage of the Complainant's Rights in the Mark and/or was unfairly detrimental to those Rights.

7 Decision

7.1 The Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

Signed: **David Engel**

Dated 17 July 2013