

DISPUTE RESOLUTION SERVICE**D00018694****Decision of Independent Expert**

Moncler S.p.A.

and

Trani Johanna

1. The Parties

Complainant: Moncler S.p.A.
Via Stendhal 47
Milan
Italy
20144
Italy

Respondent: Trani Johanna
Harbor Avenue 1550 Pudong New Area
Shanghai
Shanghai
201306
China

2. The Domain Names

monclerdealsuk.co.uk; moncleroutletukvip.co.uk; moncleroutwear.co.uk;
moncleroutwears.co.uk; monclerukdeals.co.uk; monclerukvip.co.uk;
monclervipuk.co.uk; realmoncler.co.uk

3. Procedural History

- 3.1 I 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 they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.
- 3.2 On 21 March 2017 the complaint was received. On 22 March 2017 the complaint was validated and notification of it sent to the parties. On 10 April 2017 a response reminder was sent. On 13 April 2017 no response having been received, a notification of no response was sent to the parties. On 28 April 2017 a summary/full fee reminder was sent and on 4 May 2017 the Expert decision payment was received.
- 3.3 The Respondent has not filed a response. I am satisfied that the complaint was served upon the Respondent in accordance with paragraphs 3 and 6 of the Nominet Dispute Resolution Service Policy ("the Policy").

- 3.4 I also wish to comment on payment of the Expert decision fee. In the notification of no response on 13 April 2017 the Complainant's representatives were informed the Expert decision fee was payable on or before 2 May 2017. The Complainant's representatives responded by e-mail the same day that they wished to appoint an independent expert to provide a full decision, they would pay by 2 May 2017 and requested the pro-forma invoice be addressed to them. On 28 April 2017 in the summary/full fee reminder the Complainant's representatives were informed the deadline for the payment to be received was 3 May 2017. On 2 May 2017 the Complainant's representatives responded saying they had authorised payment and enclosed a copy of the wire transfer receipt. They said payment would be received at the latest on 4 May 2017 and explained their accounting department had been waiting for a response from Nominet to their communication of 21 April 2017 before making payment. The accounting department had requested the pro-forma invoice be modified since their VAT number had not been included and VAT had been wrongly charged. The Complainant's representatives requested that payment be accepted. If not they requested confirmation that Nominet would refund the fee paid by bank transfer upon receipt and said they would immediately pay by credit card. On 3 May 2017 Nominet informed the Complainant's representatives that as the payment was initiated before the deadline it would be accepted and the case moved to the Expert decision stage once the payment was received.
- 3.5 Paragraph 12.2 of the Policy states that if the Complainant does not opt for either a full or a summary decision by paying the applicable fee within ten Days (any day other than Saturday, Sunday or any bank or public holiday in England and Wales) of receipt of the notice that the DRS process has reached the decision stage Nominet will deem the complaint to be withdrawn. I note the Complainant was given a deadline of 2 May 2017 and then of 3 May 2017 to make payment and that payment was received on 4 May 2017. Under paragraph 24.1 of the Policy Nominet may in exceptional cases extend any period of time in proceedings under the DRS and under paragraph 24.6 of the Policy the determination of whether exceptional circumstances exist under any provision of the Policy shall be in Nominet's sole discretion. In this case Nominet has extended the time for payment of the Expert decision fee and whilst such decision is in Nominet's sole discretion I consider it was reasonable in the circumstances set out above for Nominet to do so.

4. Factual Background

- 4.1 The Complainant was founded in 1952. It originally produced clothing for high altitude climbing. It now supplies luxury outerwear and sportswear, including clothing and accessories, for men, women and children.
- 4.2 The Complainant is the owner of registered trade marks for MONCLER including the following:
- (a) EU Trade Mark no 003554656 for MONCLER registered on 11 February 2005;
 - (b) EU Trade Mark no 005796594 for MONCLER registered on 28 January 2008 (with an expiry date of 29 March 2017);
 - (c) International trade mark registration no 269298 for MONCLER registered on 11 May 1963;
 - (d) International trade mark registration no 504072 for MONCLER registered on 20 June 1986;

- (e) International trade mark registration no 991914 for a figurative MONCLER mark registered on 13 October 2008;
 - (f) UK trade mark registration no 00000856043 for MONCLER registered on 1 November 1963; and
 - (g) International trade mark registration no 1197643 for a figurative MONCLER mark registered on 13 September 2013.
- 4.3 The Complainant's web site is at moncler.com. This domain name was registered on 14 May 2003.
- 4.4 The Respondent has registered about 200 domain names incorporating the MONCLER mark including the Domain Names which were registered on the following dates: monclerdealsuk.co.uk registered on 11 November 2016; moncleroutletukvip.co.uk registered on 11 November 2016; moncleroutwear.co.uk registered on 10 November 2016; moncleroutwears.co.uk registered on 10 November 2016; monclerukdeals.co.uk registered on 11 November 2016; monclerukvip.co.uk registered on 11 November 2016; monclervipuk.co.uk registered on 11 November 2016; and realmoncler.co.uk registered on 15 November 2016. The Domain Names have been suspended and have not been used for active web sites.
- 4.5 On 9 February 2017 the Complainant's representatives wrote to the Respondent seeking the transfer of the domain names incorporating the MONCLER mark including the Domain Names. No response was received to this letter.

5. Parties' Contentions

The Complainant's complaint

- 5.1 The Complainant submits that it has Rights in the MONCLER mark which it says is similar to the Domain Names:
- (a) The Complainant relies on its registered trade marks for MONCLER including in China where the Respondent is based. The Complainant says the MONCLER mark was registered in 1963 and has been used in connection with its products for more than 50 years in more than 100 countries.
 - (b) The Complainant says it operates an extensive sales network with MONCLER products marketed through stores managed directly by the Complainant and by third parties. The Complainant states its sales at the end of 2015 were about EUR 880 million worldwide of which nearly EUR 333.5 million¹ was in Asia.
 - (c) The Complainant states it advertises the MONCLER mark worldwide through television and in international magazines and that its advertising investment in 2015 was more than EUR 57.8 million. The Complainant says that it organises several yearly and seasonal advertising campaigns edited in recent years by well-known photographers and that it also organises promotional initiatives.
 - (d) The Complainant contends that the MONCLER mark is famous and well-known worldwide in light of the Complainant's significant investment in R&D, marketing, sales and distribution, as well as its impressive client base.
 - (e) The Complainant says it has registered over 1200 domain names which incorporate the MONCLER mark. The Complainant also says its site moncler.com, to which most of its domain names are redirected, generates a significant

¹ The complaint says EUR 333.5 but the Expert assumes this is EUR 333.5 million

number of visits. The Complainant states it also has a strong online presence through social media.

- (f) The Complainant contends the MONCLER mark is similar to the Domain Names. The Complainant says it is a well-established principle that domain names wholly incorporating a trade mark are confusingly similar despite containing descriptive or generic terms. The Complainant notes that the first word in each of the Domain Names (save for realmoncler.co.uk) is MONCLER and contends this is the dominant element of each of the Domain Names. The Complainant argues that the descriptive terms “outwear”, “deal”, “real”, “vip”, “uk” and “outlet” do not distinguish the Domain Names from the MONCLER mark and are apt to reinforce the likelihood of confusion of Internet users. The Complainant submits the ‘.co.uk’ suffix should be disregarded for the purpose of assessing similarity.

5.2 The Complainant contends the Domain Names, in the hands of the Respondent, are an Abusive Registration:

- (a) The Complainant states the Respondent has registered more than 200 domain names which incorporate the MONCLER mark together with descriptive or generic terms. The Complainant says the majority of these domain names are used for commercial web sites featuring the Complainant’s figurative trademarks and some official images, imitating the layout of the Complainant’s official web sites and offering for sale MONCLER branded products at very low discounted prices. The Complainant says these products are very likely counterfeit.
- (b) The Complainant contends the Respondent has no rights or legitimate interests in the Domain Names. The Complainant states the Respondent is not its licensee or authorised agent and is not permitted to use the MONCLER mark. The Complainant says that under the Policy the mere registration of a domain name does not establish rights or legitimate interests and can constitute unfair use even if nothing more is done with the domain name.
- (c) The Complainant believes the Respondent is not commonly known by the Domain Names either as an individual or business. The Complainant says MONCLER is an invented word with no meaning in foreign languages and would not be chosen by a trader unless seeking to create the impression of an association with the Complainant.
- (d) The Complainant says the Respondent has failed to use the Domain Names or demonstrated preparations to use them in connection with a bona fide offering of goods or services. The Complainant notes that under paragraph 5.2 of the Policy failure to use the Domain Names for the purposes of email or a web site is not in itself evidence of Abusive Registration but states Experts have generally agreed that in certain circumstances, such as when a brand is well-known and there is no apparent legitimate reason for the domain name registration, non-use may be indicative of a threatened abuse hanging over the head of the complainant.
- (e) The Complainant asserts there is no reason why the MONCLER mark is being used in the Domain Names except to trade on the Complainant’s goodwill. The Complainant says it is inconceivable that the Respondent was unaware of the MONCLER mark when the Domain Names were registered. The Complainant contends this is demonstrated by the Respondent’s registration of more than 200 domain names confusingly similar to the MONCLER mark and use of most of

them for web sites prominently featuring the MONCLER mark and selling MONCLER products which are likely to be counterfeit.

- (f) The Complainant says that in accordance with previous DRS decisions use of a domain name does not have to involve active steps being taken after registration. The Complainant contends it is reasonable to infer the Respondent registered the Domain Names for an Abusive purpose such as holding them with the aim of taking unfair advantage of the Complainant's Rights and using them in the same manner as the Respondent's other domain names incorporating the MONCLER mark namely for web sites imitating the look and feel of the Complainant's official web sites. The Complainant argues that by passively holding the Domain Names the Respondent is threatening to use them in a way which will, or is likely to, confuse Internet consumers into believing that they are registered to, operated or authorised by, or otherwise connected with the Complainant.
- (g) The Complainant argues that the Respondent has engaged in a pattern of registrations pursuant to Paragraph 5.1.3 of the Policy. The Complainant relies on the Respondent's registration of more than 200 domain names incorporating the MONCLER mark. The Complainant also says the Respondent owns other domain names featuring well-known names or marks of third parties in combination with generic or geographical terms and has used them for similar conduct.
- (h) The Complainant relies on the Respondent's failure to respond to the letter sent from the Complainant's representatives.

6. Discussions and Findings

6.1 Paragraph 2.2 of the Policy sets out that the Complainant is required to prove to the Expert that both of the following elements are present on the balance of probabilities:

2.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

2.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

6.2 In this case the Respondent has not submitted a response. Nevertheless the Complainant is still required to prove to the Expert that both the above elements are present on the balance of probabilities.

The Complainant's Rights

6.3 Under Paragraph 1 of the Policy, 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.*" It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.

6.4 I am satisfied on the basis of the Complainant's registered trade marks set out at paragraph 4.2 that the Complainant has Rights in the MONCLER mark. I am also satisfied that the Complainant has established unregistered Rights through its extensive use of the MONCLER mark.

6.5 The Domain Names incorporate the MONCLER mark prefaced by "real" or suffixed by "dealsuk", "outletukvip", "outwear", "outwears", "ukdeals", "ukvip" or "vipuk" (disregarding the .co.uk suffix which it is usual to ignore). The terms "real", "deals", "uk", "outlet", "vip", "outwear" and "outwears" are descriptive or generic in nature. The dominant element in each of the Domain Names is the distinctive term MONCLER.

I am therefore satisfied the Complainant has Rights in a name or mark, MONCLER, which is similar to the Domain Names.

Abusive Registration

6.6 Under Paragraph 1 of the Policy 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. *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.

6.7 A non-exhaustive list of factors which may be evidence that the Domain Names are an Abusive Registration are set out at paragraph 5 of the Policy including:

5.1.1 *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

5.1.1.1 *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*

5.1.1.2 *as a blocking registration against a name or mark in which the Complainant has Rights; or*

5.1.1.3 *for the purpose of unfairly disrupting the business of the Complainant.*

6.8 Paragraph 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Names are not an Abusive Registration. Paragraph 5.2 of the Policy also sets out that failure on the Respondent's part to use the Domain Names for the purposes of email or a web site is not in itself evidence that the Domain Names are an Abusive Registration. However, as the Complainant points out, there are circumstances where non-use can constitute a threatened abuse. The Nominet Dispute Resolution Service – Experts' Overview² states the following in relation to non-use of a domain name:

"Moreover, some Experts have found that in certain circumstances, e.g. where the name is a known brand and the Respondent has no obvious justification for having adopted the name and has given no explanation, the non-use itself can constitute a threatened abuse hanging over the head of the Complainant."

6.9 The Overview cites as a relevant decision DRS0658 chivasbrothers.co.uk concerning non-use of a domain name incorporating a famous name. In that case the expert considered CHIVAS BROTHERS to be exclusively referable to the complainant, to be a

² The purpose of the Overview is to assist all participants or would-be participants in disputes under the Policy by explaining commonly raised issues and how Experts have dealt with those issues to date. It also draws attention to areas where Experts' views differ.

distinctive name and in the context of alcoholic beverages a very famous name. The expert viewed it as inconceivable that the respondent registered the domain name without having the complainant firmly in mind. The expert considered there was no obvious reason why the respondent might be said to have been justified in registering the domain name and the respondent had elected not to come forward with any explanation for his registration of the domain name. The expert said:

“While it may be possible (at least theoretically) that the Respondent registered the Domain Name for no purpose at all, the Expert regards that as most improbable. What could the Respondent’s purpose have been? It could have been with a view to making a use of it, or it could have been with a view to selling it, or simply to block the Complainant. We are left to speculate because the Respondent has not responded, nor has the Respondent made any use at all of the Domain Name.

Where a Respondent registers a Domain Name:-

- 1. which is identical to a name in respect of which the Complainant has rights; and*
- 2. where that name is exclusively referable to the Complainant; and*
- 3. where there is no obvious justification for the Respondent having adopted that name for the Domain Name; and*
- 4. where the Respondent has come forward with no explanation for having selected the Domain Name,*

it will ordinarily be reasonable for an expert to infer first that the Respondent registered the Domain Name for a purpose and secondly that that purpose was abusive. In this case the Expert draws those inferences.”

- 6.10 In this case the Complainant’s evidence establishes that MONCLER was an extremely well-known mark at the time of registration of the Domain Names. I consider the Respondent was aware of the MONCLER mark at the time of registration of the Domain Names and had the Complainant firmly in mind when she registered the Domain Names. This is evidenced by the Respondent’s registration of about 200 domain names incorporating the MONCLER mark at about the time of or in the months following the registration of the Domain Names and the use of most of them for web sites selling MONCLER branded products.
- 6.11 The Domain Names have not been used. Like the expert in DRS0658 I regard it as most improbable that the Respondent registered all eight Domain Names for no purpose at all. In the absence of any explanation from the Respondent for her registration of the Domain Names I am left to speculate as to the purpose of the registrations. In this case I consider that I can reasonably speculate that the Respondent’s purpose was to use the Domain Names in the same way as most of the Respondent’s other about 200 domain names incorporating the MONCLER mark namely for web sites which are very similar to the Complainant’s web site, which feature the Complainant’s trade marks and which offer for sale at low prices MONCLER branded products which the Complainant suspects may be counterfeit.
- 6.12 I consider registration of the Domain Names for such a purpose constitutes an Abusive Registration under paragraph 1.i. of the Policy. The Domain Names incorporate the well-known and distinctive MONCLER mark with generic or descriptive elements. I consider Internet users are very likely to associate or connect the Domain Names with the Complainant. In my view the Respondent registered the Domain Names for the purpose of diverting Internet users looking for the Complainant or its products to web sites at the Domain Names where she intended to sell MONCLER branded products for

her own gain. The Respondent thereby registered the Domain Names for the purpose of unfairly disrupting the business of the Complainant.

- 6.13 The Complainant also relies on paragraph 5.1.3 of the Policy in support of an Abusive Registration namely that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Names are part of that pattern.
- 6.14 I do not consider the Complainant can rely on the Respondent's registration of the other domain names which incorporate the MONCLER mark for the purpose of paragraph 5.1.3 of the Policy. The Complainant also relies on the domain names coachbagsale.info, nikesellhot.com, niketokyo.com, coachhandbagssale.com, tiffanynewarrival.com and ylselljp.com and the use of these domain names. However, the Complainant has provided no evidence in support, for example WHOIS details to establish ownership of these domain names and their registration dates or print-outs of the web sites at these domain names. As paragraph 18.1 of the Policy makes clear it is the responsibility of the parties' to support submissions with appropriate evidence and in the ordinary course an Expert will not perform any research into a dispute or check the parties' assertions. I therefore do not consider the Complainant has established that paragraph 5.1.3 of the Policy applies.

7. Decision

- 7.1 I find that the Complainant has Rights in a name or mark which is similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are an Abusive Registration.
- 7.2 I therefore direct that the Domain Names be transferred to the Complainant.

Patricia Jones

Dated 15 May 2017