

DISPUTE RESOLUTION SERVICE**D00018609****Decision of Independent Expert**

Moncler S.p.A.

and

Ndiaye Therese

1. The Parties:

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

Respondent: Ndiaye Therese
80 Rue Saint Pierre
Metz 57000
France

2. The Domain Names:

monclerblackfriday.co.uk
monclercyber.co.uk
monclerukoutlet.co.uk
outletmoncleruk.co.uk
outletukmoncler.co.uk

3. Procedural History:

The Expert has confirmed that (1) he is independent of each of the parties; and
(2) to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need to be disclosed because they might be of such a nature as to

call into question his independence in the eyes of one or both of the parties.

03 March 2017 11:55 Dispute received
06 March 2017 12:55 Complaint validated
06 March 2017 13:06 Notification of complaint sent to parties
23 March 2017 01:30 Response reminder sent
28 March 2017 11:21 No Response Received
28 March 2017 11:21 Notification of no response sent to parties
03 April 2017 12:11 Expert decision payment received

This Complaint was submitted after 1 October 2016, therefore Version 4 of the DRS Policy applies.

4. Factual Background

The Complainant is a leading luxury outerwear and sportswear brand, with worldwide sales of €880 million at the end of 2015.

The Respondent is an individual with an address in Metz, France, who registered the five Domain Names between 8 and 28 November 2016. The Domain Names are redirected to websites using the Complainant's trademarks, and images apparently taken from the Complainant's official advertising, offering products purporting to come from the Complainant.

The Complainant's representatives sent a cease and desist letter and a reminder to the Respondent in January 2017, but received no response.

5. Parties' Contentions

The Complainant Rights

Since its first establishment in 1952 in Grenoble, the Complainant has developed its business under the trademark MONCLER from initially making equipment for mountain expeditions, to sportswear (including skiing apparel) in the 1960s, and fashion in the 1980s, and ultimately to being indisputably recognised as a luxury brand for sportswear. Its worldwide sales at the end of 2015 were about €880 million, of which nearly €268.5 million were in Europe. Its worldwide annual advertising

spend through television, important international magazines and other media was more than €57.8 million. The trademark MONCLER comes from an abbreviation of Monestier-de-Clermont, an Alpine town near Grenoble. The Complainant has extensive registrations of its trademark MONCLER dating back to 1963, and uses the mark in more than 100 countries. It has also registered a portfolio of more than 1,200 domain names identical to or containing MONCLER, including moncler.com, which is used for the Complainant's main website, www.moncler.com, to which most of its other domain names are redirected. The Complainant's business operates through two primary sales channels, retail (with mono-brand stores managed directly by the Complainant) and wholesale (with mono-brand or multi-brand stores managed by third parties). The Domain Names are five out of a total of more than 150 domain names registered by the Respondent encompassing the trademark MONCLER. The Complainant says that the descriptive or generic terms added by the Respondent to its trademark within the Domain Names can be disregarded, as can the ccTLD. "Black friday", "cyber", "uk", and "outlet" do not distinguish the Domain Names from the trademark MONCLER in any way, but instead are apt to reinforce the likelihood of confusion for internet users. Therefore, the Domain Names are confusingly similar to the trademark MONCLER, in which the Complainant has Rights.

Abusive Registration

In common with most of the more than 150 domain names registered by the Respondent containing the trademark MONCLER, the Domain Names are redirected to websites which publish the Complainant's figurative trademarks, and some images taken from the Complainant's official advertising. The websites do not carry any form of disclaimer of non-affiliation with the Complainant. However, the Respondent has been offering for sale on the websites unauthorised products under the trademark MONCLER at heavily discounted prices, circumstances suggesting that the products are likely to counterfeit. Some of the products are not even available on the Complainant's website, reinforcing the belief that the products are not genuine. The websites also contain a brief history of the Complainant and its products, and use the same "Privacy Policy" text which appears on the Complainant's www.moncler.com website, even giving the Complainant's address. The Respondent is not authorised in any way to use the Complainant's trademark MONCLER.

Cease and desist correspondence in January 2017 was not responded to, and in the case of a delivery of the correspondence sent to the postal address given by the Respondent, was not deliverable.

The use of the Domain Names is likely to confuse people or businesses into believing that they are registered to, operated by or authorised by, or otherwise connected with the Complainant (paragraph 5.1.2 of the DRS Policy), given that the websites generate the impression that they are the Complainant's dedicated and official websites. The use is also primarily for the purposes of unfairly disrupting the Complainant's business (paragraph 5.1.1.3 of the Policy). The Complainant has no control over the websites, although it is likely to suffer if anything goes wrong. The likelihood that what is being offered for sale is in fact counterfeit is significant in this respect.

The Respondent has used a fictitious postal address for the registration of the Domain Names, which can be an indication of bad faith under paragraph 5.1.4 of the Policy.

The Respondent is also engaged in a pattern of registrations under paragraph 5.1.3 of the Policy. As well as the other MONCLER domain names already referred to, the Respondent has registered several other domain names containing well-known trademarks of third parties, such as *nikejordanjp.com*, *saintlaurentvip.com*, *asicstokyo.com*, *williamhillgroup.com*, *laboutinpaschersoldes.com*, *adidasonlineuk.com* and others. The Respondent has already had one DRS decision against her in DRS 12014, *dressescoast.co.uk*.

The Complainant will be taking or has already taken administrative action in respect of all the other MONCLER domain names registered by the Respondent.

It is beyond dispute that the Respondent must have known of the Complainant when the Domain Names were registered. Not only is the name MONCLER not generic, but the trademark is a highly distinctive and well-known one. The fact that such a large number of registrations were made containing the MONCLER trademark makes it inconceivable that the Respondent was not aware of the existence of the Complainant's trademark registrations for MONCLER. Therefore, the Complainant says that the registration of the Domain Names was in bad faith and abusive.

The Complainant seeks transfer of the Domain Names to itself.

The Respondent

The Respondent has not responded to the Complaint.

6. Discussions and Findings

In order to succeed in its Complaint, in accordance with the Policy, the Complainant needs to establish (in respect of each Domain Name):

*"i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration."*

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is as follows:

"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".*

The definition of Rights under the Policy is as follows:

"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."

Rights

The Complainant has clearly established the extent of its reputation and registered trademark rights in the name or mark MONCLER, and the Expert agrees that the addition of the non-distinctive terms "Black friday", "cyber", "uk", and "outlet" do not distinguish the Domain Names from the trademark. The ccTLD suffix can also be disregarded. Therefore, the Complainant has Rights in the name or mark MONCLER which is similar to the Domain Names.

Abusive Registration

Paragraph 5 of the Policy provides as follows, in relation to Abusive Registration:

"A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

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;

5.1.2 Circumstances indicating that the Respondent is using or is threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate 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 Name is part of that pattern;

5.1.4 It is independently verified that the Respondent has given false contact details to us;..."

Paragraph 8 of the Policy provides a non-exhaustive list of factors which may be evidence that a domain name is not an Abusive Registration. However, although those have been addressed in the negative in the Complaint, this Complaint is undefended, and the Respondent cannot therefore hope to avail herself of those factors. The Expert therefore considers that it is not necessary to spend time dealing with them.

Although the Complaint is undefended, the Complainant still needs to make out at least a prima facie case as to Abusive Registration, in order to succeed on the balance of probabilities. In the Expert's opinion, the Complainant has done far more than meet that basic test, and the merits of the Complaint are overwhelmingly in its favour. The websites to which the Domain Names are redirected are clearly designed to give the impression

that they are connected to the Complainant, when they are not, and indeed may well be offering for sale products which are counterfeit. Moreover, the registrations in this case are clearly part of a much wider (and cynical) plan on the part of the Respondent to try to take advantage of the Complainant's brand, of which the Respondent must have been aware when she registered the Domain Names. The Respondent cannot have had any conceivable legitimate or genuine reason for doing so, and was clearly acting in bad faith.

The Expert fully agrees with the Complainant's contentions in respect of paragraphs 5.1.2 (confusion) and 5.1.1.3 (unfair disruption) of the Policy, which are effectively the substance of the Complainant's case. It would seem likely that the Complainant's contentions as to a pattern of registrations (paragraph 5.1.3) are also made out on the balance of probabilities, given the use of third party trademarks, which seems to be similar to the misuse of the Complainant's trademark in this case. As to false contact details (5.1.4) the Expert is not persuaded on that ground, as there does not seem to be independent verification. However, this last point is relatively unimportant compared to the substance of the Complaint which is entirely in the Complainant's favour.

Therefore, the Complaint succeeds.

7. Decision

The Expert finds that the Complainant has Rights in the name or mark MONCLER, which is similar to the Domain Names, and that the Domain Names in the hands of the Respondent are Abusive Registrations. The Expert therefore directs that the Domain Names be transferred to the Complainant.

Signed Bob Elliott
...13 April 2017

Dated