

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE
(Beijing Office)
ADMINISTRATIVE PANEL DECISION
Case No. CN-1200537

Complainant: G & P NET S.P.A.
Respondent: tele
Domain Name: peutereyuomo.com
Registrar: Godaddy.com, Inc.

1. Procedural History

On 20 January 2012, the Complainant submitted a complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Center (“the ADNDRC Beijing Office”) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (“the Policy”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“the ADNDRC Supplemental Rules”).

On 20 January 2012, the ADNDRC Beijing Office sent to the Complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Beijing Office Supplemental Rules.

On 21 January 2012, upon request by the ADNDRC Beijing Office, the Registrar transmitted by email to the ADNDRC Beijing Office its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 20 February 2012, the ADNDRC Beijing Office transmitted the complaint to the Respondent. On the same day, the ADNDRC Beijing Office notified the Respondent about the commencement of the proceedings and the ADNDRC Beijing Office also notified the

Complainant that the complaint had been confirmed and transmitted to the Respondent, and also notified ICANN and the Registrar of the commencement of the proceedings.

The Respondent had not filed a response within the stipulated time. On 12 March 2012, the ADNDRC Beijing Office sent out notice that no response had been received and the complaint were to be proceeded to a decision by the Panel to be appointed.

Having received a declaration of impartiality and independence and a statement of acceptance, the ADNDRC Beijing Office notified the parties, on 26 March 2012, that the Panel in this case had been appointed, with Mr. Gary Soo (苏国良 'Mr. Su Guoliang') acting as the sole panelist.

On 26 March 2012, the Panel received the file by email from the ADNDRC Beijing Office and was requested to render the Decision on or before 9 April 2012.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the administrative proceedings shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceedings. The language of the current disputed domain name registration agreement is English, thus the Panel determines English as the language of the proceedings.

2. Factual Background

The Complainant

The Complainant in this case is G & P NET S.P.A. The registration address is VIA PROVINCIALE, DEL BIAGIONI, 55, ALTOPASCIO (LUCCA), ITALY. The Complainant appointed FU Haiying and WANG Xiao, the address of which being at 20th Floor, East Tower, World Financial Centre, No. 1 Dongsanhuan Zhonglu, Chaoyang District, Beijing, 100020, China, as its authorized representative in this matter.

The Respondent

The Respondent, tele, is the current registrant of the disputed domain name <peutereyuomo.com> according to the Whois information. The address of the Respondent from the registration information is “uomouomouomouomo uomo uomo 674353, China”. The Respondent’s email is peutereyuomo@hotmail.com.

3. Parties’ Contentions

The Complainant

According to the Complainant, the Complainant is the owner of the “PEUTEREY” trademark (Registration No.: G646277 Class: 25 Goods designated: Clothing, shoes and headgear & Period of Validity: November 3, 2006 to November 3, 2015) and the “PEUTEREY & Device” trademark (Registration No.: G850742 Class: 25 Goods designated: Men’s clothing, women’s clothing and children’s clothing including overcoats, short coats, shirts, skirts, shoes, jeans, swimming suits, gloves and slippers, etc. & Period of Validity: May 9, 2005 to May 9, 2015). The Complainant also highlights that it is the legal owner of all the trademarks “PEUTEREY” and “PEUTEREY & Device” which were filed separately for registration before the World Intellectual Property Organization (WIPO) and were successfully extended the protection between 2005 and 2006 in China, and, at present, the trademarks are within the period of validity.

The Complainant submits that the Complainant’s brand “PEUTEREY” founded in Italy since 1991 is an affiliated brand of the top outer door clothing brand “GEO SPIRIT” and enjoys high reputation in European market. The Complainant produces documents to show that online searches of “PEUTEREY” via Google show that there are over 5, 000 search results and the top-20 search results are all directly related to the Complainant and its brand. According to those websites, the Complainant says, “PEUTEREY” is notably called as “Italian top brand” and “Italian luxury brand” by all kinds of fashion forums and online shops. Besides, the Complainant notes that, on Taobao.com the biggest Chinese e-commerce platform, the photos of the products bearing the trademarks

“PEUTEREY” and “PEUTEREY & Device” can be frequently seen. The Complainant asserts that all the above adequately certifies that the prior marks “PEUTEREY” and “PEUTEREY & Device” of the Complainant are well recognized in China and enjoy high reputation and great effect among the related public.

The Complainant submits that the prominent part of the disputed domain name “peutereyuomo” is similar to the trademarks, for which the Complainant owns prior rights and, as mentioned above, “PEUTEREY” is the Complainant’s trademark which enjoys high reputation in world fashion industry. The Complainant believes that, when seeing “PEUTEREY”, Chinese consumers will directly associate it with the Complainant and its products.

The Complainant explains that the prominent part of the disputed domain name “peutereyuomo” incorporates two words “peuerey” and “uomo”. “Peuerey” is identical with the Complainant’s famous mark “PEUTEREY” while “uomo” means “man; mankind” in Italian and notes furthermore that the most products sold on website www.peutereyuomo.com are clothes, which are bearing the Complainant’s trademarks “PEUTEREY” and “PEUTEREY & Device”. In view of the above, the Complainant says that consumers will easily misunderstand the disputed domain name as owned by or related to the Complainant’s company and click it to browse and, therefore, the registration and use of the disputed domain name will inevitably cause consumers’ confusion.

The Complainant’s the trademarks “PEUTEREY” and “PEUTEREY & Device” have successfully obtained the extension protection in China respectively in 2005 and 2006. According to the Complainant’s search on the official website of the China Trademark Office and main search engines, the Respondent has no civil rights or legitimate interests in respect of “PEUTEREY”. In addition, the Complainant has never authorized the Respondent to use any trademarks related to “PEUTEREY” or to register “peutereyuomo” as a domain name. Therefore, the Complainant submits that the Respondent has no civil rights or legitimate interests in respect of “peutereyuomo”.

The Complainant also submits that the disputed domain name was registered and is being used in bad faith, for the following reasons:

(a) As mentioned foresaid, after logging www.peutereyuomo.com, the Complainant notices that it is selling clothes such as jackets, down coats and outer coats etc., which are bearing the Complainant's trademarks "PEUTEREY" and "PEUTEREY & Device".

(b) As a matter of fact, the Complainant has never authorized or licensed the above website to use "PEUTEREY" and "PEUTEREY & Device" in any forms. Furthermore, through verification, the Complainant confirmed that those products sold on the website are not manufactured by the Complainant. It means that the website is selling the counterfeit products, which have infringed the trademark rights of the Complainant. In addition, the Complainant has published a statement on their website claiming that the genuine products are just sold in authorized shops instead of online.

(c) Therefore, it is obvious that the Respondent registered the disputed domain name intentionally so that could take advantage of the high reputation of the Complainant's famous trademark and products to obtain unjustifiable commercial interests by selling the counterfeit products on the said website. The act of the Respondent's registering the disputed domain name to obtain unjustifiable commercial interests will easily cause the confusion of the source of the products among the consumers. Such acts will damage not only the interests of the Complainant but also the benefits of the consumers. Therefore, the Respondent's registration and use of the disputed domain name is obviously in bad faith and should be stopped.

(d) According to the above, the Respondent's registration of the disputed domain name is in bad faith as prescribed in 4(b)(ii) and (iv) of the Policy, which reads "you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name" and "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship,

affiliation, or endorsement of your web site or location or of a product or service on your web site or location". According to the above provisions, the Complainant earnestly requests the Panel to rule that the Respondent shall transfer the domain name to the Complainant to protect the legitimate rights and interests of the Complainant and to ensure the competition order in the market.

In the premises, the Complainant asks for the transfer of the disputed domain name to the Complainant.

The Respondent

The Respondent has not submitted a response.

4. Findings

Paragraph 14 of the Rules provides that, in the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by the Rules or the Panel, the Panel shall proceed to a decision on the complaint; and that, if a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

Paragraph 15(a) of the Rules instructs the Panel as to the principles that the Panel is to use in determining the dispute, stating that the Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

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

(1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the 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.

Identity or Confusing Similarity

The Complainant submits various documents to show that the Complainant's brand and trademark "PEUTEREY" enjoy high reputation in European market and are also known in the Chinese market and that the trademarks "PEUTEREY" and "PEUTEREY & Device", owned by the Complainant, are registered respectively in China in 2006 and 2005 as regards outer door clothing. The Panel notices that such registrations were made prior to the registration of the disputed domain name. On the other hand, the Respondent did not respond or dispute the rights of the Complainant over these marks.

In the circumstances, the Panel finds that the Complainant has succeeded in establishing the necessary rights over these marks as required under Paragraph 4(a) of the Policy.

In the disputed domain name <peutereyuomo.com>, the Panel accepts that the ".com" part is the generic top level domain name for company. Noting that "peutereyuomo" itself is not a word/phase within the daily use of vocabulary and that the part "uomo" is more commonly read to mean "man; mankind" in Italian, the Panel agrees that the wording "uomo" is used as an adjective to describe "man; mankind" of the "peuterey" brand/mark. Therefore, the Panel is of the view the main distinctive part in the disputed domain name is "peuterey". There being so, "peuterey" is obviously identical to these marks in which the Complainant has rights.

In the premises, the Panel finds that the Complainant has successfully established that the disputed domain name <peutereyuomo.com> is confusingly similar to these marks in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has succeeded in proving the element in Paragraph 4(a)(1) of the Policy as regards <peutereyuomo.com>.

Rights or Legitimate Interests of the Respondent

The Complainant submits that the Respondent has no such rights or legitimate interests necessary under the Policy as regards the disputed domain name. The Complainant made clear that the Respondent has never been authorized by the Complainant to use any of these marks. To this, the Respondent does not deny or provide evidence to the contrary.

From the name of the Respondent, the Panel does not see any rights of the Respondent over the disputed domain name <peutereyuomo.com> or its main distinctive part, i.e. “peuterey”. Also, taking into account that neither “peuterey” or “peutereyuomo” is in the daily use of language, that the Respondent did not explain why it has rights to register this disputed domain name, and that the Complainant has trademark rights over the “PEUTEREY” and “PEUTEREY & Device” marks, the Panel finds that the Complainant has succeeded in proving the element in Paragraph 4(a)(2) of the Policy.

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name; or
- (ii) The Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the domain name primarily for the purpose disrupting the business of a competitor; or

(iv) By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

The Panel notices that, from the printouts of the websites, the Respondent is using the disputed domain name to offer clothes such as jackets, down coats and outer coats etc., which are bearing the Complainant's trademarks "PEUTEREY" and "PEUTEREY & Device". The Complainant highlights that through verification, the Complainant confirms that those products sold on the website are not manufactured by the Complainant and it means that the website is selling the counterfeit products, which have infringed the trademark rights of the Complainant. To this, no response has been submitted by the Respondent. The Panel notes, while doubting its accuracy, that the address of the Respondent as indicated in the domain name registration information is apparently in China and that the Complainant's marks have been put to use throughout the world and in China.

From all these, it seems clear to the Panel that the Respondent was well aware of the Complainant's rights in this regard when registering and using this disputed domain name. By doing this, the Panel finds that the registration and use of the disputed domain name were and are with bad faith and believes that the purpose is for using the domain name to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website.

Therefore, the Panel also finds that the Complainant has succeeded in proving the elements in Paragraph 4(a)(3) of the Policy as regards <peutereyuomo.com>.

5. Decision

Having established all three elements required under the Policy in respect of the disputed domain name <peutereyuomo.com>, the Panel concludes that relief should be granted in favour of the Complainant. Accordingly, the Panel decides and orders that the disputed domain name <peutereyuomo.com> shall be transferred to the Complainant G & P NET S.P.A..

Sole Panelist: 蔡国良

Dated: 9 April 2012