

ADMINISTRATIVE PANEL DECISION

Carolina Herrera, Ltd. v. Roberson Martins Modesto, Cine Pictures
Entertainment

Case No. D2022-4611

1. The Parties

The Complainant is Carolina Herrera, Ltd., United States of America, represented by Neudomains Digital SL, Spain.

The Respondent is Roberson Martins Modesto, Cine Pictures Entertainment, Brazil.

2. The Domain Name and Registrar

The disputed domain name <carolinaherrera.shop> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 2, 2022. On December 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 5, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Registrant: Status: removed) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 9, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On December 19, 2022, the Respondent sent an informal email communication to the Center. The Complainant filed an amendment to the Complaint on December 28, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 18, 2023.

On December 29, 2022 and January 2, 2023, the Respondent sent two other informal email communications to the Center, suggesting, *inter alia*, to transfer the disputed domain name to the Complainant. On January 5, 2023, the proceeding was suspended at the Complainant's request. On January 6, 2023 and February 6, 2023, the Respondent sent further informal email communications to the Center.

On February 8, 2023, the suspension of the proceeding was extended to March 6, 2023, upon the Complainant's request. On February 24, 2023, the Respondent again sent an informal email communication to the Center regarding the transfer of the disputed domain name. On March 7, 2023, the suspension of the proceeding was further extended to April 6, 2023. On April 12, 2023, the proceeding was reinstated. On May 2, 2023, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Mihaela Maravela as the sole panelist in this matter on May 11, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a North American company active in the fashion sector. It has more than 150 stores throughout the world.

The Complainant has registered various trademarks consisting of or including CAROLINA HERRERA, such as the International Trademark Registration for CAROLINA HERRERA (word), registered under No. 899878 as of May 15, 2006.

The disputed domain name was registered on November 12, 2022 and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant argues that disregarding the ".shop" generic Top-Level Domain ("gTLD") as an essential element of any domain name, the disputed domain name is identical to its CAROLINA HERRERA trademark.

With respect to the second element, the Complainant argues that it has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. There is no indication that the Respondent has made any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services or for legitimate noncommercial or fair use. The disputed domain name does not resolve to an active website. The mere holding of a domain name does not establish rights or legitimate interests in the domain name. There is no evidence that the Respondent has ever been commonly known by the disputed domain name or the trademark CAROLINA HERRERA, or that the Respondent owns any prior rights in the name or trademark CAROLINA HERRERA.

As regards the third element, the Complainant argues that given the reputation and recognition of the CAROLINA HERRERA trademarks due to their longstanding, intensive and widespread use, the Respondent had to be fully aware of the existence of the Complainant and its trademarks when registering the disputed domain name. While the disputed domain name does not resolve to an active website, the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. In this case, the Complainant argues there is no conceivable good faith use to which the Respondent could put the disputed domain name that would not infringe the Complainant's trademarks. The Respondent used a privacy service. In light of the overall circumstances, it can only be concluded that the underlying beneficiary is using a privacy service to conceal its identity, which adds to the evidence of bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions.

6. Discussion and Findings

In the informal submissions made by the Respondent it appears to have consented to the transfer of the disputed domain name. However, given the circumstances of the case, particularly the fact that despite the repeated suspension of the proceedings the Respondent has failed to take the necessary steps for the transfer, and the Complainant has asked for the proceedings to be reinstated and hence for a recorded decision and also the fact that the Respondent seems to have denied in its initial informal submissions the Complainant's allegations and its own bad faith, the Panel will proceed to a decision on the merits. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), Section 4.10.

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (iii) the disputed domain name has been registered and is being used in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, the Complainant must prove that it has rights to a trademark, and that the disputed domain name is identical or confusingly similar to that trademark. This first element under the Policy functions primarily as a standing requirement. [WIPO Overview 3.0](#), section 1.7.

The Complainant has provided evidence of its rights in the CAROLINA HERRERA trademarks by providing evidence of its trademark registrations.

As regards the second limb of the first element, the test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name. It is well-established that the gTLD, in this case ".shop" may be ignored when assessing the confusing similarity between the disputed domain name and the Complainant's trademarks. Only the second-level portion of the disputed domain name is taken into consideration.

The disputed domain name incorporates the CAROLINA HERRERA trademark in its entirety without any addition. It is, therefore, identical to the trademark in which the Complainant has rights.

The Panel finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in

order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)). In the present case the Complainant has established a *prima facie* case that it holds rights over the trademark CAROLINA HERRERA, and that the Respondent has no legitimate reason to acquire the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraphs 4(c)(i) and (iii) of the Policy. Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because he did not formally respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(ii) of the Policy, the Complainant must prove that the disputed domain name was registered and is being used in bad faith.

According to the un rebutted assertions of the Complainant, its CAROLINA HERRERA trademarks were widely used in commerce well before the registration of the disputed domain name in November 2022 and are reputed. The disputed domain name is identical to the Complainant's trademark. Under these circumstances, it is most likely that the Respondent was aware of the Complainant's trademark at the registration date of the disputed domain name.

As regards the use, the disputed domain name is passively held.

Section 3.3 of the [WIPO Overview 3.0](#) describes the circumstances under which the passive holding of a domain name will be considered to be in bad faith: "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put."

The Panel finds that passive holding of the disputed domain name does not in the circumstances of this case prevent a finding of bad faith. There is no evidence in the record of a legitimate use of the disputed domain name. The trademark of the Complainant is distinctive and widely used in commerce. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

Moreover, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good faith use and indeed none would seem plausible. Considering all the above, it is not possible to conceive any plausible actual or contemplated good- use of the disputed domain name by the Respondent.

The panel also notes the offer to sell for USD 20,000 and the delay tactics in the face of a supposed willingness to settle – these point to clear bad faith.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <carolinaherrera.shop>, be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: May 25, 2023