

ADMINISTRATIVE PANEL DECISION

Skorpio Limited v. Web Commerce Communications Limited Case No. D2023-4859

1. The Parties

The Complainant is Skorpio Limited, Switzerland, represented by Keltie LLP, United Kingdom.

The Respondent is Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <rickowensmexico.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 22, 2023. On November 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 24, 2023, 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 (Respondent unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 24, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on November 27, 2023.

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 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 3, 2024.

The Center appointed Reyes Campello Estebarez as the sole panelist in this matter on January 5, 2024. 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 company incorporated in Switzerland that manages the intellectual property rights of the American fashion designer Rick Owens. Rick Owens began his fashion design career in Los Angeles, United States of America ("United States") in 1994. Worldwide distribution of his products started in 2001 after moving production to Italy, including through retail boutique stores in Paris, New York, London, Seoul, Tokyo and Hong Kong, China. The Complainant further commercializes its products online at its official website "www.rickowens.com". Rick Owens has achieved various fashion awards with international press coverage and his clothing designs are worn by many celebrities.

The Complainant owns numerous trademark registrations for the RICK OWENS brand, including:

- European Union Trade Mark Registration No. 002493294, RICK OWENS (figurative), registered on May 21, 2003, for goods in classes 3, 9, 14, 18 and 25;
- United States Trade Mark Registration No. 2857230, RICK OWENS (figurative), registered on June 29, 2004, for goods in classes 3, 9, 14, 18 and 25;
- Chinese Trade Mark Registration No. 6162781, RICK OWENS (figurative), registered on August 7, 2014, for goods in class 25; and
- Mexican Trade Mark Registration No. 1281009, RICK OWENS (word), registered on April 23, 2012, for goods in class 25.

The aforementioned trademark registrations will collectively be referred to as the "RICK OWENS mark".

Prior decisions under the Policy have recognized the international reputation of the fashion designer Rick Owens and the RICK OWENS mark.¹

The disputed domain name was registered on March 15, 2022, and it is currently apparently inactive resolving to an Internet browser error message. According to the evidence provided by the Complainant, the disputed domain name has previously resolved to a website in Spanish language that reproduced at its heading the RICK OWENS mark (with the same graphic representation registered by the Complainant), and purportedly commercialized products bearing the RICK OWENS mark, e.g., sneakers, showing their prices in Mexican pesos.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is nearly identical to the RICK OWENS mark, and the additional term "Mexico" reinforces the impression that the disputed domain name is the Complainant's official Mexican website. The Respondent has no rights or legitimate interests in respect of the disputed domain name, as it is not authorized to use the RICK OWENS mark, not commonly known as "Rick Owens", and does not own any registered rights in any trademarks that comprise this name.

¹See, e.g., *Skorpio Limited v. Robert Pascal*, WIPO Case No. [D2017-0908](#); *Skorpio Limited v Ma Liang*, WIPO Case No. [D2012-2045](#); *Skorpio Limited v. Milen Radumilo*, WIPO Case No. [D2018-0368](#); *Skorpio Limited v. Domain Admin, Privacy Protect, LLC PrivacyProtect.org)/Philipp Wulf, Philipp Wulf*, WIPO Case No. [D2022-1488](#); and *Skorpio Limited v. Wang Xin Zhong*, WIPO Case No. [D2018-0439](#).

The disputed domain name was registered and is being used in bad faith. At the date of the registration of the disputed domain name, the RICK OWENS mark was already well-known. The disputed domain name was registered targeting the RICK OWENS mark, and it has been used to offer for sale counterfeit replicas of genuine products at a fraction of their genuine price. The Respondent has tried to capitalize on consumer recognition of the RICK OWENS mark for selling counterfeit products.²

B. Respondent

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

The Center received various automatic email communications in response to the notifications related to the proceeding. These automatic responses indicated, "Someone from our customer service team will review it and respond shortly", but no further response was received.

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy, namely the RICK OWENS mark. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the RICK OWENS mark is reproduced within the disputed domain name adding the geographical term "Mexico". Accordingly, this trademark is recognizable within the disputed domain name the disputed domain name is confusingly similar to this mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here the geographical term "Mexico", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task

² The Complainant provides evidence of a comparison of prices for a shoe offered for sale at the Respondent's website for MXN 1,356 (approximately EUR 73), and the same product offered for sale at the Complainant's official website for EUR 165.

of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a strong *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes the disputed domain name is currently apparently inactive and it resolves to an Internet browser error message. However, this current apparent passive holding of the disputed domain name does not cure its prior use. According to the evidence provided by the Complainant, the disputed domain name has previously resolved to a website in Spanish language addressed to the Mexican market (with prices in Mexican pesos) that purportedly offered for sale RICK OWENS products at much discounted prices (less than half of their genuine prices at the Complainant’s official website).

The Panel further notes that the said website did not indicate its lack of relationship with the Complainant, and imitated the design, color combination, and general look and feel of the Complainant’s official website at “www.rickowens.com”. In this respect, the Panel, under its general powers, has consulted the Complainant’s official website and has compared its design and general appearance with the evidence provide by the Complainant of the Respondent’s website.

It is further to be noted that the composition of the disputed domain name implies an affiliation with the RICK OWENS mark. The incorporation of this trademark followed by the geographical term “Mexico” suggests an affiliation with the Complainant and its trademark indicating that it may probably be referred to its official website for the Mexican market.

The Panel further considers remarkable that the Respondent has not rebutted the Complainant’s allegations not providing any evidence related to any rights or legitimate interests in the disputed domain name. The Respondent’s reaction to the Complaint seems to be stop using the disputed domain name, which implies an acceptance of its lack of rights or legitimate interests.

The evidence on the record provided by the Complainant further allows the Panel to find, on a balance of probabilities, that the products purportedly commercialized in the Respondent’s website were probable counterfeits. Their much-discounted prices (less than half) of the genuine product’s prices indicates they were not genuine products. Panels have held that the use of a domain name for illegal activity here claimed sale of counterfeit goods can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Therefore, based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the RICK OWENS mark is international well-known and the Complainant’s business has a strong presence over the Internet.

Based on the available record, the Respondent's website (previously linked to the disputed domain name), imitated the design, colors and general appearance or look and feel of the Complainant's official website, and reproduced at its heading the RICK OWENS mark (with the same graphic representation registered and used by the Complainant). Furthermore, the Respondent's website purportedly offered for sale RICK OWENS products at less than half of their normal prices.

The Panel finds that these circumstances indicate that the disputed domain name was registered and has been used in bad faith targeting the Complainant and its RICK OWEN mark for a commercial revenue. These circumstances further indicate, on a balance of probabilities, that the Respondent has used the disputed domain name to illegally offer and commercialize probable counterfeit products or unauthorized replicas of the Complainant's designs, which constitutes bad faith under the Policy. Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Additionally, regarding the current apparent non-use of the disputed domain name, panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. In this respect, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Therefore, having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy, and the Complainant has established the third element of the Policy.

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 <rickowensmexico.com> be transferred to the Complainant.

/Reyes Campello Estebaranz/

Reyes Campello Estebaranz

Sole Panelist

Date: January 19, 2024