

## **ADMINISTRATIVE PANEL DECISION**

Van Cleef & Arpels S.A. v., Domains By Proxy, LLC, DomainsByProxy.com /  
志斌 谢 (Zhibin Xie)  
Case No. D2022-1673

### **1. The Parties**

The Complainant is Van Cleef & Arpels S.A., Switzerland, represented by SILKA AB, Sweden.

The Respondent is Domains By Proxy, LLC, DomainsByProxy.com, United States of America / 志斌 谢 (Zhibin Xie), China.

### **2. The Domain Name and Registrar**

The disputed domain name <vancleefarpels-outlet.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 9, 2022. On May 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 10, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 11, 2022, 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 May 11, 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 May 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 17, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on July 1, 2022. 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 sells luxury watches, jewelry and perfumes around the world through a network of boutiques and authorized retailers. The Complainant owns multiple trademark registrations in multiple jurisdictions, including the following:

- VAN CLEEF & ARPELS, United States, No. 1445858, registered on July 07, 1987
- VAN CLEEF & ARPELS, United States, No. 971523, registered on October 23, 1973
- VAN CLEEF & ARPELS, China, No. 635247, registered on April 27, 1995
- VAN CLEEF & ARPELS, China, No. 649073, registered on December 21, 1995

The Complainant provided evidence that on March 13, 2022, the disputed domain name resolved to a website offering jewelry under the Complainant's trademark and that on May 6, 2022, the disputed domain name resolved to a blank page requesting logging including user name and password blank boxes.

The disputed domain name was registered on May 13, 2021.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant claims that it is the owner of more than 200 trademarks VAN CLEEF & ARPELS registered worldwide, amongst others in the United States and China, all of them predating the registration of the disputed domain name.

The Complainant submitted that it operates an official website at "www.vancleefarpels.com", featuring information about its products and provided evidence that it is also present in the most important social networks, such as Instagram, Twitter, Pinterest and LinkedIn.

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that:

- the Complainant's registered trademark is famous;
- where a domain name incorporates a trademark in its entirety, such domain name will normally be considered confusingly similar to that trademark and that the mere addition of the suffix "outlet" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark;
- the generic Top-Level Domain ("gTLD") ".com" is disregarded for the purpose of this analysis since it is considered a technical requirement.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant states the Respondent should be considered as not having legitimate interests in respect of the disputed domain name and submitted that:

- it has not found that the Respondent is commonly known by the disputed domain name and there is no evidence that the Respondent has a history of using or preparing to use the disputed domain name in connection with a *bona fide* offering of goods and services;
- the intention of the Respondent by registering the disputed domain name is to prevent the Complainant from exercising its legitimate rights over the well-known VAN CLEEF & ARPELS trademarks;
- the Respondent chose the disputed domain name in an effort to capitalize on the Complainant's famous trademark, and that this cannot be considered a use in connection with a *bona fide* offering of goods or services;
- the Respondent is not clearly identified but purportedly located in the United States and it used the disputed domain name in connection with the unauthorized promotion and sale of the Complainant's jewelry;
- the Respondent has no rights or legitimate interests in the disputed domain name because the Complainant has not granted authorization or license to the Respondent to use the VAN CLEEF & ARPELS trademarks, and it is not an authorized reseller;
- there is no business or legal relationship between the Complainant and the Respondent since the Respondent is not one of the Complainant's authorized retailers or resellers within any territory.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Complainant's VAN CLEEF & ARPELS trademarks enjoy an extensive reputation among the jewelry making business and have been continually and extensively used and marketed for the last century;
- as a result of these extensive marketing activities the products of the Complainant under VAN CLEEF & ARPELS trademarks have gained recognition and reputation;
- it is therefore clear that at the time of the registration of the disputed domain name, the Respondent was well aware of the VAN CLEEF & ARPELS trademarks;
- the disputed domain name currently redirects to a blank page requesting logging including user name and password blank boxes but was also used to resolve to a website which offered the Complainant's products at a discounted price displaying the VAN CLEEF & ARPELS trademarks and billing itself as an "Van Cleef & Arpels Outlet Official Website";
- it is obvious that the use of the disputed domain name suggests an affiliation with the Complainant in order to attract consumers and offer counterfeit or at least, unauthorized products and such use of a website for offering counterfeit goods is bad faith use:

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

#### **A. Identical or Confusingly Similar**

The Complainant has demonstrated that it owns multiple trademark registrations for the mark VAN CLEEF & ARPELS in the United States, China and many other countries prior to the registration of the disputed domain name on May 13, 2021.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases. (See sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In this case, the disputed domain name contains the Complainant's trademark in its entirety and only differs from the Complainant's trademark VAN CLEEF & ARPELS by the addition of the term "outlet". The Panel finds the addition of such term to the Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)).

Furthermore, it is well accepted under the UDRP case law that the specific generic Top-Level Domain ("gTLD") designation such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#), section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant's VAN CLEEF & ARPELS trademarks.

#### **B. Rights or Legitimate Interests**

Pursuant to Paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

"(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the domain name, even if [the Respondent has] acquired no trademark or service mark rights; or

(iii) [the Respondent is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Complainant has asserted that it has not authorized the Respondent to register or use the disputed domain name and presented evidence that on May 6, 2022, the disputed domain name resolved to a blank page requesting logging including user name and password blank boxes and on March 13, 2022, it resolved to a website offering jewelry under the Complainant's trademark and company name.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed domain name. 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.

The Respondent chose not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, it is evident that in light of the level of reputation the Complainant has acquired in its VAN CLEEF & ARPELS marks in connection with the sale of jewelry, the Respondent was aware of the Complainant and its VAN CLEEF & ARPELS mark and has used the disputed domain name in order to impersonate the Complainant and to sell jewelry which the Complainant states to be either counterfeit or "unauthorized" under the Complainant's Van Cleef & Arpels brand. The Panel therefore finds that the Respondent is trading unfairly on the Complainant's well-known and famous VAN CLEEF & ARPELS marks and also the valuable goodwill that the Complainant has established in this trademark, and concludes that the Respondent has not used, or undertaken any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

Likewise, no evidence has been adduced that the Respondent has commonly been known by the disputed domain name; nor, for the reasons mentioned above, is the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

Therefore, for all the above reasons the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name as set forth by paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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 the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Complainant holds multiple trademark registrations for the mark VAN CLEEF & ARPELS that predate the registration of the disputed domain name. The Complainant claims and the Panel accepts that the VAN CLEEF & ARPELS marks is well-known in the sector of jewelry.

Given the degree of reputation of the VAN CLEEF & ARPELS trademarks and the fact that the name VAN CLEEF & ARPELS is so obviously connected with the Complainant and its services it is inconceivable that the Respondent coincidentally selected the disputed domain name without any knowledge of the Complainant and its trademark VAN CLEEF & ARPELS.

The Panel therefore concludes that the Respondent registered the disputed domain name in bad faith.

The Complainant provided a screenshot that shows that on March 13, 2022, the disputed domain name resolved to a blank page requesting logging information including user name and password. In view of the Respondent's lack of explanation of any rights or legitimate interests in the disputed domain name, not coming forward to deny the Complainant's assertions of bad faith, the Panel concludes that this use of the disputed domain name is intended to mislead and attract Internet users to the Respondent's website, and disrupting the Complainant's business, probably for a commercial gain or any other sort of benefit derived from the information obtained through the login form provided in the Respondent's website.

Likewise, the screenshot of March 13, 2022, provided by the Complainant, that shows that the Respondent used of the disputed domain name to resolve to a website advertising and selling jewelry what the Complainant contends to be either counterfeit or at least unauthorized goods, clearly indicates that the Respondent's primary intent was to redirect Internet users to the Respondent's website and thus capitalizing on the goodwill of the Complainant's trademarks .(See *Sanofi-aventis v. Igor Peklov*, WIPO Case No. [D2008-1419](#); see also *Chrome Hearts LLC v. James Hart*, WIPO Case No. [DCC2011-0005](#) ("The fact that counterfeit goods are being sold through this medium indicates that the disputed domain name is being used in bad faith").

Such use of the disputed domain name amounts to bad faith use pursuant to paragraph 4(b)(iv) of the Policy and satisfies the requirement of paragraph 4(a)(iii) that the domain name "is being used in bad faith" by the Respondent.

## 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, <vancleefarpels-outlet.com>, be transferred to the Complainant.

*/Torsten Bettinger/*

**Torsten Bettinger**

Sole Panelist

Date: July 18, 2022