

ADMINISTRATIVE PANEL DECISION

Calvin Klein Trademark Trust and Calvin Klein, Inc. v. rafel bueno de costa
Case No. D2022-3681

1. The Parties

The Complainants are Calvin Klein Trademark Trust, United States of America (“United States”), and Calvin Klein, Inc., United States (hereinafter collectively referred to as “the Complainant”), represented by Kestenberg Siegal Lipkus LLP, Canada.

The Respondent is rafel bueno de costa, Brazil.

2. The Domain Names and Registrar

The disputed domain names <calvinkleindobrasil.com> and <lojascalvinklein.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2022. On October 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 5, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 18, 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 amended Complaint on October 18, 2022.

The Center verified that the Complaint, together with the amended 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 October 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2022. The Respondent sent two email communications to the Center on October 22 and October 24, 2022. No formal response was filed. On November 10, 2022, pursuant to paragraph 6 of the Rules, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on November 23, 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 has been engaged in the production, sale, and licensing of men's and women's apparel, fragrances, accessories, and footwear, among other things.

The Complainant has used the CALVIN KLEIN trademark continuously since at least as early as 1968 and owns the corresponding trademarks registrations in a large number of jurisdictions. For instance, United States Patent and Trademark Office with registration No. 1,633,261 (registered January 29, 1991) and No. 1,086,041 (registered February 21, 1978) for the CALVIN KLEIN trademark.

The Complainant's CALVIN KLEIN products are sold exclusively through Complainant's own retail stores, outlet stores, and web sites including "www.calvinklein.com" and through authorized dealers.

The disputed domain name <calvinkleindobrasil.com> was registered on August 6, 2022, and the disputed domain name <lojascalvinklein.com> was registered on August 24, 2022. The Complainant has submitted evidence showing that the disputed domain names previously resolved to online stores offering for sale Complainant's branded products. Currently, both disputed domain names are inactive.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names incorporate Complainant's CALVIN KLEIN trademark in its entirety with the addition of Portuguese terms "do brasil" and "loja", respectively.

The use of "loja" (meaning "store" in Portuguese), and "do brasil" (meaning "of Brazil" in Portuguese) intensifies the confusion a consumer would experience because the Complainant operates physical and online stores globally, including in Brazil, where consumers can purchase the Complainant's goods.

Previous UDRP decisions have held that the addition of a geographical indicator does not distinguish a disputed domain name from a Complainant's trademark (the Complainant refers to *Bayer AG v. Whoisprotection.cc / Drago Price, Bayer*, WIPO Case No. [D2020-0051](#)).

Accordingly, says the Complainant, the disputed domain names are confusingly similar to the Complainant's mark.

With regard to the second requirement, the Complainant alleges that the Respondent was aware of the Complainant's trademark and websites associated with the same before it registered the disputed domain names because the Complainant's sites were operational, and thus easily accessible to the Respondent, at the time the Respondent registered the disputed domain names.

Furthermore, the Respondent is not affiliated with the Complainant in any way. The Complainant has not authorized the Respondent to use and register its trademarks and service marks, or to seek the registration of any domain name incorporating said mark.

Besides, Respondent's registration of the disputed domain names wholly incorporating a famous mark is not supported by legitimate interests.

Further, says the Complainant, during the checkout process at the websites at the disputed domain names users were prompted to enter their personal information, including their full name, address, telephone number, and email address.

The Respondent has no proprietary rights or legitimate interests in "Calvin Klein" because the Respondent is not using the domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. The disputed domain names resolved to webpages that are blatant copies of the Complainant's official websites and which promote the sale of suspected counterfeit CALVIN KLEIN products without authorization or license from the Complainant.

The Respondent is not commonly known by the disputed domain names. The registrant on record is rafel bueno de costa located in Brazil.

The Complainant asserts that by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites, 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 its website. Indeed, the Respondent is diverting Complainant's customers or potential customers seeking information about the Complainant to websites which were blatant imitations of the Complainant's official webpages and which offered suspected counterfeit CALVIN KLEIN products for sale as part of a suspected phishing scheme.

The Respondent also uses confusingly similar landing pages as the "calvinklein.com" website, featuring a stylized CALVIN KLEIN logo at the top and similar page navigators and image layout.

Finally, the Complainant contends that there is no evidence of use, or demonstrable preparations to use the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services. The disputed domain names resolve to websites selling suspected counterfeit CALVIN KLEIN products that compete directly with the Complainant's business. Respondent's practice disrupts the Complainant's business and demonstrates bad faith.

B. Respondent

The Respondent did not substantively reply to the Complainant's contentions. In the Respondent's two informal communications to the Center, the Respondent asked if it would be reimbursed for its expenses relating to the disputed domain names should the Respondent offer the disputed domain names to the Complainant, as well as offered one of the disputed domain names for sale.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (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 was registered and is being used in bad faith.

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a Response. Under paragraph 14(a) of the Rules in the event of such a "default" the Panel is still required "to proceed with a decision on the complaint", whilst under paragraph 14(b) it "shall draw such inferences there from as it considers appropriate". This dispute resolution procedure is accepted by the domain name registrant as a condition of registration.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

For such comparison, the Complainant is beforehand required to show rights over the corresponding trademark. The Panel notes that the Complainant has shown legitimate trademark rights over CALVIN KLEIN.

As the Complainant highlights, the CALVIN KLEIN well-known trademark is fully reproduced in the disputed domain names. Previous panel decisions have come to the conclusion that such reproduction leads to the consideration of the disputed domain names being identical or confusingly similar to that trademark for purposes of UDRP standing. See *Playboy Enterprises International, Inc. v. Zeynel Demirtas*, WIPO Case No. [D2007-0768](#).

The Panel also refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") section 1.8 to conclude that addition of "dobrasil" and "loja" does not prevent a finding of confusingly similarity under the first element. See *Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page, Yellow Page Marketing B.V.*, WIPO Case No. [D2010-0817](#).

Accordingly, as CALVIN KLEIN is reproduced in both disputed domain names, the first element test is met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out non-exclusive examples in which the Respondent may establish rights or legitimate interests in the disputed domain name, by demonstrating any of the following:

- (i) before any notice to it 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) that the Respondent has been commonly known by the domain name, even if it 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 Panel finds that Complainant's evidence and allegations make a *prima facie* case that the above considerations do not apply for the Respondent. Indeed, there is no evidence that the Respondent is commonly known by the disputed domain names and the Whols information support this finding. The Panel also agrees with the Complainant that there is no *bona fide* offering in the sale of potential counterfeit CALVIN KLEIN products, neither is it fair use when the website attempts to impersonate the Complainant. See sections 2.8 and 2.13 of the [WIPO Overview 3.0](#). Besides, there is no authorization or license in favor to the Respondent to use the trademark in the corresponding disputed domain names.

In addition, the composition of the disputed domain name, its confusing similarity with the Complainant's trademark and domain names, and the use of the disputed domain names carry an impermissible risk of implied affiliation. See section 2.5.1. [WIPO Overview 3.0](#): "Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner."

The Panel finds that the Complainant has made a *prima facie* case. Accordingly the Panel looks at [WIPO Overview 3.0](#), section 2.1 which says that: "While 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 often impossible task 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”.

Here, the Respondent did not file a response but two informal emails suggesting either compensation or an attempt to sell the disputed domain name <calvinkleindobrasil.com>. Therefore, the Respondent did not rebut or provide any evidence to counter the Complainant, failing to establish any rights or legitimate interests.

Under these circumstances the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain names in bad faith.

The Panel is of the opinion that the Respondent was aware of the Complainant, its CALVIN KLEIN trademark, and business activity when registering the disputed domain names. For such finding, the Panel notes both the well-known value of the mark and the subsequent use of the disputed domain names to sell purportedly Complainant's products. Both circumstances tantamount to actual knowledge of the Complainant and its trademarks at the moment of the registration of the disputed domain names. See *EUROVET v. Whois Agent, Domain Protection Services, Inc./ Wteu Qtyeiw*, WIPO Case No. [D2022-2053](#).

The Panel cannot find any reasonable explanation for the Respondent's registration other than to trade off the Complainant's well-known trademark.

The Respondent is clearly interested in selling the disputed domain names and getting some compensation. However, these circumstances evidence that Respondent is targeting the Complainant and its trademarks.

Finally, by using the disputed domain names to resolve to websites that purport being part or at very least affiliated to the Complainant fits with the circumstances described in paragraph 4b(iv) of the Policy. That said, the Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 names <calvinkleindobrasil.com> and <lojajcalvinklein.com> be transferred to the Complainant.

/Manuel Moreno-Torres/

Manuel Moreno-Torres

Sole Panelist

Date: December 7, 2022