

## **ADMINISTRATIVE PANEL DECISION**

### **Calvin Klein Trademark Trust & Calvin Klein, Inc. v. AG Lai Da Case No. D2022-4806**

#### **1. The Parties**

The named Complainants are Calvin Klein Trademark Trust (“First Complainant”), United States of America (“United States”) and Calvin Klein, Inc. (“Second Complainant”), United States, both represented by Kestenberg Siegal Lipkus LLP, Canada.

Respondent is AG Lai Da, United Kingdom.

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

The Disputed Domain Name <calvinkleinoutlet.shop> is registered with Dynadot, LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was originally filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 14, 2022 without a named respondent.

On December 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. Also on December 15, 2022, the Registrar transmitted by email to the Center its verification response disclosing the real registrant and contact information for the Disputed Domain Name.

The Center sent an email communication to the Complainants’ representative on December 16, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on the same day naming the Respondent in accordance with the true registrant details supplied by the Registrar.

Except where it is necessary to distinguish between them, the Panel will hereafter refer to the First Complainant and the Second Complainant together as “Complainant”.

The Center verified that 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 December 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 17, 2023.

The Center appointed Philip N. Argy as the sole panelist in this matter on January 23, 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.

All other administrative requirements have been satisfied.

#### **4. Factual Background**

In the absence of a Response the following facts, taken from the Complaint and/or the evidence accompanying it, remain uncontested.

The First Complainant is a business trust organized under the laws of Delaware in the United States. It is the registered owner of numerous CALVIN KLEIN trademarks the beneficial owner of which is the Second Complainant. Second Complainant is also the servicer for First Complainant for a variety of merchandise.

The Second Complainant has been engaged in the production, sale and licensing of men's and women's apparel, fragrances, accessories, and footwear, among other things, all in association with one or more of the Calvin Klein Intellectual Properties. Since its formation, Complainant has used and registered several of its marks in the United States and throughout the world. Specifically, in the United States, Complainant has used its CALVIN KLEIN trademark since as early as 1968. Accordingly, Complainant has developed considerable goodwill in the CALVIN KLEIN marks.

The First Complainant owns United States Trademark Registrations for its CALVIN KLEIN marks in connection with apparel and other merchandise, including, *inter alia*, Registration No. 1,086,041, registered on February 21, 1973.

The Second Complainant owns a number of domain name registrations which wholly incorporate the CALVIN KLEIN marks, including: <calvinklein.com>, <calvinkleinbags.com>, <calvinkleinunderwear.com>, and <calvinkleinfashion.com>. Since their registration, the Second Complainant has used and continues to use these domain names in connection with its various websites, which provide information about Complainant and its products and services as well as offer its products for sale.

The Second Complainant has used the CALVIN KLEIN mark continuously since at least as early as 1968 in connection with the advertising, offering for sale, and sale of its various products in the United States and elsewhere. Complainant's use of the CALVIN KLEIN trademarks has resulted in millions of customers worldwide and billions of dollars in sales. The CALVIN KLEIN trademark has been used prominently, continuously and substantially exclusively in connection with the Complainant's products and services. The CALVIN KLEIN marks are well known and famous and have been for many years. Over these years, Complainant has expended millions of dollars in advertising and promoting its products under its CALVIN KLEIN trademark in a variety of media throughout the world, including print, television, and radio advertisements.

Complainant has also advertised its CALVIN KLEIN marks through direct mail and on the Internet, including on the websites associated with its domain names referenced above. Such advertising reaches a vast range of consumers: by way of example, since Complainant's "www.calvinklein.com" website first launched in 1997, it has received hundreds of millions of visitors seeking information about Complainant's CALVIN KLEIN products. Those products are sold exclusively through Complainant's own retail stores, outlet stores and websites including "www.calvinklein.com" and, through Authorized Dealers. Authorized Dealers include national specialty stores, such as Macys, Neiman Marcus, Saks Fifth Avenue, and Bergdorf Goodman.

The Disputed Domain Name was registered on November 14, 2022.

According to the evidence provided by the Complainant, the Disputed Domain Name resolved to a website in Spanish, that offered CALVIN KLEIN branded products for sale at a heavily discounted price.

The Second Complainant's above-referenced domain names have been registered and in use since long before Respondent's registration of the Disputed Domain Name.

## 5. Parties' Contentions

### A. Complainant

The Complaint is based on the three grounds set out in the Policy, namely, that the Disputed Domain Name is identical or confusingly similar to CALVIN KLEIN being a trademark in which Complainant has rights; that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and that the Disputed Domain Name was registered and is being used in bad faith.

In support of the first ground, Complainant submits that its numerous federal trademark registrations and widespread use, advertising, and promotion of the CALVIN KLEIN marks since 1968 sufficiently establish rights in the mark pursuant to the Policy. It notes that the Disputed Domain Name wholly incorporates its CALVIN KLEIN trademark with the addition of the ordinary English word "Outlet". The Complainant submits that use of "Outlet" intensifies the confusion a consumer would experience because the Complainant operates retail outlets and consumers could and most likely would assume the site to which the Disputed Domain Name resolves to be an online outlet operated by the Complainant.

Furthermore, according to Complainant, incorporating Complainant's whole mark carries a high risk of implied affiliation. It goes on to contend that use of the .shop generic top-level domain name ("gTLD") similarly re-inforces and strengthens any confusion because it suggests that the Disputed Domain Name will resolve to an online equivalent to Complainant's bricks and mortar stores.

In support of the second ground of Complaint it is submitted that Complainant's first use and first registration of its CALVIN KLEIN mark predate any use Respondent may have made of the Disputed Domain Name as a trade name, domain name, mark, or common name. Respondent's domain was registered in 2022, more than fifty years after the Complainant first used its marks. Additionally, Complainant registered the domain names and began operating its websites at "www.calvinklein.com", "www.calvinkleinfashion.com", and others, several decades before Respondent registered the Disputed Domain Name.

Respondent was aware of Complainant's domain names and websites associated with the same before it registered the Disputed Domain Name because Complainant's sites were operational, and thus easily accessible to Respondent. Furthermore, Respondent is not affiliated with Complainant in any way. Complainant has not authorized Respondent to use and register its trademarks and service marks, or to seek the registration of any domain name incorporating said mark. Because Complainant's federal registrations and use predate Respondent's domain name registration, and because Respondent is charged with constructive knowledge of Complainant's CALVIN KLEIN trademark registrations, Respondent has no proprietary rights, or legitimate interests, in the Disputed Domain Name.

In addition, Complainant's CALVIN KLEIN marks are well-known and famous, and have been for many decades. Based on the fame of Complainant's marks it would be very difficult for Respondent to show that it had any right or legitimate interest in the Disputed Domain Name. Respondent also has no proprietary rights or legitimate interest in "Calvin Klein" because Respondent is not using the Disputed Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. The Disputed Domain Name resolves to a webpage that is a blatant copy of Complainant's official websites including its images and which promotes the sale of suspected counterfeit CALVIN KLEIN products for below market value without any authorization or license from Complainant.

Further and without limitation, during the checkout process users are prompted to “Log-in” or “Create an Account” and enter their personal information, including their full name, address, telephone number and email address. As both this Panel and other panels have previously held, reproducing models of a complainant’s products and using a disputed domain name for phishing or other illegal activities re-inforces a respondent’s lack of rights or legitimate interests.

Complainant confirms that it has not authorized or licensed Respondent to use the CALVIN KLEIN trademark in connection with any services by reference to the Disputed Domain Name. Nor is Respondent commonly known as CALVIN KLEIN or CALVIN KLEIN OUTLET.

Under the third limb of the Policy it is submitted that Respondent is diverting Complainant’s customers or potential customers seeking information about Complainant to a website which offers suspected counterfeit CALVIN KLEIN products for sale as part of a suspected phishing scheme. Complainant has no control over the use of a domain name embodying its primary intellectual property, CALVIN KLEIN. Many Internet users rely on the web browser’s URL to seek information about authorized sources of information and merchandise. By using the Disputed Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on its website.

The Disputed Domain Name resolves to a webpage which displays the CALVIN KLEIN intellectual properties alongside suspected counterfeit CALVIN KLEIN merchandise which are available for prices below market value. Additionally, Complainant has no control over the listings shared and/or their authenticity. Respondent also uses a confusingly similar landing page as Complainant’s official websites, including those at “www.calvinklein.com” and “www.calvinklein.es”. The imitation websites use the same stylized CALVIN KLEIN logo at the top, similar drop-down menus and page navigators, and reproduce official CALVIN KLEIN promotional photographs without any authority.

## **B. Respondent**

Respondent did not reply to the Complainant’s contentions.

## **6. Discussion and Findings**

Despite the absence of a Response the onus remains on Complainant to make out each of the grounds of the Policy and these are dealt with sequentially below.

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

The evidence is quite conclusive that the First Complainant is the registered proprietor of numerous trademarks around the world which comprise or include the words CALVIN KLEIN. It plainly has rights in those words as a trademark. However, when corporate groups establish entities or trust structures to hold their trademark properties for licensing to other members of the corporate group or to third parties, there is usually some form of agreement explaining what rights the licensee has which can be taken into account by a panel under the first limb of the Policy. Here the Second Complainant is asserted to be the “beneficial owner” of the marks and the “service” for the First Complainant “for a variety of merchandise”. No other information is provided. The Complaint is accompanied by an extensive declaration by the Second Complainant’s Vice President, Enforcement and Assistant General Counsel. She says that her duties “include oversight and management of brand protection matters related to Calvin Klein and Calvin Klein Trademark Trust”. But instead of then elaborating on the relationship and explaining their respective rights she merely declares “Calvin Klein Trademark Trust and Calvin Klein, Inc. shall collectively hereinafter be referred to as ‘Complainant.’” and proceeds to make various statements about trade mark ownership and commercial activities all by reference to the conflated “Complainant”, making it impossible for the Panel to determine which entity has what rights. It is not for complainants to expect panels to make assumptions in

their favor. The onus is always on a complainant to make out the grounds of the Policy, and the first ground needs to be proved by evidence, even if that amounts to no more than a sworn assertion from corporate counsel. Here there is not even that. However, given that there is sufficient evidence of the Second Complainant's commercial activities to establish that it has at a minimum extensive common law rights in the CALVIN KLEIN trade marks, the Panel finds that the Second Complainant also has rights in the CALVIN KLEIN trade mark

The next question is whether the Disputed Domain Name is identical or confusingly similar to the CALVIN KLEIN trademark. As Complainant has submitted, the CALVIN KLEIN trademark is wholly contained within the Disputed Domain Name with the term "outlet" simply appended. Thus the term "outlet" cannot displace the impression created by use of the CALVIN KLEIN trademark by itself. It follows that what would otherwise have been a domain name identical to the trademark remains at a minimum confusingly similar to it, that confusion also being re-enforced by the juxtaposition with the .shop gTLD.

For the foregoing reasons, and despite the Panel's dissatisfaction with the conflation of the First Respondent and Second Complainant's rights and activities, the Panel finds the first limb of the Policy made out.

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

The extensive evidence submitted showing use by the Second Complainant of the CALVIN KLEIN trademark throughout the world makes it difficult to envisage how Respondent could have any rights or legitimate interests in respect of the Disputed Domain Name. Furthermore, the form of the Disputed Domain Name is corroborative of Respondent having complete knowledge of Complainant's commercial activities and the fame of its trademarks.

Moreover, since the Disputed Domain Name is composed of a trademark plus an additional term, the Panel finds that there is a risk of implied affiliation. See section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition.

In the absence of a Response the Panel accepts Complainant's submissions and is satisfied that Respondent has no such rights.

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

Similarly, the Panel is compelled to accept Complainant's submissions in relation to this limb of the Policy given the apparently malicious intent of the website to which the Disputed Domain Name resolves, the seemingly fraudulent solicitation of consumers' personal information and credit card details under the guise of being the Second Respondent's online retail presence, and the flagrant copying of images and text from the Second Complainant's official website.

In particular, the Panel finds that by using the Disputed Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website.

In the absence of any explanation from Respondent (and the Panel cannot presently conceive of any plausible one) it is plain beyond doubt that the Disputed Domain Name was both registered and is being used by Respondent in bad faith.

## 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 domain name <calvinkleinoutlet.shop> be transferred to the Second Complainant, CALVIN KLEIN, INC. This is consistent with the Second Complainant being the registrant of the domain names currently being used to sell its merchandise.

*/Philip N. Argy/*

**Philip N. Argy**

Sole Panelist

Date: February 4, 2023