

ADMINISTRATIVE PANEL DECISION

Calvin Klein Trademark Trust, and Calvin Klein, Inc. v. Serna Sabra Case No. D2023-3200

1. The Parties

The Complainants are Calvin Klein Trademark Trust, and Calvin Klein, Inc., United States of America (“United States” or “US”), represented by Lipkus Law LLP, Canada.

The Respondent is Serna Sabra, United States.

2. The Domain Name and Registrar

The disputed domain name <calvinkleinverkaufe.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 25, 2023. On July 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 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 (CALIFORNIA, US) and contact information in the Complaint. The Center sent an email communication to the Complainants on July 26, 2023, 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.

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 August 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 8, 2023.

The Center appointed Angela Fox as the sole panelist in this matter on September 14, 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 First Complainant, Calvin Klein Trademark Trust, holds the trademark registrations for CALVIN KLEIN, a well-known fashion brand, on behalf of its beneficial owner, the Second Complainant, Calvin Klein Inc. (hereinafter referred to jointly as the "Complainant").

The Complainant and its associated companies have been engaged in the production, sale, and licensing of men's and women's apparel, fragrances, accessories, and footwear under the CALVIN KLEIN brand since at least as early as 1968 in the US, and internationally. The Complainant and its associated companies have millions of customers worldwide and billions of US dollars in sales under the CALVIN KLEIN brand. Over the years, it has spent hundreds of millions of US dollars advertising and promoting its CALVIN KLEIN branded products around the world, including in print, television, radio, and social media advertisements. The Complainant's CALVIN KLEIN products are sold exclusively through its own retail and outlet stores and websites, including at the domain name <calvinklein.com>, and through authorized dealers.

The Complainant is the owner of numerous trademark registrations in the United States and internationally for CALVIN KLEIN and marks including CALVIN KLEIN covering clothing and other merchandise. Annexed to the Complaint were details of the following:

- United States Trademark Registration No. 1,086,041 for CALVIN KLEIN registered on February 21, 1978;
- United States Trademark Registration No. 1,633,261 for CALVIN KLEIN (stylized), registered on January 29, 1991;
- United Kingdom Trademark Registration No. 1,492,382 for CALVIN KLEIN registered on January 24, 1994;
- United Kingdom Trademark Registration No. 2,169,731 for CK CALVIN KLEIN registered on February 26, 1999;
- European Union Trademark Registration No. 617,381 for CALVIN KLEIN registered on January 29, 1999;
- Chinese Trademark Registration No. 1,681,239 for CALVIN KLEIN registered on December 14, 2001; and
- German Trademark Registration No. DD647386 for CALVIN KLEIN registered on September 11, 1990.

The Complainant also owns a number of domain name registrations which wholly incorporate its CALVIN KLEIN marks, including <calvinklein.com>, <calvinkleinbags.com>, <calvinkleinunderwear.com>, and <calvinkleinfashion.com>, which were registered and have been in use since prior to registration of the disputed domain name.

The disputed domain name was registered on June 19, 2023. It is in use for a website allegedly offering CALVIN KLEIN branded clothing for sale, along with multiple other clothing brands including ADIDAS, &CO., ALEXANDER MCQUEEN, and many others.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's CALVIN KLEIN trademark. The disputed domain name incorporates the whole of the Complainant's trademark plus the German word "verkaufe", which it says means "sell" in English. As the Complainant operates both physical and online stores globally where consumers can purchase CALVIN KLEIN products, the disputed domain name could lead consumers to falsely believe that it denotes an online store where the Complainant sells its goods to consumers. Additionally, the Complainant submits that the disputed domain name carries a high risk of implied affiliation.

The Complainant also submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant's use of its CALVIN KLEIN trademark began more than 50 years before the disputed domain name was registered. The Respondent is not commonly known by a name corresponding to the disputed domain name. The Complainant is not affiliated with the Respondent in any way, and has not authorized the Respondent to use and register its trademark, nor to seek the registration of any domain name incorporating it. The Complainant argues that the Respondent's use of the disputed domain name in connection with an online shop offering CALVIN KLEIN branded goods conveys a false impression of association with the Complainant, when the Respondent is not in fact authorized to sell the Complainant's goods, and is therefore not use in connection with a *bona fide* offering of goods or services. As the use is commercial in nature, it is not a legitimate noncommercial or fair use.

Finally, the Complainant argues that the disputed domain name was registered and has been used in bad faith. The Respondent is actively using the disputed domain name to attract Internet users to its website for commercial gain 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. Given the fame of the Complainant's CALVIN KLEIN trademark and the fact that the Respondent is using the disputed domain name to sell products bearing the CALVIN KLEIN mark, it is clear that the Respondent had knowledge of that mark when it registered the disputed domain name. The Complainant further submits that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor, by siphoning off customers and potential customers from the Complainant's own websites including at the domain name <calvinklein.com>.

B. Respondent

The Respondent did not reply to the Complainant's contentions and is in default. No exceptional circumstances explaining the default have been put forward. Therefore, in accordance with paragraphs 14(a) and (b) of the Rules, the Panel will decide the Complaint and shall draw such inferences as it considers appropriate from the Respondent's default.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds 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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

A. Identical or Confusingly Similar

The Complainant has proved that it has registered trademark rights in CALVIN KLEIN.

The disputed domain name includes CALVIN KLEIN in its entirety, followed only by the additional German term “verkaufe”, meaning “sell” in English, and the generic Top-Level Domain (“gTLD”) suffix “.com”. As noted in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“the [WIPO Overview 3.0](#)”), at section 1.11.1, the gTLD suffix is a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. The additional term “verkaufe” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark. See [WIPO Overview 3.0](#), section 1.8.

Section 1.7 of the [WIPO Overview 3.0](#) states that “[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

In this case, the disputed domain name incorporates the entirety of the Complainant’s registered CALVIN KLEIN trademark, which is clearly recognizable within the disputed domain name. The Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The burden of proving a respondent’s absence of rights or legitimate interests in a domain name falls on a complainant, but UDRP panels have long recognized that the information needed to prove such rights or legitimate interests is normally in the possession of respondents.

In order to avoid requiring a complainant to prove a negative, which will often be impossible, UDRP panels have typically accepted that once a complainant has established a *prima facie* case that a respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to prove that it does indeed have such rights or legitimate interests (see, *inter alia*, *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#); and section 2.1 of the [WIPO Overview 3.0](#)). In the present case, the Complainant has put forward a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to use the disputed domain name, nor is there any evidence that the Respondent has ever been commonly known by it. The Respondent has made no effort to show that it has rights or legitimate interests in the disputed domain name.

The Panel notes that the disputed domain name has been used to link to a website allegedly offering goods for sale under the CALVIN KLEIN trademark. The Complainant states that it sells its CALVIN KLEIN branded merchandise only through its own physical and online stores, and through authorized retailers, and that the Respondent is not an authorized retailer for the Complainant’s goods.

Sections 2.8.1 and 2.8.2 of the [WIPO Overview 3.0](#) states that:

“2.8.1 Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the ‘Oki Data test’, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and

(iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.
[...]

2.8.2 Cases applying the Oki Data test usually involve a domain name comprising a trademark plus a descriptive term (e.g., “parts”, “repairs”, or “location”), whether at the second-level or the top-level. At the same time, the risk of misrepresentation has led panels to find that a respondent lacks rights or legitimate interests in cases involving a domain name identical to the complainant’s trademark.”

This case involves a domain name comprising a trademark plus a descriptive term, and the website to which the disputed domain name links does not display any wording disclosing the Respondent’s relationship with the Complainant. The Respondent is, moreover, using the disputed domain name to link to a site offering not only CALVIN KLEIN branded goods, but also third-party branded merchandise.

Taking all of this into account, the Panel concludes that the Respondent’s activities are fundamentally misleading and in line with the approach in sections 2.8.1 and 2.8.2 of the [WIPO Overview 3.0](#), the Panel concludes that this is not a case of fair use by a reseller or distributor. There is in this case a risk of implied affiliation, taking account of the fame of the CALVIN KLEIN trademark, the presence of the descriptive German term “verkaufe” in the disputed domain name, and the Complainant’s own practice, shown in evidence, of selling its products only through its own locations or through authorized re-sellers, of whom the Respondent is not one.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant has been using its CALVIN KLEIN trademark for over 50 years, and it has become established as an internationally well-known fashion brand.

It is clear that the Respondent was aware of the Complainant’s mark when registering the disputed domain name, because the website linked to the disputed domain name is in use to allegedly offer CALVIN KLEIN products, among others, for sale.

Under paragraph 4(b)(iv) of the Policy, the Panel may find both registration and use in bad faith where there is evidence that by using the domain name, a 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 a 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 it.

In this case, the Panel is satisfied that the disputed domain name is inherently liable to mislead Internet users into believing that it denotes a website of the Complainant or one of its authorized resellers, allegedly selling only the Complainant’s CALVIN KLEIN branded products, when in fact it is not.

In light of all these circumstances, the Panel finds that the disputed domain name was registered and has been used 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 disputed domain name, <calvinkleinverkaufe.com>, be transferred to the Complainant.

/Angela Fox/

Angela Fox

Sole Panelist

Date: October 5, 2023