

## **ADMINISTRATIVE PANEL DECISION**

Louis Vuitton Malletier v. Giselle Perez, Epsilon Comunicacion SL  
Case No. D2023-4954

### **1. The Parties**

The Complainant is Louis Vuitton Malletier, France, represented by Studio Barbero S.p.A., Italy.

The Respondent is Giselle Perez, Epsilon Comunicacion SL, Spain, represented by Francisco Javier Diaz Aparicio, Spain.

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

The disputed domain name <louisvuitton.com> is registered with IONOS SE (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 28, 2023. On November 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 1, 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 (Epsilon Comunicacion SL) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 4, 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 amended Complaint on December 6, 2023.

On December 8, 2023, the Center informed the parties in Spanish and English, that the language of the registration agreement for the disputed domain name is Spanish. On December 11, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent objected to the Complainant's request.

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 December 21, 2023. In accordance with the Rules,

paragraph 5, the due date for Response was January 10, 2024. The Respondent sent an informal communication regarding the language of the proceeding on January 4, 2024. The Response was filed with the Center on January 10, 2024, in Spanish.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on January 23, 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 French manufacturer of luxury and fashion goods. It is the proprietor of numerous registrations for its LOUIS VUITTON trademark, including the following:

- International Trademark No. 416052 for LOUIS VUITTON (word mark), registered on June 19, 1975, for goods in classes 03, 06, 08, 13, 14, 16, 18, 20, 21, 24, 25, 28 and 34;
- United States of America Trademark No. 1045932 for LOUIS VUITTON (word mark), registered on August 10, 1976, for goods in class 18, claiming a date of first use in commerce in 1875;
- Hong Kong, China, Trademark Registration No. 19861189AA for LOUIS VUITTON (word mark), registered on May 16, 1986, for goods in classes 18 and 25.

The Complainant has registered numerous domain names reflecting its trademark, including <louisvuitton.com>.

The disputed domain name was registered on August 17, 2023. It redirects to a website with a parking page of the service hosting IONOS SE.

#### **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 confusingly similar to its trademarks;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the Respondent has registered and is using the disputed domain name in bad faith.

##### **B. Respondent**

The Respondent states that it does not recognize the jurisdiction of the Center for this proceedings since the Policy does not create a decision with *res iudicata* effect and the decisions adopted under the Policy are not an arbitral award.<sup>1</sup>

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<sup>1</sup> The Panel notes that the Registrar replied to the request for registrar verification stating that "the UDRP is incorporated into our registration agreement and applies to the above mentioned domain name".

The Respondent explains that they have created a system called the “X Platform” because historically the letter “x” has been associated with negative content like pornography, and the Respondent wants to avoid the registrations of well-known names associated with the letter “x”. Therefore, the Respondent has decided to register the disputed domain name with the letter “x” to reserve it for good use and avoid affecting the Complainant’s reputation.

The Respondent states also that none of the requirements of the Policy are present in this case. With respect to the first element, the Respondent states that there is no risk of confusion since the disputed domain name is used by the Respondent for different products or services than the one protected by the trademark of the Complainant.

Concerning the legitimate interests, the Respondent states that it has rights or legitimate interests over the disputed domain name since the Respondent has developed a platform to register domain names with the letter “x”.

Finally, with respect to the bad faith registration and use, the Respondent states that there is no such bad faith because there is no risk of confusion since the Parties are in different areas of commerce and they do not compete with each other. In addition, the Respondent states that the disputed domain name is being held passively.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (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.

### **6.1. Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Spanish. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that (i) the Complainant would be prejudiced, should it be required to translate the Complaint and participate in this proceeding in Spanish; (ii) requiring the Complainant to translate the Complaint and all documents into Spanish would cause delay in contravention to paragraph 10(c) of the Rules, which requires that “[t]he Panel shall ensure that the administrative proceeding takes place with due expedition”; and (iii) the Respondent has been involved in a prior WIPO case where the Panel accepted the complainant’s request for English be the language of the proceeding and rendered the decision in English language. See *Arcelormittal v. Giselle Perez, Epsilon Comunicacion SL*, WIPO Case No. [D2023-3571](#), where the language of the registration agreement was Spanish, but the complainant filed the Complaint in English and the Panel accepted the complainant’s request for English to be the language of the proceeding, finding that “[...]ordering the Complainant to translate the Complaint, in view of the costs involved, would imply a significant burden to the Complainant, in addition to an unwarranted delay in the proceeding. Noting also that the Respondent failed to answer the Complaint, and did not oppose the Complainant’s language request when it was given the opportunity do so (both transmitted to the Respondent in English and Spanish), the Panel decides that the language of the proceeding shall be English”.

The Respondent requested that the language of the proceeding be Spanish claiming that (i) the Registration agreement for the disputed domain name is in Spanish; (ii) the Respondent is a Spanish company located in Spain; (iii) there is no prejudice to the Complainant since they have offices in Spain also; and (iv) the use of English in these proceedings affects the Respondent.

At the same time, the Panel also notes that the Respondent submitted a Response, in Spanish, addressing the Complainant's contentions.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, and the circumstances of this case, the Panel finds that accepting the Complaint filed in English does not prejudice the Respondent's right of defense, and the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English, accepts the Response filed in Spanish, but will proceed with rendering the decision in English.

### **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.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the letter "x" may bear on assessment of the second and third elements, the Panel finds the addition of such letter 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.

Finally, the goods and/or services for which the mark is registered or used in commerce are not considered relevant to the first element test. [WIPO Overview 3.0](#), section 1.1.

Therefore, the Respondent's assertion that the disputed domain name is used by the Respondent for different products or services than the one protected by the trademark of the Complainant is of no relevance to this case (see *Pension Benefit Guaranty Corporation v. C S, CS*, WIPO Case No. [D2023-4921](#), "This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage."). The entirety of the mark is reproduced within the disputed domain name and that leads to a finding in favor of the Complainant according to the test of confusing similarity under the Policy.

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 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 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 Respondent has created a system to register domain names using third-party trademarks (without authorization) with the addition of the letter “x” at the beginning or the end of the domain names, to reserve them for good use and avoid affecting the company’s reputation. Such a system does not confer the Respondent rights or legitimate interests to register the disputed domain name under the Policy.

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, the Complainant must prove that the disputed domain name was registered and used in bad faith..

In the present case, the Panel notes that:

- The Complainant’s mark LOUIS VUITTON had been widely used and registered at the time of the registration of the disputed domain name by the Respondent and had acquired and enjoyed worldwide reputation. Therefore, the Panel finds it highly likely that the Respondent had the Complainant’s mark (a unique expression) in mind when registering the disputed domain name.
- The Respondent in his answer has recognized that the Complainant’s trademark is well known when he stated that he is in the business of registering domain names using well-known trademarks with the addition of the letter “x”.
- The Respondent has been involved in other domain name disputes bearing the letter “x” either after or before the trademark in the domain names (see *Novartis AG v. Epsilon Comunicacion SL y Giselle Pérez*, WIPO Case No. [DES2023-0028](#), with respect to domain names <novartisx.es> and <xnovartis.es>; *Arcelormittal v. Giselle Perez, Epsilon Comunicacion SL*, WIPO Case No. [D2023-3300](#), with respect to the domain name <xacelormittal.com>; and *Arcelormittal v. Giselle Perez, Epsilon Comunicacion SL*, WIPO Case No. [D2023-3571](#), with respect to the domain name <acelormittalx.com>). In all cases, it was held that the Respondent was acting in bad faith.
- The disputed domain name is not in use, it redirects to a website with a parking page of a service hosting.

Furthermore, the Panel notes Respondent’s claim that it has decided to register the disputed domain name with the letter “x” to reserve it for good use and avoid affecting the Complainant’s reputation. However, even if that was the Respondent’s intention with the registration of the disputed domain name, that same purpose of not affecting the Complainant’s reputation would be achieved by transferring the disputed domain name to the Complainant, allowing the Complainant to manage the disputed domain name. The Panel cannot turn a

blind eye to the fact that the Respondent registered a disputed domain name almost corresponding to a famous trademark, and by retaining control over the disputed domain name, the Panel considers that would be like the Respondent holding the Complainant's hostage.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

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. Having reviewed the available record, the Panel notes the distinctiveness and 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.

The Panel finds that 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 <xlouisvuitton.com> be transferred to the Complainant.

*/Pablo A. Palazzi/*

**Pablo A. Palazzi**

Sole Panelist

Date: February 21, 2024