

# **ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE**

**(Beijing Office)**

## **ADMINISTRATIVE PANEL DECISION**

**Case No. CN-1200536**

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**COMPLAINANT: G & P NET S.P.A.**

**RESPONDENT: PEUTEREYSITOUFFICIALES**

**DOMAIN NAME: PEUTEREYSITOUFFICIALES.COM**

**REGISTRAR: GODADDY.COM, INC.**

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### **1. Procedural History**

On January 20, 2012, the Complainant submitted the Complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Centre (the "ADNDRC Beijing Office") pursuant to the Uniform Policy for Domain Name Dispute Resolution (the "Policy") approved by the Internet Corporation for Assigned Names and Numbers ("ICANN") on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and Asian Domain Name Dispute Resolution Centre Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "ADNDRC Supplemental Rules").

On January 20, 2012, The ADNDRC Beijing Office confirmed the receipt of the Complaint and asked ICANN and the Registrar for the confirmation of the registration information with regard to the disputed domain name.

On January 21, 2012, the ADNDRC Beijing Office received from the Registrar the registration confirmation in connection to the disputed domain name.

On February 20, 2012, the ADNDRC Beijing Office sent the transmittal of the claims to the Respondent.

On February 20, 2012, the ADNDRC Beijing Office sent to the parties the notification of the commencement of the proceeding, and of the matter the claims have been confirmed and forwarded; and notified ICANN and the Registrar of the commencement of the proceeding.

Having received no answer by the Respondent until March 11, 2012, the ADNDRC Beijing Office sent, on March 12, 2012, the notification to the disputing parties of the Hearing by Default.

Having received a Declaration of Independency and Impartiality and a Statement of Acceptance from Mr. Chi Shaojie, the Centre informed the disputing parties of the Confirmation of the Appointment of the sole panelist on March 26, 2012.

The sole panelist finds that the Panel was properly constituted in accordance with the Rules and the ADNDRC Supplemental Rules.

The procedural language is English, as being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and also in conformity with the language used by the Complainant in the submitted Complaint.

## **2. Factual Background**

### **For the Complainant**

The Complainant is G & P NET S.P.A. domiciled in VIA PROVINCIALE, DEL BIAGIONI, 55, ALTOPASCIO (LUCCA), ITALY, and represented in the proceeding by FU Haiying and WANG Xiao addressed in 20th Floor, East Tower, World Financial Centre, No. 1 Dongsanhuan Zhonglu, Chaoyang District, Beijing, 100020, China.

### **For the Respondent**

The Respondent is known, by the registration information, as peutereysitoufficiales, domiciled in tele peutereysito-ufficiales peutereysitouff peutereysitouff 753432, China, as revealed in the registration.

## **3. Parties' Contentions**

### *The Complainant*

The Complainant alleges in its Complaint that:

The Complainant owns two registered trademarks, i.e. "PEUTEREY",

Registration No.: G646277 Class: 25 Goods designated: Clothing, shoes and headgear. Period of Validity: November 3, 2006 to November 3, 2015; "PEUTEREY & Device", Registration No.: G850742 Class : 25 Goods designated: Men's clothing, women's clothing and children's clothing including overcoats, short coats, shirts, skirts, shoes, jeans, swimming suits, gloves and slippers, etc. Period of Validity: May 9, 2005 to May 9, 2015.

The Complainant's brand "PEUTEREY" founded in Italy since 1991 is an affiliated brand of the top outer door clothing brand "GEO SPIRIT" and enjoys high reputation in European market. Through conducting online searches of "PEUTEREY" via Google, there are over 5,000 search results and the top-20 search results are all directly related to the Complainant and its brand. According to those websites, "PEUTEREY" is notably called as "Italian top brand" and "Italian luxury brand" by all kinds of fashion forums and online shops. Besides, on Taobao.com the biggest Chinese e-commerce platform, the photos of the products bearing the trademarks "PEUTEREY" and "PEUTEREY & Device" can be frequently seen. All the above adequately certifies that the prior marks "PEUTEREY" and "PEUTEREY & Device" of the Complainant are well recognized in China and enjoy high reputation and great effect among the related public.

As mentioned above, "PEUTEREY" is the Complainant's trademark which enjoys high reputation in world fashion industry. When seeing "PEUTEREY", Chinese consumers will directly associate it with the Complainant and its products. The prominent part of the disputed domain name "peutereysitoufficiales" incorporates three words "peuerey", "sito" and "ufficiales". "Peuterey" is identical with the Complainant's famous mark "PEUTEREY" while "sito" together with "ufficiale" means "official website" in Italian. Furthermore, most of the products sold on website [www.peutereysitoufficiales.com](http://www.peutereysitoufficiales.com) are clothes bearing the Complainant's trademarks "PEUTEREY" and "PEUTEREY & Device". In fact, the only official website of the Complainant is [www.peuterey.it](http://www.peuterey.it). In view of the above, consumers will easily misunderstand the disputed domain name as owned by or related to the Complainant's company and click it to

browse. Therefore, the registration and use of the disputed domain name will inevitably cause consumers' confusion.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant's trademarks "PEUTEREY" and "PEUTEREY & Device" have successfully obtained the extension protection in China respectively in 2005 and 2006. According to the Complainant's search on the official website of the China Trademark Office and main search engines, the Respondent has no civil rights or legitimate interests in respect of "PEUTEREY". In addition, the Complainant has never authorized the Respondent to use any trademarks related to "PEUTEREY" or to register "peutereysitoufficiales" as a domain name. Therefore, the Respondent has no civil rights or legitimate interests in respect of "peutereysitoufficiales".

As mentioned aforesaid, after logging [www.peutereysitoufficiales.com](http://www.peutereysitoufficiales.com), the Complainant notices that it is selling clothes such as jackets, down coats and outer coats etc., which are bearing the Complainant's trademarks "PEUTEREY" and "PEUTEREY & Device". As a matter of fact, the Complainant has never authorized or licensed the above website to use "PEUTEREY" and "PEUTEREY & Device" in any forms. Furthermore, through verification, the Complainant confirmed that those products sold on the website are not manufactured by the Complainant. It means that the website is selling the counterfeit products, which have infringed the trademark rights of the Complainant. In addition, the Complainant has published a statement on their website claiming that only official website of PEUTEREY is [www.peuterey.it](http://www.peuterey.it) and the genuine products are just sold in authorized shops instead of online.

Therefore, it is obvious that the Respondent registered the disputed domain name intentionally so that could build a website imitating the official website of the Complainant and then take advantage of the high reputation of the Complainant's famous trademark and products to obtain unjustifiable commercial interests by selling the counterfeit products on the said website. The act of the Respondent's registering the disputed domain name to obtain unjustifiable commercial interests will easily cause the confusion of the source of the products among the consumers.

Such acts will damage not only the interests of the Complainant but also the benefits of the consumers. Therefore, the Respondent's registration and use of the disputed domain name is obviously in bad faith and should be stopped.

According to the above, the Respondent's registration of the disputed domain name is in bad faith as prescribed in 4(b)(ii) and (iv) of the Policy, which reads "you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name" and "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location". According to the above provisions, the Complainant earnestly requests the Panel to rule that the Respondent shall transfer the domain name to the Complainant to protect the legitimate rights and interests of the Complainant and to ensure the competition order in the market.

Based upon the above fundamental reasons, the Complainant thinks that all the three conditions set forth under the relevant paragraph of the Policy for the request for transfer of the disputed domain name have all been met.

### **The Respondent**

After being served of the claim and all the accompanying documents emailed by the Complainant, and of all the procedural documents by the ADNDRC Beijing Office, the Respondent makes no response by any means in the whole course of the proceeding.

## **4. Findings**

It is significant for the parties to understand the legal nature of the current proceeding which is totally different from that of arbitration or litigation. Though the proceeding is known as administrative proceeding, it is really NOT the proceeding by a government agency. The jurisdiction by the

Panel over the current dispute on the domain name registered by the Respondent comes from the authorization by the organization for the administration of domain name registration and maintenance. Anyone intends to register a domain name needs to sign a registration agreement with the registrar which makes no substantive examination on the registration application, but stipulates in the registration agreement that whenever a claim against the registration is submitted, the registrant is obliged to be a procedural party which has rights to make arguments against the claim, but subject to an award made by a Panel constituted in conformity with the stipulated procedural rules. As it is, the current proceeding is a part of the whole proceeding for the registration and maintenance of domain names. As such, the fundamental feature of the Panel's making a judgment on the entitlement to the disputed domain name is to decide which party should be the rightful holder of the disputed domain name, so as to be in conformity with the basic requirements set forth under the Policy and to help keep the good operative order for the running of the internet, and to be beneficiary to the protection of common interests of the web-users.

The indispensable pre-condition for the Panel to find out the disputing facts is to base itself upon the allegations and defenses by the parties, which does not exist in the judgment of the present dispute due to the lack of any defense by the Respondent. In view of this, what the Panel is going to do for the fact-finding is to base itself upon the submissions and exhibits by the Complainant alone. Unless the Panel has a reason to reject any submission or evidence by the Complainant in view of the panelist's professional sense to make judgment and personal experiences in making decisions on domain name disputes, the facts are to be held by the adoption of the Complainant's submitted evidences.

One of the prerequisites for the Respondent to register the disputed domain name through the Registrar is to accept the Policy as the binding regulations for the registration. As mentioned, the Policy applies to this dispute as the substantive criteria for making the judgment of whether the Complainant's request is to be sustained or rejected. As stipulated in the Paragraph 4(a) of the Policy, when claiming back a domain name

registered by the Respondent, the Complainant must prove each and all of the following:

(i) That the domain name of the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) That the Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) That the domain name has been registered and used in bad faith.

Based itself upon the stipulations under the Policy, what the Panel needs to do is to find out whether each and all of the three basic facts can be attested by the Complainant. If the answer is yes, the Panel makes an award in the Complainant's favor in accordance with the relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules. If not, the claim by the Complainant shall be rejected.

#### *Identity or Confusing Similarity*

Pursuant to Paragraph 4(a) (i) of the Policy, the Complainant must prove that the domain name at issue is identical OR confusingly similar to a trademark or service mark to which it has rights. As stipulated in the Policy, the Complainant needs to prove either the IDENTITY or the CONFUSING SIMILARITY. To meet the requirement, the Complainant submits trademark certificates to prove that it is entitled to the trademark "PEUTEREY" and "PEUTEREY & DEVICE" which were registered earlier than the disputed domain name and are currently valid. Taking the relevant exhibits by the Complainant, the Panel holds the fact.

The disputed domain name is "peutereysitoufficiales.com" and its identifying part is "peutereysitoufficiales". According to the Complainant as an Italian entity, this "peutereysitoufficiales" is composed of three parts in an Italian way, i.e. "peuterey", "sito" and "ufficiales"; the first part is identical to the Complainant's registered trademark, the second means "website" and the third means "official" in English. It is obvious that the disputed domain name is NOT identical to the registered trademark of the Complainant's. Hence, what the Panel is going to hold is whether the two are confusingly similar. Though the Panelist does not understand

Italian language, he does know the reality that certain words used in different languages in Latin lingual system are in the same meaning with similar Latin spellings. For an instance, the Italian words “sito” and “ufficiales” are similar to the English words “site” and “official”. As such, the Panel thinks the Complainant’s explanation on the identifying part of the disputed domain name persuading and convincing, especially under the circumstances that there is for the moment no interpretation on “peutereysitoufficiales” to the contrary, from the Respondent in particular.

With regard to the issue of “confusion”, the Panel is of the opinion that when talking on the issue, attention should be focused on the “Potentiality” instead of “Reality”, i.e. what the Complainant needs to prove is the POSSIBLE confusion by the consumers. For those buyers of the Complainant’s peuterey-branded goods, the most eye-catching component in the identifying part of the disputed domain name is “peuterey”. They may not understand Italian though, they may easily link the disputed domain name to the goods of “peuterey” and its maker. This probability is enhanced when they log-in the website using the disputed domain name. As proved by the Complainant, lots of garments etc. bearing the Complainant’s trademark are found in the website using the disputed domain name, thus making the Panel in a position to be HARDLY hold that the disputed domain name COULD NOT cause confusion to the web-users who are interested in the Complainant’s goods; and further rules that the disputed domain name is confusingly similar to the Complainant’s registered trademark, and the Complainant meets the first requirement set forth under Paragraph 4(a)(i) of the Policy.

#### *Rights or Legitimate Interests of the Respondent*

Pursuant to Paragraph 4(a)(ii), the second requirement for the Complainant to meet in terms of the request for the transfer of the disputed domain name is to prove that the Respondent does not have any right to or legitimate interest in the domain name at issue. Reading the expression of the stipulation, it seems to be the Complainant who shall take the burden of proof to establish the fact that the Respondent does NOT have rights or legitimate interests in connection to the

disputed domain name. Nevertheless, since the Complainant claims that it is entitled to the disputed domain names and the Respondent has nothing to do with the name except registered and used it in bad faith, it can hardly submit any evidence to prove something it does not think existing. Probably for this reason, the Panel pays more attention to whatever the Respondent claims with regard to the rights or legitimate interests in respect to the disputed domain name. The Policy gives the chance to the Respondent to make argument on this issue by stipulating several could-be circumstances in the relevant article of the Policy. Unfortunately, the Respondent makes no argument to say it does have certain rights or legitimate interests in regard to the domain name at issue. Under the circumstances, how could the Panel hold that it is the Respondent who is entitled to the disputed domain name?

On the other side, the Complainant submitted enough exhibits to certify that it innovated and created the distinctive mark “peuterey” which meaning can hardly be identified by common folks, and has been extensively using the mark in its business activities; as well as the related high reputation of the Complainant. Based upon comprehensive analyses of all the relevant evidences by the Complainant, the Panel has sufficient reason to ascertain that it is none other than the Complainant who has rights and legitimate interests in connection to the disputed domain name; and further holds that the Complainant meets the second requirement set forth under Paragraph 4(a)(ii).

### *Bad Faith*

The Complainant has yet to establish the fact of bad faith on the part of the Respondent as set forth in the Paragraph 4(a)(iii) of the Policy. Under the Paragraph 4(b) of the Policy, the following circumstances, in particular, shall be considered evidence of the registration and use of a domain name in bad faith: “..... (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.” The Complainant submits with

evidence that the Respondent registered the disputed domain name for the prevention of the Complainant's registration of the same, and further uses the disputed domain name in a web-site intending to misleading inter-net users to think the web is operated by or linked to the Complainant. These establish the Respondent's bad-faith in the registration and use of the disputed domain name. Based upon the relevant evidences by the Complainant, the Panel believes that the submission by the party is true.

Furthermore, the logical thinking of the Panel is when a party registers a domain name which is NOT created by the party with its distinctive feature known in the real world, but identical or confusingly similar to a mark or logo or sign to which the other party is entitled with high market value, the intention of the registration is clear, namely taking illegal advantages by causing confusion to the consumers. On the other hand, if the registrant is NOT intentionally to take advantage of other's, it should create a distinctive domain name to make web-users easily tell the name from others. What is more, if someone registers a domain name in bad faith, it is hard for him to make use of the registered subject matter in good-faith, otherwise the ill-intention of the registrant would not be realized. This fundamental logic further supports the holding of bad-faith fact in the foregoing paragraph. In view of this, the Panel cannot but holds that the Respondent registered and uses the disputed domain names in bad faith; and comes to the conclusion that the Complainant meets the requirement set forth under Paragraph 4(a)(iii) of the Policy.

Based upon all the above findings, the Panel rules that the Complaint fulfills each and all of the conditions provided in Paragraph 4(a)(i)(ii) (iii) of the Policy.

## 5. Decision

In light of all the foregoing findings and in accordance with Paragraphs 4(a), 8(a) of the Policy and 5(e) of the Rules, the Panel holds:

a) That the disputed domain name “peutereysitoufficiales.com” is confusingly similar to the trademark “peuterey” to which the Complainant has rights; and

b) That the Respondent has no rights to or legitimate interests in the disputed domain name; and

c) That the domain name was registered and subsequently used by the Respondent in bad faith.

As such, the Panel rules that the disputed domain name “peutereysitoufficiales.com” should be transferred to the Complainant G & P NET S.P.A..

Sole Panelist:



Dated: April 9, 2012