



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1700975
Complainants:	Essilor International (Compagnie Generale d'Optique) and Luxottica Group S.p.A.
Respondent:	William Heffner
Disputed Domain Name:	<luxottica-essilor.com>

1. The Parties and Disputed Domain Name

The Complainants are 1) Essilor International (Compagnie Generale d'Optique), of 147, rue de Paris, 94220 Charenton-le-Pont, France; and 2) Luxottica Group S.p.A., of Via Cesare Cantù 2, 20123 Milan, Italy.

The Respondent is William Heffner, of 200 North Morton Avenue, Morton, Pennsylvania 19070, United States.

The disputed domain name is <luxottica-essilor.com>, registered by the Respondent with Namecheap Inc., of 4600 East Washington Street, Suite 305, Phoenix, Arizona 85034, United States.

2. Procedural History

The Complainants filed the Complaint with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre on 10 May 2017 in accordance with the Uniform Policy for Domain Name Dispute Resolution approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October 1999 (the Policy), the Rules for Uniform Domain Name Dispute Resolution Policy approved by the ICANN Board of Directors on 28 September 2013 (the Rules) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from 31 July 2015 (the Supplemental Rules). On 11 May 2017, the Hong Kong Office acknowledged receipt of the Complaint and sent an email to Namecheap Inc (the Registrar) requesting verification of information regarding the disputed domain name.

On 16 May 2017, the Registrar disclosed registrant and contact information for the disputed domain name which differed from that identified in the Complaint. On 17 May 2017, the Hong Kong Office requested the Complainants to amend the complaint form as regards the name and details of the Respondent and to include the Registration Agreement

of the Registrar incorporating the Policy. On 22 May 2017, the Complainants submitted an Amended Complaint and on 23 May 2017 the Hong Kong Office acknowledged receipt.

On 23 May 2017, the Hong Kong Office sent the Respondent a written notice of complaint, informing him that he was required to submit a Response within 20 days from 23 May 2017 (that is, on or before 12 June 2017). The Hong Kong Office did not receive a Response from the Respondent in respect of the Complaint by that deadline. Accordingly, on 14 June 2017, the Hong Kong Office notified the Respondent's default.

On 16 June 2017, the Hong Kong Office appointed Prof. Matthew Kennedy as the sole Panelist in this dispute, who confirmed that he was available to act independently and impartially between the parties in this matter. On 19 June 2017, the Hong Kong Office transferred the case files to the Panel.

3. Factual Background

Complainant Essilor International is a French company that manufactures, produces and distributes ophthalmic lenses, instruments and equipment. Its flagship brands are VARILUX, CRIZAL, EYEZEN and XPERIO. It owns multiple trademark registrations, including international trademark registration number 1231641 for ESSILOR, registered from 29 September 2014 and specifying goods and services in multiple classes, including spectacle lenses in class 9 and retailing of spectacle lenses in class 35. It operates an official website at www.essilor.com.

Complainant Luxottica Group S.p.A. is an Italian company that designs, manufactures and distributes fashion, luxury, and sports eyewear. Its portfolio of brands includes RAY-BAN, OAKLEY, VOGUE EYEWEAR, PERSOL, OLIVER PEOPLES and ALAIN MIKLI. It owns multiple trademark registrations, including international registration number 1079199 for LUXOTTICA reproduced in stylized characters, registered from 4 March 2011 and specifying services in class 35, including retailing in shops or via global computer networks of spectacle frames and lenses. It operates an official website at www.luxottica.com.

The Complainants announced on 16 January 2017 that they had signed a merger agreement.

The Respondent is an individual located in the United States. The disputed domain name was registered on 20 January 2017 and, at the time of filing of the Complaint, resolved to a webpage titled "Under Construction" that displayed the following notice:

"This page is currently under construction. As a matter of interest to those in the optical world, we will be listing all known companies and interests held by certain companies in the optical world. This is an independently operated site, with no affiliation with the aforementioned companies."

4. Parties' Contentions

A. Complainants

The Complainants' contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to trademarks in which the Complainants have rights. The disputed domain name incorporates the marks ESSILOR and LUXOTTICA in their entirety.
- ii. The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has neither used, nor made any demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Rather, the disputed domain name sits idle behind a holding page displaying the message “Under Construction”. The Respondent is not a licensee of either Complainant and is not entitled to use any trademarks owned by either Complainant for any purposes whatsoever. Furthermore, the Respondent has never been commonly known by the disputed domain name and is not making any legitimate non-commercial or fair use of the disputed domain name.
- iii. The disputed domain name has been registered and is being used in bad faith. The Respondent’s prominent use of the ESSILOR and LUXOTTICA marks constitutes an infringement of both Complainants’ trademark rights. The Respondent’s website is intended to be used in association with companies in the optical industry, thereby suggesting the Respondent, at the very least, is interested in this industry and should have some basic knowledge about the key players in this field. The registration of the disputed domain name, which incorporates two famous marks in the optical world in their entirety, is not a mere coincidence, and was not done in good faith. The timing of this registration should remove any doubt that the disputed domain name was registered and is being used in bad faith.
- iv. The Complainants request that the disputed domain name be transferred to Complainant Essilor International.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

5. Findings

The Complaint was filed by two complainants against a single respondent. Each Complainant owns a trademark that is wholly incorporated in the disputed domain name. The Panel finds that the Complainants have a common grievance against the Respondent and that it is efficient to permit the consolidation of their complaints. Therefore, the Complainants are referred to below collectively as “the Complainant” except as otherwise indicated.

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail, namely:

- i. Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent’s domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

Based on the evidence submitted, the Panel finds that Complainant Essilor International has rights in the ESSILOR trademark and that Complainant Luxottica Group S.p.A. has rights in the LUXOTTICA trademark.

The disputed domain name wholly incorporates the LUXOTTICA and ESSILOR trademarks. The disputed domain name also includes a hyphen between each of the marks, but this is mere punctuation that does not dispel the confusing similarity between the disputed domain name and the Complainant's trademarks. The disputed domain name also includes the generic Top-Level Domain suffix ".com" but this is a mere technical requirement of registration.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks. The Complainant has satisfied the first element of Paragraph 4(a) of the Policy.

B) Rights and Legitimate Interests

Nothing on the record indicates that the Respondent has any relevant trademark rights, or that he uses the disputed domain name in connection with a bona fide offering of goods or services or that he has been commonly known by the disputed domain name.

The Respondent uses the disputed domain name in connection with a webpage that is allegedly under construction. The webpage foreshadows a proposed listing of "all known companies and interests held by certain companies in the optical world". However, that is merely an assertion that does not evidence any demonstrable preparations to use the disputed domain name in connection with a bona fide offering of services within the terms of Paragraph 4(c)(i) of the Policy. The webpage states that the proposed listing will be made "[a]s a matter of interest to those in the optical world". However, a mere assertion about some proposed future use is insufficient to evidence a legitimate noncommercial or fair use of the disputed domain name within the terms of Paragraph 4(c)(iii) of the Policy.

Based on the evidence on the record and the findings in Section 5C below, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has satisfied the second element of Paragraph 4(a) of the Policy.

C) Bad Faith

The Complainant's ESSILOR and LUXOTTICA trademarks are distinctive with no apparent dictionary meaning. It is clear from the combination of these terms in the disputed domain name, and from the text on the webpage to which the disputed domain name resolves, that the Respondent is aware of the Complainant's trademarks and of the Complainant's business in the optical sector. The disputed domain name was registered only four days after the announcement of the Complainant's merger, which indicates to the Panel that the Respondent deliberately

targeted the Complainant's trademarks when he registered the disputed domain name.

As regards use, the disputed domain name was registered shortly after the announcement of a corporate merger, and the disputed domain name reflects a potential name of the merged entity. The Panel considers that the most likely explanation for the Respondent's use of the disputed domain name is opportunistic bad faith, despite the assertions on the webpage to which the disputed domain name resolves. See *Pharmacia & Upjohn AB v. MonsantoPharmacia.com Inc.*, WIPO Case No. D2000-0446; *SMS Demag AG v. Seung Gon, Kim*, WIPO Case No. D2000-1434; *A.P. Moller v. Web Society*, WIPO Case No. D2000-0135; *Repsol YPF, S.A. v. COMn.com*, WIPO Case No. D2001-0741; and *Konica Corporation, Minolta Kabushiki Kaisha aka Minolta Co., Ltd. v. IC*, WIPO Case No. D2003-0112.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant has satisfied the third element of Paragraph 4(a) of the Policy.

6. Decision

For the foregoing reasons, the Panel orders that the disputed domain name <luxottica-essilor.com> be transferred to Complainant Essilor International (Compagnie Generale d'Optique).

Matthew Kennedy
Panelist

Dated: 21 June 2017