

WIPO Arbitration and Mediation Center  
Zaak-/rolnummer: DNL2015-0031  
Datum: 29 juli 2015

### **1. The Parties**

The Complainant is Moncler S.P.A. of Milano, Italy, represented by Studio Barbero, Italy.

The Respondent is Quinfox Automatisering B.V. of 's-Hertogenbosch, the Netherlands.

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

The disputed domain name <moncler.nl> is registered with SIDN through Registrar.eu.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 18, 2015. On June 18, 2015, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name. On June 23, 2015, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the "Regulations").

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 23, 2015. In accordance with the Regulations, article 7.1, the due date for Response was July 13, 2015. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 14, 2015.

The Center appointed Alfred Meijboom as the panelist in this matter on July 20, 2015. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

In accordance with article 17.2 of the Regulations, the language of the proceeding is English.

### **4. Factual Background**

The Complainant is active in the field of luxury outerwear and sportswear, and is the owner of a number of trademark registrations, including the following registrations which are valid in the Netherlands:

- International Trademark with registration no. 504072 for MONCLER, registered on June 20, 1986 in classes 9, 18, 20, 25, 28, designating also Benelux;
- International Trademark with registration no. 269298 for MONCLER, registered on May 11, 1963 in classes 20, 22, 24, 25, designating also Benelux;
- Benelux Trademark with registration no. 305911 for MONCLER, registered on October 19, 1971 in class 3;
- Community Trademark with registration no. 3554656 for MONCLER, registered on February 11, 2005 in class 3;
- Community Trademark with registration no. 5796594 for MONCLER, registered on January 28, 2008 in classes 3, 9, 14, 16, 18, 22, 24, 25, 28.

The disputed domain name was registered on April 16, 2008. The Respondent acquired the disputed domain name on April 15, 2015. The disputed domain name does not resolve to an active website.

## 5. Parties' Contentions

### A. Complainant

The Complainant has registered the trademark MONCLER since as long as 1963 and has been using it in more than 100 countries for over 50 years in connection with its products. The Complainant registered the trademark MONCLER also in Benelux in 1971. The Complainant operates within an extensive sales network, and had a turnover of about EUR 580 million worldwide. The Complainant's products are marketed through the retailer channel and directly by the Complainant, as well as in the wholesale channel with monobrand or multibrand stores managed by third parties. Furthermore, the trademark MONCLER was and presently is strongly supported by intensive advertising campaigns worldwide through television and other media such as international magazines with broad circulation. In light of the Complainant's significant investments in research and development, marketing, sales and distribution channels, as well as the existence of its huge client base for these products, MONCLER is a famous and well-known trademark worldwide, including in the Netherlands.

The Respondent registered the disputed domain name without authorization from the Complainant, and originally redirected it to a registrar parking page, while currently the website under the disputed domain name is pointing to a blank page. When the Complainant became familiar with the disputed domain name by the end of 2014, it sent a cease and desist letter on December 1, 2014 to the person listed as the registrant of the disputed domain name at that time and whose email address was based on the same domain name on which the current Respondent's email address is based. The registrant did neither reply to the cease and desist letter nor to the two reminders sent in January 2015. The Complainant discovered that the disputed domain name had been registered in the Respondent's name on April 15, 2015. On May 8, 2015, the Complainant sent the Respondent a cease and desist letter. The Respondent did not reply to this letter and the reminder either. When the Complainant contacted the Respondent by telephone it was asked to forward the letters to an alternative email address and it would look into the matter, which the Respondent failed to do after the Complainant sent the letters to the Respondent's alternative email address. The Complainant sent several more cease and desist letters and reminders, and contacted the Respondent by telephone again, without receiving any reply from the Respondent.

The Complainant claims that the disputed domain name is identical to its MONCLER trademarks as listed in paragraph 4 above, except for the Top-Level Domain ".nl", which should be ignored. The Complainant further alleges that the Respondent has not provided the Complainant with any evidence of its use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services before any notice of the dispute. The Respondent has been and is currently holding the disputed domain name passively, which non-use is insufficient to establish a legitimate interest in respect of a domain name. The Respondent is also not a licensee or an authorized agent of the Complainant or in any other way authorized to use the Complainant's trademark MONCLER. The Complainant also contends that the Respondent is not commonly known by the disputed domain name as an individual, business, or other organization and the trademark MONCLER is not the family name of the Respondent. As additional element within the frame of rights or legitimate interests, the Respondent did not reply to the cease and desist letters and the subsequent reminders sent on behalf of the Complainant, nor did it provide any explanation as to the registration and use of the disputed domain name when it was contacted by telephone on behalf of the Complainant. The Complainant therefore concludes that the Respondent has no rights to or legitimate interests in respect of the disputed domain name.

The Complainant is of the opinion that the Respondent also registered or used the disputed domain name in bad faith. The Complainant claims that the Respondent was undoubtedly aware of the existence of the Complainant's MONCLER trademark at the time of the registration of the disputed domain name, given the reputation of the trademark in many countries, including the Netherlands. According to the Complainant, the disputed domain name is also used in bad faith as it has been previously redirected to a registrar parking page and is currently redirected to an inactive website. In addition, the lack of any response by the Respondent to the Complainant's cease and desist letters and subsequent reminders are further circumstances suggesting bad faith on the part of the Respondent.

#### *B. Respondent*

The Respondent did not reply to the Complainant's contentions.

### **6. Discussion and Findings**

As the Respondent has not filed a response, the Panel shall rule on the basis of the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the panelist considers it to be without basis in law or in fact.

The Panel notes that, in accordance with article 16.4 of the Regulations, the Center has fulfilled its obligation to employ reasonably available means to achieve actual notice of the Complaint to the Respondent.

Based on article 2.1 of the Regulations, a request to transfer a domain name must meet three cumulative conditions:

- a. a domain name is identical or confusingly similar to a trademark or trade name protected under Dutch law in which the complainant has rights, or other name by means of article 2.1(a) under II of the Regulations; and
- b. the respondent has no rights to or legitimate interests in the domain name; and
- c. the domain name has been registered or is being used in bad faith.

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

It is established case law that the Top-Level Domain ".nl" may be disregarded in assessing the similarity between the trademarks on the one hand, and the disputed domain names on the other hand (see, e.g., *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. DNL2008-0008).

When accordingly ignoring the Top Level Domain, the disputed domain name is identical to the MONCLER trademarks identified in paragraph 4 above which are protected under Dutch law in which the Complainant has rights, so that the Panel finds that the Complainant has satisfied the requirement of article 2.1(a) of the Regulations.

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

Article 2.1(b) of the Regulations requires that the Complainant demonstrates that the Respondent has no rights to or legitimate interests in the disputed domain name. This condition is met if the Complainant makes a *prima facie* case that the Respondent has no such rights or interests, and the Respondent fails to rebut this (see, e.g., *Technische Unie B.V. and Otra Information Services v. Technology Services Ltd.*, WIPO Case No. DNL2008-0002).

The Panel is satisfied that the Complainant made such *prima facie* case, showing that the Respondent has not made demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of

goods or services before the Respondent having received the notice of the dispute, and that the Respondent was not commonly known by the disputed domain name or a similar name. The Respondent has not disputed the above.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of article 2.1(b) of the Regulations.

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

The lack of any active use of the disputed domain name to resolve to an active website without any active attempt to sell or to contact the Complainant does not as such prevent a finding of bad faith. The Panel must examine all circumstances of the case to determine if the Respondent has registered or used the disputed domain name in bad faith (*e.g., Eutelsat SA v. Hoofsaeecke BV*, WIPO Case No. DNL2013-0010).

The Complainant has been the owner of the MONCLER trademarks which have been valid in the Netherlands since as early as 1963 and the Complainant has shown actual use of the trademarks. The registration and use of the MONCLER trademarks therefore significantly predate the Respondent's registration of the disputed domain name. The Panel is further satisfied that the MONCLER trademark has a reputation and in absence of evidence to the contrary, the Panel finds that the Respondent must have been aware of the MONCLER trademarks when it registered the disputed domain name.

As it has been established that the disputed domain name was registered in bad faith, the Panel finds that the requirements of article 2.1(c) of the Regulations have also been met.

## **7. Decision**

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the disputed domain name <moncler.nl> be transferred to the Complainant.

Alfred Meijboom  
Panelist  
Date: July 29, 2015