

ADMINISTRATIVE PANEL DECISION

Calvin Klein Inc. and Calvin Klein Trademark Trust v. Won Sop Lee
Case No. D2022-0312

1. The Parties

The Complainant is Calvin Klein Inc., United States of America (“United States”) and Calvin Klein Trademark Trust, United States, represented by Kestenberg Siegal Lipkus LLP, Canada.

The Respondent is Won Sop Lee, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <meta-calvinklein.com> is registered with Gabia, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 29, 2022. On January 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 7, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On February 7, 2022, the Center notified the Parties in both English and Korean that the language of the registration agreement for the disputed domain name is Korean. On February 9, 2022, the Complainant requested for English to be the language of the proceeding and filed the amended Complaint with its translated version. The Respondent did not comment on the language of the proceeding.

The Center verified that the 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 February 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 7, 2022.

The Center appointed Moonchul Chang as the sole panelist in this matter on March 16, 2022. 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 has been engaged in the production, sale and licensing of men's and women's apparel, fragrances, accessories, and footwear, among other things, all in association with one or more of the Calvin Klein intellectual properties.

Since 1968, the Complainant has used and registered its marks in the United States and throughout the world. In the United States, the Complainant owns Registration No. 1,633,261 (registered January 29, 1991) and 1,086,041 (registered February 21, 1978) for the CALVIN KLEIN trademark.

The Complainant is the owner of a number of domain name registrations which incorporate the CALVIN KLEIN trademark. These include <calvinklein.com>, <calvinkleinbags.com>, <calvinkleinunderwear.com>, <calvinkleinjeans.com>, and <calvinkleinfashion.com>. These domain names were registered and used long before the registration of the disputed domain names and are used to promote and sell the Complainant's CALVIN KLEIN-branded products.

According to the publicly available Whois information, the disputed domain name <meta-calvinklein.com> was registered on November 12, 2021. The disputed domain name is currently inactive.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

(a) The disputed domain name is identical or confusingly similar to its trademark. The disputed domain name incorporates the Complainant's trademark CALVIN KLEIN in its entirety. The addition of the term "meta" in the disputed domain name would not prevent a finding of the confusing similarity. The use of the term "meta" is relevant because Mark Zuckerberg announced on October 28, 2021, the introduction of his new company name, Meta, and its focus on the metaverse.

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has neither authorized nor given its consent to the Respondent to register or use the disputed domain name. The Respondent has no proprietary rights or legitimate interests in the CALVIN KLEIN mark and the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. The disputed domain name is currently inactive. In addition, the Respondent has never been commonly known by the disputed domain name.

(c) The disputed domain name was registered and is being used in bad faith.

First, the Respondent is diverting the Complainant's customers or potential customers seeking information about the Complainant to an inactive page of the Respondent. The disputed domain name can also divert Internet users to websites that the Respondent activates in the future without the Complainant's authorization.

Second, the disputed domain name is currently inactive. However, previous UDRP panels have held that the passive use may amount to bad faith.

Third, a reverse Whois search indicates that around November, 2021, approximately 207 domain names were registered by and/or in association with the Respondent's email address. Many of these domain names feature "meta" and share the same Registrar, Gabia, Inc.

Further, the Respondent intended to use the CALVIN KLEIN trademark in association with the purported interests generated from "meta" announcement on October 28, 2021.

Fourth, although the Complainant delivered a cease and desist letter to the Respondent via email on January 14, 2022, no response was received by the Complainant.

Finally, the Respondent is diverting Internet traffic to its own webpage that is inactive, taking advantage of the goodwill associated with the Complainant. Otherwise the Respondent's registration of the disputed domain name was solely done to prevent the Complainant from registering it and was acquired for the purpose of selling the disputed domain name for valuable consideration in excess of any out-of-pocket expenses and/or in attempt to generate financial gain by creating of confusion with the Complainant's mark.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of Proceedings

According to paragraph 11 of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement unless the Panel determines otherwise or otherwise agreed to by the Parties. In this present case, the Registrar confirmed that the language of the Registration Agreement for the disputed domain name is Korean. However, the Complaint was filed in English.

The Complainant requests that the language of proceeding be English for the following reasons. The Respondent appears to be a Korean individual, however the disputed domain name includes CALVIN KLEIN in Latin characters and the English word "meta". There is no Korean script featured in the disputed domain name.

Here, the Panel observes that the Center, for its part, has communicated with the Parties in a bilingual manner in both English and Korean concerning all of the various steps and requirements thus far in the administrative proceeding. However, the Respondent has not responded to the issue of the language of the proceeding. The spirit of paragraph 11 of the Rules is to ensure fairness in the selection of the language of the proceeding by giving full consideration, *inter alia*, to the Parties' level of comfort with each language, expenses to be incurred, and possibility of delay in the proceeding in the event translations are required and other relevant factors. The Panel would have accepted a Response in either English or Korean, but none was submitted. In consideration of the above circumstances and in the interest of fairness to both Parties, the Panel concludes, in view of all of the above, that it accepts the Complaint in English, and that it will render this Decision in English.

6.2. Substantive Issues

Under paragraph 4(a) of the Policy, the Complainant must demonstrate that the three elements enumerated in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to the Complainant's trademark or service mark; 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.

A. Identical or Confusingly Similar

The disputed domain name includes the Complainant's trademark CALVIN KLEIN in its entirety together with addition of a term "meta". The Panel's assessment of identity or confusing similarity involves a straightforward comparison between the disputed domain name and the textual components of the relevant mark. Adding such term does not prevent a finding of confusing similarity and does not change the overall impression of the disputed domain name as being confusingly similar to the Complainant's trademark. (Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Numerous UDRP panels have held that where a domain name incorporates a complainant's trademark in its entirety, or where at least a dominant feature of the relevant mark is recognizable in the domain name, it is sufficient to consider the domain name "confusingly similar" to that mark within the meaning of the Policy. (Section 1.7 of [WIPO Overview 3.0](#)). In addition, the generic Top-Level Domain ("gTLD") ".com" can be disregarded under the confusing similarity test. (Section 1.11.1, [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that the first element under paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the overall burden of proof is on the Complainant. However, once the Complainant presents a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, the burden of production of evidence shifts to the Respondent. (Section 2.1 of [WIPO Overview 3.0](#)).

Firstly, the Complainant contends that it has never authorized or licensed the Respondent to use the Complainant's trademark CALVIN KLEIN or to register any domain names incorporating it and that the Respondent has used the Complainant's trademark without permission of the Complainant. On the other hand, the Respondent did not reply to the Complaint. Currently the disputed domain name is inactive.

Secondly, the Complainant contends that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. In the meantime, the Respondent failed to come forward with any appropriate allegations or evidence that might demonstrate its rights or legitimate interests in the disputed domain name to rebut the Complainant's *prima facie* case.

Thirdly, there is no evidence presented to the Panel that the Respondent has used, or has made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services or is making a legitimate noncommercial or fair use of the disputed domain name. In addition, there is no evidence to suggest that the Respondent has been commonly known by the disputed domain name.

In the consideration of the above circumstances the Panel finds that the Complainant has made out a *prima facie* case and the Respondent failed to come forward with any appropriate evidence that might rebut the Complainant's *prima facie* case.

Accordingly, the Panel concludes that the Complainant has satisfied the second element under paragraph 4(a) of the Policy in the present case.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the disputed domain name "has been registered and is being used in bad faith". Hence, the Complainant must establish both bad faith registration and bad faith use of

the disputed domain name. In addition, the circumstances listed in paragraph 4(b) of the Policy are not exclusive, and other circumstances may likewise lead to a finding of bad faith registration and use.

Firstly, the Complainant obtained the registration of the United States trademarks much earlier than the Respondent registered the disputed domain name in 2021. Having considered that the Complainant's trademark CALVIN KLEIN is internationally well known and famous it is highly likely that the Respondent has been aware of the reputation of the CALVIN KLEIN mark when registering a confusingly similar domain name that full incorporates the Complainant's mark plus the term "meta". Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. (Section 3.1 of the [WIPO Overview 3.0](#)). Thus, it is considered bad faith that the Respondent deliberately chose the disputed domain name to create a likelihood of confusion with the Complainant's trademark so as to create a false association or affiliation with the Complainant.

Secondly, the Panel notes that the disputed domain name is currently inactive. However, it is well established that the lack of use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. (Section 3.3 of the [WIPO Overview 3.0](#)). Having considered the reputation of the Complainant's mark CALVIN KLEIN and the failure of the Respondent to submit a response or to provide any evidence of *bona fide* use, the Panel finds the Respondent's bad faith use of the disputed domain name.

Finally, the Complainant also submitted evidence that numerous domain names featuring famous third parties' trademarks, were registered by or in association with the Respondent's email address. It supports that these registrations could lead to a pattern of cybersquatting and the Respondent intended to take unfair advantage of the CALVIN KLEIN trademark in addition to various other third party trademarks.

Accordingly, the Panel concludes that the Complainant has satisfied the third element under paragraph 4(a) of the Policy in the present case.

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 <meta-calvinklein.com> be transferred to the Complainant.

/Moonchul Chang/

Moonchul Chang

Sole Panelist

Date: March 30, 2022