

ADMINISTRATIVE PANEL DECISION

Skorpio Limited v. Domain Administrator, See PrivacyGuardian.org / Karolin Diederich

Case No. D2022-1487

1. The Parties

The Complainant is Skorpio Limited, Switzerland, represented by Keltie LLP, United Kingdom (“UK”).

The Respondent is Domain Administrator, See PrivacyGuardian.org / Karolin Diederich, Germany.

2. The Domain Name and Registrar

The disputed domain name <rickowensuk.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 26, 2022. On April 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 26, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 27, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on April 27, 2022.

The Center verified that the Complaint together with the amendment to 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 April 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 20, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on May 27, 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 is a Swiss company that manages the intellectual property rights of the American fashion designer Rick Owens. Rick Owens began his fashion designer career in Los Angeles, United States of America ("USA"), in 1994 and moved his production to Italy, starting worldwide distribution, in 2001. He won various awards and his clothing designs have been worn by many celebrities. Owens has opened stores in Paris, New York, London, Seoul, Tokyo, and Hong Kong.

The Complainant has registered several trademarks consisting of RICK OWENS including the European Union trademark registration No. 002493294 registered on May 21, 2003 and the USA registration No. 3828467 registered on August 3, 2010.

The disputed domain name was registered on February 17, 2022 and resolves to a website purporting to sale RICK OWNES goods at discounted prices. These include a leather boot purportedly reduced from GBP915 to GBP68. The website does not include any details of the operator of the website, and displays the stylized trademark of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is nearly identical to the Complainant's rights and that the additional word "UK" does nothing to prevent the confusing similarity of the disputed domain name with the Complainant's famous trademark; in fact, it merely reinforces the impression that the disputed domain name is the Complainant's UK website.

As regards to the second element, the Complainant argues that it has not given its consent for the Respondent to use the Complainant's registered trademarks or confusingly similar variations thereof in a domain name registration. To the best of the Complainant's knowledge the Respondent is not commonly-known as "RICK OWENS".

With respect to the third element, the Complainant contends that given that the Complainant's registered rights upon which the Complaint is based date back to 2003, the Respondent must have been aware of the reputation of the Complainant's business under its RICK OWENS trademark at the time the Respondent registered the disputed domain name. As regards to the use, the Complainant contends that the disputed domain name resolves to a website displaying/advertising goods for sale using the Complainant's registered trademarks and that the items for sale via the disputed domain name are unauthorised counterfeits. The Complainant refers to the goods being offered for sale at a fraction of the genuine price on the website at the disputed domain name. The Complainant submits that there is a realistic and serious threat posed by the Respondent's continued ownership of the disputed domain name in view of the inevitable damage the counterfeit items will cause to the reputation that the Complainant enjoys in its famous RICK OWENS trademark.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Matters

No communication has been received from the Respondent in this case. However, given that notice of the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default.

6.2 Substantive Matters

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

A. Identical or Confusingly Similar

The Complainant has provided evidence of its rights in the RICK OWENS trademarks. The trademark RICK OWENS is reproduced in its entirety in the disputed domain name. The addition of “uk” does not prevent a finding of confusing similarity with the Complainant’s trademark RICK OWENS, which is recognizable in the disputed domain name. The fact that a domain name wholly incorporates a complainant’s trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such trademarks. The addition of an additional term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

It is well accepted by UDRP panels that a generic Top level Domain (“gTLD”), such as “.com”, is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark RICK OWENS and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, according to the un rebutted evidence of the Complainant, the website at the disputed domain name is used to offer for sale RICK OWENS goods at a significantly discounted price – not even 10 per cent of their original price. Comparing the prices for the same product on the Complainant’s website and the website at the disputed domain name, as described in Section 4, it is reasonable to conclude that those offered on the website at the disputed domain name are

counterfeit products. As a result, the Panel finds on balance of probabilities that the website to which the disputed domain name resolves offers counterfeits of the Complainant's products. (Even if the products were genuine, the lack of any disclaimer on the website at the disputed domain name as to the registrant's relationship with the trademark owner or the lack thereof, would falsely suggest to Internet users that the website to which the disputed domain name resolves is owned by the Complainant or at least affiliated to the Complainant (as per the *Oki Data principles outlined in Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).)

Also, there is no evidence that the Respondent is commonly known by the disputed domain name.

Furthermore, the nature of the disputed domain name, that includes the Complainant's well-established trademark, carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because the Respondent did not respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The Complainant's registration and use of the relevant trademarks predate the date at which the Respondent registered the disputed domain name. The disputed domain name resolves to a website reproducing the Complainant's trademark and purportedly offering for sale the Complainant's products but at a much lower price. Given the distinctiveness and renown of the Complainant's trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks, and to target those trademarks.

The use of the term "uk" reinforces the impression that the disputed domain name is the Complainant's website for the UK market. The disputed domain name resolves to a website, which ostensibly offers counterfeits of the Complainant's products. As such, the disputed domain name suggests affiliation with the Complainant in order to attract consumers and offer counterfeit products.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

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 <rickowensuk.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: June 10, 2022