

ADMINISTRATIVE PANEL DECISION

Société de Gestion Pierre Cardin v. Zhang Fei
Case No. D2024-1656

1. The Parties

Complainant is Société de Gestion Pierre Cardin, France, represented by Tmark Conseils, France.

Respondent is Zhang Fei, China.

2. The Domain Name and Registrar

The disputed domain name <pierrecardin-portugal.com> (the “Domain Name”) is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2024. That same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 22, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (UNKNOWN) and contact information in the Complaint. That same day, the Center sent an email communication to Complainant, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 2, 2024.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on May 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 28, 2024.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on June 3, 2024. 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

Complainant is a company incorporated under French law, founded in 1950. It holds trademark rights to the PIERRE CARDIN mark (or the “Mark”) through an exclusive license, including the following registrations: French Trademark Registration Nos. 1374766 (issued, October 14, 1986) and 4915362 (issued, November 22, 2022); and European Trademark Registration No. 005875554 (issued April 10, 2008). These trademarks are used in connection with products and services relating to, for example, fashion, accessories, leatherware, jewelry, fragrances, furniture, tableware, and design.

In its business, Complainant registered and uses various domain names incorporating the Mark such as <pierrecardin.com> registered on February 26, 1999. And Complainant has owned the corporate name SOCIETE DE GESTION PIERRE CARDIN, which it registered in the Commerce Register in France since May 29, 1973, under the No. 732037056.

Complainant’s creations have been worn by Madonna, Beyoncé, the Beatles, Zendaya and Catherine Deneuve, and been featured in many press articles and publications on social networks. Complainant has 238 boutiques in France and almost a thousand points of sale around the world.

The Domain Name was registered on November 18, 2023. It resolved to a website featuring the Pierre Cardin Mark and “Paris” prominently at the top of the page (as does Complainant’s website) and models wearing clothes that look like clothes sold on Complainant’s website. Moreover, the models looked the same and had the same poses as the models on Complainant’s website. Now, the Domain Name resolves to a page stating: “This site can’t be reached. Check if there is a typo in pierrecardin-portugal.com.”

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name. The Domain Name reproduces identically the PIERRE CARDIN Mark which is the prominent and essential character of the Domain Name. Adding the generic Top-Level Domain (gTLD) “.com” does not eliminate the confusing similarity between the Mark and the Domain Name. Also, including the geographical term “Portugal” does not serve to dispel the confusing similarity of the Domain Name, rather it reinforces the association with Complainant because it is purely descriptive of the location and activities carried out by Complainant and allows the user to believe that it is Complainant’s official site in Portugal. Given the fame and extensive reputation and notoriety throughout the world of PIERRE CARDIN, the public would expect the owner and user of the Domain Name to be associated with Complainant.

Complainant is the sole owner of the Mark, corporate name and domain name made of/including the PIERRE CARDIN Mark. It has not authorized any third-party to identify itself to the public as PIERRE CARDIN or PIERRECARDIN Portugal in a domain name. There appears to be no legitimate reason why Respondent would incorporate Complainant’s well-known PIERRE CARDIN Mark in the Domain Name.

Complainant, who was founded in 1950, enjoys a solid reputation in the fashion industry. So, Respondent must have been aware of the Mark and sought to impermissibly take advantage of Complainant’s commercial interest in the Mark (i.e., its goods and services in the fashion field in particular). Respondent’s use of the Domain Name linked to Complainant’s PIERRE CARDIN Mark will generate a larger audience than would likely have been the case if Respondent chose a domain name that was not confusingly similar to a famous mark.

Considering the protection and constant use by Complainant of the Mark worldwide, there is no chance Respondent registered the Domain Name coincidentally. Rather, because of the attractiveness of the PIERRE CARDIN Mark in relation to clothing, accessories, bags, jewelry, and design, the registration of the Domain Name was done in bad faith. A simple Internet check via Google indicates the existence of

Complainant's long-term activity under the name PIERRE CARDIN and Complainant's website appears as the first result when using the key word PIERRE CARDIN. Reproducing the Mark in combination with the word "Portugal" in the Domain Name proves Respondent was aware of the existence of Complainant's Mark.

The Domain Name resolves to a website that imitates or impersonates Complainant's official website. On that website is Complainant's counterfeit products for sale. The public may think that this Domain Name resolves to Complainant's website in Portugal given the similarities between Respondent's and Complainant's websites. Respondent's use of the Domain Name is intended to mislead and attract the Internet user to Respondent's competitive website. The consequence is that there will be confusion, as a substantial proportion of Internet users visiting the website under the Domain Name will be doing so in the expectation of reaching a site of, or authorized by, Complainant. When they reach the site, they may realize that they have been mistaken, but in any event the objective of bringing them there will have already been achieved. Indeed, Respondent will derive income from his activities, as evidenced by the illegal sale of the counterfeit products.

Moreover, Respondent is using the Mark to target an audience by suggesting that the content of the site has been validated by Complainant. Such acts have no other purpose than to disrupt Complainant's business and are therefore conclusive evidence that Respondent registered and used the Domain Name in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

As demonstrated with the above registrations, Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Mark is reproduced within the Domain Name. Accordingly, the Domain Name is confusingly similar to the Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "Portugal" may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the Domain Name and the Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with

relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy or otherwise.

It is un rebutted that Complainant has not authorized Respondent to identify itself to the public as PIERRE CARDIN for any purpose including in a domain name. Respondent's use of Complainant's well-known Mark in the fashion industry in the Domain Name linked to a website purporting to sell Complainant's products, without disclosing the lack of relationship, and creating a risk of implied affiliation, is not a bona fide use of the Domain Name. The fact that the Domain Name currently is not resolving to such a website does not negate this element because as long as Respondent owns the Domain Name he may use it again in a manner that is not a bona fide use of the Domain Name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that Respondent has been using the Mark worldwide well over 40 years and certainly many years before Respondent registered the Domain Name. Insofar as the Mark has an international reputation including in the fashion industry, it is unlikely that Respondent did not know of the Mark or Complainant's rights in the Mark when registering the Domain Name. Furthermore, considering the facts that: (1) Respondent added the geographical term "Portugal" to the well-known Mark, a place where Complainant does business; (2) Respondent was using the Mark on a fashion oriented website to sell clothes and accessories purporting to be of the Complainant; and (3) Respondent's website featured the Mark and "Paris" prominently at the top of the page (as does Complainant's website), used models wearing clothes that looked like clothes sold on Complainant's website, and the models looked the same and had the same poses as the models on Complainant's website, the Panel concludes that Respondent registered the Domain Name in bad faith.

Respondent's prior use of the Domain Name constitutes bad faith use for two reasons. First, using Complainant's well-known Mark with a site that mimicked Complainant's site was calculated to suggest an association with Complainant and disrupt the business of a competitor. Furthermore, the use of the Domain Name as described above was a clear intention to attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Mark.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the Domain Name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the long-standing distinctiveness and reputation of Complainant's Mark internationally, the composition of the Domain Name, and the

Respondent's bad faith registration and prior use and finds that in the circumstances of this case the current passive holding of the Domain Name does not prevent a finding of bad faith under the Policy.

The Panel finds that Complainant has established the third element of the Policy.

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 Domain Name <pierrecardin-portugal.com> be transferred to Complainant.

/Harrie R. Samaras/

Harrie R. Samaras

Sole Panelist

Date: June 12, 2024