

## ADMINISTRATIVE PANEL DECISION

Calvin Klein Trademark Trust and Calvin Klein, Inc. v. Harry Godfrey, Jessica Phillips, Katherine Clayton, Lola Law, Toby Graham, and Zoe McKenzie

Case No. D2023-4071

### 1. The Parties

The Complainant are Calvin Klein Trademark Trust (the “First Complainant”), United States of America (the “US”) and Calvin Klein, Inc., US (the “Second Complainant”), represented by Lipkus Law LLP, Canada.

The Respondent is Harry Godfrey, Italy, Jessica Phillips, Italy, Katherine Clayton, Italy, Lola Law, Italy, Toby Graham, Italy, and Zoe McKenzie, Italy.

### 2. The Domain Names and Registrar

The disputed domain names <calvinkleinargentina.org>, <calvinkleinaustralia.org>, <calvinkleinbelgique.net>, <calvinkleinbulgaria.net>, <calvinkleincanada.org>, <calvinkleinchile.net>, <calvinkleincolombia.org>, <calvinkleincz.org>, <calvinkleindanmarksale.com>, <calvinkleindeutschland.com>, <calvinkleineesti.net>, <calvinkleinespana.net>, <calvinkleingreece.org>, <calvinkleinhrvatska.org>, <calvinkleinhu.net>, <calvinkleinhu.org>, <calvinkleinireland.net>, <calvinkleinisrael.org>, <calvinkleinitalia.com>, <calvinkleinjapan.org>, <calvinkleinlatvija.net>, <calvinkleinlietuva.net>, <calvinkleinmexico.org>, <calvinkleinnlsale.net>, <calvinkleinnz.net>, <calvinkleinosterreich.net>, <calvinkleinperu.org>, <calvinkleinpolska.net>, <calvinkleinportugal.org>, <calvinkleinromania.org>, <calvinkleinschweiz.org>, <calvinkleinsk.net>, <calvinkleinslovenija.org>, <calvinkleinsouthafrica.org>, <calvinkleinsrbija.org>, <calvinkleinsuisse.net>, <calvinkleinsuomi.org>, <calvinkleinsverige.net>, <calvinkleinuae.org>, <calvinkleinuk.org>, and <calvinkleinuruguay.org> (the “Domain Names”) are 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 September 27, 2023. On September 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 4, 2023, 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.

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 October 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 3, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on November 17, 2023. 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 First Complainant, Calvin Klein Trademark Trust, holds the trademark registrations for CALVIN KLEIN, a well-known fashion brand, on behalf of its beneficial owner, the Second Complainant, Calvin Klein Inc. (hereinafter referred to jointly as the “Complainant”).

The Complainant and its associated companies have been engaged in the production, sale, and licensing of men’s and women’s apparel, fragrances, accessories, and footwear under the CALVIN KLEIN brand since at least as early as 1968 in the US, and internationally. The Complainant and its associated companies have millions of customers worldwide and billions of US dollars in sales under the CALVIN KLEIN brand. Over the years, it has spent hundreds of millions of US dollars advertising and promoting its CALVIN KLEIN branded products around the world, including in print, television, radio, and social media advertisements. The Complainant’s CALVIN KLEIN products are sold exclusively through its own retail and outlet stores and websites, including at the domain name <calvinklein.com>, and through authorized dealers.

The Complainant is the owner of numerous trademark registrations in the US and internationally for CALVIN KLEIN and marks including CALVIN KLEIN covering clothing and other merchandise. Annexed to the Complaint were details of the following:

- US Trademark Registration No. 1086041 for CALVIN KLEIN registered on February 21, 1978;
- US Trademark Registration No. 1633261 for CALVIN KLEIN (stylized), registered on January 29, 1991;
- United Kingdom Trademark Registration No. UK00001492382 for CALVIN KLEIN (stylized) registered on January 24, 1994;
- United Kingdom Trademark Registration No. UK00002169731 for CK CALVIN KLEIN (stylized) registered on February 26, 1999;
- European Union Trademark Registration No. 000617381 for CALVIN KLEIN (stylized) registered on January 29, 1999;
- German Trademark Registration No. DD647386 for CALVIN KLEIN registered on November 9, 1990.

The Complainant also owns a number of domain name registrations which wholly incorporate its CALVIN KLEIN marks, including <calvinklein.com>, <calvinkleinbags.com>, <calvinkleinunderwear.com>, and <calvinkleinfashion.com>, which were registered and have been in use since prior to registration of the disputed domain names.

The 41 Domain Names involved in this dispute were all registered on September 13, 2023. The Domain Names resolve to an inactive page.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant requests the consolidation of the Complaint against the multiple Domain Names registrants based on the reasons provided in its Complaint and treats the Respondents in the singular as, the "Respondent".

The Domain Names are confusingly similar to the Complainant's CALVIN KLEIN trademark.

The Respondent has no rights or legitimate interests in respect of the Domain Names. The Respondent has registered and are using the Domain Names in bad faith.

The Complainant requests the transfer of the Domain Names.

### **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Consolidation: Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the Domain Names are under common control. The Complainant requests the consolidation of the Complaint against the multiple Domain Name registrants pursuant to paragraph 10(e) of the Rules.

The Domain Name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the Domain Names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

The Complainant provided evidence to support consolidation of the Respondents into one proceeding based on its Complaint and the information available in the Whois record and email contact information. As regards common control, the Complainant notes that:

- All 41 of the Domain Names were registered on September 13, 2023, within 14 minutes of each other.
- The Registrar for all 41 of the Domain Names is Alibaba.Com Singapore E-Commerce Private Limited.
- All the Domain Names use the same name servers.
- All 41 of the Domain Names follow a common naming pattern as they consist of the Complainant's CALVIN KLEIN mark, a geographical term (e.g., "Argentina", "Greece", "UAE", etc.), and a generic

- Top-Level-Domain (“gTLD”).
- The Registrant’s organization contact details for the 22 “.org” disputed domain names also follow a common pattern as they are all people’s names (e.g., “Jessica Phillips”, “Lola Law”, “Toby Graham”, “Zoe McKenzie”, “Katherine Clayton”, and “Harry Godfrey”). Moreover, the Registrants for all 41 of the Domain Names are located in Italy, in either “Vernazza”, “Monterosso [al Mare]”, or “Manarola”, which are three of the five towns that constitute the Cinque Terre coast line.
- Each of the Domain Names is being used passively as the Domain Names resolve to webpages stating “this site can’t be reached”.

As regards fairness and equity, the Panel sees no reason why consolidation of the Respondents would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different Domain Names registrants (referred to below as “the Respondent”) in a single proceeding.

## 6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements with respect to each disputed domain name:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; 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.

The burden of proof of each element is borne by the Complainant. The Respondent’s default does not by itself mean that the Complainant is deemed to have prevailed. See [WIPO Overview 3.0](#), section 4.3.

### 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 the Complainant’s trademark and the Domain Names. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the 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.

All the Domain Names entirely reproduce the Complainant’s trademark CALVIN KLEIN with the mere addition of terms related to geographic areas such as “Argentina”, “Australia”, “Belgique” (meaning “Belgium” in French), “Bulgaria”, “Canada”, “Chile”, “Colombia”, “CZ” (country code for the Czech Republic), “Danmark” (meaning “Denmark” in Danish), “Deutschland” (meaning “Germany” in German), “Eesti” (meaning “Estonian” in Estonian), “Espana” (meaning “Spain” in Spanish), “Greece”, “Hrvatska” (meaning “Croatia” in Croatian), “HU” (country code for Hungary), “Ireland”, “Israel”, “Italia” (meaning “Italy” in Italian), “Japan”, “Latvija” (meaning “Latvia” in Latvian), “Lietuva” (meaning “Lithuania” in Latvian), “Mexico”, “NL” (country code for Netherlands (Kingdom of)), “NZ” (country code for New Zealand), “Osterreich” (meaning “Austria” in German), “Peru”, “Polska” (meaning “Poland” in Polish), “Portugal”, “Romania”, “Schweiz” (meaning “Switzerland” in German), “SK” (country code for Slovakia), “Slovenija” (meaning “Slovenia” in Slovenian), “South Africa”, “Srbija” (meaning “Serbia” in Slovenian), “Suisse” (meaning “Switzerland” in French), “Suomi” (meaning “Finland” in Finnish), “Sverige” (meaning “Sweden” in Danish), “UAE” (country code for United Arab Emirates), “UK” (country code for United Kingdom), Uruguay, and the dictionary term “Sale”.

The Panel finds that the CLAVIN KLEIN trademark is recognizable within all the Domain Names. Accordingly, the Domain Names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of terms may bear on assessment of the second and third elements, the Panel finds the addition of terms does not prevent a finding of confusing similarity between the Domain Names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel accordingly finds that all the Domain Names are confusingly similar to the CALVIN KLEIN trademark in which the Complainant has rights, and that paragraph 4(a)(i) of the Policy is satisfied.

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

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

While 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 often impossible 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. 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 record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Names. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Names such as those enumerated in the Policy or otherwise. Moreover, the Panel finds that the composition of the Domain Names carries a risk of implied affiliation to the Complainant, which cannot constitute fair use.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

Because the CALVIN KLEIN mark had been used and registered by the Complainant before the Domain Name registrations, the Panel finds it more likely than not that the Respondent had the Complainant’s mark in mind when registering the Domain Names.

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.

The Panel considers that the record of this case reflects that:

- The registration of the Complainant’s trademark pre-dates the registration of the Domain Names by several years;
- The Complainant’s CALVIN KLEIN trademark has been considered well-known (*Calvin Klein Trademark Trust, Calvin Klein, Inc. v. Abhishek Kumar*, WIPO Case No. [D2023-1647](#));
- The Domain Names were all registered at the same date and with the same Registrar;

- The Domain Names incorporate the Complainant's CALVIN KLEIN mark in its entirety, with the addition of geographical indicators or the descriptive term "sale";
- The Respondent is in default;
- The Domain Names are passively held.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1. UDRP 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 record, the Panel finds the non-use of the Domain Names does not prevent a finding of bad faith in the circumstances of this proceeding. While 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 record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, the composition of the Domain Names, the implausibility of any good faith use to which the Domain Names may be put, and finds that in the circumstances of this case the passive holding of the Domain Names does not prevent a finding of bad faith under the Policy.

Having reviewed the record, the Panel finds the Respondent's registration and use of the Domain Names constitutes bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

## 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 names, <calvinkleinargentina.org>, <calvinkleinaustralia.org>, <calvinkleinbelgique.net>, <calvinkleinbulgaria.net>, <calvinkleincanada.org>, <calvinkleinchile.net>, <calvinkleincolombia.org>, <calvinkleincz.org>, <calvinkleindanmarksale.com>, <calvinkleindeutschland.com>, <calvinkleineesti.net>, <calvinkleinespana.net>, <calvinkleingreece.org>, <calvinkleinhrvatska.org>, <calvinkleinhu.net>, <calvinkleinhu.org>, <calvinkleinireland.net>, <calvinkleinisrael.org>, <calvinkleinitalia.com>, <calvinkleinjapan.org>, <calvinkleinlatvija.net>, <calvinkleinlietuva.net>, <calvinkleinmexico.org>, <calvinkleinnlsale.net>, <calvinkleinnz.net>, <calvinkleinosterreich.net>, <calvinkleinperu.org>, <calvinkleinpolska.net>, <calvinkleinportugal.org>, <calvinkleinromania.org>, <calvinkleinschweiz.org>, <calvinkleinsk.net>, <calvinkleinslovenija.org>, <calvinkleinsouthafrica.org>, <calvinkleinsrbija.org>, <calvinkleinsuisse.net>, <calvinkleinsuomi.org>, <calvinkleinsverige.net>, <calvinkleinuae.org>, <calvinkleinuk.org>, and <calvinkleinuruguay.org> be transferred to the Complainant.

*/Pablo A. Palazzi/*

**Pablo A. Palazzi**

Sole Panelist

Date: December 1, 2023.