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ENERO 2017 – JANUARY 2017

Includes an International IP Law Section in English

I.- JURISPRUDENCIA

1. Marcas. “CHUBUT” y “CHUBUT CENTRO DE LA PATAGONIA”. Inexistencia de confusión.

II.-

**International IP Law
Section in English**

WIPO - ADR DOMAIN NAME DECISION

Promod v. Yuan Oi aka Qi Yuan

(Part one)

I.- JURISPRUDENCIA

I. 1. Marcas. “CHUBUT” y “CHUBUT CENTRO DE LA PATAGONIA”. Inexistencia de confusión.

En “Mastellone Hnos. c/ Provincia de Chubut Subsecretaría de Turismo s/ Cese de oposición al registro de marca” la Sala II de la CNCivComFed resolvió, el 26.08.16 que no existe posibi-

lidad de confusión entre ambas marcas sosteniendo que “lo único que aquí interesa es analizar si le corresponde a la demandada, titular del signo “CHUBUT CENTRO DE LA PATAGONIA” en la clase 35, impedir la existencia de otro signo marcario con semejanzas que provoquen confusión en el público consumidor. Habida cuenta de las diferentes actividades que desarrollan ambas partes, que nunca podría originarse una situación de confusión por parte del público consumidor, y ello es tan evidente que no merece la exposición de importantes fundamentos, pues es obvio que quien concurre a un supermercado o a un almacén con el propósito de comprar el famoso queso



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"CHUBUT" no encontrará folletos referentes a la promoción de turismo regional que despliega la provincia demandada, y aunque aconteciera tal extremo, no existe posibilidad de error alguno". Fuente: www.eldial.com.ar

II.-

International IP Law Section in English

**WIPO Arbitration and
Mediation Center**

ADMINISTRATIVE PANEL DECISION

**Promod v. Yuan Qi aka Qi
Yuan**

(Part One)

1. The Parties

The Complainant is Promod of Marcq-en-Baroeul, France, represented by Dreyfus & associés, France.

The Respondent is Yuan Qi aka Qi Yuan of Guangdong, China.

2. The Domain Name and Registrar

The disputed domain name <promod.pw> is registered with

Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on October 13, 2016. On October 13, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 14, 2016, 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.



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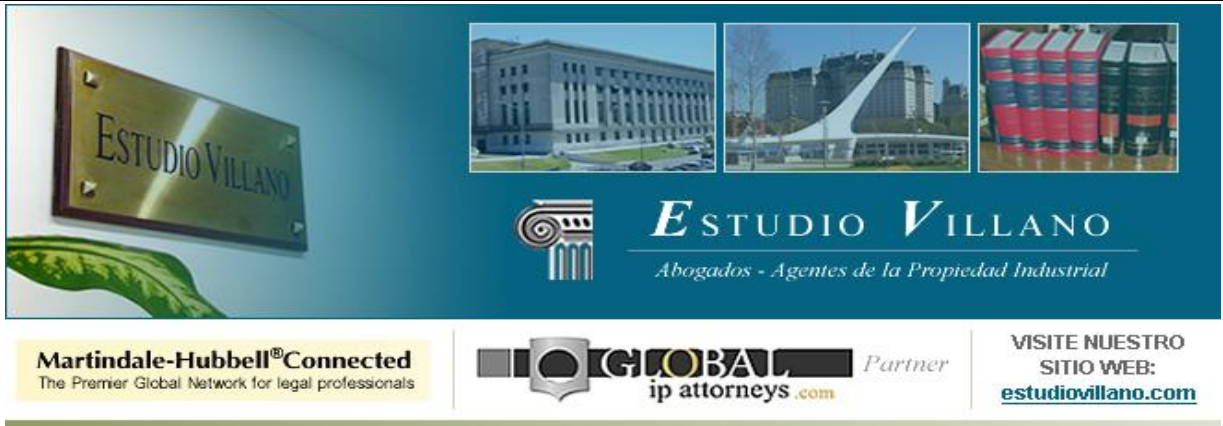
October 18, 2016, the Center sent an email communication to the Parties in both Chinese and English. On the same day, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding by the specified due date. The Center 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 in both Chinese and English of the Complaint, and the proceedings commenced on October 24, 2016. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2016. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 14, 2016. The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on November 21, 2016. 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, founded as a fashion boutique in 1975, is now one of France’s largest fashion store chains and owns more than 900 retail outlets in about 40 countries. The Complainant has more than 5,000 employees around the world. The Complainant owns the trademark PROMOD for use in connection with women’s clothing, women’s shoes, jewelry, and accessories. The Complainant owns International Trademark Registration Nos. 623483 (dated August 31, 1994 and covering goods in Class 9) and 597138 (dated February 8, 1993 and



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covering goods in Classes 24, 25, and 26) for the PROMOD mark, both of which are protected in several jurisdictions, including China. The Complainant registered the domain names <promod.fr> and <promod.com> in 1996 and uses them to promote its PROMOD trademark and to promote its goods and services. The Respondent registered the disputed domain name on March 1, 2016. The disputed domain name resolves to a website featuring the name “Marques boutique” and advertising fashion brands such as Ralph Lauren, Ray-Ban, Moncler, and Christian Louboutin. The website features links that direct Internet users to third-party retail outlet websites

purporting to sell such branded goods. The Respondent’s website includes English and French words as do the third-party websites. The Complainant made efforts to resolve the dispute prior to filing the Complaint. The Complainant sent a cease-and-desist letter to the Respondent via registered letter and email, requesting that the Respondent cease use of the disputed domain name and transfer the same to the Complainant. The Respondent did not reply.

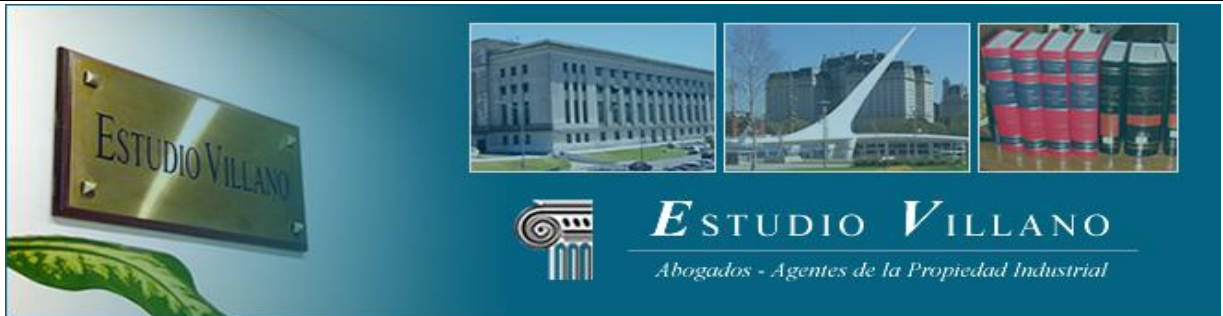
5. Parties’ Contentions

A. Complainant

The Complainant states that the disputed domain name is identi-

cal or confusingly similar to the Complainant’s mark. The Complainant and its PROMOD mark enjoy a worldwide reputation. The disputed domain name reproduces the PROMOD mark exactly. The country code Top-Level Domain (“ccTLD”) “.pw” does not affect the likelihood of confusion and should not be considered. See, e.g., *L’Oréal S.A. v. Lianfa*, [WIPO Case No. DPW2014-0003](#); *Pirelli & C. S.p.A. v. Gaoxiang*, [WIPO Case No. DPW2014-0004](#). By registering the disputed domain name, the Respondent has created a likelihood of confusion with the Complainant’s trademark. Consumers have learned to perceive goods offered under the PROMOD mark as being those of the Complainant.

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Therefore, it is likely that the public would assume that the disputed domain name would be owned by or somehow associated with the Complainant. The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not affiliated with the Complainant nor has the Complainant authorized the Respondent to use the PROMOD trademark or to register any domain name including the PROMOD trademark. The Respondent does not have prior rights in the PROMOD mark. The Complainant's registrations for the PROMOD mark precede the registration of the disputed domain name for many years. Additionally, the disputed domain name is so similar to the

famous PROMOD trademark that the Respondent cannot reasonably pretend that he intended to conduct legitimate activity through the disputed domain name. The Respondent has not made any reasonable and demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services nor has the Respondent shown any intention to make noncommercial fair use of the disputed domain name. Instead, the Respondent uses the disputed domain name to operate a website under the name "Marques boutique" that displays clothes and accessories of various renowned brands. A click on the images displayed on the website directs Internet users

to different websites that commercialize the clothes and accessories, and such goods appear to be counterfeits. Additionally, the Respondent did not respond to the Complainant's letter requesting that the Respondent cease use of the disputed domain name and to transfer it to the Complainant. Because the Respondent did not avail himself of the right to respond to the Complainant, the Complainant argues that it can be assumed that the Respondent has no rights of legitimate interest in the disputed domain name. See, e.g., *Nordstrom, Inc. and NIHC, Inc. v. Inkyu Kim*, [WIPO Case No. D2003-0269](#). The disputed domain name was registered and is being used in bad faith. Bad faith

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registration can be found where the Respondent knew or should have known of the Complainant's trademark rights and, nevertheless, registered a domain name in which he has no rights or legitimate interest. *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, [WIPO Case No. D2009-0320](#); *The Gap, Inc. v. Deng Youqian*, [WIPO Case No. D2009-0113](#). It is implausible that the Respondent was unaware of the Complainant when he registered the disputed domain name. Given the reputation of the PROMOD trademark, registration in bad faith can be inferred. Additionally, the disputed domain name reproduces the PROMOD mark exactly and it resolves to a web-

site commercializing exactly the same products as the Complainant, indicating that the Respondent was aware of the Complainant. Moreover, it is a domain name registrant's obligation to verify that the registration of the domain name would not infringe the rights of a third party. In this case, a quick trademark search for the PROMOD mark would have revealed to the Respondent the existence of the Complainant and its trademark. That the Respondent failed to do so is a contributing factor to his bad faith registration. *LANCOME PARFUMS ET BEAUTE & CIE, L'OREAL v. 10 Selling*, [WIPO Case No. D2008-0226](#).

Bad faith use can be found based on the following circum-

stances. The Respondent does not have permission from the Complainant to use its trademark and has made no *bona fide* or legitimate use of the disputed domain name. See *Alstom, Bouygues v. Webmaster*, [WIPO Case No. D2008-0281](#); *Guerlain S.A. v. Peikang*, [WIPO Case No. D2000-0055](#). The disputed domain name is confusingly similar to the Complainant's trademark, therefore a likelihood of confusion can be presumed and such confusion will inevitably result in Internet traffic being diverted from the Complainant to the Respondent's website. See *MasterCard International Incorporated ("MasterCard") v. Wavepass AS*, [WIPO Case No. D2012-1765](#); *Edmunds.com*,

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Inc. v. Triple E Holdings Limited, [WIPO Case No. D2006-1095](#). Additionally, the disputed domain name resolves to a webpage that displays clothes and accessories of various renowned brands. Links on the webpage redirect the user to other websites that sell counterfeit goods. Therefore, the disputed domain name is being used to sell counterfeit goods under the PROMOD mark, which is strong evidence of bad faith. See *Goyard St-Honore v. Fundacion Private Whois, Domain Administrator*, [WIPO Case No. D2013-0443](#); *Canon U.S.A. Inc. v. Miniatures Town*, [WIPO Case No. D2011-1777](#). The Respondent has intentionally attempted to attract, for commercial gain, Internet users to

his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or products advertised on his website. The Respondent's use of the Complainant's trademark to direct Internet users to websites relating to the Complainant's competitors is evidence of a clear intent to disrupt the Complainant's business, to deceive consumers, and to trade off the Complainant's goodwill by creating an unauthorized association between the Respondent and the Complainant's mark. The Respondent likely registered the disputed domain name to prevent the Complainant from using its trademark in the disputed do-

main name. See *L'oreal v. Chenxiangsheng*, [WIPO Case No. D2009-0242](#). Finally, the Respondent has not replied to the Complainant's cease-and-desist letter. The Complainant requests that the disputed domain name be transferred to it.

To be continued in the next issue ...

Source: www.wipo.org

Estudio Villano

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Page 7 of 7