

ADMINISTRATIVE PANEL DECISION

Calvin Klein Trademark Trust and Calvin Klein Inc. v. Abeer Ayoub Case No. D2018-0387

1. The Parties

The Complainants are Calvin Klein Trademark Trust and Calvin Klein Inc. (together referred to as the “Complainant”) of New York, New York, United States of America (“United States”), represented by Kestenberg Siegal Lipkus LLP, Canada.

The Respondent is Abeer Ayoub of Wayne, New Jersey, United States, self-represented.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 20, 2018. On February 21, 2018, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 2018, the Registrar transmitted, by email, its verification response to the Center 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”), 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 that this proceeding commenced on February 26, 2018. In accordance with the Rules, paragraph 5, the Center set the due date for Response to March 18, 2018. The Respondent did not submit any Response by the due date. Accordingly, on March 19, 2018, the Center notified the Parties of the Respondent’s default. After the Center’s notification of the Respondent’s default, on March 19, 2018, the Respondent submitted two email communications to the Center, though neither constituted a substantive Response to the Complaint.

On March 29, 2018, the Center appointed Peter L. Michaelson as the sole panelist in this matter. 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.

As reflected in the registration record for the disputed domain name in the public Whois database (a copy of that record appears in Annex B to the Complaint), the disputed domain name was registered on December 12, 2017 and will expire on December 12, 2018.

4. Factual Background

A. The Complainant's CALVIN KLEIN marks (collectively the "CALVIN KLEIN Marks")

As indicated in the Complaint, the Complainant owns United States and foreign trademark registrations, including those for the term "CALVIN KLEIN" in block letters and stylized form. The Complainant has provided, in Annex D to the Complaint, copies of the registration certificates for two of its United States registrations, the pertinent details of which are:

1. CALVIN KLEIN (stylized)

United States Registration No. 1,633,261

Registered: January 29, 1991; Last Renewed: February 1, 2010; Filed: October 30, 1989

This mark is registered for use in connection with: "men's and boys' underwear and men's and boys' shorts; women's and girls' underwear (including brassieres and underpants); women's nightgowns", all in international class 25. This registration indicates that, in conjunction with these goods, first use of the mark commenced on December 31, 1968 and first use in commerce commenced as of June 30, 1982.

2. CALVIN KLEIN (block letters)

United States Registration No. 1,086,041

Registered: February 21, 1978; Last Renewed: February 7, 2018; Filed: March 15, 1976

This mark is registered for use in connection with: "women's wearing apparel-namely, skirts, shirts, blouses, jackets, pants, coats, fur-trimmed coats, vests, dresses, sweaters, t-shirts, shorts, skirts and shirts, warm-up suits, rainwear, capes, scarves, shawls, belts, walking shorts, tank tops and jump suits", all in international class 25. This registration indicates that, in conjunction with these goods, both first use of the mark and first use in commerce commenced as of June 30, 1968.

B. The Parties and their activities

The Complainant is an international manufacturer, distributor and retailer which engages in the production, sale and licensing of men's and women's apparel, eyeglasses, fragrances, accessories, and footwear, among other goods. Its products prominently display one or more of its CALVIN KLEIN Marks. The Complainant starting using its mark CALVIN KLEIN in 1968 and has continuously used it thereafter in connection with advertising, offering for sale, and sale of its products in the United States and elsewhere. Over the years, the Complainant has sold billions of dollars of its branded products with those products having ultimately reached millions of customers worldwide. These sales exclusively occur through the Complainant's own retail stores, outlet stores, its websites and through its authorized dealers including national specialty stores such as Neiman Marcus, Saks Fifth Avenue and Bergdorf Goodman. To support its sales, the Complainant has expended millions of dollars in advertising and promoting its products under its marks using a variety of media throughout the world, including Internet-based advertising, direct mail, print, television, and radio. The Complainant also uses its marks in connection with sponsoring fashion events, various organizations and social events. As a result of these activities occurring over decades of use, the Complainant has developed considerable goodwill in its marks with those marks having acquired fame. See Declaration of Ms. Dawn Atlas, Vice President, Enforcement and Assistant General Counsel of Calvin Klein, Inc. ("Atlas" declaration, a copy of which appears in Annex C to the Complaint) at paragraphs 4, 7, 12, 13, 14 and 18.

The Complainant also owns a number of domain name registrations for websites through which it markets its products and which all incorporate Complainant's mark CALVIN KLEIN, including: <calvinklein.com>, <calvinkleinbags.com>, <calvinkleinunderwear.com> and <calvinkleinfashion.com>. Since 1997 when the Complainant's website at <calvinklein.com> was launched (a screenshot of the current home page of that website is provided in Annex E (though noted to be in Annex G in the Complainant's List of Annexes) to the Complaint), that site has received hundreds of millions of visitors then seeking information about the Complainant's branded products. Atlas declaration at paragraphs 10, 16 and 18.

The disputed domain name does not resolve and never has resolved to an operational website.

On December 15, 2017, the Complainant's Counsel, after having become aware of the Respondent's registration of the disputed domain name, sent an email message to the Respondent requesting the latter transfer the disputed domain name to the Complainant. The parties then engaged in several email exchanges ending in mid-February 2018 in an attempt, although ultimately unsuccessful, to settle their dispute. Through an email message dated December 15, 2017, the Respondent stated that it intends to eventually resell eyeglass frames under the mark CALVIN KLEIN. While the Respondent claimed, through an e-mail dated February 6, 2018 to the Complainant's Counsel, that it was licensed for the past 20 years to sell CALVIN KLEIN frames, the Respondent provided no evidence to support its claim and requested the Complainant to supply a copy of the license agreement. Through a responding email message of February 16, 2018, the Complainant's Counsel denied that Complainant ever authorized the Respondent to use any of the Complainant's marks in registering a domain name.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its mark CALVIN KLEIN.

Specifically, the disputed domain name contains this mark prepended by the words "glasses by" with those words being incapable of adding sufficient distinctiveness whatsoever to the name to mitigate any resulting user confusion between the disputed domain name and the Complainant's mark. Furthermore, given the Complainant's reputation in its industry and the fame attained by its CALVIN KLEIN Marks, the inclusion of the words "glasses by" in the name heightens a potential for confusion to occur among Internet users between the mark CALVIN KLEIN and the name as those users will likely think that the Respondent's website, should it become operational and to which the disputed domain name would resolve, provides glasses sold by the Complainant when, in fact, the Respondent is not one of the Complainant's authorized retailers and has no affiliation, sponsorship by or relationship with the Complainant.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, the Respondent is not licensed or otherwise authorized by the Complainant to use any of its CALVIN KLEIN Marks. The Respondent has neither used nor made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, nor it is using the name in connection with any legitimate noncommercial or fair use. In that regard and at present, the name does not resolve to any operational website. Moreover, should such a site become operational, then, as any use of the name is likely to infringe the Complainant's exclusive rights in its CALVIN KLEIN Marks, that use would not be *bona fide*.

Further, the Respondent has never been commonly known by any name, trade name or domain name that incorporates the term CALVIN KLEIN, nor could it be given the Complainant's exclusive trademark rights in that term which date back to 1968 and the worldwide fame which its CALVIN KLEIN Marks have achieved since then. Thus, it is highly unlikely that the Respondent could develop any association, relationship or connection with any of those marks without infringing the Complainant's rights. Moreover, the Respondent admits that she was fully aware of the Complainant prior to registering the disputed domain name inasmuch as she intended to resell eyeglass frames carrying the Complainant's mark CALVIN KLEIN and had even purchased for resale legitimate frames bearing that mark. As the Complainant did not authorize the Respondent to resell its branded frames, any such conduct by the Respondent would constitute trademark infringement. Consequently, that conduct would be illegitimate and preclude the Respondent from having any rights or legitimate interests in the name.

(iii) Registered and Used in Bad Faith

The Complainant also contends that, for various reasons, the Respondent has registered and is using the disputed domain name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent was well aware of the exclusive rights, goodwill and reputation which the Complainant possessed in its CALVIN KLEIN Marks when she intentionally selected the disputed domain name which totally incorporated the mark CALVIN KLEIN and then, in spite of that knowledge and without having received any authorization from the Complainant registered the name. Though the name has not and does not now resolve to an operational website, nevertheless the name provides the Respondent with an opportunity, which she may realize sometime in the future, to purposefully exploit the goodwill and reputation associated with those marks and, by so doing, disrupt the Complainant's business by diverting Internet users away from the Complainant's website and thus cause injury to the Complainant.

Further, during the course of the parties' e-mail exchange, the Respondent offered to sell the disputed domain name to the Complainant for: (a) USD 6500, a sum which the Respondent stated reflected the expenses she incurred (both in terms of hard and soft costs) in developing the portion of her business directed to reselling the Complainant's branded eyeglass frames through use of the name; together with (b) royalties from the Complainant's sales of eyeglass frames carrying the mark CALVIN KLEIN and made through a website through which the disputed domain name would then resolve. In light of this offer, the Complainant contends that the Respondent registered the name to prevent the Complainant from registering it and to eventually sell the name for valuable consideration in excess of the Respondent's out-of-pocket expenses.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

On March 19, 2018, the day the Respondent was notified of its default, the Respondent submitted two email communications to the Center, neither of which constituted a substantive Response to the Complaint and with one of which having merely supplied a copy of the email exchanges that transpired between the parties during their unsuccessful settlement discussions which occurred from mid-December 2017 through mid-February 2018.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's mark CALVIN KLEIN.

From a simple comparison of the disputed domain name to the Complainant's mark CALVIN KLEIN, no doubt exists that the disputed domain name is confusingly similar to it. The disputed domain name consists of the mark in its entirety prepended by the words "glasses by" to which the generic Top-Level Domain ("gTLD") ".com" has been appended, with the addition of the gTLD being irrelevant in this case in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, the Respondent's addition of two generic words "glasses by" clearly resulted in such a minor variation. See, e.g., *SAP SE v. Lakshmi Reddy Bhumireddy and P. Hareesh*, WIPO Case No. D2017-0396; *Compagnie Générale des Etablissements Michelin v. Cameron Jackson*, WIPO Case No. D2016-2392; *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; and *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148.

Moreover, by including the descriptive words "glasses by" with the Complainant's mark CALVIN KLEIN to form the disputed domain name, the potential for user confusion is likely to be exacerbated, not reduced. It is quite conceivable, given current common naming conventions and patterns in use on the Internet, that an Internet user, who seeks information on eyeglass frames associated with the Complainant and carrying its mark but is uncertain of its associated domain name for use in accessing its website, would form a domain name by prepending the term "glasses by" to the mark CALVIN KLEIN to form a composite name and then add the common gTLD ".com" to yield a resulting domain name <glassesbycalvinklein.com>. The user would then insert that domain name into his/her browser with a reasonable expectation that doing so would direct that browser to either the Complainant's website or a website authorized by the Complainant from which that user could obtain information for the Complainant's branded eyeglass frames. However, here the Respondent registered that domain name. The result is that the user's action would cause that person not to be taken to the Complainant's website, but rather, and without that user realizing the diversion, to the Respondent's website instead – once that site became operational. Hence, adding the term "glasses by" to the mark CALVIN KLEIN, as the Respondent did, only heightens the likelihood of the Respondent causing user deception and ensuing confusion to the Respondent's ultimate benefit and the detriment of Complainant. See, e.g., *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; and *Tommy Bahama Group, Cummins, Nat'l Assn. of Realtors* and *Space Needle*, all cited *supra*.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's mark CALVIN KLEIN. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the Complainant's CALVIN KLEIN Marks and does not have any relationship, affiliation or connection whatsoever with the Respondent.

Further, with respect to paragraph 4(c)(i) of the Policy, the Respondent does not now use nor has it ever made any demonstrable preparations to use the disputed domain name to resolve to an operational website

through which it presently does or will make a *bona fide* offering of any goods or services. Furthermore, as to paragraph 4(c)(iii) of the Policy, the name is not used in any manner that is either noncommercial or reflective of fair use whatsoever, let alone one that does not provide a potential for commercial gain. In that regard, since the date the name was registered, it has not resolved to an operational website.

Moreover, as to paragraph 4(c)(ii) of the Policy, the record is entirely devoid of any evidence which reflects that the Respondent is currently or has ever been commonly known by the disputed domain name or any of the Complainant's CALVIN KLEN Marks. Given that the notoriety and consequently reputation that the Complainant has acquired since it first used its mark CALVIN KLEIN at least as early as June 30, 1968 and subsequently registered that mark on February 21, 1978 – the former being approximately 50 years prior to the date on which the Respondent registered the disputed domain name on December 12, 2017 and here coupled with the fact that, over the intervening years, those marks have become famous, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to any of those of the Complainant – at least for the goods provided by the Complainant under any of its CALVIN KLEIN Marks – without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Covestro Deutschland AG v. Kay Mone / KMN INC.*, WIPO Case No. D2018-0145; *Alstom v. Zahir Khan, Palki Event Inc.*, WIPO Case No. D2017-1124; *Compagnie Générale des Etablissements Michelin v. Cameron Jackson, supra*; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID; 62520014085963*, WIPO Case No. D2015-0787; and *Chicago Mercantile Exchange Inc. and CME Group Inc; Cummins*; and *Staatliche Porzellan-Manufaktur Meissen*, all cited *supra*.

Consequently, the Respondent does not satisfy any of paragraphs 4(c)(i)(iii) of the Policy and thus has no rights or legitimate interests in the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Respondent was well aware, prior to having registered the name, of the Complainant and its mark CALVIN KLEIN and the substantial reputation and goodwill which that mark acquired and the exclusive rights which the Complainant held in that mark. In that regard, the Respondent claimed to have been a licensee of the Complainant for approximately 20 years, though she offered no corroborating proof and the Complainant denies she ever was licensed.

There is no doubt that since 1968, the Complainant's mark CALVIN KLEIN has acquired not only a substantial reputation globally in its industry and marketplace, but also, as a result of the Complainant's considerable promotional activities, fame. This deliberate unauthorized registration of a domain name which includes a mark of another, let alone a mark which is famous, reflects bad faith.

It is eminently clear to the Panel, that had the Complainant not initiated the present proceeding when it did the Respondent may have effectuated her expressed intention of establishing an operational website through which, without having any authorization from the Complainant, she would offer legitimate eyeglass frames bearing the mark CALVIN KLEIN for resale to Internet customers. Doing so would opportunistically exploit the reputation, fame and goodwill inherent in that mark for the Respondent's own pecuniary benefit by diverting Internet traffic and business destined to the Complainant's website to the Respondent's site instead. Not only would the diversion deprive the Complainant of the ensuing business and revenue therefrom, it would also injure the reputation inherent in the Complainant's CALVIN KLEIN Marks by causing Internet users to think that a relationship of some sort exists between the parties when, in fact, no such relationship then existed all. This conduct, particularly under the present facts involving marks that have acquired fame and which caused a realistic concern in the Complainant of trademark infringement, and further, the Respondent's offer to sell and retain royalties from the disputed domain name constitutes bad faith use.

Thus, the Panel concludes that the Complainant has provided sufficient evidence of its allegations, with respect to the disputed domain name to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name <glassesbycalvinklein.com> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: April 12, 2018