

**DISPUTE RESOLUTION SERVICE**

**D00019569**

**Decision of Independent Expert**

Mr. Philipp Plein

and

Madonna Lomidze

**1. The Parties:**

Complainant: Mr. Philipp Plein  
Via Dufour 20  
CH-6900  
Lugano  
Switzerland  
Switzerland

Respondent: Madonna Lomidze  
KastelORIZOU 4 Agios Tychonas horizon residence block b flat 401  
Limassol  
Cyprus  
4532  
Cyprus

**2. The Domain Name:**

<philipp-plein.co.uk>

### **3. Procedural History:**

23 November 2017 14:11 Dispute received  
24 November 2017 14:11 Complaint validated  
28 November 2017 09:12 Notification of complaint sent to parties  
15 December 2017 01:30 Response reminder sent  
19 December 2017 09:58 Response received  
19 December 2017 09:58 Notification of response sent to parties  
21 December 2017 17:34 Reply received  
21 December 2017 17:34 Notification of reply sent to parties  
02 January 2018 12:54 Mediator appointed  
03 January 2018 14:38 Mediation started  
16 January 2018 15:03 Mediation failed  
16 January 2018 15:04 Close of mediation documents sent  
26 January 2018 01:30 Complainant full fee reminder sent  
29 January 2018 10:34 Expert decision payment received

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of either of the parties.

### **4. Factual Background**

The Complainant is the founder of the PHILIPP PLEIN fashion brand and operates a website connected to the domain name, <philipp-plein.com>. He is the proprietor of European Union Trade Mark Registration No. 002966505 registered 21 January, 2005 (application filed 6 December, 2002) PHILIPP PLEIN (words) for a variety of goods in classes 3, 14, 18, 20, 21, 24, 25 and 28.

The Domain Name was registered on 11 October 2011 and is connected to a webpage featuring the banner "Domain For Sale" followed by the message "For buying this domain Contact us at: info@philipp-plein.co.uk".

### **5. Parties' Contentions**

#### **The Complainant**

The Complainant contends that his PHILIPP PLEIN registered trade mark is identical to the Domain Name and that the Domain Name is an Abusive Registration. The Complainant contends that the Domain Name was registered as a blocking registration and/or with a view to disrupting the Complainant's business. The Complainant contends that Internet users will visit the Respondent's website expecting the Domain Name to be a domain name of the Complainant and, on finding themselves at an inactive website, will visit the websites of competitors of the Complainant in order to purchase their desired goods.

### **The Respondent**

The Respondent states that she registered the Domain Name intending to use it in the future to showcase her painting. "Plein" is a reference to painting in outdoor daylight and "PHILIPP" is an acronym for "Passionate", "Harmony", "Illustrating", "Light", "Inside", "Pure" and "Painting".

The Respondent states that while she is now aware of the Complainant's brand and is a regular buyer of the Complainant's clothing, she was not aware of the Complainant's brand when she registered the Domain Name. She now plans to revive her original plan for the Domain Name.

## **6. Discussions and Findings**

### General

Pursuant to paragraph 2.a.i of the Policy, for the Complainant to succeed in this Complaint he must prove to the Expert on the balance of probabilities that:

- I. he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- II. the Domain Name, in the hands of the Respondent, is an Abusive Registration

"Abusive Registration" is defined in paragraph 1 of the Policy as a domain name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's

- Rights; or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

### Rights

There does not appear to be a dispute between the parties that the Complainant has trade mark rights to his name, "Philipp Plein" and that his name/mark is substantially identical to the Domain Name. Nor could there sensibly be any dispute in the matter. The only differences are the presence in the Domain Name of a hyphen between "Philipp" and "Plein" and the ".co.uk" country code Top Level Domain ("ccTLD") identifier.

The Expert finds that the Complainant has Rights in respect of a name or mark, which is identical or similar to the Domain Name.

### Abusive Registration

Why did the Respondent register the Domain Name? Was it to take advantage of the Complainant's trade mark in some way or was it, as the Respondent claims, to connect it to a website showcasing her painting and reflecting her passion for painting outdoors in daylight?

The Complainant's name and trade mark is complex. It is not a simple name. For the Respondent to have unwittingly come up with that complex combination of letters by chance stretches credibility to the extreme. However, truth can on occasion be stranger than fiction. Is this a case in point?

The Expert is unable to accept the Respondent's explanation. If it were true, the Respondent would have recognized the very real risk that it would be dismissed out of hand as being fanciful and would have striven to demonstrate the surprising truth of the explanation. As a starter the Respondent could have shown that she is a painter and is or was passionate about painting in 'plein air'. However, the Respondent has done nothing along those lines. Nor has she explained why the Domain Name is connected to a parking page indicating that the Domain Name is for sale.

The acronym, PHILIPP, for Passionate, Harmony, Illustrating, Light, Inside, Pure and Painting comes across to the Expert as highly artificial. In short, the view of the Expert on the balance of probabilities is that the acronym was dreamt up for no reason other than to defeat the Complaint, the Respondent having no proper answer to the Complainant's contentions.

What were the Respondent's motives for registering the Domain Name? The

Complainant contends that it was to prevent the Complainant registering the Domain Name and/or to disrupt the business of the Complainant by diverting potential customers of the Complainant to websites of the Complainant's competitors. Another possibility, not mentioned by the Complainant, is that the Respondent was hoping to sell the Domain Name at a profit. After all the Domain Name is connected to a webpage indicating that it is for sale.

Paragraph 5 of the Policy features a non-exhaustive list of factors, which may be evidence that a domain name is an Abusive Registration. Of these, the factors pertinent to this case include those set out in sub-paragraphs 1.1.1 (for sale to the Complainant or a competitor of the Complainant at a profit), 1.1.2 (to prevent the Complainant registering it), 1.1.3 (for the purpose of unfairly disrupting the business of the Complainant) and 1.2 (to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant).

However the most pertinent of these factors is set out in paragraph 5.1.6 of the Policy, which reads:

*“The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.”*

The Complainant has satisfied the Expert that he has Rights in respect of his name and trade mark, PHILIPP PLEIN. The hyphen in the Domain Name is a commonly used symbol used in domain names to separate names/words (and plainly serves in the present context to break up an otherwise troublesome triple 'p') and the “.co.uk” ccTLD identifier serves a purely technical function. The Expert is satisfied that the Domain Name and the Complainant's name and trade mark are an exact match for this purpose. The Expert is satisfied that the Complainant's trade mark has a significant reputation and that the Respondent has no reasonable justification for having registered the Domain Name.

Given the Expert's finding on the evidence before him that it is more likely than not that the Respondent has put forward a false explanation for her adoption of the Domain Name, and in the absence of any other explanation, the Expert finds that the Respondent registered the Domain Name with the intention of taking unfair advantage of or causing unfair detriment to the Complainant's Rights.

The Expert finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

**7. Decision**

The Expert directs that the Domain Name be transferred to the Complainant.

**Signed** .....

**Dated** 14 February 2018 .....