

ADMINISTRATIVE PANEL DECISION

Calvin Klein Trademark Trust and Calvin Klein Inc. v. Client Care, Web
Commerce Communications Limited
Case No. D2022-2697

1. The Parties

The Complainants are Calvin Klein Trademark Trust and Calvin Klein Inc., United States of America (“United States” or “US”), represented by Kestenberg Siegal Lipkus LLP, Canada.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <calvinkleinbudapest.com>, <calvinkleincanadaonline.com>, <calvinkleincanadaoutlet.com>, <calvinkleinchileoutlet.com>, <calvinkleincolumbiaoutlet.com>, <calvinkleinireland.com>, <calvinkleinmalaysiaoutlet.com>, <calvinkleinnzsale.com>, <calvinkleinoutletmexico.com>, <calvinkleinoutletonline.com>, <calvinkleinportugalpt.com>, <calvinkleinsingapore.com>, and <calvinkleinusasale.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed involving eight disputed domain names and the domain name <calvinkleinfactoryoutlet.com> with the WIPO Arbitration and Mediation Center (the “Center”) on July 23, 2022. The Complainants submitted the first amended Complaint on July 25, 2022 and the second amended Complaint on July 26, 2022, adding another five disputed domain name to the proceeding. On July 25, 2022 and on August 2, 2022, the Center transmitted by email respectively to the Registrar a request for registrar verification in connection with the disputed domain names and the domain name <calvinkleinfactoryoutlet.com>. On July 27, 2022 and on August 3, 2022, the Registrar transmitted by email to the Center its verification responses, disclosing registrant and contact information for the disputed domain names and the domain name <calvinkleinfactoryoutlet.com> which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on August 5, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainants filed the third amended Complaint on August 6, 2022.

The Center verified that the Complaint, together with the first, the second and the third amended Complaints, 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 August 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 7, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on September 19, 2022. 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.

The Center discovered that the registrar of the domain name <calvinkleinfactoryoutlet.com> had changed to GoDaddy.com, LLC. The Center attempted to have the domain name <calvinkleinfactoryoutlet.com> restored to the original Registrar Alibaba.com Singapore E-Commerce Private Limited by email on October 13, 2022. The Registrar Alibaba.com Singapore E-Commerce Private Limited replied on October 14, 2022 that they “were notified on September 29th of the Registry Forced Transfer of Registrar” and requested the registrar GoDaddy.com, LLC and the Center to contact the Registry. On October 18, 2022, the Registry Verisign replied and indicated that they had executed a court order on September 28, 2022 to transfer the domain name <calvinkleinfactoryoutlet.com> to the registrar GoDaddy.com, LLC.

On October 25, 2022, the Panel issued the Panel Order No.1 which provided information regarding the change of the registrar of the domain name <calvinkleinfactoryoutlet.com>. The Panel also noted that the domain name <calvinkleinfactoryoutlet.com> redirects to a website which shows information related to the court proceeding. The Panel therefore requested the Complainants to confirm by October 30, 2022 if it would like to remove the domain name <calvinkleinfactoryoutlet.com> from the present proceeding. The Respondent may comment on the Complainants’ submission to the Panel Order No.1 by November 2, 2022.

On October 25, 2022, the Complainants confirmed that they would like to remove the domain name <calvinkleinfactoryoutlet.com> from the present proceeding. The Respondent did not comment on the above Complainants’ submission.

4. Factual Background

The Complainant, Calvin Klein Trademark Trust, organized under the laws of Delaware, United States, is the registered owner of the trademarks CALVIN KLEIN which it holds on trust for the Complainant, Calvin Klein, Inc. For the purposes of this decision, the Complainants are referred to as “the Complainant”, unless otherwise indicated. Calvin Klein, Inc. is the beneficial owner of the marks which are used by it for a variety of merchandise.

Calvin Klein, Inc. has been engaged in the production, sale and licensing of men’s and women’s apparel, fragrances, accessories, and footwear, among other things, all in association with the Complainant’s intellectual property rights.

Evidence of the Complainant’s trademark rights is set out in a Declaration filed on its behalf. In particular the Complainant relies on the registered trademarks for the mark CALVIN KLEIN in China, the European Union (“EU”), the United Kingdom, and the US. These include:

- China registration No. 1681239 registered December 14, 2001 – CALVIN KLEIN;
- EU registration No. 000617381 registered January 29, 1999 – CALVIN KLEIN;
- United Kingdom registration No. 1,492,382 registered January 21, 1994 – CALVIN KLEIN;

- US registration No. 1,086,041 registered February 21, 1978 – CALVIN KLEIN; and
- US registration No. 1,633,261 registered January 29, 1991 – CALVIN KLEIN (in stylized form).

The Declaration also evidences domain name registrations which incorporate the mark CALVIN KLEIN. These include: <calvinklein.com>, <calvinkleinbags.com>, <calvinkleinunderwear.com>, and <calvinkleinfashion.com>. The Complainant has used and continues to use these domain names in connection with its various websites which provide information about the Complainant and its products and services.

As can be seen from the Declaration, the Complainant has used the trademark CALVIN KLEIN continuously since at least 1968 in connection with the advertising, offering for sale, and sale of its products throughout the world. It has resulted in millions of customers and billions of USD in sales. The CALVIN KLEIN marks are well known and famous. The Complainant has expended very large sums in advertising and promoting its products under the mark CALVIN KLEIN throughout the world in a variety of media including print, television and radio advertisements.

The disputed domain names were either registered on July 21, 2022 or on July 25, 2022. 11 out of the 13 disputed domain names resolve to either inactive websites or websites displaying Index of some downloadable files without any substantive content. The disputed domain names <calvinkleinmalaysiaoutlet.com> and <calvinkleinsingapore.com> redirect to third party websites mainly offering for sale clothing, sports shoes, and bags.

5. Parties' Contentions

A. Complainant

The Complainant has advertised using the marks CALVIN KLEIN through direct mail and on the Internet using the above domain names. Its products are also sold exclusively through its own retail stores, outlet stores and websites including "www.calvinklein.com" and through authorized dealers including Macy's, Niemann Marcus, Saks Fifth Avenue, and Berghof Goodman.

The disputed domain names incorporate the Complainant's CALVIN KLEIN trademark in its entirety. The only difference between the Complainant's trademark and the disputed domain names are the addition of the geographic terms "budapest", "canada", "chile", "colombia", "ireland", "malaysia", "nz" (the country code for New Zealand), "mexico", "portugal", "pt" (the country code for Portugal), "singapore", "usa" as well as the generic expressions "online", "outlet", "factory" and "sale", respectively.

The Complainant's first use and first registration of its CALVIN KLEIN mark predates any use made by the Respondent of the disputed domain names.

The Respondent may have made use of the disputed domain names as a trade name, domain name, mark, or common name. However, the disputed domain names were registered in July 2022, more than 50 years after the Complainant first used its marks.

The Respondent was aware of the Complainant's domain names and websites before it registered the disputed domain names because the Complainant's websites were operational, and thus easily accessible to the Respondent, at the time the Respondent registered the disputed domain names.

The Respondent is not affiliated with the Complainant in any way.

The Complainant has not authorized the Respondent to use and register its trademarks and service marks, or to seek the registration of any domain name incorporating the said marks.

The Complainant's CALVIN KLEIN marks are well known and famous for many years.

The Respondent also has no rights or legitimate interests in the disputed domain names because the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Most of the disputed domain names resolve to 403 Forbidden error websites or websites with links to downloadable files including 1 to 1.2 Gb of data which may contain potentially dangerous files. The disputed domain names <calvinkleinmalaysiaoutlet.com> and <calvinkleinsingapore.com> redirect to other websites which appear to be copies of third party websites.

Further, the Respondent is not commonly known by the disputed domain names.

The Respondent registered and is using the disputed domain names in bad faith. The non-active use of most of the disputed domain names does not prevent a finding of bad faith because the Complainant's CALVIN KLEIN trademark is famous and there is no plausible contemplated active use of the disputed domain names that would not be illegitimate.

The Complainant submits that the Respondent's use of the disputed domain names <calvinkleinmalaysiaoutlet.com> and <calvinkleinsingapore.com> to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the websites associated with these disputed domain names satisfies Policy, paragraph 4(b)(iv). The Respondent is taking advantage of the goodwill associated with the Complainant and its trademark CALVIN KLEIN.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

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

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademark CALVIN KLEIN on the basis of its multiple trademark registrations. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see [WIPO Overview 3.0](#), section 1.2.1).

It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a registered trademark. Numerous UDRP panels have recognized that the incorporation of a trademark in its entirety is sufficient to

establish that a domain name is identical or confusingly similar to the Complainant's registered mark. Such findings were confirmed, for example, within the case *Quixtar Investments Inc. v. Dennis Hoffman*, WIPO Case No. [D2000-0253](#).

The Respondent's incorporation of the Complainant's trademark CALVIN KLEIN in full in the disputed domain names is evidence that the disputed domain names are confusingly similar to the Complainant's mark. Mere addition of the geographic terms "budapest", "canada", "chile", "colombia", "ireland", "malaysia", "nz" (for New Zealand), "mexico", "portugal", "pt" (for Portugal), "singapore", and "usa", as well as the terms "online", "outlet", and "sale" does not prevent a finding of confusing similarity with the Complainant's mark. As noted in [WIPO Overview 3.0](#), section 1.8: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". Similarly, it is well accepted that a generic Top-Level Domain ("gTLD") is typically ignored when assessing the confusing similarity between a trademark and a domain name. (See section 1.11 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the trademark in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth.

Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests in the disputed domain names.

The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain names. The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner. Furthermore, most of the disputed domain names resolve to either inactive websites or websites displaying Index of some downloadable files without any substantive content. The disputed domain names <calvinkleinmalaysiaoutlet.com> and <calvinkleinsingapore.com> redirect to third party websites mainly offering for sale clothing, sports shoes, and bags.

The Panel also finds that the nature of the disputed domain names carries a risk of implied affiliation with the Complainant's trademarks (see [WIPO Overview 3.0](#), section 2.5.1).

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain names, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names and that paragraph 4(a)(ii) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, 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 location or of a product or service on its website or location.

With regard to the bad faith at the time of registration, the Panel notes that it is not likely that the Respondent was not aware of the Complainant and its prior registered trademark. On the contrary, the Panel finds that it is likely that the Respondent was aware of the Complainant and its rights and reputation in the CALVIN KLEIN mark at the time the disputed domain names were registered.

In the Panel's view, the Complainant's CALVIN KLEIN mark is famous and the registration of the disputed domain names that are confusingly similar to the Complainant's mark by the unrelated Respondent can by itself create a presumption of bad faith in this case as indicated in section 3.1.4 of the [WIPO Overview 3.0](#) that "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar ([...] or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

11 out of the 13 disputed domain names resolve to either inactive websites or websites displaying Index of some downloadable files without any substantive content. Considering the circumstances of this case, in particular, reputation of the Complainant's CALVIN KLEIN mark, the Panel finds that the non-use of the disputed domain names does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)). The remaining disputed domain names <calvinkleinmalaysiaoutlet.com> and <calvinkleinsingapore.com> redirect to third party websites mainly offering for sale clothing, sports shoes, and bags. The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or locations or of a product or service on its websites or locations.

The Panel concludes that the disputed domain names were registered and are being used in bad faith and that consequently, the Complainant has satisfied the requirement under paragraph 4(a)(iii) 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 disputed domain names <calvinkleinbudapest.com>, <calvinkleincanadaonline.com>, <calvinkleincanadaoutlet.com>, <calvinkleinchileoutlet.com>, <calvinkleincolombiaoutlet.com>, <calvinkleinireland.com>, <calvinkleinmalaysiaoutlet.com>, <calvinkleinnzsale.com>, <calvinkleinoutletmexico.com>, <calvinkleinoutletonline.com>, <calvinkleinportugalpt.com>, <calvinkleinsingapore.com>, and <calvinkleinusasale.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: November 7, 2022