

ADMINISTRATIVE PANEL DECISION

Calvin Klein Trademark Trust & Calvin Klein, Inc. v. ALEX CONTRERAS
Case No. D2024-0860

1. The Parties

Complainant is Calvin Klein Trademark Trust & Calvin Klein, Inc., United States of America (“United States”), represented by Lipkus Law LLP, Canada.

Respondent is ALEX CONTRERAS, United States.

2. The Domain Name and Registrar

The disputed domain name <calvinkleincollections.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 27, 2024. On February 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 28, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on February 29, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 1, 2023.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on March 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2024. Respondent sent email communications to the Center on March 2, 5 and 6 2024. The Center sent the Commencement of Panel Appointment Process on April 3, 2024.

The Center appointed Scott R. Austin as the sole panelist in this matter on April 9, 2024. 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 following facts appear from the Complaint (as amended) and its attached Annexes, which have not been contested by Respondent, and which provide evidence sufficient to support:

Since its founding in 1968, Complainant Calvin Klein, Inc., has been engaged in the production, sale and licensing of a range of men's and women's apparel, fragrances, accessories, and footwear, and related goods and services under a variety of similar trademarks incorporating the words "Calvin Klein" (the "CALVIN KLEIN Marks") of which marks Complainant is the beneficial owner through Complainant Calvin Klein Trademark Trust (collectively, with Calvin Klein, Inc., "Complainant") which owns the Calvin Klein Marks as shown on the electronic copies of the trademark registration certificates submitted in the Annexes and attested to in a signed declaration submitted by the Vice President, Enforcement and Assistant General Counsel of Complainant Calvin Klein, Inc. For purposes of this decision, the Complainants are collectively referred to as "Complainant", unless otherwise indicated.

Complainant asserts that through its fifty-plus years of uninterrupted use of the CALVIN KLEIN Marks in connection with a wide variety of apparel and other merchandise in the United States and throughout the world, the marks are well known and famous, and their use has resulted in millions of customers worldwide and billions of dollars in sales.

Complainant claims both common law trademark rights in the CALVIN KLEIN marks through over 50 years of continuous and exclusive use, and statutory trademark rights through a number of registrations for the CALVIN KLEIN Mark in the United States and around the world for a range of products and services, including the following:

United States Registration No. 1,086,041, CALVIN KLEIN, registered on February 21, 1978, for a range of apparel products in International Class 25; and

Canadian Registration No. TMA307161, CALVIN KLEIN, registered on September 20, 1985, for a range of apparel products in International Class 25.

Canadian Registration No. TMA339967, CALVIN, registered on May 6, 1988, for (1) Fragrances and (2) Wearing apparel namely, shorts, blouses, sweaters, pants, skirts and jeans.

European Community Registration No. 617,381, CALVIN KLEIN, registered on January 29, 1999.

Complainant also shows it wholly incorporates the CALVIN KLEIN Mark into a number of domain name registrations including: (1) <calvinklein.com> its official registered domain name, registered to Complainant since June 10, 1997, used to promote its products through its official website accessed at "www.calvinklein.com" (the "Official CALVIN KLEIN Mark Website"), (2) <calvinkleinbags.com>, (3) <calvinkleinunderwear.com>, and (4) <calvinkleinfashion.com>, (5) <calvinkleinjeans.com>, and (6) <mycalvins.com>, among others.

Respondent registered the disputed domain name on February 20, 2024, and it resolves to an inactive website.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a cancellation of the disputed domain name: that the disputed domain name is confusingly similar to Complainant's trademark; that Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not submit a formal response to Complainant's contentions. On March 2, 2024, in an informal email sent to the Center the Respondent stated: "I have responded to the complainant and we are looking at solving this amicably..." On March 5, 2024, the Center provided to the parties information on suspension of the proceedings for settlement. On that same day Complainant's counsel replied via email denying Respondent's statement alluding to settlement, stating, "The parties are not involved in settlement dialogue. Thank you." Respondent then made several queries to the Center in a follow up email on March 5, 2024, Respondent stating: "Does this proceeding mean my domain will be forcefully taken from me? How do I prepare to defend myself in this proceeding? The Center moved forward with Commencement of the proceeding on March 6, 2024; the case notification documents provided information on how to file a Response, including a link to a model Response form. On that same day, Respondent submitted a third email submission, stating: If the complainant is ready to solve this amicably, a common ground for peace is what i request." The Center acknowledged receipt of the email and noted that it would be forwarded to the Panel when appointed.

6. Discussion and Findings

6.1 Procedural Issues

Unsolicited Additional Submissions

Consideration of Respondent's Unsolicited Supplemental Filing

The Panel has reviewed the parties' supplemental filings in this proceeding, namely, the email submissions received by the Center on March 2, 5, and 6, 2024, before the deadline for a Response had passed as set forth in Section 3, along with the admissibility of such unsolicited additional filings in this proceeding.

Rule 12 of the Rules provides that the Panel may request, in its sole discretion, further statements or documents from either of the Parties. There is no provision in the Rules, however, for a party to file an additional submission without leave of the Panel. This is because, under the expedited process provided under the Policy and Rules, each party is given one opportunity to put forward all the material on which it wishes to rely and is expected to do so. See, *Delikommat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner*, WIPO Case No. [D2001-1447](#).

Under the Rules, each Party is entitled as of right to submit only one single pleading. Paragraphs 10 and 12 of the Rules grant the Panel discretion to determine the admissibility of supplemental filings, including further statements or documents.

The Panel is of the view that Respondent's submissions fail to address any points relevant to the disposition of this case, e.g., the elements of the Policy, being essentially an unsupported representation to the Panel that both parties were interested, if not actually engaged in settlement negotiations, which assertion Complainant denied and repudiated. Respondent's questioning whether he would be forced to transfer his domain name, his request for defense guidance and repeated settlement overtures, do nothing to further his cause and the emails are without supporting arguments or attached supporting evidence and without the

oath required to be signed by a respondent as part of a formal response. Noting that the Panel would be fully within its discretion to disregard Respondent's submissions, given that the emails arrived before the decision date they are exceptionally taken into account in the interest of completeness of the record, but are of limited weight given the factors noted above.

6.2 Substantive Issues

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") , section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of the probabilities that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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 Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. Trademark registration evidence has been submitted in the name of Complainant referenced in section 4 above. Ownership of a nationally registered trademark constitutes prima facie evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1; see *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#); see also *Janus International Holding Co. v. Scott Rademacher*, WIPO Case No. [D2002-0201](#).

The [WIPO Overview 3.0](#), section 1.8 provides: "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."

While the addition of the term here, "collections", may bear on assessment of the second and third elements, the Panel finds the addition of such term within the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and Complainant's mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. See *Advance Magazine Publishers Inc. v. Arena International Inc.*, WIPO Case No. [D2011-0203](#).

Prior UDRP panels have also found the Top-Level Domains, such as “.com” and “.net”, being viewed as a standard registration requirement, may typically be disregarded under the first element analysis. See [WIPO Overview 3.0](#), section 1.11.1; see also *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#); *L'Oréal v. Tina Smith*, WIPO Case No. [D2013-0820](#).

The Panel finds Complainant's CALVIN KLEIN Mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the CALVIN KLEIN Marks for purposes of the Policy.

The Panel finds the first element of the Policy has been established.

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. See also *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Complainant contends that none of the circumstances provided in paragraph 4(c) of the Policy for demonstrating a respondent's rights to and legitimate interests in a domain name are present in this case. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

First, Complainant asserts that it has no commercial relationship with Respondent, who is not sponsored by or affiliated with Complainant in any way, nor has Complainant given Respondent authority or license to register or use Complainant's trademarks in any manner, including in domain names. Prior UDRP panels have held “in the absence of any license or permission from Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed”. *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#).

Second, Complainant contends Respondent is not commonly known by the disputed domain name, which evinces a lack of rights or legitimate interests under Policy paragraph 4(c)(ii). The Registrar's registrant data submitted to the Center for the corresponding disputed domain name, identified Respondent as “ALEX CONTRERAS” as registrant. Respondent could not be considered to be commonly known by the disputed domain name because he clearly bears no resemblance to it, nor to the CALVIN KLEIN Marks, nor to Complainant's official domain name. Prior UDRP panels have held where no evidence, including the Whois record for the disputed domain name, suggests that Respondent is commonly known by the disputed domain name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the disputed domain name within the meaning of Policy paragraph 4(c)(ii). See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#).

Most importantly, Complainant contends Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services because, as Complainant's Annex evidence shows of the web page connected to the disputed domain name is inactive and resolves to a page that states “The content of the page cannot be displayed”.

According to the [WIPO Overview 3.0](#), section 2.5.1, where a domain name consists of the complainant's trademark and certain additional terms, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the complainant.

Having reviewed the record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established for the disputed domain name.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, 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 also 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.

Complainant contends that Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business by configuring and registering a domain name that incorporates the CALVIN KLEIN Marks in its entirety with the addition of a term relevant to Complainant's apparel and fashion business, "collection" which are often used in fashion marketing. Respondent has thereby configured a domain name for registration that is confusingly similar to Complainant's trademarks, as well as its official domain name. Prior UDRP panels have found a domain name was registered in bad faith where the respondent registered the domain name for the purpose of intentionally attempting to impersonate or mislead in order to commit fraud. See, e.g., *Houghton Mifflin Co. v. The Weatherman Inc.*, WIPO Case No. [D2001-0211](#); *Marlink SA v. Sam Hen, Elegant Team*, WIPO Case No. [D2019-1215](#); *Beam Suntory Inc. v. Name Redacted*, WIPO Case No. [D2018-2861](#).

Prior UDRP panels have also held where the disputed domain name is configured in a manner to wholly incorporate a complainant's mark, as Complainant's CALVIN KLEIN Marks are incorporated with the additional common term here, the disputed domain name can only sensibly refer to Complainant; thus, there is no obvious possible justification for Respondent's selection of the disputed domain name other than registration in bad faith. See *Société pour l'Oeuvre le Mémoire d'Antoine de Saint Exupéry, Succession Saint Exupéry d'Agay v. Perlegos Properties* WIPO Case No. [D2005-1085](#).

Prior panels have also recognized that the mere registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can itself create a presumption of bad faith. See, *Carrefour SA v. 伍誉 (Wu Yu)*, WIPO Case No. [DCO2022-0023](#). Complainant contends that given the fame of Complainant's CALVIN KLEIN Marks a previous UDRP panel has held that there can be no good faith use for a domain name that incorporates the CALVIN KLEIN Mark. See *Calvin Klein Inc. and Calvin Klein Trademark Trust v. 颜文君 (Wen Jun Yan)*, WIPO Case No. [D2021-1151](#).

Finally, the inactive status of the website linked to the disputed domain name does not undo or attenuate Respondent's bad faith conduct. Panels have found that the non-use of a domain name (including a blank or "not found" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel notes the worldwide fame, distinctiveness and reputation of Complainant's CALVIN KLEIN Marks, the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the inactive disputed domain name does not prevent a finding of bad faith under the Policy. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith registration and use under the Policy. The Panel finds that the evidence presented here supports Complainant's contention that Respondent's registration of the disputed domain name was solely to prevent Complainant from registering the disputed domain name, which has been inactive since registration, and that Respondent's use of the disputed domain name to attract internet users to the Respondent's disputed domain name by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Respondent's Domain Name satisfies Policy paragraph 4(b)(iv).

The Panel finds that Complainant has established the third element 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 name <calvinkleincollections.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: May 6, 2024