

**DISPUTE RESOLUTION SERVICE**

**D00015013**

**Decision of Independent Expert**

**Calvin Klein Trademark Trust**

**and**

**Chris Rogers**

**1. The Parties**

Complainant: Calvin Klein Trademark Trust  
205 West 39th Street  
New York  
NY 10018  
United States

Respondent: Chris Rogers  
52 Copse Road  
Clevedon  
Bristol  
BS21 7QP  
United Kingdom

**2. The Domain Name**

calvinklein.co.uk

**3. Procedural History**

On 06 November 2014 the Dispute was received and on 07 November the Complaint was validated and notification of the Complaint was sent to both parties. On 20 November a Response was received and notification of this was sent to both parties. On 25 November a reply reminder was sent and Nominet noted on 28 November that no reply had been received and a mediator was appointed. On 03 December mediation was started but failed on 15 December and the close of mediation documents were sent to both parties. On 24 December an Expert decision payment was received and on 15 January 2015 Tim Brown was appointed as the Expert.

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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

#### **4. Factual Background**

The Complainant - Calvin Klein Trademark Trust - is a trust vehicle located in the United States of America and is the owner of a number of trade marks and other intellectual property rights for the Calvin Klein group which date from at least 1978. The Calvin Klein group trades internationally under the "Calvin Klein" name.

The Complainant's product lines include, *inter alia*, women's dresses and suits, men's tailored clothing, men's and women's sportswear and apparel, fragrances, handbags and home furnishings.

The Complainant has operated an online presence from <calvinklein.com> since at least June 1997.

The Respondent is an individual based in Clevedon, Bristol, United Kingdom.

The Domain Name was previously registered by an authorised agent of the Complainant but was recently lapsed by mistake; it was then registered by the Respondent on 18 August 2014.

The Domain Name was configured to redirect web users to a search results page for the term "Calvin Klein" on the third party website <amazon.co.uk>. Currently the Domain Name does not resolve.

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

##### **5.1 Complainant**

The Complainant's contentions are as follows:

##### **5.1.1 Complainant's Rights**

The Complainant has exhibited extracts from the relevant databases showing its ownership of the undernoted registered trade marks, which are a mixture of word and stylised marks:

UK Trade Mark Registration Number 1492382 CALVIN KLEIN  
UK Trade Mark Registration Number 2130032 CALVIN KLEIN  
UK Trade Mark Registration Number 1094301 CALVIN KLEIN  
UK Trade Mark Registration Number 1434780 CALVIN KLEIN  
UK Trade Mark Registration Number 2057946 CALVIN KLEIN

Community Trade Mark No. 000079707 CALVIN KLEIN  
Community Trade Mark No. 006710107 CALVIN KLEIN  
Community Trade Mark No. 006710081 CALVIN KLEIN  
Community Trade Mark No. 005502752 CALVIN KLEIN  
Community Trade Mark No. 005502018 CALVIN KLEIN  
Community Trade Mark No. 000617381 CALVIN KLEIN

The Complainant further notes that it enjoys unregistered or common law rights in the term CALVIN KLEIN, contending that CALVIN KLEIN is one of the best-known designer brands in the world. Since it commenced operations in 1968, the Complainant (and the Calvin Klein group) says it has through extensive trading, advertising and marketing, acquired a very substantial worldwide reputation in the CALVIN KLEIN brand.

The Complainant contends that the CALVIN KLEIN name and mark enjoy a high degree of media, consumer and industry recognition. The Complainant says that CALVIN KLEIN was ranked #8 on MediaRadar's "Most Talked About Fashion Brands of 2013" list and #9 on L2's Digital IQ Index: Fashion in 2013; both of which, the Complainant contends, recognise very high consumer appeal and knowledge of the CALVIN KLEIN brand.

The Complainant notes that it has operated a website which is accessible globally at <calvinklein.com> since June 1997 and has exhibited relevant WHOIS records and screenshots. The Complainant observes that its registration of <calvinklein.com> pre-dates the Respondent's registration of the Domain Name by over seventeen years.

The Complainant contends that the Domain Name is identical to its CALVIN KLEIN name and marks, in which the Complainant has registered and unregistered rights and notes that the domain name suffix .co.uk is of no relevance and wholly generic when comparing a mark to a domain name.

The Complainant also contends that the term CALVIN KLEIN is novel and has no direct or descriptive meaning in the English language, neither is it the Respondent's own name and notes that the Domain Name cannot sensibly refer to anyone other than the Complainant.

### **5.1.2 Abusive registration**

The Complainant contends that at the time it became aware of the Domain Name, the Respondent was using the Domain Name to redirect users to the products he sold on <amazon.co.uk>. The Complainant says that the online store at <amazon.co.uk> consists of its products sold by the Respondent in the name of the Complainant without any affiliation, licence or authorisation from the Complainant and includes infringing products, such as "Calvin Classics and Calvin underwear".

The Complainant avers that the Domain Name is Abusive in terms of a number of elements of the Policy and its contentions for each are set out below:

#### **5.1.2.1 Policy 3(a)(i)(B)**

The Complainant contends that the Respondent registered the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has rights in terms of Policy 3(a)(i)(B).

The Complainant claims that the Respondent registered the Domain Name to benefit from the reputation of CALVIN KLEIN brand and prevent the Complainant from registering the .co.uk equivalent of its <calvinklein.com> domain name in a region where the Complainant enjoys a significant commercial presence.

The Complainant says that because of the Complainant's substantial reputation in the CALVIN KLEIN name and mark the Respondent cannot maintain that it was unaware of the CALVIN

KLEIN brand and the Complainant's rights at the time of registration of the Domain Name. The Complainant contends that the Respondent use of the domain name to link to an online store at <amazon.co.uk> for Calvin Klein and other infringing products makes clear that he is aware of the Complainant and notes that the Respondent has no legitimate reason to use the CALVIN KLEIN name and mark.

The Complainant further contends that the Domain Name was previously registered to an authorised agent of Calvin Klein but was recently allowed to lapse by mistake. The Complainant observes that there was no intention to abandon the Domain Name and the authorised agent was prevented from renewing or re-registering the domain name due to the Respondent's opportunistic step in registering the domain name without authorisation from the Complainant.

The Complainant says that in the UK users are likely to try to find a website by typing in a trading name or mark followed by the .co.uk suffix. Equally, it notes that customers are likely to search for domain names incorporating the CALVIN KLEIN mark when searching for the Complainant's products. The Complainant says that this is especially the case where the mark owner already operates a website incorporating their trading name or mark and a .com suffix - that is <calvinklein.com>. The Complainant concludes that the Domain Name is acting as a blocking registration, preventing users in the UK from accessing information about the Complainant and its products.

#### **5.1.2.2 Policy 3(a)(i)(C)**

The Complainant avers that the Respondent registered the Domain Name primarily for the purpose of confusing the public into thinking that they are visiting the Complainant's official online store and thus unfairly disrupting the Complainant's business.

The Complainant observes that the Domain Name is used by the Respondent to automatically re-direct users to pages on an online store at <amazon.co.uk>, where Calvin Klein products are sold without authorisation or licence provided by the Complainant and which includes third party products which infringe the Complainant's trade marks. The Complainant notes that the Respondent has not set out that it is not an official, authorised Calvin Klein dealer. Accordingly, the Respondent is benefiting from the CALVIN KLEIN brand by misrepresenting itself as the Complainant and illegitimately diverting business away from the Complainant and its authorised dealers.

The Complainant contends that this situation creates a very serious potential for disruption to the Complainant's business, since potential customers of the Complainant's products, who type the Domain Name into their browser thinking it will lead them to the Complainant's official CALVIN KLEIN website will be taken to a site which is not the Complainant's. The Complainant says that users are likely to mistakenly assume that the Respondent's site is run or authorised by the Complainant.

The Complainant avers that the Respondent's primary purpose in registering the Domain Name was to target the Complainant's actual and potential customers. The Complainant says in light of the substantial reputation in its name and products that the Respondent cannot claim that he was unaware of the CALVIN KLEIN brand or the Complainant's Rights at the time of registration. The Complainant suggests the Respondent selected the Domain Name to take advantage of the CALVIN KLEIN name and mark and draw internet traffic away from the Complainant to its own site.

### **5.1.1.3 Policy 3(a)(ii)**

The Complainant contends that the Respondent's use of the Domain Name confuses or is likely to confuse people and/or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant says that the <amazon.co.uk> store hosted under the Domain Name offers the Complainant's and other infringing products and is likely to confuse users into thinking that it is an official website operated by the Complainant or its authorised dealers.

The Complainant says that the Domain Name would be a natural port of call for a user looking for the UK authorised website in relation to its brands, observing that the <.co.uk> suffix is commonly used by international businesses for websites relating to UK business operations and suggests that users would be confused if the Domain Name did not link to a website operated by the Complainant. The Complainant submits that it is inevitable that confusion will have occurred.

### **5.1.1.4 Policy 1(i) and (ii)**

The Complainant observes that it has not authorised the Respondent to use any of its trade marks in domain names. The Complainant contends that the Domain Name, in the hands of the Respondent, who has not paid any licence fee or similar to the Complainant, takes unfair advantage of the Complainant's Rights.

The Complainant further contends that the Respondent has registered and used the Domain Name to give itself an unjustified commercial advantage on the Internet. The Complainant avers that the Respondent has registered the Domain Name to take the most effective advantage of the Complainant's global reputation and goodwill in its CALVIN KLEIN brand. The Complainant suggests that this will potentially encourage other traders to exploit the Complainant's rights without authority and that the unauthorised use of the Complainant's mark in the Domain Name will erode its distinctiveness and decrease its value.

## **5.2 Respondent**

The Respondent's contentions are very brief and are set out in full below:

*I have never hosted a website at this domain.*

*I have never sold traffic from this domain.*

*I have never impersonated this brand.*

*I have never tried to sell or rent this domain.*

## **6. Discussions and Findings**

In order for an Expert to award a transfer of a Domain Name (as the Complainant has requested) the Complainant must prove on the balance of probabilities that:

- i. The Complainant 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.

I will discuss each of these elements in turn.

### **6.1 Rights**

The Complainant has exhibited a number of registered marks for the term CALVIN KLEIN, which pre-date the registration of the Domain Name by some years.

The Complainant also contends it has unregistered or common law rights in the term CALVIN KLEIN and has made a number of claims - unsupported by evidence - to demonstrate such rights. Given the undoubted strength of the Complainant's registered rights as set above, I do not consider it necessary to consider these submissions any further.

As is customary in DRS proceedings the <.co.uk> suffix is only needed for technical reasons and can therefore be ignored for the purposes of comparison. Equally, the whitespace in the Complainant's marks cannot be represented in the domain name space and so too can be ignored. It is therefore clear that the Complainant has demonstrated that it has Rights which are identical to the Domain Name.

I note the same view regarding the Complainant's rights was taken by the Expert in DRS 732 Calvin Klein Inc v. Andrew Dodsworth - an earlier, unrelated dispute concerning the Domain Name.

### **6.2 Abusive registration**

As narrated above, the Respondent has chosen to give a very brief response to the Complaint. He has merely made a number of statements which are presumably intended to deny that his registration and use of the Domain Name is Abusive in terms of the Policy. The Respondent has not submitted any argument to support these statements nor has he given any evidence to back them up. I will accordingly give limited weight to his response; it is rare that brief unsupported assertions are of much assistance to a respondent or complainant's case.

According to the Complainant's submissions, the Domain Name previously forwarded web users to the website <amazon.co.uk>. Currently the Domain Name does not resolve to an active website. It is not clear when the Respondent's use of the Domain Name changed. I will discuss each use of the Domain Name in turn.

The Complainant's screenshots show that the Domain Name forwarded to the search results for the term "Calvin Klein" on the website <amazon.co.uk> operated by Amazon.com Inc. - the well-known Internet retailer. This resulted in web users, who typed the Domain Name into their browser or found it through a search engine, arriving at <amazon.co.uk> and being presented with a page of search results as if they had typed the term "Calvin Klein" into Amazon's search facility themselves.

I note that the Complainant's screenshots show 12,700 results relating to a variety of products connected with the Complainant. The screenshots also show a number of links which assist web users in navigating to other parts of the Amazon website, which inevitably feature unrelated products sold by third party retailers.

The Complainant says in its submissions that the Respondent was using the Domain Name to redirect users to the products he sold on <amazon.co.uk> in the name of the Complainant without any affiliation, licence or authorisation from the Complainant and which included infringing products, such as Calvin Classics and Calvin underwear.

Close examination of the screenshots shows that it is unlikely that the products shown in the search results are exclusively sold by the Respondent. Indeed it seems unrealistic that an individual retailer would be able to successfully stock and fulfill the 12,700 products shown in the search results. In my view, the various products displayed are likely to be sold by a variety of third party retailers using Amazon's retail platform.

If the Domain Name forwarded web users to a variety of retailers who appear in Amazon's search results for "Calvin Klein" what was the benefit to the Respondent? Perhaps some of the products were indeed sold by the Respondent; perhaps the Respondent was paid through an affiliate scheme to forward traffic to <amazon.co.uk>? The Parties' submissions remain silent on these specifics.

However, in my view, the Respondent's precise motivation for configuring the Domain Name as he did is largely irrelevant. The Policy sets out that a domain name can be Abusive if it is registered primarily for the purpose of unfairly disrupting the business of a complainant (Policy 3.a.1.C) or if it is being used or threatened to be used in a way which has confused or is likely to confuse people or businesses into believing that a domain name is registered to, operated or authorised by or otherwise connected with a complainant (Policy 3a.ii). The Policy does not specify that such disruption or confusion has to be commercial in nature or that a respondent must benefit from this financially or otherwise.

Given that the Domain Name is identical to the Complainant's marks and its configuration to redirect to products sold by third party retailers, I believe it is extremely likely that "initial interest confusion" among web users will result. On this point I have referred to paragraph 3.3 of the Expert's Overview<sup>1</sup> which notes:

*Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.*

*In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name*

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<sup>1</sup> The Experts' overview is a document put together by Nominet's panel of Experts which deals with a range of issues that come up in DRS disputes. It is published on Nominet's website at: [http://www.nominet.org.uk/sites/default/files/drs\\_expert\\_overview.pdf](http://www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf)

I take the view that the facts of the current dispute closely fit the species of confusion set out in the Overview and conclude that the Respondent's registration of a Domain Name identical to the Complainant's CALVIN KLEIN marks and subsequent commercial use - whether or not this benefited the Respondent directly - is Abusive in terms of the Policy.

Turning briefly to the Domain Name's current non-use, Policy 3.b notes that failure on a respondent's part to use a domain name for the purpose of email or a web site is not itself evidence that it is an Abusive Registration. However, given the Respondent's previous use outlined above, I do not consider that the current non-use does anything to mitigate the said previous Abusive use.

## **7. Decision**

Having concluded that the Complainant has Rights in respect of names or marks which are identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I determine that the Domain Name should be transferred to the Complainant.

**Signed Tim Brown**

**Dated 22 January 2015**