

ADMINISTRATIVE PANEL DECISION

Milano.com Limited v. Kathaleen Hosle

Case No. DCC2013-0003

1. The Parties

The Complainant is Milano.com Limited of Chengdu, Sichuan, China, represented by Wilson Sonsini Goodrich & Rosati, United States of America.

The Respondent is Kathaleen Hosle of Cyprus.

2. The Domain Name and Registrar

The disputed domain name <milano.cc> (the "Domain Name") 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 August 28, 2013. On August 29, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 29, 2013, the Registrar transmitted by email to the Center its verification response 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" 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 4, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was September 24, 2013. The Response was filed with the Center on September 22, 2013.

The Center appointed Ian Lowe as the sole panelist in this matter on October 8, 2013. 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 Complainant is an online marketplace for a range of products including women's fashion apparel, fashion accessories, bridal apparel, swim apparel and jewelry and beauty products. It is hosted at the website "www.milano.com" (the "Website"). The Website is available in a number of languages including English, French, Russian, Spanish, German and Japanese. The Complainant maintains MILANOO-branded Facebook pages in a number of languages and these had over 170,000 followers, or "likes" as of August 7, 2013. The Complainant also has a strong presence on YouTube with a MILANOO-branded channel that features the Complainant's promotional videos. The Website has an interactive component, similar to social media websites, where customers write reviews of their purchases. The Website's "Reviews" page has over 48,000 consumer reviews.

The Complainant focuses its promotions on direct email advertising, Internet advertising, social media advertising such as Facebook and YouTube channels and press releases that are distributed internationally. Since its launch, the Complainant has spent millions of dollars on the worldwide advertising and promotion of the MILANOO brand and its related offerings, including millions of dollars in 2011 alone.

The Domain Name was registered by the Respondent on May 23, 2011. It resolves to an online marketplace for women's fashion apparel selling a range of products including wedding dresses, special occasion dresses, handbags, shoes and accessories.

5. Parties' Contentions

A. Complainant

The Complainant states that it has hosted its online marketplace at <milano.com> since July 2008 and that the Website is now familiar to Internet shoppers everywhere. It claims that its English version website has received over 40 million visits since 2008, the French language version over 14 million visits and the German language version over 9 million. According to the Complainant it has sold tens of millions of dollars worth of fashion goods via its MILANOO-branded marketplace and its global sales volume has increased every year since its launch. As result of the Complainant's extensive marketing efforts and the success of its MILANOO-branded offerings, it maintains that the MILANOO mark is distinctive and has been distinctive in the relevant marketplace since prior to the registration of the Domain Name in 2011 and that the mark represents valuable goodwill owned by the Complainant.

The Complainant contends that the Domain Name is identical or confusingly similar to its trademark MILANOO, in which it has unregistered rights as a result of its longstanding use of the mark and the goodwill it has acquired in the mark since the launch of the Website in 2008.

The Complainant considers that the website to which the <milano.cc> domain name resolves is an online marketplace for women's fashion apparel that is confusingly similar to the Complainant's own fashion marketplace at the Website. It believes that the Respondent hopes to capitalize on the fame of the MILANOO name by confusing shoppers into believing that this site is associated with the Complainant. It points out that, like the Website, the Respondent's website features a prominent display of special occasion apparel such as prom dresses and bridal wear. Not only does the Respondent use the Domain Name to promote a fashion marketplace but the Respondent has also copied the Website by emphasizing the same specialty merchandise for which the Complainant is famous.

The Complainant states that the Respondent does not use a prominent brand name or logo anywhere on its fashion marketplace hosted at "www.milano.cc" and that the Respondent refers to itself as "Milano" in portions of its website such as the CONTACT US section, the FAQ section and the ABOUT US section. Accordingly, the Complainant alleges that the Respondent has designed its website so that visitors will believe the site is associated with or operated by an entity known as Milano.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent is not known by the name MILANOO and has not been authorized by the Complainant to use the name. In the view of the Complainant the name MILANOO is a neologism created by the Complainant that has no meaning. The Respondent cannot acquire rights in a name that does not belong to her by using it without the authority of the owner of the name.

Finally, the Complainant alleges that the Respondent registered and has used the Domain Name in bad faith. It points to the fact that the Respondent registered the Domain Name some years after the Complainant had started to use the name MILANOO for an online fashion apparel website and has then used it for the same purpose. In those circumstances, particularly where MILANOO was a name made up by the Complainant, the Respondent almost certainly knew of the Website and the business carried on by the Complainant at the Website at the time she registered the Domain Name for a competing business.

Finally, the Complainant claims that the Respondent uses the Domain Name to lure Internet users to the Respondent's own fashion marketplace that is confusingly similar to the Complainant's marketplace. Shoppers who are directed to this site, either via search results or by directly typing the URL into a web browser, are likely to believe that they have successfully accessed a website related to the Complainant's business. In fact, even a Milanoo enthusiast would be confused. The Respondent's website is used to sell the fashion apparel that consumers expect to see on the Complainant's website and the Respondent refers to herself as Milanoo throughout the website. The Complainant submits that using the Domain Name in this manner has been recognized as bad faith use in violation of the UDRP.

B. Respondent

The Respondent points out first that the Domain Name was registered several months before the Complainant filed trademark applications in respect of the MILANOO mark with the United States Patent and Trademark Office and with the OHIM. These are applications not referred in the Complaint. She further claims that the success of the Website was not as great as the Complainant claims prior to the registration of the Domain Name and is not the result of the sale of MILANOO branded products but of products bearing the trademarks of well-known United States and European brands. She suggests that as a result of this allegedly improper activity, the <milanoo.com> domain name was transferred to a third party in April 2012.

The Respondent also contends that there is "no character or picture related to Milanoo or milanoo.com and no misleading behaviour to customers or damage to milanoo.com in the milanoo.cc website".

Finally the Respondent states that there has been no attempt to sell the Domain Name and no speculative behaviour but simply an online business providing high quality service to customers.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name the Complainant must prove that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant does not claim any registered rights in respect of a relevant trademark but relies on the establishment of sufficient goodwill and reputation in the MILANOO name through some five years trading

using the “www.milano.com” website and the associated marketing and online promotion of the marketplace at the Website. Although the Respondent claims that the Website was not as successful as the Complainant alleges in the period before the Domain Name was registered, the Panel is satisfied that as a result of the sales activity carried on through the Website and the related promotion since 2008 the Complainant has acquired unregistered rights in the trademark MILANOO. The Domain Name is identical to the trademark MILANOO, ignoring the “.cc” suffix. Accordingly, the Panel finds that the Domain Name is identical to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent does not explain in her Response what rights or legitimate interests she may have in the Domain Name. She gives no account of how she came to adopt the MILANOO name which the Panel accepts was a neologism adopted by the Complainant with no normal meaning. There is no suggestion that the Respondent was known by that name and it is particularly striking that the Respondent chose it for a domain name and a website carrying on the same activity as the Complainant. Even though the Respondent appears to be carrying on a legitimate business from the website at the Domain Name, the use of another’s name in these circumstances cannot give rise to rights or legitimate interests in that name for the purposes of paragraph 4(a)(ii) of the Policy.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

The Domain Name comprises the MILANOO name and the “.cc” suffix. In view of the nature of the MILANOO name, a neologism with no ordinary meaning, the Panel considers it overwhelmingly likely that the Respondent had the Complainant in mind when she registered the Domain Name, particularly in view of the use to which the Domain Name has been put, namely an online marketplace selling exactly the same sort of goods as are sold from the Complainant’s website. The subsequent use of the Domain Name for a website competing in that way appears to the Panel to be classic bad faith use, intended to draw Internet users to the Respondent’s website under the mistaken view that they are visiting the Website. Needless to say, this is done with a view to commercial gain given the business being carried on at the Respondent’s website.

Although the Respondent has filed a Response, she has offered no explanation for her choice of the Domain Name for a website offering the same products as the Complainant.

In the circumstances, the Panel finds that the Domain Name was registered and is being used in bad faith.

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 Domain Name <milano.cc> be transferred to the Complainant.

Ian Lowe

Sole Panelist

Date: October 22, 2013