

ADMINISTRATIVE PANEL DECISION

Milano.com Limited v. Kathaleen Hosle
Case No. DME2013-0013

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.com> (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 September 4, 2013. On September 4, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 4, 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") as adopted by doMEn, d.o.o. (doMEn), the registry operator of the .ME TLD on April 30, 2008, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") approved by doMEn on October 1, 2012, 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 10, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was October 1, 2013. A communication containing an informal Response was filed with the Center on September 23, 2013. On September 24, 2013, the Center acknowledged receipt requesting confirmation that the above-referenced communication and attached documents may be regarded as the complete Response. On October 2, 2013, the Center informed the parties of the commencement of the Panel Appointment process.

The Center appointed Ian Lowe as the sole panelist in this matter on October 11, 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 "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. At the time of filing the Complaint it did not resolve to an active website. On the same date the Respondent registered the domain name <milano.cc> which is the subject of a separate UDRP complaint filed by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant states that it has hosted its online marketplace at "www.milano.com" since July 2008 and that its 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 version over 14 million visits and the German 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 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 "milano" and has not been authorized by the Complainant to use the name. In the view of the Complainant, the name "milano" is a neologism created by the Complainant that has no meaning.

The Complainant considers that the website to which the domain name <milano.cc> resolves, operated by the Respondent, is an online marketplace for women's fashion apparel that is confusingly similar to the Complainant's own fashion marketplace at the Website. The Complainant believes that the Respondent hopes to capitalize on the fame of the "milano" name by confusing Internet shoppers into believing that the website at the Domain Name is associated with the Complainant. It points out that, like the Website, the

Respondent's website at <milanoo.cc> features a prominent display of special occasion apparel such as prom dresses and bridal wear. Not only does the Respondent use the domain name <milanoo.cc> 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.milanoo.cc" and that the Respondent refers to itself as "Milanoo" in portions of this website such as the "Contact Us" section, the "FAQ" section and the "About Us" section. Accordingly, the Complainant alleges that the Respondent has designed the website at "www.milanoo.cc" so that visitors will believe the site is associated with or operated by an entity known as Milanoo.

The Complainant fears that the Respondent will use the Domain Name for the same purpose as the other domain name <milanoo.cc>. In circumstances where "milanoo" was a name made up by the Complainant and the Respondent almost certainly knew of the Website and the business carried on by the Complainant at the Website at the time it registered the Domain Name, the Complainant maintains that bad faith may be inferred even though the Respondent is not making any material use of the Domain Name.

B. Respondent

First, the Respondent points out 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 ("USPTO") and with the Office for Harmonization in the Internal Market ("OHIM"). These are applications not referred in the Complaint. The Respondent further claims that since the Complainant's trademark is MILANOO.COM but the Domain Name is <milanoo.me> this "doesn't violate the regulation of Disclaimer and Description of Mark."

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 website "www.<http://milanoo.com/milanoo.com>" and the associated marketing and online promotion of the marketplace at that website. 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 country code top-level domain ("ccTLD") ".me".

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 the Response what rights or legitimate interests she may have in the Domain Name. The Respondent 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 commonly known by that name. The Respondent has not made any attempt to rebut the *prima facie* case put forward by the Complainant that the Respondent cannot have rights or legitimate interests in the Domain Name.

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 ccTLD “.me”. 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 it registered the Domain Name, particularly in view of the use to which the domain name <milanoo.cc> registered by the Respondent on the same day as the Domain Name has been put – namely, an online marketplace selling exactly the same sort of goods as those sold at the Complainant’s website. The subsequent use of the Respondent’s other domain name <milanoo.cc> for a website competing in that way appears to the Panel to be classic bad faith use, intended to draw Internet users to the website under the mistaken view that they are visiting the Website. Although the Respondent has filed a Response, she has offered no explanation for the registration of the Domain Name.

As numerous UDRP panels have found, passive use of a domain name can amount to bad faith use for the purposes of the Policy. In the current case, the Panel also considers that the Complainant has justifiable concerns that the Respondent may put the Domain Name to similar use to that of the other domain name <milanoo.cc>.

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 disputed domain name <milanoo.me> be transferred to the Complainant.

Ian Lowe

Sole Panelist

Date: October 25, 2013