

WIPO Arbitration and Mediation Center**ADMINISTRATIVE PANEL DECISION****Advance Magazine Publishers Inc. v. [X]****Case No. DNL2018-0026****1. The Parties**

The Complainant is Advance Magazine Publishers Inc. of New York, New York, United States of America (“United States”), represented by Arnold + Siedsma, Netherlands.

The Respondent is [X] of Assendelft, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <vogueman.nl> (the “Domain Name”) is registered with SIDN through Hostnet B.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2018. On the same day, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On April 26, 2018, SIDN 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 Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 1, 2018. In accordance with the Regulations, article 7.1, the due date for Response was May 21, 2018. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 22, 2018.

The Center appointed Wolter Wefers Bettink as the panelist in this matter on May 31, 2018. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

The Complainant is a publisher of well-known magazines such as Vogue (since 1892), Glamour, The New Yorker, Vanity Fair and GQ. In addition to the United States edition, Vogue is published through Complainant’s subsidiaries or through local licensees in *inter alia* the following countries: Australia, Brazil, China, France, Germany, Greece, Italy, Japan, the Netherlands, Portugal, Republic of Korea, Russian Federation, Spain, United Kingdom of Great Britain and Northern Ireland, as well as in Latin America. Since 2000, the Complainant has operated a website under the domain name <vogue.com>, which features fashion show video coverage, Vogue magazine content, photos, designer profiles and current apparel line information, as well as ads from luxury brand owners.

The website under <vogue.com> receives over seven million page views per month and has over 600,000 unique users every month. Since September 2015 the Dutch licensee of the Complainant on a regular basis publishes a Dutch edition of Vogue Man.

The Complainant owns over 1,000 trade mark registrations consisting of or containing the term “vogue” in connection with magazines and online publications and distribution of information worldwide, including:

- a. European Union trade mark VOGUE, registered on May 28, 2014 under No.000183756;
- b. European Union trade mark VOGUE MAN, registered on October 2, 2015 under No. 013911227;
- c. Benelux trade mark (figurative) VOGUE, registered on September 1, 1993 under No. 0527961 (“Trade Marks”).

The Domain Name was registered on November 8, 2017 and resolves to a parking page advertising Registrar services.

It appears that the Respondent has been making preparations for the opening of a fashion and style store for men under the name Vogue Man in Amsterdam (in a font identical to that of the Benelux trade mark VOGUE of the Complainant), putting the name Vogue Man on the front of the store, setting up a Facebook page and registering the Domain Name

The Complainant has sent a cease and desist letter requesting the Respondent to permanently cease infringement of the Trade Marks and to transfer the Domain Name to the Complainant. In response, the Respondent has signed a declaration that it has ceased and desists from infringing the Complainant’s Trade Marks, in particular in relation to use of the mark VOGUE MAN, including use on its shop front, its Facebook page and its website. In an email dated March 12, 2018, the Respondent’s lawyer stated (in English translation): “In respect of the website client is prepared to transfer it to your client under reasonable conditions”.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the Domain Name is identical to and confusingly similar with the trade mark VOGUE MAN as it incorporates this in its entirety.

In addition, the Complainant states that the Domain Name is identical to and confusingly similar with the trade mark VOGUE, as it incorporates this, whereas the word “man” refers to the focus of the goods and services, namely fashion and style for men and is therefore descriptive. According to the Complainant, visitors of the website under the Domain Name may believe the Respondent is directly or indirectly connected to the Complainant or that there is a commercial connection between the Complainant and the Respondent.

The Complainant submits that the Respondent has no rights to or legitimate interests in the Domain Name, as it never gave permission to the Respondent for the use of the Trade Marks in connection with the registration of the Domain Name or otherwise. The

Complainant further states that, prior to its registration of the Domain Name, the Respondent had no legitimate use or right to the use of the Trade Marks either. The Complainant adds that the Respondent has registered the Domain Name in connection with the opening of its fashion store under the name Vogue Man, for which purpose it used a letter font on the front of its store identical to that of the figurative trade mark VOGUE. According to the Complainant, the Respondent knew or had to know that by doing so it would use a sign identical to the Trade Marks, thereby profiting from the reputation of the Trade Marks. The Complainant alleges that the use of the name Vogue Man for a fashion store constitutes a trade mark infringement, which the Respondent has acknowledged and declared to permanently cease. In view of the above, the Complainant concludes that the Respondent has not used the Domain Name for the *bona fide* offering of goods, or the preparation thereof, prior to its obtaining knowledge of the Complaint. In the view of the Complainant, the lack of right or legitimate interest of the Respondent in the Domain Name also follows from the cease and desist declaration the Respondent signed, stating that it would permanently cease the use of the name Vogue Man, for its store, Facebook page and website.

According to the Complainant, the Respondent registered the Domain Name in bad faith, to use it in connection with its fashion store under the name Vogue Man and thereby engaging in activities similar to those of the Complainant, both focusing on fashion and style. The Complainant further submits that such use of the Domain Name would cause the Respondent to benefit from the repute of the trade mark VOGUE and from Internet users searching for information in relation to publications under the Trade Marks, thereby profiting from the confusion caused with the Trade Marks and their repute and that of the Complainant's magazines. Bad faith is also evident, as the Complainant states, from the fact that the Respondent is withholding the Domain Name from the Complainant, while the Respondent now states to be willing to transfer the Domain Name under conditions, apparently seeking monetary compensation as a condition for the transfer.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks.

The Domain Name is confusingly similar to the Trade Marks as it incorporates both the mark VOGUE and the mark VOGUE MAN in its entirety (see also [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) ("WIPO Overview 3.0"), [section 1.7](#)).¹

In addition, the Respondent has signed a cease and desist statement that it has ceased and desists from infringing the Complainant's Trade Marks, implying that its use of the Trade Marks (and in particular the Benelux trade mark VOGUE MAN) infringes the Complainant's rights in the Trade Marks.

The generic Top-Level Domain ("gTLD") ".com" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0, section 1.2](#)).

Therefore, the Panel finds that the Domain name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has to make out at least a *prima facie* case that the Respondent does not have rights to or legitimate interests in the Domain Name ([WIPO Overview 3.0, section 2.1](#)). Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent has not received the Complainant's consent to use the Trade Marks as part of the Domain Name, is not commonly known by the Domain Name, has no connection or affiliation with the Complainant and has not acquired trade mark rights in the Domain Name.

The Respondent's use of the Domain Name in relation to its planned shop under the name Vogue Man and the Facebook page for that shop, does not amount to a *bona fide* offering of goods or services, nor to a legitimate noncommercial or fair use.

In view of the above, the Panel concludes that the Complainant has established that the Respondent has no rights to or legitimate interests in the Domain Name.

C. Registered or Used in Bad Faith

In accordance with article 3.1 of the Regulations, the Complainant has to show that the Domain Name was registered and has been used in bad faith.

Based on the information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the Domain Name the Respondent was in bad faith as it was or should have been aware of and indeed specifically targeted, the Complainant and the Trade Marks. In particular, such knowledge and intent is derived from the following facts: (i) the Respondent's registration of the Domain Name occurred well after the registration of the earliest Trade Marks; (ii) the Trade Marks may be deemed famous throughout the world, including the Netherlands; (iii) the element "vogue" of which the Trade Marks consist (in whole or in relevant part), is incorporated in its entirety in the Domain Name, and does not appear to be a name of which a registrant is likely to spontaneously or accidentally think of; and (iv) use of the specific font of the figurative Benelux trade mark VOGUE for the shopfront of the Respondent's planned fashion store.

In addition, the apparent registration of the Domain Name in relation to the Respondent's planned store with the name Vogue Man and the Facebook page, constitutes bad faith as the Respondent thereby seeks to benefit from the repute of the Trade Marks and from confusion with the Trade Marks among Internet users searching for information in relation to publications under the Trade Marks.

Finally, the fact that the Respondent signed a cease and desist statement in respect of infringement of the Trade Marks, but then was only prepared to transfer the Domain Name on "reasonable conditions"- which appears to include financial terms – here is further evidence of bad faith registration and use.

The Panel concludes that the Domain Name has been registered and is being used in bad faith.

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the domain name <vogueman.nl> be transferred to the Complainant.

Wolter Wefers Bettink

Panelist

Date: June 14, 2018

¹ In view of the fact that the Regulations are to an extent based on the UDRP, it is well established that cases decided under both the Regulations and the UDRP are relevant to this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. DNL2008 0050).