Decision for dispute CAC-UDRP-101638

Case number	CAC-UDRP-101638
Time of filing	2017-08-09 11:44:09
Domain names	sandro.asia

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	SANDRO ANDY

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	lifangqiang

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has supplied evidence that it is the owner of the following trade mark rights:

International Registration No. 827287 issued on 4 March 2004
SANDRO in International Classes 3, 9, 14, 16, 18, 21, 24, 25, 26, 27 and 24

European Registration No. 008772568 issued on 27 July 2010
SANDRO in International Classes 14, 18 and 25

French Registration No. 3244120 issued on 4 September 2003
SANDRO in International Classes 3, 9, 14, 16, 18, 21, 24, 25, 26, 27 and 34

FACTUAL BACKGROUND

The Complainant is a French company established in 1984 operating in the fashion industry. The Complainant is recognized throughout the world with more than 540 stores, 59 of which are in Asia.

Nothing is known about the Respondent, apart from the fact that it is based in China.

The disputed domain name was registered on 1 November 2016. It is being used to point to a website containing sponsored links to websites selling clothes, including those of the Complainant and its competitors, and stating that the disputed domain name is available for sale.

PARTIES CONTENTIONS

Parties' Contentions

Complainant

Identical or confusingly similar

The Complainant evidences the three trade mark rights listed in the "Identification of Rights" section above. It also notes that it has registered its SANDRO trade mark in several countries throughout the world, including in China (where the Respondent resides), where it owns the following trade mark right:

International Registration 827287 issued on 4 March 2004
SANDRO in International Classes 3, 9, 14, 16, 18, 21, 24, 25, 26, 27 and 24 (designating China)

The Complainant argues that the disputed domain name is identical to its registered SANDRO trade mark without adornment.

It also contends that the addition of the new generic Top Level Domain (gTLD) .ASIA does not prevent the likelihood of confusion between the disputed domain name and the Complainant’s trade marks. The Complainant further states that the addition of a TLD is not relevant when determining whether a domain name is identical or confusingly similar to a complainant’s trade mark. The Complainant argues that the TLD may instead reinforce the confusion as Internet users will likely believe that the disputed domain name redirects to the Complainant's official website dedicated to the Asian market.

No rights or legitimate interests

The Complainant points out that the WHOIS records list "lifangqiang" as the name for the registrant of the disputed domain name. The Complainant underlines that previous panels have held that a respondent is not commonly known by a domain name if the WHOIS information is not similar to such name. The Complainant therefore contends that the Respondent is not known by the disputed domain name.

The Complainant argues that the Respondent is not affiliated with nor authorized by the Complainant to use its SANDRO trade mark, and has no rights or legitimate interests in respect of the disputed domain name.

The Complainant further submits that it has not licenced nor authorized the Respondent to use its trade mark SANDRO, or to register the disputed domain name.

Furthermore, the Complainant contends that the website associated with the disputed domain name displays sponsored links in relation to the Complainant’s activity and its competitors, including the terms "Robe Bash" (Bash dress) or "SANDRO robe" (Sandro dress). The disputed domain name is also on sale online for a minimum bid of USD 90.

The Complainant further submits that there is no evidence that the Respondent has used, or has made any demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services or for noncommercial or fair use purposes. In the Complainant's opinion, the Respondent has only registered the disputed domain name in order to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trade mark.

The Complainant underlines that, once it makes a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, the burden shifts to the Respondent to show that it does have rights or legitimate interests.

Registered and used in bad faith

The Complainant points out that the disputed domain name resolves to a website containing sponsored links related to the Complainant's activity and competitors. The Complainant contends that the disputed domain name is used to attract traffic to the Respondent's website.

The Complainant further argues that the website associated with the disputed domain name displays a link redirecting to a webpage where the disputed domain name is for sale for a minimum bid of USD 90.

The Complainant states that offering the disputed domain name for sale to the Complainant, or to one of its competitors, was the Respondent's primary purpose for the registration of the disputed domain name.

The Complainant asserts that the Respondent's bad faith is also clearly evident from the fact that the website to which the disputed domain name is pointing contains links related to its activity and competitors.

To the Complainant, the abovementioned factors indicate that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant or to one of its competitors, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name.

By registering and using the disputed domain name, the Complainant argues that the Respondent has maintained the disputed domain name in order to intentionally attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trade mark.

On this basis, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

Respondent

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has shown, to the satisfaction of the Panel, that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has shown, to the satisfaction of the Panel, that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has shown, to the satisfaction of the Panel, that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the Policy have been met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In this case the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel is therefore obliged to make its decision on the basis of the factual statements contained in the Complaint and the documents made available by the Complainant to support its contentions.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following for a panel to order a transfer of the domain name(s) at issue:

(i) the domain name registered by the respondent is identical or confusingly similar to a trade mark or service mark in which Complainant has rights; and

(ii) the respondent has no rights or legitimate interests in the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has trade mark rights in the term SANDRO.

The Panel notes that the disputed domain name incorporates the Complainant's SANDRO trade mark in its entirety. Moreover, the addition of the ".ASIA" new gTLD serves to enhance the likelihood of confusion because it suggests that the disputed domain name is related to the Complainant's business activity in Asia.

On the basis of these considerations, the Panel finds that the disputed domain name is identical to a trade mark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element that the Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the disputed domain name (Policy, paragraph 4(a)(ii)).

Paragraph 4(c) of the Policy sets out various ways in which a respondent may demonstrate rights or legitimate interests in the domain name(s) at issue, as follows:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

The Panel has considered the evidence put forward by the Complainant and is of the view that the Complainant has presented a clear prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name. As a result of its default, the Respondent has failed to rebut that showing.

The Respondent cannot be considered to be making a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy referred to above, given that the disputed domain name exactly matches the Complainant's trade mark and is pointing to a website containing sponsored links relating to the Complainant's activities. Neither can such use be said to be a legitimate non-commercial or fair use of the domain name within the meaning of paragraph 4(c)(iii). Furthermore, no evidence has been supplied that the Respondent is commonly known by the disputed domain name, as referred to at paragraph 4(c)(ii).

Given the above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The third element that the Complainant must prove is that the disputed domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy sets out various circumstances which may be treated by the Panel as evidence of the registration and use of a domain name in bad faith, as follows:

"For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

Given the Complainant's notoriety, the fact that its trade marks significantly pre-date the registration of the disputed domain name, the content of the website to which the disputed domain name is pointing, and the fact that it is for sale, it is clear to the Panel that the Respondent is acting in bad faith.

Regarding bad faith registration, the Respondent is offering the disputed domain name for sale. Therefore, the Panel finds that the Respondent registered the disputed domain name primarily for the purpose of selling it, in accordance with paragraph 4(b)(i) of the Policy.

As far as bad faith use is concerned, the Panel is also satisfied that the Respondent’s conduct falls within paragraph 4(b)(iv) of the Policy. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the Complainant's trade mark as to the source,

sponsorship, affiliation, or endorsement of its website or of a product or service on its website.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SANDRO.ASIA**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2017-09-15

Publish the Decision