Decision for dispute CAC-UDRP-101601

Case number	CAC-UDRP-101601
Time of filing	2017-09-29 11:06:05
Domain names	noisymayjeans.com

Case administrator

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

Complainant

Organization	Bestseller A/S

Respondent

Name	Moza Siders

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant has rights in the following registered trademarks for NOISY MAY by virtue of the fact that they are owned by Aktieselskabet af 21. November 2001, which is part of the BESTSELLER Group of which the Complainant is a member:

(a) European Union trademark (No. 011299054, registered on 09/05/2013);

(b) United States trademark (No. 4,536,290, registered on 27/05/2014); and

(c) China trademark (No. 11675855, registered on 07/04/2014)

(collectively " the NOISY MAY mark").

The Complainant and Aktieselskabet af 21. November 2001 are hereafter referred to as "the Complainant " or "BESTSELLER."

The Disputed Domain Name was registered by the Respondent on 29 December 2016.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

As appears from the foregoing, the Complainant is a member the BESTSELLER Group, and one of its brands is NOISY MAY .The NOISY MAY marks referred to above are owned by Aktieselskabet af 21. November 2001, which is part of the BESTSELLER Group. Copies of the registration certificates and excerpts from the official trademark databases were attached to the Complaint. The Panel has examined those certificates and excerpts and accepts them as evidence of the NOISY MAY marks and their registration.

BESTSELLER also owns many domain names incorporating the NOISY MAY mark, including noisymay.com, noisy-may.com, noisymay.dk, noisymay.de and noisymay.store. Copies of the WHOIS information on the domain names were attached to the Complaint.

BESTSELLER is a family-owned Danish fashion company selling and distributing clothing, shoes and accessories worldwide under a variety of trademarks such as VERO MODA, JACK & JONES, ONLY and NOISY MAY.

The disputed domain name was registered on 29 December 2016 whereas the Complainant's NOISY MAY marks were registered in 2013 and 2014 . The disputed domain name is being used to resolve to a website being used to sell unauthorized NOISY MAY clothing and appearing as an official NOISY MAY online store.

The Complainant sent a cease and desist letter to the registrant of the NOISYMAYJEANS.COM domain name on the 22 August 2017, notifying the registrant of its prior rights. The registrant of the disputed domain name NOISYMAYJEANS.COM did not respond to the cease and desist letter.

The Complainant argues as follows:

1. Trademark Infringement

The disputed domain name NOISYMAYJEANS.COM (Hereinafter the “Disputed Domain Name”) contains THE NOISY MAY trademark in its entirety and only differs from NOISY MAY by the addition of the word JEANS at the end of the domain name. The word JEANS is descriptive for the goods offered for sale on the website of the Disputed Domain Name. NOISYMAYJEANS.COM is as such both visually, aurally and conceptually very similar to our NOISY MAY trademark.

Regarding the similarity of goods, the goods for which the NOISY MAY marks have been registered, and for which the Complainant currently uses the trademark NOISY MAY are, among others, clothing, jeans, shirts, jackets and leather clothing which are identical to the goods offered for sale on the website of the Disputed Domain Name.

The website does not aim at any particular market, as it seems to ship the offered goods worldwide.

As the Disputed Domain Name is both visually, aurally and conceptually very similar to the NOISY MAY marks and as the goods offered for sale on the website of the Disputed Domain Name are identical to the goods for which the trademarks have been registered, the Disputed Domain Name is confusingly similar to the registered NOISY MAY trademarks.

Following from the above, the Disputed Domain Name is confusingly similar to BESTSELLER’s NOISY MAY trademarks and is infringing the trademark rights of BESTSELLER, within the meaning of paragraph 4(a)(i) of the ICANN Uniform Domain Name Dispute Resolution Policy (Hereinafter the “Policy”).

2. No Rights or Legitimate Interests in the Disputed Domain Name

BESTSELLER has neither authorized the registrant of the Disputed Domain Name to use the NOISY MAY marks nor to sell NOISY MAY goods. The registrant of the Disputed Domain Name gives the appearance an official NOISY MAY online store, through the use of BESTSELLER’s copyright protected images on the website.

Furthermore, it appears that the registrant is not able to deliver the goods which are marketed on the website. This appears from the fact that BESTSELLER has been contacted by a consumer who purchased goods from the website of the Disputed Domain Name believing that it was an official NOISY MAY dealer, but not received any goods.

The Disputed Domain Name is therefore not being used in a legitimate non-commercial or fair way and only intends to attract as many internet users as possible, pretending to sell them NOISY MAY goods.

Furthermore, the registrant of the Disputed Domain Name has no trademark registrations on any part of the Disputed Domain Name and there is nothing whatsoever which indicates that the registrant has any legitimate interests in the disputed domain.

Consequently, the registrant of the Disputed Domain Name does not have any rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad Faith

The website of the Disputed Domain Name is using, not only BESTSELLER's registered trademark all over the website, but BESTSELLER's copyright protected images as well. The website of the Disputed Domain Name furthermore appears as an official NOISY MAY online store selling BESTSELLER's NOISY MAY goods.

However, as has been noted, it seems as if the site is not selling goods at all, which substantiates that the Disputed Domain Name has been registered in bad faith.

There can be no doubt, the Complainant submits, that the Disputed Domain Name was not registered in, and is not currently being used in good faith, when the registrant is, and has been, intentionally using BESTSELLER's registered trademark and copyright protected images on the website, as well as images which appear to have been taken directly from the website of the Complainant's wholesale customer ASOS.com Ltd, so as to appear as an official NOISY MAY online store, authorized by BESTSELLER. Therefore, the registrant of the Disputed Domain Name has been intentionally attempting to attract internet users to the website for commercial gain, by creating a likelihood of confusion with BESTSELLER's NOISY MAY trademark, attempting to show an affiliation with the website by BESTSELLER, within the meaning of paragraph 4(b)(iv) of the Policy.

For the reasons stated above, the Disputed Domain Name has been registered and is being used in bad faith by the registrant within the meaning of paragraph 4(a)(iii) of the Policy.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service 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, to the satisfaction of the Panel, shown the Respondent to have 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, to the satisfaction of the Panel, shown 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 UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Pursuant to paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has

to demonstrate that:

(i) The Disputed 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 Disputed domain name; and

(iii) The Disputed Domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first element that the Complainant must make out is that the Disputed Domain Name is identical with, or confusingly similar to, the trademark or service mark rights relied on by the Complainant.

The first question that arises under this element is whether the Complainant has rights in a trademark or service mark on which it may rely.

The Complainant has shown by evidence that the Panel accepts that it is the owner of the NOISY MAY marks referred to above in the section "Factual Background".

The second question that arises is whether the Disputed Domain Name is identical to or confusingly similar to the NOISY MAY marks, and what is required here is a comparison between the domain name and the marks.

Clearly the two are not identical , but the question remains whether they are confusingly similar. The Panel finds that they are confusingly similar for the following reasons.

First, the domain name contains the whole of the NOISY MAY trademark which is of course the dominant part of the domain name, raising in the mind of the internet user the immediate impression that the domain name relates to or is invoking the trademark.

Secondly, the only addition to the trademark as incorporated into the domain name is the word "JEANS", naturally raising in the mind of the internet user the impression that the domain name deals with and leads to a website that deals with jeans manufactured or sold under the NOISY MAY trademark. As a matter of fact established by the evidence, the Complainant sells jeans under its NOISY MAY trademark. The internet user would also naturally assume that the domain name may lead to an official website dealing with NOISY MAY jeans and providing a facility for buying them.

That interpretation of domain names that consist of a trademark followed by a generic word describing goods purporting to be sold under the trademark is now well established and has been applied in many UDRP decisions.

It is of course also well established that the omission of the gap between the two words in the trademark when compressed into the domain name and the use of a top level domain such as ".com" cannot negate a finding of confusing similarity which is otherwise present, as it is in the present case.

The Panel therefore finds that the Disputed domain name is confusingly similar to the NOISY MAY marks.

The Complainant has thus made out the first of the three elements that it must establish.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the Disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may show that the Respondent has rights or legitimate interests in the Disputed Domain Name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [Disputed] domain name or a name corresponding to the [Disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate noncommercial or fair use of the [Disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It can readily be seen from the phraseology used that those criteria form a non-exhaustive list of circumstances where a respondent can show rights or legitimate interests in a domain name.

It is now well established that Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. See Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA 741828 (FORUM Aug. 18, 2006) (holding that the complainant must first make a prima facie case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); see also AOL LLC v. Gerberg, FA 780200 (FORUM Sept. 25, 2006) ("Complainant must first make a prima facie showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.").

The Panel finds that Complainant has made out a prima facie case that arises from the following considerations:

(a) the Respondent has chosen to take the Complainant's trademark and to use it in its domain name, adding only the word "JEANS", which underlines the impression that this is a domain name dealing with jeans sold under the NOISY MAY marks and that it will lead to a website dealing with that subject;

(b) the Respondent registered the domain name on 29 December 2016, well after the NOISY MAY marks were registered;

(c) the disputed domain name and the website to which it resolves are being used to sell unauthorized NOISY MAY clothing, appearing as an official NOISY MAY online store;

(d) the Respondent has no affiliation with the Complainant;

(e) On the unchallenged evidence, there is nothing to show that the Respondent is commonly known by the Disputed Domain Name;

(f) The Complainant has not authorized the Respondent to use the Complainant's trademarks.

(g) The Respondent has not filed a Response that would have enabled it to show that it had a right or legitimate interest in the domain name had there been evidence to justify that conclusion or that it could bring itself within any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy;

(h) It also appears from the evidence that not only is the Respondent pretending to sell jeans under the NOISY MAY trademark, but that it is unable to deliver the goods advertised on its website at all.

As the Respondent has not filed a Response or sought to show by any other means that it can rebut the prima facie case

against it, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

BAD FAITH

It is clear that to establish bad faith for the purposes of the Policy, Complainant must show that the Disputed Domain Name was registered in bad faith and has been used in bad faith. It is also clear that the criteria set out in paragraph 4 (b) of the Policy for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to those principles, the Panel finds that the Disputed Domain Name was registered and used in bad faith. That is so for the following reasons.

First, the Panel has examined the website to which the domain name resolves and finds that it carries a wholesale unauthorised use of the NOISY MAY trademark to sell jeans and other articles of clothing as well as carrying images the copyright of which is clearly owned by the Complainant. The website offers jeans for sale and also other articles, so the domain name has been used to induce potential customers to come to the website and to buy a wide range of goods. The website is also dressed to give the appearance that it is a legitimate site where goods may be safely bought. However, as the Complainant points out and the Panel agrees is probably the case, the site may not be selling anything at all as in at least one case the customer did not receive the goods bought. There can be no other explanation for this conduct other than the fact that the whole get-up of the site has been created to mislead the public and create confusion as to whether the goods offered for sale are genuine NOISY MAY items, when it is clear from the evidence they are not.

The evidence therefore brings the case squarely within paragraph 4 (b) (ii) of the Policy, as the Respondent must be taken to have registered the domain name "... primarily for the purpose of disrupting the business of a competitor...", namely the Complainant.

Moreover the case comes squarely within paragraph 4 (b) (iv) of the Policy as the evidence shows that

"...(iv) by using the domain name, ... (the Respondent has) intentionally attempted to attract, for commercial gain, Internet users to (its) web site..., by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of (the Respondent's) web site ...".

Finally, in addition and having regard to the totality of the evidence, the Panel finds that, in view of the Respondent’s registration of the Disputed Domain Name using the NOISY MAY mark and in view of the conduct that Respondent engaged in when using it, Respondent registered and used the Disputed Domain Name in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOISYMAYJEANS.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2017-11-01