Decision for dispute CAC-UDRP-101708

Case number	CAC-UDRP-101708
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Domain names	CHANTELLELINGERIE.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	CHANTELLE SA

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	Marvin Anhalt

OTHER LEGAL PROCEEDINGS

None that the Panel has been made aware of.

IDENTIFICATION OF RIGHTS

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

International Trade mark No. 160643 CHANTELLE in Classes 24 and 25, registered on 27 March 1952;

European Trade mark No. 001469261 CHANTELLE in Class 38, registered on 8 November 2001; and

United States Trade mark No. 87041110 CHANTELLE, registered on 11 October 2016.

FACTUAL BACKGROUND

The Complainant is a French company belonging to the Chantelle Group, established in 1876 and operating in the women's lingerie market. The official website of the Complainant may be found at www.chantelle.com.

The Respondent is an individual based in the United States.

The disputed domain name was registered on 8 February 2002. It currently resolves to a registrar holding page.

Pursuant to Paragraph 12 of the Rules for Uniform Domain Name Dispute Resolution Policy, the Panel issued a Procedural Order on 16 November 2017, noting that a simple online search had revealed that both parties had been involved in a previous UDRP decision in 2001, namely Chantelle v. Marvin Anhalt, WIPO Case No. D2001-1181, <chantellebra.com> and <chantellebras.com>. The Panel noted that this decision was denied on the basis that the Respondent had a connection with one of the Complainant's authorised distributors, and requested the parties to provide further information.

The Complainant filed an additional submission within the deadline set by the Panel, but the Respondent did not respond.

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. The Complainant submits that the disputed domain name is confusingly similar to its trade mark, incorporating the Complainant's trade mark in its entirety with the addition of the generic term "lingerie". The Complainant also contends that the use of the .COM generic Top Level Domain (gTLD) does not prevent the likelihood of confusion between the disputed domain name and the Complainant’s trade mark.

The Complainant argues that the use of the descriptive term "lingerie" in fact reinforces the confusion with the Complainant's trade mark, as it directly refers to the Complainant’s activity and therefore internet users will likely believe that the disputed domain name redirects to one of the Complainant's official websites.

No rights or legitimate interests

The Complainant underlines that a complainant is required to make out prima-facie case that a respondent lacks rights or legitimate interests and the burden of proof then shifts to the respondent to rebut the complainant’s prima-facie case.

The Complainant argues that the Respondent is not known by the Complainant and that the Complainant has not authorized the Respondent to make any use of its trade mark. The Complainant also states that it does not carry out any activity for, nor has any business with, the Respondent.

The Complainant submits that the fact that the Respondent did not respond to its cease and desist letter does not provide him with any rights or legitimate interests in the disputed domain name.

Furthermore, the Complainant contends that the disputed domain name has been pointing to a registrar holding page since it was registered 15 years ago and that there is no evidence that the Respondent has used, or has made any demonstrable preparations to use, the disputed domain name.

The Complainant further states that the Respondent has no rights or legitimate interests in the disputed domain name and has only registered the disputed domain name to create a likelihood of confusion with the Complainant's trade mark. The disputed domain name points to a holding page which cannot constitute a bona fide offering of goods or services.

Registered and used in bad faith

The Complainant contends that, given the distinctiveness and reputation of the Complainant's trade mark as well as the addition of the descriptive term "lingerie", there is no doubt that the Respondent registered the disputed domain name in full knowledge of the Complainant's trade mark.

The Complainant states that the disputed domain name has resolved to a registrar holding page since it was registered in 2002.

To the Complainant, the lack of response to its cease and desist letter is a further indication of bad faith registration and use.

The Complainant argues that the Respondent has registered and maintained the disputed domain name in order to prevent the Complainant from reflecting its trade mark in such a domain name, and thus from promoting and developing its e-shop.

Complainant's additional submission

In response to the Panel's Procedural Order, the Complainant pointed out that the two domain names covered by the previous UDRP decision were still pointing to a registrar holding page 16 years later, and underlined that previous panels had found passive holding to equate to a lack of legitimate interest.

The Complainant noted that the Respondent had previously been involved in the sale of women's lingerie, including the Complainant's products. In the Complainant's opinion this meant that there was no doubt that the Respondent knew about the Complainant's trade marks when he registered the disputed domain name, and previous panels had found this to be an indication of bad faith. In addition, the Complainant argued that the Respondent's activities did not give him the right to register domain names containing the Complainant's trade mark, and that this gave him an unfair advantage.

The Complainant also pointed out that the Respondent had had many opportunities to explain his registration but had not done so.

Respondent

The Respondent did not respond to the Complaint nor to the further arguments supplied by the Complainant in response to the Panel's Procedural Order.

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 were 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 UDRP 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, paragraph 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 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 CHANTELLE.

The Panel notes that the disputed domain name incorporates the Complainant's CHANTELLE trade mark in its entirety. Moreover, the addition of the descriptive term "lingerie" reinforces the likelihood of confusion because it relates to the Complainant's activity.

On the basis of these considerations, the Panel finds that the disputed domain name is confusingly similar 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 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 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, even when given a further opportunity to explain his actions by the Panel as a result of the Panel's Procedural Order.

Considering that the disputed domain name is resolving to a registrar holding page, the Panel finds that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. In this regard it is of note that the Respondent cannot rely on the so-called "Oki Data test" set out in Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903, <okidataparts.com>, given that the disputed domain name is only being used to point to a registrar holding page.

In light of this fact the Respondent cannot be said to be making a legitimate non-commercial or fair use of the domain name within the meaning of paragraph 4(c)(iii) either.

Finally, no evidence has been supplied that the Respondent is commonly known by the disputed domain name, as per paragraph 4(c)(ii).

Given the findings listed 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 on the balance of probabilities states 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 non-exhaustive circumstances that 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."

Whilst on the face of it none of the above criteria are immediately apparent, it is clear that this case may be distinguished from the earlier case in 2001 involving the same parties and similar domain names. Please see Chantelle v. Marvin Anhalt, WIPO Case No. D2001-1181, <chantellebra.com> and <chantellebras.com>. In that case the domain names at issue were registered in 2000 and the Respondent used legal counsel to submit a detailed defence based on its connection to one of the Complainant's authorised distributors. Given this the panel denied the case on the basis that the Complainant had not supplied enough evidence to prove that the Respondent had no rights or legitimate interests in the domain names at issue. The panel did not make a ruling on bad faith as this was not necessary, although it stated that the Respondent may have had some difficulty in this regard. The panel underlined that the Complainant may well be justified in submitting a fresh complaint in future if the circumstances changed, and in this regard the current Panel finds it significant that the domain

names dealt with by the previous decision are still pointing to a registrar holding page some 16 years later.

The disputed domain name was registered in 2002, after this decision, and points to a registrar holding page. The Respondent has not responded, either to the Complaint or to the Panel's Procedural Order, and has therefore submitted no evidence or arguments to justify its registration or use, in particular with regard to any continuing connection with one of the Complainant's authorised distributors. Given this the Panel finds that the disputed domain name is of a very different character to the domain names covered by the previous decision.

In view of the fact that the disputed domain name wholly incorporates the Complainant's very distinctive and well-known trade mark with the addition of a confusing generic term linked to the Complainant's activities, and that the Respondent has offered no explanation for this, the Panel finds that it was registered in bad faith. The Panel also finds that the disputed domain name is being used in bad faith, given that the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use, and it has long been established under the Policy that passive holding of a domain name does not prevent a finding of bad faith.

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. **CHANTELLELINGERIE.COM**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2017-12-15

Publish the Decision