Decision for dispute CAC-UDRP-101976

Case number	CAC-UDRP-101976
Time of filing	2018-05-21 13:41:58
Domain names	lafumaclothing.com

Case administrator

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

Complainant

Organization	MILLET MOUNTAIN GROUP

Complainant representative

Organization	Cabinet Germain & Maureau

Respondent

Name	Klaudia Brandt

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of the following trademarks:

- French national word trademark LAFUMA no. 1642621 registered since 1991;
- French national figurative trademark LAFUMA plus logotype no. 3581711 registered since 2008;
- European word trademark LAFUMA no. 6800734 registered since 2008;
- European figurative trademark LAFUMA plus logotype no. 7187339 registered since 2008.

(“Complainant’s Trademarks”).

The Disputed domain name was registered on 24 March 2017.

FACTUAL BACKGROUND

As the Respondent did not file any response to the complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) The Complainant, i.e. LAFUMA SA is a company founded in France in 1930 specializing in clothing and equipment for trekking, mountaineering and skiing activities;
(b) the Complainant is the owner of the Complainant's Trademarks;
(c) the Complainant is also the owner of domain names, including the same distinctive wording LAFUMA such as <lafuma.com> registered since 16 October 1998;
(d) The Disputed domain name points to an active website, where the Complainant's Trademarks are reproduced.

The Complainant seeks transfer of the Disputed domain name to the Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

THE COMPLAINANT:

In addition to the above factual assertions, the Complainant also contends the following:

(i) The Disputed domain name is confusingly similar to Complainant's Trademarks as addition of a generic term "clothing" to the Disputed domain name does not create a new or different right to the mark or diminish confusing similarity (as established, for example, in FORUM case n° FA0701000890812 Kohler Co. v. Thomas Curley);

(ii) Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's Trademarks, or apply for registration of the Disputed domain name; and

(iii) The website under the Disputed domain name displays the Complainant's Trademarks and the products of the Complainant are offered there for sale. There is no disclaimer or any information explaining that the Respondent is not affiliated with the Complainant. Given the distinctiveness of the Complainant's trademarks and the content of the website, it is clear that the Respondent has registered the domain name with full knowledge of the Complainant's Trademarks. The Respondent's intention in registering the Disputed domain name therefore must have been to benefit financially from the Complainant's LAFUMA trademarks by pretending to be an official reseller of the Complainant's products. This amounts to bad faith of the Respondent in registration and use of the Disputed domain name.

THE RESPONDENT:

The Respondent did not provide any response to the complaint.

RIGHTS

The Panel concluded that the Disputed domain name is confusingly similar to the Complainant's Trademark 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

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements to obtain an order that the Disputed domain name should be transferred or cancelled:

(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.

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

RIGHTS

The Disputed domain name is confusingly similar to Complainant's Trademarks. It includes the distinctive element "Lafuma" which is identical to Complainant's Trademarks. The Panel agrees with the Complainant that adding a generic term "clothing" to the Disputed domain name does not diminish confusing similarity of the Disputed domain name to Complainant's Trademarks.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (please see, for example, WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd. <croatiaairlines.com>).

Under the Disputed domain name there is an e-shop where Lafuma products are being offered for sale. There is no information on the website as to the identity of the Respondent or its relationship with the Complainant. In the opinion of the Panel, as both Complainant and Respondent appear to be domiciled in the EU, a general principle of EU law applies that reseller (even an unauthorized one) may generally use the trademark of the brand it sells to advertise genuine products of that brand provided that such use is customary for the industry in question and not damaging the reputation of the trademark (please see for example the ECJ case C-337/95 Christian Dior v. Evora). Having applied this principle to the field of domain names a conclusion can be made that a reseller selling genuine products of a brand could generally have legitimate interest to use the name of such brand also in a domain name. However, there are certain important obligations which such reseller has to meet. Such obligations were outlined in the WIPO Case No. D2001-0903 Oki Data Americas, Inc. v. ASD, Inc., <okidataparts.com> and are the following:

(i) the reseller must actually be offering the goods or services at issue;

(ii) the reseller must use the site to sell only the trademarked goods or services;

(iii) the site must accurately and prominently disclose the reseller's relationship with the trademark holder; and

(iv) the reseller must not try to "corner the market" in domain names that reflect the trademark.

It is clear that the Respondent in this case failed at least the obligation under point (iii) above as the website operated under the Disputed domain name does not include any information as to Respondent's relationship with the Complainant.

Therefore, the Panel concludes that the Respondent does not have rights or legitimate interest in the Disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Panels also finds that the Respondent must have registered the Disputed domain name in the full knowledge of Complainant's Trademarks, as the Respondent's website sells Complainant's products. Therefore, the Respondent also must have been aware of the fact that it is not authorized reseller of Lafuma products. However, the Respondent not only failed to disclose such fact to consumers, it even failed to provide any contact details whatsoever (which is a public law offense in itself in many EU jurisdictions). Therefore, the Respondent apparently intended to conceal the fact that it is not authorized reseller of Lafuma brand and mislead the consumers to believe that, as a result of displaying the Complainant's Trademarks at Respondent's website, the products sold at such website come from the Complainant or its authorized distributor. Such conduct would be regarded as unfair competition (or passing off) in many EU jurisdictions and in the opinion of the Panel, it is also evidencing bad faith of the Respondent upon registration and use of the Disputed domain name. In this respect, the Complainant correctly pointed out to the CAC Case No. 101284 SALOMON SAS v. Hui min <SALOMONTW.COM>, with which the Panel concurs.

As a result, the Panel found that the Disputed domain name has been registered and used by the Respondent in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LAFUMACLOTHING.COM**: Transferred

PANELLISTS

Name	**Michal Matějka**

DATE OF PANEL DECISION 2018-07-03

Publish the Decision