Decision for dispute CAC-UDRP-102122

Case number	CAC-UDRP-102122
Time of filing	2018-08-07 09:18:17
Domain names	sandro.online

Case administrator

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

Complainant

Organization	SANDRO ANDY

Complainant representative

Organization	Nameshield (Daria Baskova)

Respondent

Name	SAEED HASSAN

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on the following trademarks:

- SANDRO (word), International Trademark Registration No. 827287, registered on March 4, 2004;
- SANDRO (figurative) International Trademark Registration No. 1371455, registered in July 20, 2017.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

Created in 1984, the Complainant is a French company in the fashion industry. It is a part of the SMCP group. The Complainant's fashion articles for women sold since 1984 and for men - since 2007 in France and other countries around the world. The Complainant states that it has 593 points of sale in 37 countries.

The Complainant owns international trademark registrations for the wording “SANDRO”, such as the trademark No. 827287 and the trademark No. 1371455 and owns an important domain names portfolio, including the same word SANDRO such as the domain name <sandro-paris.com>, registered since September 25, 2003 and <sandro.fr> registered since September 16, 2002.

The disputed domain name was registered on July 18, 2018 and it resolves to the parking page with pay-per-click links.

The Complainant states that the disputed domain name is identical to its SANDRO trademark since it includes the Complainant's trademark in its entirety and without any adjunction of letter or word.

The Complainant contends that the addition of the suffix “.online” is not sufficient to escape the finding that the domain names is identical to the Complainant's trademark and does not change the overall impression of the designation as being connected to the trademark of the Complainant.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Respondent is not related in any way with the Complainant.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark, or apply for registration of the disputed domain name. According to the Complainant, the Respondent is not using the domain in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use. The Complainant states that the Respondent uses the disputed domain name for a parking page with third party pay- per-click links that divert traffic to third-party websites not related to Complainant. The Complainant also notes 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 non-commercial or fair use purposes.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

The Complainant claims that its SANDRO brand shows growth and worldwide recognition, driven by very dynamic trends internationally and a solid acceleration in digital based on the second quarter’s report for 2018. Over the last twelve months, SANDRO opened 33 directly operated stores including key locations like Stockholm (Sweden), Miami (United States), Zhengzhou (China) and Dubai (United Arab Emirates).

According to the Complainant, the choice of the new gTLD extension “.online” is even likely to increase the likelihood of confusion with the Complainant’s trademark, since it suggests that the disputed domain name leads to the official website or online marketplace for goods marketed by the Complainant.

The Complainant states that given the Complainant's trademarks and reputation, the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks and uses it for the purpose of misleading and diverting Internet traffic.

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

A. Identical or confusingly similar with Complainant's trademark

The Complainant owns trademark registrations that include the word "SANDRO".

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name entirely incorporates the Complainant's trademark without any additions or changes.

As stated in WIPO Overview 3.0: "In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing" (see par. 1.7).

In this case the disputed domain name is identical to the Complainant's word trademark.

The suffix ".online" shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied (see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110;

Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 and CAC Case No. 101284).

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and FORUM Case No. 0006000095095, Vertical Solutions Management, Inc. v. webnet-marketing, inc.).

The Respondent is not known under the disputed domain name, neither license nor authorization has been granted to the Respondent to use the Complainant's trademark in the disputed domain name and no evidence is available of any rights or legitimate interests of the Respondent in respect of the disputed domain name.

The Respondent uses the disputed domain name for a parking page with third party pay- per-click links.

It also appears that such links are provided by the registrar.

It is recognized that use of a domain name for parking can be consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is being used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark (see par. 2.9 of WIPO Overview 3.0).

While the Complainant's SANDRO mark may represent a name or a surname in certain countries, it is not a dictionary word as such and the evidence available in this case does not support any legitimate rights or interests of the Respondent.

Some of the links available on the site under the disputed domain name are not related to the Complainant, its business and products whereas some other links seem to be related to clothing and fashion – main business areas of the Complainant.

There is no indication that the Respondent may have any connection with a name or surname SANDRO.

Therefore, the Panel finds that the Complainant has shown a prima facie case that has not been rebutted by the Respondent and satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

The disputed domain name is used for a parking page with third party pay- per-click links and some of such links are not related to the Complainant, whereas the other links are related. It also appears that the links are provided by the registrar and it is unclear to what extent the Respondent controls the content of the page under the disputed domain name.

It is well accepted by the UDRP jurisprudence that with respect to "automatically" generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith (see par. 3.5 of WIPO Overview 3.0).

As was explained above, the use of a domain name to host a parked page comprising PPC links can be acceptable in certain cases and negate the bad faith element as illustrated by the UDRP case law, primarily in cases where a mark used in a domain name is a common word in a widely used language and respondent's use is consistent with the meaning of a domain name (see CAC Case No. 101988) or where a domain name is descriptive and there is no indication that when the respondent registered the domain name, it was aware or should have been aware of the trademark of the complainant or targeted the complainant (see e.g. CAC Case No. 100101 and Gold Medal Travel Group plc v. Damir Kruzicevic, WIPO Case No. D2007-1902).

However, the Panel finds that this is not the case here.

The disputed domain name is registered after the registration of the Complainant's word trademark and by the time of the registration of the disputed domain name the Complainant's SANDRO business was already well developed and recognized globally as demonstrated by the evidence submitted by the Complainant.

As one of the previous panel's noted the Complainant's SANDRO mark has a notoriety (CAC Case No. 101638). From all the circumstances and evidence of this case, it appears that the Respondent's conduct falls within paragraph 4(b)(iv) of the Policy since 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 trademark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website.

As was noted by previous Panels, a respondent's use of a domain name to host links to products and/or services that are in direct competition with a complainant's business or a respondent's use of a domain name to direct Internet users to websites unrelated to a complainant use may represent evidence of bad faith (see FORUM Case No.0602000637920, The University of Houston System v. Salvia Corporation and FORUM Case No.1608001691369, TGI Friday's of Minnesota, Inc. v. Tulip Company / Tulip Trading Company).

In the absence of any explanations from the Respondent, the Panel finds that the Respondent registered the disputed domain name having the Complainant and its reputation in mind.

The Panel also notes that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". Under this standard, a party should demonstrate to a panel's satisfaction that it is more likely than not that a claimed fact is true. In particular, panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case e.g., where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent (see par. 4.2 of WIPO Overview 3.0).

The Panel finds, in the absence of any available evidence and response from the Respondent, that the balance of probabilities in this case is in the Complainant's favor.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SANDRO.ONLINE**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2018-09-11

Publish the Decision