Decision for dispute CAC-UDRP-102168

Case number	CAC-UDRP-102168
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Domain names	rochasshop.com

Case administrator

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

Complainant

Organization	INTERPARFUMS

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Congj Buxar

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies on its two international marks, numbers 451949 and 697119 of 1980 and 1998 for the word marks Rochas Paris and Rochas in classes 3,9,14, 18, 21,24, 25, 34 and 14,18 and 25 respectively. Together these are registered in over 50 countries. It also relies on its EU Trade Mark (or CTM) for a figurative mark with the word element, Rochas, in class 3 of 2013, no. 2863249. It relies on these registered regional and international rights and also has various national marks and rights arising from use. Its main website is at www.Rochas.com.

FACTUAL BACKGROUND

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

The Complainant is the owner of the trademark “Rochas”, a fashion, beauty, and perfume house founded in 1925 by French designer Marcel Rochas. The Complainant is the owner of several registered international and community trademarks including the distinctive wording ROCHAS. The Complainant also owns several domain names, including the same distinctive wording ROCHAS such as <rochas.com>.

The disputed domain name was registered on 3 August 2017. The disputed domain name points to a website giving the

overall impression of being relating to the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The disputed domain name is confusingly similar to the protected mark combined with generic term.

The Complainant contends that the disputed domain name is confusingly similar to its well-known and distinctive trademark ROCHAS. The Complainant contends the addition of the word “SHOP”, and the gTLD “.COM” are not sufficient elements to escape the finding that the disputed domain name is confusingly similar to the Complainant’s trademarks and do not change the overall impression of the designation as being connected to the trademark ROCHAS. See WIPO Case No. D2017-2187 LEGO Juris A/S v. Torsten Kruger (“The addition of the descriptive term "shop" does nothing to dispel the confusing similarity between the disputed domain name and the Complainant's LEGO trademark”). Further, the website in connection with the disputed domain name makes clear reference to the Complainant. Thus, it does not avoid the likelihood of confusion between the disputed domain name and the Complainant, its trademark ROCHAS and its domain names associated.

The Respondent does not have any rights or legitimate interests in the disputed domain name. According to the WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., 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, a 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.

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 trademark ROCHAS, or apply for registration of the disputed domain name by the Complainant. The website used in relation to the disputed domain name displays content that is about the Complainant. Indeed, the website pretends to be the Complainant in order to sell products branded ROCHAS. The Complainant argues that Respondent uses the disputed domain name to pass off as Complainant in order to sell counterfeit products. See Watts Water Technologies Inc. v. wo ci fa men zhi zao (kun shan) you xian gong si, FA 1740269 (“Respondent has used the domain name to resolve to a website that mimics the color scheme associated with Complainant’s WATTS brand and displays counterfeit versions of Complainant’s products for purchase in an attempt to pass itself off as Complainant… [therefore], the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.”). Thus, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, and has registered and used it only in order to create a likelihood of confusion with the Complainant’s trademarks.

The disputed domain name has been registered and is being used in bad faith.

The disputed domain name is confusingly similar with the Complainant's well-known trademarks ROCHAS. The combination of the term "ROCHAS" with the word "SHOP" further indicates that the Respondent was conscious of the reputation of the Complainant's mark and the kind of business it is engaged in. The term “SHOP” reinforces the false impression that there is some sort of legitimate connection with the Complainant. See WIPO Case No. D2017-2187 LEGO Juris A/S v. Torsten Kruger (“The term "shop" tends to reinforce the false impression that there is some sort of legitimate connection with the Complainant, as its goods are commonly sold through retail shops.”). Thus, given the distinctiveness of the Complainant's trademarks and reputation, the Complainant contends that it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of Complainant's rights in the trademark. Past Panels have held that a registration is constitutive of bad faith. Please see for instance, registration of other domain names which include third party trademarks, may be evidence of bad faith under paragraph 4(b)(ii) of the Policy. See Philip Morris Inc. v. r9.net, D2003-0004 (WIPO Feb. 28, 2003) (finding that the Respondent’s previous registration of domain names such as <pillsbury.net>, <schlitz.net>, <biltmore.net> and <honeywell.net> and subsequent registration of the <marlboro.com> domain name

evidenced bad faith registration and use pursuant to paragraph 4(b)(ii) of the Policy). In addition, the Complainant asserts that the Respondent is intentionally attempting to attract for commercial gain — Internet users to Respondent's website by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of Respondent's website. Using a confusingly similar domain name to mislead users for the purpose of offering counterfeit products can evince bad faith registration and use per paragraph 4(b)(iv) of the Policy. See Affliction, Inc. v. Chinasupply, FA 1223521 (Forum Oct. 23, 2008) (finding that the respondent attempts to commercially gain and thus demonstrating bad faith per paragraph 4(b)(iv) of the Policy by creating confusion as to the complainant's connection with the website by selling counterfeit products). On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith. Thus, the Complainant contends that the Respondent has registered the disputed domain name and is using it in bad faith. See WIPO Case No. D2017-2187 LEGO Juris A/S v. Torsten Kruger (above) and Affliction, Inc. v. Chinasupply, FA 1223521 (Forum Oct. 23, 2008) (finding that the respondent attempts to commercially gain and thus demonstrating bad faith per paragraph 4(b)(iv) of the Policy by creating confusion as to the complainant's connection with the website by selling counterfeit products).

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

Panel Request for Additional Information

on 15 October 2018, the Panel communicated this request to the parties.

"This is a request from the Panel for additional information from the parties under rule 12 of the UDRP rules. The Complaint alleges that the goods offered at the website to which the disputed domain name resolves, are counterfeit goods and not genuine goods. This is a request for evidence to support that allegation. The Respondent is also invited to submit evidence on this issue. Both parties are also asked to make submissions on the applicability to this case of the OKI Data principles from WIPO Case No. D2001-0903. The further information requested is to be provided by noon on Friday, 19 October 2018, GMT. "

The Complainant responded as follows:

In accordance to the applicability to this case of the OKI Data principles from WIPO Case No. D2001-0903, the Complainant contends that the "The site must accurately disclose the registrant's relationship with the trademark owner".

Regarding the allegation of counterfeit goods and not genuine goods, the Respondent uses the trademarks, names, products and images of Complainant's products without authorization.

The Complainant offers its products through authorized sales or service agent of trademarked goods. The Respondent is not listed. On those facts, any products sold by another seller (non-listed by the Complainant) are considered as unauthorized and therefore not genuine goods. Moreover, the Respondent has not provided any response to prove his good faith and the Complainant contends that the Respondent has engaged in a pattern of such conduct in other decisions:

WIPO case n° D2018-1672 Dansko, LLC v. Congj Buxar <danskoshop.com> "Complainant has received several consumer correspondences about DANSKOSHOP.COM whereby consumers have asked if the DANSKOSHOP.COM website is indeed affiliated with Complainant, and complaining that they never received the footwear they purchased from the DANSKOSHOP.COM website" Respondent has used the DANSKOSHOP.COM domain name to create a website that seeks to misdirect potential consumers from Complainant's legitimate website"; and "[t]he website associated with the DANSKOSHOP.COM domain looks virtually identical to Complainant's website, including the use of Complainant's DANSKO® marks, the names and images of Complainant's products, as well as the overall 'look and feel' of Complainant's copyright protected website." Complainant does not specify which, if any, of the enumerated factors is applicable here. However, Complainant's allegations that Respondent created a website that falsely appears to be a website for or

associated with Complainant, where Respondent fails to deliver promised merchandise, appears to be consistent with paragraph 4(b)(iv) of the Policy. Indeed, numerous previous UDRP panels have found bad faith under such circumstances. See, e.g., Medac Gesellschaft für klinische Spezialpräparate mbH v. Cancero Pharma, Cancer Foundation & CanceroPharma, WIPO Case No. D2016-1129 (finding bad faith where complainant alleged that respondent “is using the disputed domain name to sell products from the Complainant and its competitors, and a test purchase showed that the Respondent, after having received payment, failed to deliver the order”).

WIPO case n° D2018-1007 Seafolly IP Co. Pty Ltd Seafolly Pty Limited of Seafolly v. Congj Buxar <seafollyoutlet.com>

The disputed domain name resolves to a website which purpose is selling swimwear and related accessories by reference to the SEAFOLLY trademark, without the consent of Complainants. Then the disputed domain name is only used to divert Internet users to another site selling swimwear and related accessories under or by reference to the SEAFOLLY trademark, and other competing products. On the basis of the above, the Panel finds that Respondent registered the disputed domain name to attract Internet users, for commercial gain, by creating a likelihood of confusion with Complainants' trademarks and domain names (Paragraph 4(b)(iv) of the Policy). WIPO case n° D2017-2558, Na’ale Naot Agricultural Cooperative Society for Business Ltd. Yaleet, Inc. v. Congj Buxar <naotoutlet.com> "Respondent's website linked to the Disputed Domain Name offers the sale of Complainants' footwear under NAOT trademarks. Respondent's website lifted copyrighted images of Complainants' NAOT products, increasing the likelihood that Internet users would be confused into believing Respondent's website emanated from or was sponsored or authorized by Complainants. Complainants received complaints from Internet users who had attempted to purchase Complainants' NAOT footwear and had not received their orders, indicating that the users had indeed been attracted to Respondent's website by the confusion Respondent created with Complainants' mark, and that Respondent was not acting as a legitimate reseller of Complainants' footwear."

FORUM case n° 1761720 Zimmermann Wear Pty Ltd v. Congj Buxar <zimmermannoutlet.com>

“Complainant asserts, without objection from Respondent, that Respondent uses the <zimmermannoutlet.com> domain name to deceive Internet users who inadvertently land on the website resolving from the domain name into believing that the competing products displayed there are associated with Complainant, and that Respondent seeks to profit commercially from the operation of that resolving website […] Respondent’s registration and use of the disputed <zimmermannoutlet.com> domain name, which we have found to be confusingly similar to Complainant’s ZIMMERMANN trademark and service mark, is an attempt by Respondent to profit from the confusion thus caused among Internet users as to the possibility of Complainant’s affiliation with the domain name. Under Policy ¶ 4(b)(iv), this further demonstrates Respondent’s bad faith in registering and using the domain name. See Xylem Inc. and Xylem IP Holdings LLC v. YinSi BaoHu YiKaiQi, FA1504001612750 (Forum May 13, 2015): The Panel agrees that Respondent’s use of the website to display products similar to Complainant’s imputes intent to attract Internet users for commercial gain, and finds bad faith per Policy ¶ 4(b)(iv).”

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 not, 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 not, 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

The UDRP policy (The Policy) provides at paragraph 4 as follows:

“4. Mandatory Administrative Proceeding...

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

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

In the administrative proceeding, the complainant must prove that each of these three elements are present(emphasis added).”...

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint..... 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 trademark or service mark rights; or

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

There is no question that the Complainant has Rights in a mark similar to the disputed domain name, both from its registered marks and arising from its substantial use in trade. It is a well known mark. The Panel also accepts that the addition of the generic word ‘shop’ does not sufficiently distinguish the disputed domain name from the mark to avoid similarity. That word is however relevant to the other limbs of the Complainant's burden below.

The key issue on the very face of this case is whether the Respondent is making a bona fide offering of goods or services as a reseller and has a legitimate right or interest in doing so under the second limb of the Complainant’s burden under the Policy.

No trade mark owner has the right to monopolise the resale of second hand or previously lawfully sold goods. This is the limit to and/or exhaustion of the rights of a trade mark owner. This balances the rights of owners against those of retailers, second hand dealers and consumers and distributors. The rule also protects descriptive uses necessary to indicate the kind, quality or purpose of goods, provided the use is exercised in accordance with honest practices — which encompasses a duty to act fairly in relation to the legitimate interests of the trade mark owner. In UDRP jurisprudence this is reflected in the OKI DATA principles from WIPO Case No.D2001-0903 which provide that a reseller/distributor can make a bona fide offering of goods and services under rule 4(c) (i) of the Policy and have a legitimate interest in a domain name, provided that:

(a) The use involves the actual offering of goods and services in issue;

(b) The site sells only the trade - marked goods;
(c) The site accurately and prominently discloses the registrant's relationship with the trade mark holder;
(d) The Respondent must not try to "corner the market" in domain names that reflect the trademark.

The Policy is very clear that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. We note there is no procedure for a default judgment under the UDRP. Only once a prima facie case is made out will the evidential burden shift to a respondent.

In this case, the Complainant failed to address this overt issue in the Complaint in the view of the Panel. The Panel therefore asked the Complainant for additional information on 15 October 2018. We asked it to address the OKI DATA principles and to provide evidence for the (bare) assertion that counterfeits are sold at the site at the disputed domain name. The reply was not responsive and no evidence was provided. Its answer said in relevant part "[t]he Complainant offers its products through authorized sales or service agent of trademarked goods. The Respondent is not listed. On those facts, any products sold by another seller (non-listed by the Complainant) are considered as unauthorized and therefore not genuine goods." However, it is well established in UDRP jurisprudence, that the OKI DATA rule applies to unauthorized or unofficial resellers and repairers just as it does to official agents, per WIPO Case D2001- 1292 (Volvo Trademark Holdings AB) (OKI DATA principles apply as long as he operates a business genuinely revolving around the owners' goods and services) and WIPO Case D2007 -1524 (nascartours) (OKI DATA applies to authorized and unauthorized sellers). See also Bettinger, 2nd Ed. P1387 IIIE.310. The Complainant also cited a decision in WIPO case n° D2018-1672 Dansko, LLC v. Congj Buxar <danskoshop.com> however that decision failed to consider the OKI DATA principles as the panel considered the issue did not arise given the default of the respondent in that case.

We now turn to the OKI DATA factors and apply them as best we can in light of the paucity of evidence.

(1) The site at the disputed domain name appears on the face of it, to this Panel, to be selling genuine goods. It is possible, and even likely, that these goods may have been sold or placed on the market internationally by the Complainant, whose rights may or may not be exhausted, dependant on the law in the relevant location. The Complainant also makes the bare assertion that goods ordered by consumers from the site fail to ever arrive. It submitted no evidence in support of this allegation and asked the Panel to infer this from the facts of the Dansko case due to the apparent identity of the Respondent. We decline to draw such an inference. As noted, that case failed to consider the issue of genuine resales or the status of the goods and is in our view conclusory. Similarly in relation to Seafolly Pty Limited of Seafolly and Seafolly IP Co. Pty Ltd v. Congj Buxar Case No. D2018-1007 (which concerned sales at seafollyoutlet.com). Again, a reading of this case shows that it is effectively a default judgment and does not consider resales. Similarly, in relation to FORUM case n° 1761720 Zimmermann Wear Pty Ltd v. Congj Buxar ("In view of Respondent's failure to submit a response, the Panel will, pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules, decide this proceeding on the basis of Complainant's undisputed representations, and, pursuant to paragraph 14(b) of the Rules, draw such inferences as it deems appropriate. The Panel is entitled to accept all reasonable allegations and inferences set out in the Complaint as true unless the evidence is clearly contradictory " and on the second limb: "Complainant has made out a sufficient prima facie showing under this head of the Policy. Respondent's failure to respond to the Complaint therefore permits us to infer that Respondent does not have rights to or legitimate interests in the disputed domain name..." With all due respect to those decisions, they are default decisions and although this is an administrative proceeding, some basic evidential standard must be upheld. In summary, here the site appears to the Panel to sell genuine merchandise but there is no actual evidence either way. The burden is the Complainant's. It failed to discharge this burden even when expressly asked to do so. The evidence will not be inferred in its favour, rather any doubt will be resolved in favour of the Respondent.

(2) It appears to the Panel that only Rochas merchandise is sold at the site at the disputed domain name – that is, the site sells only the trade marked goods but again, there is no actual evidence either way and the burden is the Complainant's. It has failed to discharge this burden. The evidence will not be inferred in its favour, rather any doubt will be resolved in favour of the Respondent.

(3) As to disclaimers and representations, the Panel notes the disputed domain name includes the word 'shop.' The main page on the site says Rochas Paris. It does not say that it is Rochas or that it is not. The use of the generic word 'shop'

arguably operates as a kind of disclaimer. It means retailer. Branded goods are sold by many retailers other than wholly owned or authorised ones. We note that the Complainant's own website, rochas.com, appears labelled in browser results as "site officiel." We do not find any overt representation that is inaccurate on the site. The evidence from the site itself appears equivocal.

(4) Arguably 'shop' avoids impersonation and does not block or corner the Complainant.

(5) Other: The evidence does not appear to show any use of the logo mark as opposed to the word. The use of the word Rochas to sell Rochas clothing would be necessary and would be fair or nominative/descriptive use. The copyright issue is not relevant to this inquiry and we are in no position to take a view on it and it was a bare allegation without supporting evidence in any event.

In summary, there is no evidence whatsoever that the site is not a genuine reseller or that it is engaging in anything other than legitimate resales. The view of the Panel is that the OKI DATA principles appear broadly met and the Respondent appears to have a legitimate interest in the use of the disputed domain name. The Complainant failed to meet its burden of proof to show the contrary even to a prima facie standard. The second limb of the Complainant's burden has not been adequately proven. Its failure on third limb follows accordingly.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **ROCHASSHOP.COM**: Remaining with the Respondent

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2018-10-18

Publish the Decision