Decision for dispute CAC-UDRP-102315

Case number	CAC-UDRP-102315
Time of filing	2019-01-23 11:20:16
Domain names	sandroparis.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	SANDRO ANDY

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Kanzaki Yasuo

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 Registration No. 827287 issued on 4 March 2004
SANDRO in International Classes 3, 9, 14, 16, 18, 21, 24, 25, 26, 27 and 24

European Registration No. 008772568 issued on 27 July 2010
SANDRO in International Classes 14, 18 and 25

FACTUAL BACKGROUND

The Complainant is a French company established in 1984 operating in the fashion industry. The Complainant is recognized throughout the world with more than 593 points of sale and has continuously used the domain name <sandro-paris.com> since 2003.

Nothing is known about the Respondent, apart from the fact that he is based in Japan.

The disputed domain name was registered on 8 January 2012. At the time that the Complaint was filed, it was being used to point to a registrar parking page, stating that it was being offered at auction for a minimum price of $1,000. The disputed domain name is now pointing to an “Under Construction!” page.

PARTIES CONTENTIONS

Parties' Contentions

Complainant

Identical or confusingly similar

The Complainant evidences its two trade mark registrations as follows:

International Registration No. 827287 issued on 4 March 2004
SANDRO in International Classes 3, 9, 14, 16, 18, 21, 24, 25, 26, 27 and 24

European Registration No. 008772568 issued on 27 July 2010
SANDRO in International Classes 14, 18 and 25

The Complainant argues that the disputed domain name is confusingly similar to its registered SANDRO trade mark since the addition of the geographical term “paris” is not sufficient to distinguish a domain name from a trade mark, but only serves to reinforce the confusion since the Complainant is present and active in France.

It also contends that the addition of the generic Top Level Domain (gTLD) .COM does not prevent the likelihood of confusion between the disputed domain name and the Complainant’s trade marks.

No rights or legitimate interests

The Complainant underlines that, once it makes a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, the burden shifts to the Respondent to show that he does have rights or legitimate interests.

The Complainant underlines that previous panels have held that a respondent is not commonly known by a domain name if the WHOIS information is not similar to such name. The Complainant therefore contends that the Respondent is not known by the disputed domain name.

The Complainant contends that the Respondent is not licensed or authorized to use the Complainant’s SANDRO trade mark in a domain name, nor is he related in any way to the Complainant.

Furthermore, the Complainant contends that the disputed domain name is pointing to a registrar parking page, which cannot constitute any bona fide demonstrable preparations to use the disputed domain name.

The fact that the disputed domain name is offered at auction for a minimum bid of $1,000 also indicates the Respondent’s lack of rights or legitimate interests in the disputed domain name.

Registered and used in bad faith

The Complainant contends that the Respondent deliberately chose to associate the term SANDRO with the geographical term “paris” as the Complainant is established in Paris and its official website is <sandro-paris.com>.

Given the distinctiveness and reputation of the Complainant’s SANDRO trade mark, the Complainant submits that it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant’s trade mark.

Furthermore, the Complainant contends that the general offer to sell the disputed domain name for more than his out-of-pocket costs evidences the Respondent's registration and use of the disputed domain name in bad faith.

On this basis, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

Respondent

The Respondent did not respond to the Complaint.

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 UDRP 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 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, Rule 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(s) 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 SANDRO.

The Panel notes that the disputed domain name incorporates the Complainant's SANDRO trade mark in its entirety. Moreover, the addition of the geographical term “paris” merely serves to enhance the likelihood of confusion with the Complainant’s trade mark, since the Complainant is a French company based in Paris.

The .COM gTLD is generally disregarded as it is simply a functional element.

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(s) 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.

Based on the evidence submitted by the Complainant, at the time that the Complaint was filed, the disputed domain name was pointing to a registrar parking page where it was offered for sale. The Panel is of the view that such use cannot constitute a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy.

The Respondent is neither authorised nor licensed by the Complainant to use its SANDRO trade mark. Furthermore, no evidence has been supplied that the Respondent is commonly known by the disputed domain name, as referred to in paragraph 4(c)(ii).

Nor can the use described above be said to be legitimate non-commercial or fair use of the domain name within the meaning of paragraph 4(c)(iii).

Given the 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 is 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 circumstances which 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." Given that the Complainant's trade marks significantly pre-date the registration of the disputed domain name and that the term SANDRO appears to be exclusively associated with the Complainant worldwide, the Panel finds that the Respondent registered the disputed domain name with full knowledge of the Complainant's trade marks, which clearly indicates bad faith under the Policy, especially given that the Complainant is based in France.

It seems clear from the WHOIS at the time that the Complaint was filed that the disputed domain name had not been renewed and that the subsequent auction was organised automatically by GoDaddy, as per its usual practice as far as expiring domain names are concerned. However, the fact that the disputed domain name appears to be passively held by the Respondent shall not prevent a finding of bad faith, notably taking into account the Complainant's notoriety and the Respondent's failure to submit a Response. The Complainant's trade mark is very distinctive, especially when combined with the term "paris" and bearing in mind that the Complainant's main website is located at 'www.sandro-paris.com'. The Panel therefore finds that there could be no plausible legitimate use of the disputed domain name (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

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. **SANDROPARIS.COM**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2019-03-01