Decision for dispute CAC-UDRP-102311

Case number	CAC-UDRP-102311
Time of filing	2019-01-21 09:51:18
Domain names	SANDROONLINESHOP.COM

Case administrator

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

Complainant

Organization	SANDRO ANDY

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Lucy Barton

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademark registrations for SANDRO, including the following:

- International trademark registration Nos. 827287 for SANDRO (word mark), registered on March 4, 2004 in classes 03, 09, 14, 16, 18, 21, 24, 25, 26, 27 and 34; 1371455 for SANDRO (figurative mark) registered on July 20, 2017 in classes 03, 09, 14, 18 and 25;

- European Union trademark registration No. 8772568 for SANDRO (word mark), registered on July 27, 2010 in classes 14, 18 and 25;

- French trademark No. 3244120 for SANDRO (word mark), registered on September 4, 2003 in classes 03, 09, 14, 16, 18, 21, 24, 25, 26, 27 and 34.

The Complainant is also the owner of several domain names including the trademark SANDRO, such as <sandro-paris.com>, registered on September 25, 2003, and <sandro.fr>, registered on September 16, 2002.

FACTUAL BACKGROUND

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The Complainant is a French company operating in the fashion industry, which was created in 1984 and is part of the SMCP group.

The first SANDRO retail store was opened in Paris in 2004 and, today, the Complainant has 593 points of sale in 37 countries. The Complainant's digital sales reached 10% of the income of the SMCP group by 2016.

The disputed domain name <SANDROONLINESHOP.COM> was registered on February 16, 2018 and is pointed to a website offering for sale purported SANDRO products along with competitors' ones.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT

The Complainant states that the disputed domain name is confusingly similar to its trademark, as it includes the trademark SANDRO in its entirety with the addition of other generic or descriptive terms and of the gTLD suffix ".COM", which does not prevent a finding of confusing similarity under the first element.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name because:

i) the Respondent is not affiliated with nor authorized by the Complainant in any way and does not carry out any activity for, nor has any business with the Respondent;

ii) the Complainant has not granted any license or authorization the Respondent to make any use of the Complainant's trademark SANDRO, or apply for registration of the disputed domain name;

iii) the Respondent does not meet the conditions set forth in the decision Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903 for an entity's offer to be regarded as a bona fide offering of goods or services within the meaning of paragraph 4(c) of the Policy, as the Respondent has built a website at the disputed domain name which is very similar to the Complainant's one, displaying the SANDRO trademark and selling products identical to the ones of the Complainant in order to mislead consumers. Therefore, the Complainant claims that, by using the disputed domain name, the Respondent intended to create a likelihood a confusion in the Internet users' mind. The Complainant further notes that the website also sells products from Complainant's competitors.

The Complainant states that the Respondent registered and is using the disputed domain name in bad faith since the Respondent registered the disputed domain name with knowledge of the Complainant's rights, as the disputed domain name is confusingly similar to the Complainant's prior registered and well-known trademark SANDRO and the corresponding website clearly makes reference to the Complainant's trademark.

The Complainant also asserts that the Respondent, by registering and using the disputed domain name incorporating the Complainants' well-known trademark SANDRO along with generic terms related to the Complainants business activity, tried to mislead Internet users and consumers, for commercial gain, into thinking that the website at the disputed domain name is, in some way or another, connected to, sponsored by or affiliated with the Complainant and its business.

RESPONDENT

The Respondent did not reply to the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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 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

1. The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark SANDRO, as it includes the Complainant's trademark in its entirety, with the mere addition of the generic terms "online" and "shop" and the Top-Level domain ".com" which, as stated in a number of prior decisions rendered under the UDRP, are not sufficient to exclude confusing similarity.

2. The Complainant stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent might have been commonly known by the disputed domain name or by a name corresponding to the disputed domain name. According to the evidence on records, the Respondent has pointed the disputed domain name to a website featuring the Complainant's trademark SANDRO and offering for sale purported SANDRO products along with competitors' goods, without providing any accurate disclaimer as to the lack of affiliation with the Complainant and generating the impression that the website is operated by, or affiliated with, the Complainant. Therefore, the Panel finds that the Respondent's use does not meet the conditions set forth in the decision Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903 (the so-called "Oki data test") for a reseller to succeed in claiming to be making a bona fide offering of goods or services under a disputed domain name. Moreover, the use of the disputed domain name described above clearly does not amount to a legitimate non-commercial or fair use. Therefore, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name and that, by not submitting a Response, the Respondent has failed to rebut the Complainant's prima facie case.

3. As to the bad faith at the time of the registration, the Panel finds that, in light of the prior registration and use of the trademark SANDRO in connection with the Complainant's fashion products, the well-known character of the trademark in its sector and the express reference to the Complainant's trademark and products on the website published at the disputed domain name, the Respondent was very likely aware of the Complainant's trademark at the time of the registration of the disputed domain name.

In view of the current use of the disputed domain name to redirect users to a website featuring the Complainant's trademark and offering for sale purported SANDRO fashion products along with competitors' ones, the Panel finds that the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the Complainant's trademark SANDRO as to the source, sponsorship, affiliation or endorsement of its website and the products offered therein, according to paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SANDROONLINESHOP.COM**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2019-03-04

Publish the Decision