Decision for dispute CAC-UDRP-102395

Case number	**CAC-UDRP-102395**
Time of filing	**2019-03-15 09:48:20**
Domain names	**myloccitane.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Laboratoires M&L**

Complainant representative

Organization	**Brandstock Domains GmbH**

Respondent

Name	**Lucas Verdonk**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any 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 trademarks. In particular, Laboratoires M&L owns:

(i) the International Registration No. 1330027 "L'Occitane" registered on June 28, 2016 for classes 4, 16, 18, 25, 43 and 44.

(ii) the International Registration No. 579875 "L'OCCITANE" registered on November 5, 1991 for classes 3, 4, 5, 16 and 21 and duly renewed.

(iii) the International Registration No. 1006051 "L'Occitane" registered on October 8, 2008 for classes 9, 14, 18, 24, 25, 28, 30, 35, 43 and 44 and duly renewed.

The above trademarks are protected in many countries of the world.

FACTUAL BACKGROUND

The Complainant, Laboratoires M&L, is part of the L'Occitane Group. L'Occitane Group is a global, natural and organic

ingredient-based cosmetics and well-being products manufacturer and retailer. The Group has five brands (L'OCCITANE EN PROVENCE, MELVITA, ERBORIAN, L'OCCITANE AU BRÉSIL and LIMELIFE BY ALCONE) in its portfolio and is committed to developing and retailing high quality products that are rich in natural and organic ingredients of traceable origins and respect the environment.

The Complainant contends that in 2015, L'Occitane Group counted 2,797 retail locations on all continents throughout the world, with 1,384 owned retail stores and that L'Occitane Group employs more than 8,000 people around the world and generated a revenue of more than 1 billion US dollars in 2015. The Complainant also informs that in 2015, net sales of L'Occitane Group were €1,177.9 million.

The Complainant has affirmed and proved to be the owner of numerous trademarks consisting of "L'OCCITANE" in various jurisdictions all over the world.

The disputed domain name is <myloccitane.com>.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's "L'OCCITANE" mark since the disputed domain name wholly incorporates the mark, simply adding to it the generic term "my" and the generic Top-Level Domain ("gTLD") suffix ".com".

The Complainant believes that the Respondent has no rights or legitimate interests in respect of the domain name since, to the best of the Complainant's knowledge, the Respondent is not commercially linked to the Complainant. Furthermore, the Complainant informs that it never granted the Respondent any authorization, consent, right or license to use the trademark "L'OCCITANE" within the disputed domain name or in any other way. Additionally, the Complainant has made research and found no trademarks or any other rights owned by the Respondent on the MYLOCCITANE term.

The Complainant also contends that the domain name was registered and is being used in bad faith. In particular, the Complainant states that "L'OCCITANE" trademark has enjoyed wide-spread extensive use and is widely well-known and that accordingly it seems inconceivable that the Respondent was not aware of the Complainant's prior rights when the domain name in dispute was registered. This especially in consideration of the fact that the Respondent is located in France, where L'Occitane Group originates. It is therefore clear, in the Complainant's view, that the Respondent had the Complainant or its trademarks in mind when registering the disputed domain name.

Actually, the Complainant sees no possible way whatsoever that the Respondent would use the domain name in connection with a bona fide offer of products or services. Indeed, any use of the "L'OCCITANE" trademark without authorization would amount to trademark infringement and damage to the repute of the trademark. In the Complainant's view, the sole detention of the disputed domain name by the Respondent, in an attempt to prevent the Complainant from reflecting its trademark in a domain name, is a strong evidence of bad faith. Actually, according to the Complainant, any actual use of the domain name by the Respondent would amount to bad faith active use.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

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

(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.

1) The Complainant has established to be the owner of the trademark "L'OCCITANE" at least since November 1991. The Complainant's trademark is registered well before the registration of the disputed domain name (January 23, 2019). The Panel notes that the consensus view in previous UDRP panel decisions is that in determining confusing similarity under paragraph 4(a) of the Policy, the generic Top-Level Domain (“gTLD”) suffix (“.com” in this particular instance) should be totally disregarded. Therefore the comparison has to be made between the signs "L'OCCITANE" on the one side and "MYLOCCITANE" on the other side. The disputed domain name incorporates the Complainant's trademark "LOCCITANE", with the omission of the apostrophe, coupled with the possessive pronoun, used as a prefix, MY. Firstly, the Panel notes that many previous panels under the Policy have found that the omission of the apostrophe, a character not permitted in domain names, is obviously irrelevant for analysis of whether the disputed domain name is confusingly similar to Complainant's mark (please see for instance Trader Joe's Company v. Trader Joe's / John Murray of Trader Joes Inc., d/b/a Trader Joes Furniture, WIPO Case No. D2016-0591 and L'OREAL v. Lewis Cheng, WIPO Case No. D2008-0437). Furthermore, this Panel believes that the addition of the generic term "my" does not distinguish the <myloccitane.com> domain name from Complainant’s "L'OCCITANE" mark (please see Vanguard Trademark Holding USA LLC v. Privacy Protection Service INC - CAC Case No. 100946). Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. Furthermore the Complainant has made research and found no trademarks or any other rights owned by the Respondent on the MYLOCCITANE term. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) The Complainant’s trademarks “L'OCCITANE” is distinctive and well known in the most of the countries. It is uncontroverted that Complainant’s worldwide use and registration of the "L'OCCITANE" mark largely precede the registration dates of the disputed domain name. The fact that the Respondent has registered a domain name that is almost identical and at least confusingly similar to it clearly indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. This is a clear evidence of registration of the domain name in bad faith. The Complainant has demonstrated that the domain name in dispute is merely directed to an error page and therefore it is clear that the disputed domain name is not used for any bona fide offerings since it is not connected to any web site. Countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The consensus view of UDRP panellists is that

passive holding of a disputed domain name may, in appropriate circumstances, be consistent with a finding of bad faith. In particular, previous panels have tended to make such findings in circumstances in which, for example, a Complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the Complainant's trade mark rights. As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademark. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which almost exactly corresponds to the Complainant's trademark currently extensively used by the latter to distribute its products. In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith. In this respect it is important to consider the decision in case Comerica Inc. v. Horoshiy, Inc. WIPO Case No. D2004-0615 according to which "The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the spectrum of continuing bad faith abuse by Respondent of Complainant's mark, name and related rights and legitimate business interests". The Panel is therefore convinced that, even though the disputed domain name has not yet been actively used, the Respondent's non-use of the disputed domain name equals to use in bad faith (see also Amundi Asset Management v. Amundi, CAC Case No. 102288 and Accor v. VNT Corporation, CAC Case No. 100004). In the light of the above, the Complainant considers that also the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MYLOCCITANE.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2019-04-17

Publish the Decision