Decision for dispute CAC-UDRP-103196

Case number	CAC-UDRP-103196
Time of filing	2020-07-29 10:51:49
Domain names	ulysse-nardin.net

Case administrator

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

Complainant

Organization	Manufacture et fabrique de montres et chronomètres Ulysse Nardin Le Locle S.A.

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Oversee Domain Management LLC

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 owns the following trade mark registrations that predate the registration of the disputed domain name:

• International trade mark ULYSSE NARDIN, registration number 197476, which was registered on 24 December 1956;
• International trade mark ULYSSE NARDIN, registration number 1030658, which was registered on 9 September 2009; and
• International trade mark ULYSSE NARDIN, registration number 1336486, which was registered on 11 January 2017.

FACTUAL BACKGROUND

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

The Complainant is a Swiss watchmaker, which was founded in 1846.

The Complainant owns several trade marks for ULYSSE NARDIN that predate the registration of the disputed domain name. It also owns a large portfolio of domain names containing the trade mark ULYSSE NARDIN, including <ulysse-nardin.com>, and <ulyssenardin.net>.

The Respondent registered the disputed domain name on 18 July 2020. It resolves to a parking page with links that relate to the Complainant and its activities.

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 trade mark 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 requires the Complainant to prove each of the following three elements:

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

(ii) the Respondent has no rights or legitimate interests in the disputed domain name; and

(iii) the disputed domain name has been registered and used in bad faith.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name is confusingly similar to its trade mark ULYSSE NARDIN. It submits that the trade mark is wholly encompassed in the disputed domain name and only differs by the addition of a hyphen separating the words "ULYSSE" and "NARDIN", plus the gTLD ".net". It says that this is insufficient to avoid confusing similarity. See WIPO Case No. D2000-0437, Inter-IKEA Systems B.V. v. Evezon Co. Ltd.

It is generally accepted that the addition of the top-level suffix, such as ".net" is a standard registration requirement. It does not add any distinctiveness to a domain name and can be disregarded when assessing whether the disputed domain name is confusingly similar to the Complainant's trade mark.

Inserting a hyphen between the two words that make up the Complainant's trade mark, does not avoid the conclusion that the disputed domain name is confusingly similar the Complainant's trade mark ULYSSE NARDIN.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark ULYSSE NARDIN and

that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain name and says that:

(i) The Respondent is not is identified in the Whois database as the disputed domain name and is not commonly known by the disputed domain name;

(ii) The Respondent is not affiliated with nor authorised by the Complainant and has no business with, nor carries out any activity for, the Complainant;

(iii) The Respondent is not licensed to use the Complainant's trade mark ULYSSE NARDIN, and is not authorised to register the disputed domain name; and

(iv) The disputed domain name is confusingly similar to the Complainant's trade mark and resolves to a parking page with commercial links related to the Complainant and its activities. This use does not qualify as a bona fide use. See WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe.

The Panel finds that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The burden of proof shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name.

The Respondent has not filed a Response. There is no evidence to show that the Respondent has any rights or a legitimate interest in the disputed domain name. The Respondent is not commonly known by the disputed domain name and is not authorised to use the Complainant's trade mark. The disputed domain name resolved to a parking page with links to related to the Complainant and its activities. This is not bona fide offering of goods or services nor a legitimate non-commercial or fair use.

Taking the above factors into consideration the Panel finds that the Respondent has no rights or legitimate interest in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C REGISTERED AND BEING USED IN BAD FAITH

The Complainant asserts that the disputed domain name has been registered and is being used in bad faith and says that:

(i) The Respondent registered the disputed domain name several years after the registration of the Complainant's trade mark ULYSSE. NARDIN;

(ii) The expression "ULYSSE NARDIN" has no significance except in relation to the Complainant and its products;

(iii) The disputed domain name is highly similar to the Complainant's domain name <ulysse-nardin.com> and this registration cannot be coincidental. The Respondent should have known about the Complainant's rights, which evidences bad faith; and

(iv) The disputed domain name resolves to a parking page with commercial links related to the Complainant, thus the Respondent has attempted to attract Internet users for commercial gain, which is evidence of bad faith. See WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC.

The Complainant's trade marks pre-date the registration of the disputed domain name. The Respondent has not filed a Response nor asserted any reason for incorporating the Complainant's trade mark, ULYSSE NARDIN, when it registered the disputed domain name. There appears no reason for the Respondent to register the disputed domain name, incorporating the words "ULYSSE" and "NARDIN", other than to create a likelihood of confusion with the Complainant's mark.

The disputed domain name resolves to a parking page and includes links to the Complainant and its business activities. There appears no reason for the Respondent to include such links other than to attempt to attract internet user to its website by creating a likelihood of confusion with the Complainant and its mark.

The Panel concludes that the disputed domain name was both registered and is being used in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ULYSSE-NARDIN.NET**: Transferred

PANELLISTS

Name	**Veronica Bailey**

DATE OF PANEL DECISION 2020-09-01

Publish the Decision