Decision for dispute CAC-UDRP-103392

Case number	CAC-UDRP-103392
Time of filing	2020-11-05 10:10:39
Domain names	lefebvredalloz.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	EDITIONS DALLOZ

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	yahya zumrut

OTHER LEGAL PROCEEDINGS

None.

IDENTIFICATION OF RIGHTS

The Complainant owns various trade mark registrations worldwide that incorporate its DALLOZ mark. In particular it owns French trade mark registration 3951077 for the word mark DALLOZ filed on 4 October 2012 and registered on 25 October 2013 and this registration is the base mark for its International registration 1527534 registered on 16 January 2020. It also owns several domain names incorporating its DALLOZ trade mark such as <dalloz.fr> registered on 1 August 1996.

FACTUAL BACKGROUND

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

Tthe Complainant submits that it is among the leaders in professional and university legal publishing in France.

The Complainant says that it owns several trademarks including the term “DALLOZ” in several countries as noted above.

In addition the Complainant’s parent company LEFEBVRE SARRUT applied for European trademark LEFEBVRE DALLOZ on 16 October 2020. Furthermore, the Complainant owns several domain names comprising the wording “DALLOZ”, such as <dalloz.fr> registered and used since 1 August 1996.

The disputed domain name <lefebvredalloz.com> was registered on 16 October 2020 and resolves to a SEDO page where the domain name is offered for sale for 988 USD.

The Complainant states that the disputed domain name <lefebvredalloz.com> is confusingly similar to its trademark DALLOZ®. The addition of the terms “LEFEBVRE” is not sufficient to escape the finding that the domain name is confusingly similar to the trademark DALLOZ®. It says that this does not change the overall impression of the designation as being connected to the Complainant’s trademark DALLOZ®. Nor does it prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademarks.

The Complainant says that it is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”. Moreover, the Complainant asserts that the addition of the generic Top-Level Domain suffix “.COM” does not change the overall impression of the designation as being connected to the trademark DALLOZ®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and its associated domain names.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Complainant says further that neither licence nor authorisation has been granted to the Respondent to make any use of the Complainant’s trademarks DALLOZ®, or apply for registration of the disputed domain name by the Complainant.

The Complainant asserts that the disputed domain name points to a registrar parking page where the domain name is offered for sale for 988 USD. It contends that this general offer to sell the disputed domain name evidences the Respondent’s lack of rights or legitimate interest.

The disputed domain name <lefebvredalloz.com>, according to the Complainant, was registered on the day of the filling of the corresponding trademark LEFEBVRE DALLOZ by the Complainant’s parent company LEFEBVRE SARRUT.

The disputed domain name includes the corresponding filed trademark in its entirety. Therefore, the Complainant contends that it evinces that the Respondent has knowledge of the Complainant, its trademark DALLOZ®, and its parent company and its filed trademark LEFEBVRE DALLOZ when he registered the disputed domain name. On those facts, the Complainant claims that the use of the Complainant’s trademark in the disputed domain name gives rise to the inference that the Respondent registered the disputed domain name for its trademark value.

Moreover, says the Complainant, the Respondent does not make any use of the disputed domain name but rather the disputed domain name resolves to a SEDO page displaying a general offer to sell the domain for 988 USD. The Complainant claims that the Respondent has failed to make an active use of the disputed domain name. Past panels say the Complainant have held that failure to actively use a domain name is evidence of bad faith registration and use. Furthermore, the Complainant contends that the Respondent has registered the disputed domain name only in order to sell it back for more than its out-of-pocket costs, which evinces bad faith registration and 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

The Complainant has demonstrated that it owns French trade mark registration 3951077 for the word mark DALLOZ filed on 4 October 2012 and registered on 25 October 2013. The disputed domain name wholly contains the Complainant's DALLOZ mark and is therefore confusingly similar to it. The addition into the disputed domain name of "Lefebvre" (the first name of the Complainant's parent company, Lefebvre Sarrut, does not prevent this finding of confusing similarity).

The Complainant has submitted that the Respondent is not affiliated with or authorised by the Complainant and has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. It says that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain names and is not commonly known by the disputed domain name.

The Complainant notes that it's parent company, Lefebvre Sarrut, applied for a European trade mark for LEFEBVRE DALLOZ on 16 October 2020 and that the identical disputed domain was registered by the Respondent on the same day. It notes that the disputed domain name resolves to a SEDO parking page at which the disputed domain name is offered for sale at US$988. The Complainant has submitted that this offer demonstrates that the Complainant is not using the disputed domain name in relation to a bona fide offering of goods or services and has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name which case has not been rebutted by the Respondent. As a result, the Complaint succeeds under paragraph 4(a)(ii) of the Policy.

It is apparent that the Respondent registered the disputed domain name the same day as the Complainant's parent company applied for a European trade mark for the LEFEBVRE DALLOZ mark. This trade mark is highly distinctive and the DALLOZ mark and name is very well reputed and it cannot be a mere coincidence that the Respondent chose to register the identical disputed domain name on the same day. Accordingly, the Panel finds that it was more likely than not that the Respondent was well aware of the Complainant group and its business and DALLOZ mark when it registered the disputed domain name and that he did so opportunistically.

The disputed domain name has not been used by the Respondent but rather resolves to a Sedo parking page on which it is advertised as being for sale for US$988. The advertised price is well beyond the basic administrative cost involved in applying for the disputed domain name and it is apparent that the Respondent registered the disputed domain name in order to make a profit from its re-sale.

These facts, including the Respondent's opportunistic registration of the disputed domain name the same day as the Complainant registered its highly distinctive trade mark, the well-reputed nature of the DALLOZ mark and the parking of the disputed domain name on a SEDO parking page with an advertisement for sale of the disputed domain name at many times

the administrative cost of its acquisition are together supportive of an inference of the Respondent's use of the disputed domain name in bad faith.

Under paragraph 4(b)(i) of the Policy, circumstances indicating that a respondent has registered a domain name primarily for the purpose of selling, renting, or otherwise transferring it to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name are evidence of registration and use of a domain name in bad faith. In this case the disputed domain is identical to the Complainant's highly distinctive trade mark and in circumstances that it was registered the same day as application was made for the trade mark, there is a very strong inference that the Respondent was seeking to profit one way or another from the disputed domain name by re-selling it to the Complainant or to a competitor.

Accordingly, the Panel finds that the disputed domain name was both registered and used in bad faith and the Complaint also succeeds under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LEFEBVREDALLOZ.COM**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2020-11-27

Publish the Decision