Decision for dispute CAC-UDRP-102005

Case number	CAC-UDRP-102005
Time of filing	2020-12-03 09:26:36
Domain names	essilux.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	EssilorLuxottica

Complainant representative

Organization	Convey srl

Respondent

Name	Jason Mansuy

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 International Trademark Registration n. 1371150 ESSILUX of July 26, 2017 in classes 9, 35, 41, 44 designating inter alia European Union, Singapore and USA.

French Trademark Registration n. 4332839 of January 27, 2017 in classes 9, 35, 41, 44 (registered in the name of Essilor International (Compagnie Générale d'Optique) is also invoked.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

- The Complainant is the owner of the trademark ESSILUX, with international and national trademark registrations.

- The Complainant is a French-Italian company based in Paris and founded in 2017 from the merger of the Italian company

Luxottica with the French company Essilor International, the name is a combination of the two company names.

- The Domain Name was registered by the Respondent on January 16, 2017, without authorization of Complainant, and has been pointed to a parking page with various sponsored links.

- On June 03, 2020 a cease-and-desist letter was sent to the email of the privacy shield indicated as Respondent requesting to refrain using the Domain Name and to transfer it to the Complainant. The Respondent replied on July 21, 2020 that he was available to “resolve this in a fair and equitable way” and he would evaluate offer to sell the Domain Name. The Legal Representative requested to define the meaning of “fair market value" and the Respondent answered as follows: “I think a fair price for this domain is $50,000. Please let me know ASAP, as I have multiple parties interested in purchasing the domain.”

- The disputed Domain Name is identical to the trademark ESSILUX in which the Complainant has rights. As far as the time of registration is concerned, the date of the registration of the Complainant’s trademark is not relevant for the evaluation of identity or similarity with the domain name.

- Although the “Essilux” mark was applied for registration - eleven days - after Respondent registered the domain name on January 16, 2017, Respondent’s prior knowledge is evident from a few objective, relevant and consistent evidence. In particular:

- The Respondent has been an employee of a company of the Complainant, Essilor of America / Essilor Laboratories of America, from 2015 to 2017 and was an employee when the merger was announced on January 16, 2017.

- The Respondent registered the domain name at issue the very same day the merger was announced publicly, to secure the registration before the Complainant could register its company name and trademark “ESSILUX” as a domain.

- From the inception of such fraudulent designs and endeavor, the Respondent has concealed his identity by employing a privacy service, in order to reduce as much as possible his clear connections with Complainant.
Complainant contends that such evidence is more than enough to claim bad faith on the Respondent’s side.

- The Respondent has no rights or legitimate interests in respect of the domain name; the Respondent is not an authorized dealer of the Complainant nor has ever been authorized by the Complainant to use the trademark ESSILUX in the disputed Domain Name. ESSILUX trademarks was coined by the merger of the Italian company Luxottica with the French company Essilor International. There has been no evidence showing that Respondent has any registered trademark rights with respect to the disputed domain name.

- Respondent registered the disputed Domain Name on January 16, 2017, the exact day of the official announcement of the merger between the companies Luxottica and Essilor International. Furthermore, the Respondent is a former employee of Essilor of America / Essilor Laboratories of America, where he has been working in the position of Business Development Manager.

- Since the disputed Domain Name - at present - is connected to a parking page with various sponsored links, which cannot be deemed a bona fide offering of goods or services.

- Holder of the disputed domain name registers and uses the disputed domain name in bad faith.

- In the case at hand the Domain Name was registered the same date of the official announcement to the press of the merger between Luxottica and Essilor. Secondly, the Respondent is a former employee of the US branch of Essilor and has been active in the optical sector for fifteen years. Also, documents concerning the merger were shared internally to the parties of the merger such as the Presentation of Luxottica and Essilor International Merger.

- The Respondent was aware of the merger and registered the Domain Name to prevent Complainant from registering its

name or trademark in a domain name and, also, to obtain profits from its sale and from the pay-per-click links of the parking page where the Domain Name is currently redirected. Those aims have been declared in his email of September 11, 2020 where the Respondent has requested USD 50,000.00 for the transfer of the Domain Name (deeming such high amount a “fair market value”) adding that the Domain Name is subject to multiple offers from third-parties.

- The above-mentioned aspects reveal that the Respondent’s intent in registering the disputed domain name was to profit or otherwise exploit the complainant’s trademark and, therefore, the implausibility of any good faith use of the Domain Name by the Respondent.

RESPONDENT:

- The Complainant filed for registration of the mark "Essilux" AFTER the domain name "essilux.com" had already been acquired by Respondent. The Complainant had been in merger talks for a considerable period of time and had ample opportunity to consider future name possibilities and chose NOT to use Essilux as a name. There is absolutely NO mention of "Essilux" in any of the written materials provided by the Complainant. The Respondent created the word "essilux" from his own imagination.

- Although "essilux" is an interesting name that includes elements of the words "Essilor" and "Luxottica", there are many other brands that use these elements. Indeed, a jewelry company in Italy goes by the name of Essilux Group, using "Essilux" to be a combination of "Essential" and "Luxury".

- The Respondent, as a then-employee of the Complainant, was prevented from putting the domain into commercial use as planned because of the fear of retribution from the Complainant. Instead, the domain has been sitting idle, and the Respondent has not made any money thus far from the domain, despite faithfully paying all applicable fees and dues to maintain the registration.

- The Complainant did not make an effort to acquire the domain name in question in a fair and equitable manner and instead issued a cease and desist order as the initial communication with the Respondent.

- The Respondent offered to transfer the domain to the Complainant at a price of just $50,000, even though it could be reasonably argued that the value is far greater. A simple search on DNJournal.com will show that there have been many domain name exchanges this year well in excess of $50,000, and one could reasonably argue that many of the names hold far less commercial value than essilux.com. The Respondent, being a current customer of the Complainant, wanted (and indeed still wants) to resolve this amicably so that this dispute does not interfere with their business relationship.

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.

I. RIGHTS

The disputed domain name is identical to the trademark ESSILUX in which the Complainant has rights.

While the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights, such rights must be in existence at the time the complaint is filed. (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.1.3).

The fact that the disputed domain name pre-dates the Complainant's trademark registrations may have relevance to the other two elements, possible rights or legitimate interests of the Respondent and whether or not the Respondent has registered and used the domain name in bad faith, but those other elements are analysed below.

The Panel considers that the first circumstance is met, since the disputed domain name is identical to the Complainant's trademark.

II. NO RIGHTS OR LEGITIMATE INTERESTS

Pursuant to paragraph 4(c) of the Policy, a Respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is 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 trademark or service mark at issue.

The Respondent has not proved that any of these circumstances exist, although these are mere examples and therefore the Respondent can prove its rights or legitimate interests based on other circumstances.

The circumstances alleged by the Respondent in his response in this respect are not credible. It does not seem reasonable to assert that he created the word "essilux" from his own imagination, when it has been established that he was an employee of the Complainant's US subsidiary who had access to corporate information on the merger of the two companies which was identified a few days later by the ESSILUX mark.

The Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Having done so, the burden of production shifts to the Respondent to come forward with appropriate evidence demonstrating rights or legitimate interests (see WIPO Overview 3.0, section 2.1). The Respondent has failed to provide any solid justification for the registration of the disputed domain name. It is impossible to believe that the identity between the disputed domain name and the Complainant's principal mark and trade name is coincidental.

III. BAD FAITH

Paragraph 4(b) of the Policy establishes a non-exhaustive list of circumstances which may prove bad faith registration and use on the part of the Respondent:

(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 trademark 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 trademark 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 web site 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 web site or location or of a product or service on your web site or location.

According to WIPO Jurisprudential Overview 3.0, article 3.8.2, in certain limited circumstances where the facts of the case establish that the Respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the Respondent has acted in bad faith. Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent's insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application.

In the present case, exactly those circumstances apply, since the Respondent was an employee of the company that merged and a few days later adopted the trademark and trade name ESSILUX. The timing of the events clearly shows that the Respondent was aware of these corporate plans and therefore registered the disputed domain name in bad faith.

In reply to the cease-and-desist letter sent by the Complainant, the Respondent requested USD 50,000.00 for the transfer of the disputed domain name (deeming such high amount a "fair market value") adding that the disputed domain name is subject to multiple offers from third-parties. This request shows that the Respondent intends to obtain a significant economic benefit from the sale of a domain name whose registration can only be explained by its privileged information, which proves the Respondent's bad faith.

The use of a privacy service also seems to confirm the bad faith of the Respondent. While there may be circumstances that make the use of a privacy service legitimate, several decisions have considered it a circumstance that contributes to consider bad faith proven when it is combined with other types of circumstances. In GVC Holdings plc / ElectraWorks Limited v. Registration Private, Domains By Proxy, LLC / Adnan Atakan Alta, WIPO Case No. D2016-2563, the panel found that:

"Although privacy services might be legitimate in certain circumstances, it is for the Panel difficult to see in the present case, why the Respondent should need to protect its identity except to make it difficult for the Complainant to protect its trademark rights. The Panel rather believes that the choice of the disputed domain names (which fully incorporate the Complainant's trademark), the content as well as the design of the Respondent's corresponding websites rather indicate that the Respondent deliberately opted for a privacy shield in order to prevent an efficient enforcement of legitimate trademark rights by the Complainant."
In the light of the above, the Panel finds that the Complainant has established registration and use of the disputed domain name in bad faith and concludes 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. **ESSILUX.COM**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2021-01-15

Publish the Decision