

Decision for dispute CAC-UDRP-103725

Case number CAC-UDRP-103725

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Domain names namechaussures.shop

Case administrator

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

Complainant

Organization RAUTUREAU APPLE SHOES

Complainant representative

Organization Nameshield (Laurent Becker)

Respondent

Name Nick Lyon

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 several trade marks for its brand "NONAME" in classes 18 and 25 as follows:

- International trademark NONAME no.1192615 registered on 26 November 2013;
- International trademark NONAME no. 589889 registered on 10 August 1992;
- EU trademark NONAME no. 18189192 registered on 29 January 2020;
- French trademark NONAME no. 4006423 registered on 22 May 2013.

The Complainant is also the owner of a large domain names portfolio, including <no-name.fr> registered since 11 December 2001.

FACTUAL BACKGROUND

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

The Complainant is a shoe business called Rautureau Apple Shoes, and it is the owner of various trade marks including Free Lance, JB Rautureau, Schmoove, Armistice and No name.

The disputed domain name <namechaussures.shop> was registered on 4 March 2021 and is in use as at 12 May 2021 selling shoes made by others, including the No Name branded shoes of the Complainant as of the date the Panel visited the site on 12 May 2021.

PARTIES CONTENTIONS

CONTENTIONS:

COMPLAINANT:

1. The disputed domain name is confusingly similar to the protected mark

The Complainant argues that the disputed domain name <namechaussures.shop> is made up of a part of registered trademark NONAME and the word “chaussures” is descriptive of Complainant’s shoe business and the products Complainant markets in connection with this business. Therefore, the Panel finds that the addition of a descriptive term does not differentiate Respondent’s disputed domain name from Complainant’s mark under Policy 4(a)(i). See *Am. Int’l Group, Inc. v. Ling Shun Shing*, FA 206399 (The Forum December 15, 2003) (finding that the addition of the term “assurance,” to the complainant’s AIG mark failed to sufficiently differentiate the name from the mark under Policy 4(a)(i) because the appended term related directly to the complainant’s business). Besides, it is well established that TLDs may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing disputed domain names and trademarks. Please see WIPO Overview 3.0, section 1.11 (“The applicable Top Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”). Thus, the disputed domain name is confusingly similar to the Complainant’s trademark.

2. The Respondent does not have any rights or legitimate interest in the disputed domain name

According to the WIPO Case No. D2003-0455, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Complainant argues that Respondent is not known by and has never used and/or traded under the name “NONAME” or “NAMESCHASSURES” as the Respondent pretends to be in the website. 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. Thus, the Respondent is not known as the disputed domain name. Please see for instance *The Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>* (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).”) The Complainant contends that the Respondent is not affiliated with nor authorized by it in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and he is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither licence nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark, or apply for registration of the disputed domain name by the Complainant.

The disputed domain name redirects to a French online shop purporting to offer the Complainant’s shoes. The website includes in its entirety the Complainant’s logo at the main page given the impression to be one of Complainant’s official

websites. Therefore, the Respondent uses the disputed domain name to pass itself off as Complainant. The disputed domain name's website offers Complainant's products for sale without Complainant's authorization while displaying Complainant's trademark. The Respondent is thus intent on tricking internet users into believing there is an affiliation between Complainant and the subject website when there is no affiliation. Respondent's use of the at-issue domain name in this manner indicates neither a bona fide offering of goods or services under Policy 4(c)(i), nor a non-commercial or fair use pursuant to Policy 4(c)(iii). See *Fadal Engineering, LLC v. Daniel Strizich, Independent Technology Service Inc*, Fa 1581942 (The Forum November 13, 2014) ("finding that Respondent's use of the at-issue domain to sell products related to Complainant without authorization "does not amount to a bona fide offering of goods or services under policy 4(c)(i), or a legitimate noncommercial or fair use under Policy 4(c)(iii)."); see also WIPO Case No. D2021-0297 F. *Hoffmann-La Roche AG v. Alejandro Gonzalez, Offshore Racks* ("The Respondent's use of the confusingly similar disputed domain name on a website offering for sale overlapping products and services is neither a bona fide offering of goods or services, nor a legitimate non-commercial or fair use pursuant to Policy").

Furthermore, there is no disclaimer in the website for the lack of affiliation to the Complainant to avoid the likelihood of confusion with the Complainant. Respondent's failure to accurately and prominently disclose on its website its (lack of a) relationship with Complainant forecloses such use from being a bona fide offering of goods or services. See WIPO Case No. D2021-0297 F. *Hoffmann-La Roche AG v. Alejandro Gonzalez, Offshore Racks* ("Noting the high risk of implied affiliation between the disputed domain name and the confusingly similar well-known trademark of the Complainant, the Panel finds that there is no plausible fair use to which the disputed domain name could be put that would not have the effect of being somehow connected to the Complainant"). Therefore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3. The disputed domain name has been registered and is being used in bad faith

The Respondent uses the disputed domain name displaying Complainant's trademark and other references to Complainant while offering Complainant's products for sale without Complainant's authorization to do so. The Respondent's use is disruptive to Complainant's business and demonstrates bad faith registration and use under Policy 4(b)(iii) and (iv). See *G.D. Searle & Co. v. Celebrex Cox-2 Vioxx.com*, FA 124508 (The Forum October 16, 2002) ("Unauthorized use of Complainant's.. mark to sell Complainant's products represents bad faith use under Policy 4(b)(iii)."); see also, *Hewlett-Packard Co. v. Ali*, FA 353151 (The Forum December 13, 2004) ("Respondent [used "HP" in its domain name] to benefit from the goodwill associated with Complainant's HP marks and us[ed] the <hpdubai.com> domain name, in part, to provide products similar to those of Complainant. Respondent's practice of diversion, motivated by commercial gain, constitutes bad faith registration and use pursuant to Policy 4(b)(iv).").

Therefore, the Complainant asserts that Respondent registered the disputed domain name to disrupt the business of Complainant. This case falls with paragraph 4(b)(iv) of the Policy which provides that a registrant has registered and is using a domain name in bad faith where: "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."

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

See *Fadal Engineering, LLC v. DANIEL STRIZICH, INDEPENDENT TECHNOLOGY SERVICE INC*, FA 1581942 (Forum November 13, 2014) ("finding that Respondent's use of the at-issue domain to sell products related to Complainant without authorization "does not amount to a bona fide offering of goods or services under policy 4(c)(i), or a legitimate noncommercial or fair use under Policy 4(c)(iii)."); see also WIPO Case No. D2021-0297 F. *Hoffmann-La Roche AG v. Alejandro Gonzalez, Offshore Racks* ("The Respondent's use of the confusingly similar disputed domain name on a website offering for sale overlapping products and services is neither a bona fide offering of goods or services, nor a legitimate non-commercial or fair use pursuant to Policy"). See also WIPO Case No. D2021-0297 F. *Hoffmann-La Roche AG v. Alejandro*

Gonzalez, Offshore Racks (“Noting the high risk of implied affiliation between the disputed domain name and the confusingly similar well-known trademark of the Complainant, the Panel finds that there is no plausible fair use to which the disputed domain name could be put that would not have the effect of being somehow connected to the Complainant”). See G.D. Searle & Co. v. Celebrex Cox-2 Vioxx.com, FA 124508 (Forum October 16, 2002) (“Unauthorized use of Complainant’s.. mark to sell Complainant’s products represents bad faith use under Policy 4(b)(iii).”); see also, Hewlett-Packard Co. v. Ali, FA 353151 (Forum December 13, 2004) (“Respondent [used “HP” in its domain name] to benefit from the goodwill associated with Complainant’s HP marks and us[ed] the <hpduhai.com> domain name, in part, to provide products similar to those of Complainant. Respondent’s practice of diversion, motivated by commercial gain, constitutes bad faith registration and use pursuant to Policy 4(b)(iv).”).

RESPONDENT:

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 not, 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 not, 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

Although the Respondent has not come forward, the Policy does not provide for default decisions and we must still ensure that the Complainant has made out its case. See WIPO Overview at 4.6 “The respondent’s default does not automatically result in a decision in favor of the complainant. Subject to the principles described in 2.1 above with regard to the second UDRP element, the complainant must establish each of the three elements required by paragraph 4(a) of the UDRP. While a panel may draw negative inferences from the respondent’s default, paragraph 4 of the UDRP requires the complainant to support its assertions with actual evidence in order to succeed in a UDRP proceeding.”

A. Identical or Confusingly Similar, §4(a)(i).

The First Limb of the Policy is whether the Complainant can show he has rights to a name or mark identical or confusingly similar to the disputed domain name <namechaussures.shop>.

The Complainant has various a registered marks and relies on four of them. Two are international registrations, there is an EUTM and a French national mark. All are properly considered Logo marks. All are French Language marks (although the EUTM has a second language of English).

EUTM No. 018189192 is a logo mark which is a black & white chequerboard and underneath includes the word element No

Name. Int. Mark No. 1192615 is a logo mark for the logo No Name in stylised form with a black diagonal line through the O. Its language is French. It designates 35 countries. Int. Mark No. 589889 is the logo in a blacked out box. French Mark No. 4006423 says it is a word mark on TM View but it is the logo and is in French.

The Complainant complains of the use in the disputed domain name of the word <name>. It makes no claim to any rights in the word shoes. However it cannot be in any better position in relation to the word, name. That is an ordinary dictionary word in the English language. It is also recognised internationally in non English speaking countries as a common ordinary English dictionary word. No party can have any exclusive rights to such a word. It cannot be distinctive of any party unless it has what is known as acquired distinctiveness or secondary meaning – so that it has become so famous that the brand is what most people think of – not the word. Traders who select highly descriptive marks have to tolerate confusion. The point is that in this case, the Complainant has no exclusive right to the common word name. It only has logo marks and certainly in common law jurisdictions, the Registries would object on Absolute Grounds to any attempt to register the word mark to claim any exclusivity to that word element. Let us say here then that the Complainant may have rights but they are extremely weak and not exclusive. This can impact the analysis under the other two factors.

The only additional element in the disputed domain name is a generic Top-Level Domain (“gTLD”) suffix (“.com”). As a mere technical requirement of registration, this element may be disregarded in the comparison between a domain name and a trademark for the purposes of the first element of paragraph 4(a) of the Policy, unless the gTLD suffix has some relevance to the comparison between the trademark and the domain name as a whole. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.11.

In view of the above, the Panel is satisfied that the Complainant has (only just) discharged its burden on the first requirement by demonstrating that the disputed domain name is identical or confusingly similar to a mark in which it has a right.

B. Rights or Legitimate Interests, §4(a)(ii).

Under paragraph 4(a)(ii) of the Policy, a complainant has the burden of establishing that a respondent lacks rights or legitimate interests in respect of the disputed domain name, but this burden is light. It is sufficient in the first instance for the Complainant to allege a prima facie case, and if the evidence presented is conclusive or yields an inference that Respondent lacks rights or legitimate interests, the burden shifts to Respondent to rebut the allegations.

A respondent demonstrates that it has a right or legitimate interest by offering proof that it acquired the disputed domain names for a lawful purpose. The UDRP sets out three non exhaustive circumstances that if “found by the Panel to be proved based on its evaluation of all evidence presents, shall demonstrate [its] rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

“(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial 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.”

Here, the Respondent appears to be a reseller of the genuine product, the shoes sold under the Complainant's mark. The Panel could see this as of the dates it visited the site on 12 and 14 May 2021. Resellers selling goods under their name/mark are protected at law by the doctrine of exhaustion or first sale policy (the relevant first sale likely being at wholesale) and the Policy also protects them. The WIPO Overview 3.0 says as follows: “2.8.1 Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate

interest in such domain name.” The main case is *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, <okidataparts.com>. Elements of that test are significantly more restrictive than EU law which protects resellers without many of the restrictions imposed by panels.

In this case, despite the issues with the mark itself, the Respondent does in fact appear to be referencing the mark of the Complainant in its domain name. This conclusion is based solely on the fact that the site also uses the Chequerboard EUTM logo mark. The shoes are offered/shown in the photographs and the brand is noted in plain type underneath the relevant photograph. The shoes also have a marking on them that is also a circle with a diagonal through it. However, it appears to be a genuine site. It is in French only. Much of this is totally acceptable where the genuine item is sold by a genuine reseller. This is all highly fact sensitive and finely balanced. The use of logo marks by resellers needs care in these circumstances in case it suggests affiliation. Ideally logo marks should be avoided by resellers. Some panels think such sites cannot sell other products but that is overly broad and is in no way the position in the EU at law. In all, it appears to the Panel that the site is that of a genuine reseller. That party does not need to be authorised or approved by the Complainant.

Accordingly, based on the record of this proceeding, the Panel finds that the Complainant has not satisfied the second element in paragraph 4(a) of the Policy.

C. Bad Faith registration and Bad Faith Use, §4(a)(iii).

Paragraph 4(b) of the Policy sets out four non-exclusive circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website 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 the respondent’s website or location or of a product or service on the site or location.

Where there is a legitimate/fair use interest, there will usually be no Bad Faith. The real question is whether the Respondent as a reseller goes too far in leveraging the Complainant’s branding and this turns on the manner of logo use. The case is finely balanced but the Panel finds the Complainant has not discharged its burden on this limb of the Policy. The evidence does not unequivocally suggest that the Respondent is acting in Bad Faith but rather is equally consistent with good faith reselling/retailing.

For the above reasons, the Panel finds that the Complainant has failed to establish that Respondent registered or is using <namechaussures.shop> in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. NAMECHAUSSURES.SHOP: Remaining with the Respondent

PANELLISTS

Name **Victoria McEvedy**

DATE OF PANEL DECISION **2021-05-14**

Publish the Decision
