

Decision for dispute CAC-UDRP-103810

Case number	CAC-UDRP-103810
Time of filing	2021-05-19 09:33:20
Domain names	isabelmarantrakuten.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	IM PRODUCTION
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Complainant representative

Organization	Nameshield (Laurent Becker)
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Respondent

Organization	Xing Chun Ding
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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

Complainant holds the following trademark for the sign ISABEL MARANT:

- European Union trademark "ISABEL MARANT" No. 1035534, dated of December 23, 1998, registered in classes 3, 14 and 25 and duly renewed since then.

Complainant also cites an International trademark "ISABEL MARANT" No 1 284 453, dated of November 16, 2015 in classes 4, 8, 11, 16, 20, 27 and 28 but it is not clear from the evidence provided in which countries the said trademark was actually registered and whether it was registered at all.

Complainant also operates the domain name <isabelmarant.com>, registered since April 20, 2002.

FACTUAL BACKGROUND

Complainant is a French company specialized in the manufacture and marketing of ready-to-wear, shoes, handbags and jewellery. Complainant markets these products under the brand ISABEL MARANT, and has stores around the world (e.g.

Belgium, Germany, Spain, France, Italy, United-States...).

Complainant also owns the domain name <isabelmarant.com>, registered since April 20, 2002.

On May 5, 2021, Respondent registered the disputed domain name <isabelmarantrakuten.com> and resolves to Chinese content.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant argues that the disputed domain name is confusingly similar to its ISABEL MARANT trademarks.

Complainant emphasizes that the addition of the word "RAKUTEN" is not sufficient to neutralize the risk of confusion and that the addition of the gTLD ".COM" is not relevant in the appreciation of the risk of confusion.

Complainant further asserts that Respondent does not have any rights or legitimate interests in the disputed domain name.

Complainant recalls that it must make a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, and that once such case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name.

Complainant relies on the available Whois information and argues that Respondent is not commonly known under the disputed domain name.

In addition, the Complainant asserts that the Respondent is not related to the Complainant, that it does not carry out any activity for, nor has any business with the Respondent. Moreover, the Respondent has not been granted neither license nor authorization to make any use of the Complainant's trademarks ISABEL MARANT, or apply for registration of the disputed domain name by the Complainant.

Finally, according to the Complainant, the Respondent does not use and has no plan to use the disputed domain name.

Complaint finally comes down to the conclusion that, under the specific circumstances of the case, the Respondent's registration and use of the disputed domain name amounts to bad faith.

First, Complainant emphasizes confusing similarity of the disputed domain name <isabelmarantrakuten.com> with its trademark ISABEL MARANT, and the reputation and distinctive character of the trademark to show that the Respondent registered the disputed domain name with full knowledge of Respondent's rights and thus in bad faith.

Besides, Complainant states that Respondent's passive holding of the disputed domain name is evidence that Respondent is using the disputed domain name in bad faith, as well as the fact that he has not demonstrated any activity in respect of the disputed domain name.

RESPONDENT:

Respondent did not provide any response to the complaint, and is therefore in default.

RIGHTS

Principal reasons for the decision

Paragraph 4(a) of the Policy requires the Complainant to prove three elements in order to the transfer of the domain name:

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

Rights

Complainant shown it has valid trademark rights in the "ISABEL MARANT" sign.

The Panel agrees and considers Complainant's trademark rights in the sign ISABEL MARANT are established.

Complainant adds that the addition of the term "RAKUTEN" and the gTLD ".COM" should be disregarded when assessing similarity test between Complainant's trademarks and the disputed domain name. Under Policy 4(a)(i), top-level domains are indeed generally disregarded in the similarity test. For recent case law, see CREDIT MUTUEL ARKEA v. Domain Administration, Case n° 102345 (CAC March 14, 2019) "The suffix is ignored for similarity. The applicable Top Level Domain ("TLD") in a domain name (e.g. ".com") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test, see CANAL + FRANCE v. Franck Letourneau, WIPO Case No. DTV2010-0012, <canalsat.tv>". Furthermore, the addition of the term "RAKUTEN" should also be disregarded since it does not change the overall impression of likelihood.

The Panel agrees that the disputed domain name is causing confusion with Complainant's trademark, as it reproduces entirely its "ISABEL MARANT" trademarks with the mere addition of the word "RAKUTEN" and the gTLD ".COM".

As a result, the Panel finds that Complainant has satisfied Policy 4(a)(i).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant shall make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), the burden then shifts to Respondent. This standard and burden of proof have been established through continuous case law, see LESAFFRE ET COMPAGNIE v. Tims Dozman, Case n° 102430 (CAC May 2, 2019) "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 disputed domain name."

Complainant asserts that, based on the available Whois information, Respondent is not commonly known under the disputed domain name. Previous panels have relied on such finding to conclude that Respondent lacks rights or legitimate interests in the disputed domain name in this situation: "The Complainant contends that no evidence suggests that the Respondent has been known in any way by the disputed domain name or by the distinctive part "AVAST". (...) On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy." (Avast Software s. r. o. v. Milen Radumilo, Case n° 102384 (CAC April 25, 2019).

Complainant further argues that Respondent has never been allowed by Complainant nor to use the Complainant's trademark ISABEL MARANT, or apply for registration of the disputed domain name. Besides, Complainant alleges that Respondent is not related in any way with the Complainant, and that it does not carry out any activity for, nor has any

business with the Respondent. This is generally considered as evidence that Respondent lacks rights or legitimate interests in the disputed domain name, see *QUESTRA INC. v. MARVELOUS MARVIN, HASCONTRACTS*, WIPO Case No. D2020-0633, “The Complainant has made un rebutted assertions that is has not granted any authorization to the Respondent to use the Complainant’s trademark. Based on the evidence, the Respondent is not affiliated or related to the Complainant in any way. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired unregistered rights. (...) The Panel finds the Respondent has no rights or legitimate interests in respect of the Domain Name in accordance with paragraph 4(a)(ii) of the Policy.”. Consequently, the Panel considers that Respondent lacks rights or legitimate interests in the disputed domain name.

Complainant further argues that Respondent did not use the disputed domain name. Long-standing case law has established that such passive holding of the domain name to redirect consumers to a parking page shows that Respondent does not use the domain name in connection to any bona fide offering of goods or services, see *AMUNDI ASSET MANAGEMENT v. NULL NULL*, Case No. 102393 (CAC April 15, 2019) “Moreover, the disputed domain name resolves to a parking web page with the commercial links and the disputed domain name, therefore, does not constitute a bona fide offering of goods and services or a legitimate non-commercial fair use.”. For that reason, the Panel finds that Respondent does not use the domain name in connection to any bona fide offering of goods or services.

The Panel therefore conclude that Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name and has therefore satisfied Policy 4(a)(ii).

BAD FAITH

Complainant argues that given the distinctiveness of its trademark and its reputation, the Respondent could not ignore Complainant’s rights at the time of the disputed domain name’s registration.

The case law has previously held that it was possible to infer constructive knowledge of Complainant’s rights at the time of registration, and thus bad faith registration, from the well-known character of Complainant’s trademark, see *AVAST SOFTWARE S.R.O v. ADISOFTRONICS*, Case No. 101917 (CAC May 2, 2018) “The Panel accepts the Complainant’s view that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity, as it is the case of the Disputed domain name, can by itself create a presumption of bad faith. Indeed, this is a common view of UDRP panellists”.

The Panel acknowledges the well-known nature of the “ISABEL MARANT” trademark in the field of manufacture and marketing of ready-to-wear, shoes, handbags and jewellery and thus that Respondent could not ignore Complainant’s rights at the time of registration. Therefore, the Panel concludes that the Respondent registered the disputed domain name <isabelmarantrakuten.com> in bad faith.

Complainant further asserts that Respondent did not use the disputed domain name and has no plan to use it.

Previous panels have found that such behaviour was found to be bad faith from the Respondent part, see *ARCELORMITTAL (SA) v. Milton Liquors ILC*, Case No. 102360 (CAC April 11, 2019) “In the Panel’s view, the Respondent has intentionally registered the disputed domain name which reproduces the Complainant’s trademark almost identically. By the time the disputed domain name was registered, it is unlikely that the Respondent did not have knowledge of the Complainant’s trademark. The Complainant also proved that the Respondent used the disputed domain name to lead to a parking page, with sponsored links. These facts, confirm that the disputed domain name is used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website.” The Panel agrees and finds this situation amounts to use in bad faith.

The Panel finds that Complainant has satisfied Policy (4)(a)(iii).

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

Complainant holds trademark rights for the ISABEL MARANT sign. The disputed domain name is reproducing Complainant's trademarks. Respondent failed to establish legitimate rights or legitimate interests in the disputed domain name. Complainant has established that Respondent registered and uses the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. ISABELMARANTRAKUTEN.COM: Transferred
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PANELLISTS

Name	Nathalie Dreyfus
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DATE OF PANEL DECISION 2021-06-16

Publish the Decision
