

Decision for dispute CAC-UDRP-103754

Case number	CAC-UDRP-103754
Time of filing	2021-05-27 14:14:42
Domain names	notino.art, inontino.com, i-notino.site, notino-tester.site

Case administrator

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

Organization	NOTINO LIMITED
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Respondent

Name	Eduard Voiculesxu
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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 names.

IDENTIFICATION OF RIGHTS

NOTINO LIMITED is the owner, among others, of the following trademark registrations:

- EUTM Registration no. 15221815 for "NOTINO" filed on June 28, 2016 and protected for goods and services in classes 16, 35, 38 and 39;
- EUTM Registration no. 15944127 for "NOTINO TODAY IS YOURS (dev.)" filed on October 17, 2016 and protected for goods and services in classes 16, 35, 38 and 39;
- EUTM Registration no. 16743965 for "NOTINO TRY&BUY" filed on May 16, 2017 and protected for good and services in classes 3, 16 and 35;
- EUTM Registration no. 16804049 for "NOTINO TRY&BUY (dev.)" filed on June 6, 2017 and protected for good and services in classes 3, 16 and 35;
- EUTM Registration no. 17471574 for "NOTINO" filed on November 13, 2017 and protected for services in classes 35 and 41;
- EUTM Registration no. 18071749 for "NOTINO (dev.)" filed on September 11, 2019 and protected for goods and services in classes 3, 16, 35, 38, 39 and 41;
- US Registration no. 87013739 for "NOTINO" filed on April 26, 2016 and protected for services in class 35;
- Canadian Registration no. 1791404 for "NOTINO" filed on July 14, 2016 and protected for services in class 35;

- Us Registration no. 87252597 for "NOTINO TODAY IS YOURS" filed on November 30, 2016 and protected for services in class 35.

FACTUAL BACKGROUND

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

- 1) The Complainant declares to be the holder of the domain name <notino.cz> and other variations (such as <notino.sk>, <notino.pl>, <notino.it>, <notino.dk> and <notino.hu>), on which NOTINO LIMITED runs eshops with cosmetics, perfumes and other related goods in almost all the European Union and also outside the EU.
 - 2) According to the Complainant the brand "NOTINO" and the eshops marked "NOTINO" are well known within the EU.
 - 3) NOTINO LIMITED has also proved to be the owner of many trademarks consisting of or including the word "NOTINO" protected in many countries.
 - 4) The Complainant has noted that all the domain names here contested are registered in the name of the Respondent at the registrar Go Daddy, LLC.
 - 5) Furthermore, according to the Complainant, all the domain names in dispute are identical or confusingly similar to the Complainant domain names and trademarks consisting of or including "NOTINO".
 - 6) In addition, it is the Complainant's view that since the holder of the disputed domain names was never authorized to use the name "NOTINO" in the domain names in dispute, the Respondent is violating rights of the Complainant.
 - 7) Finally, the Complainant believes that the Respondent is in bad faith since it is running the same Complainant's business activity by offering cosmetics, perfumes and other related goods through domain names similar to the Complainant marks here invoked. Therefore, according to the Complainant, the holder of the disputed domain names obviously intends, for commercial gain, to misleadingly divert consumers and to tarnish the "NOTINO" trademarks.
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PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

A) In the case at hand the Complaint relates to four domain names:

- <notino.art>
- <inontino.com>
- <i-notino.site>
- <notino-tester.site>

According to Article 3(c) of Rules for Uniform Domain Name Dispute Resolution Policy ("Rules"), the Complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In the present case the Panel has verified that all the above mentioned disputed domain names are registered in the name of Mr. Eduard Voiculescu.

Therefore the Panel does not see any obstacles in rendering a decision in the present case even if the Complaint relates to more than one domain name.

B) Paragraph 4(a) of the Policy provides that to obtain the transfer of the domain name, the complainant must prove that each of the following elements is present:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

1a) <notino.art>

The Complainant has established it has rights in the trademark "NOTINO". The Panel notes that "NOTINO" is a well-known trademark as per the information provided by the Complainant and additional Internet searches made by the Panel. The disputed domain name has been registered on January 5, 2021, years after the Complainant trademark registrations. The only difference between the disputed domain name and the Complainant's trademark is the gTLD ".art". The Panel finds that the disputed domain name is identical to the Complainant's mark as "NOTINO" is incorporated in its entirety in the disputed domain name and it is a well-established principle that suffixes (TLDs) such as ".com", ".org" or, in this case, ".art", may be disregarded when determining if there is identity or confusing similarity (see e.g. *Playboy Enterprises International, Inc. v. John Taxiarchos*, WIPO Case No. D2006-0561; *Burberry Limited v. Carlos Lim*, WIPO Case No. D2011-0344; *Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525).

1b) <inontino.com>

The Complainant has established it has rights in the trademark "NOTINO". The Panel notes that "NOTINO" is a well-known trademark as per the information provided by the Complainant and additional Internet searches made by the Panel. The disputed domain name has been registered on January 5, 2021, years after the Complainant trademark registrations. The letter "i" used in the front of word "nontino" as well as the adding of a letter "n" in the middle of the domain name in dispute, do not change the overall impression of the designation as being connected to the Complainant or its trademark. In addition it must be noted that the letter "i" in the beginning of the trademarks or domain names usually points to the "internet" and connects the trademark to the internet activities. The addition of the generic top level domain ".com", as seen before, does not change the overall impression of the designation as being connected to Complainant's trademark as well.

1c) <i-notino.site>

The Complainant has established it has rights in the trademark "NOTINO". The Panel notes that "NOTINO" is a well-known trademark as per the information provided by the Complainant and additional Internet searches made by the Panel. The disputed domain name has been registered on January 5, 2021, years after the Complainant trademark registrations. The disputed domain name is obviously confusingly similar to the Complainant's trademark "NOTINO" since the adding of a letter i (followed by a hyphen) before the word "NOTINO" does not affect that finding. This does not eliminate any risk of confusion with the Complainant's trademark, as also seen in the previous paragraph.

1d) <notino-tester.site>

The Complainant has established it has rights in the trademark "NOTINO". The Panel notes that "NOTINO" is a well-known trademark as per the information provided by the Complainant and additional Internet searches made by the Panel. The disputed domain name has been registered on January 5, 2021, years after the Complainant trademark registrations. The disputed domain name is obviously confusingly similar to the Complainant's trademark "NOTINO" since the adding of a generic term (considering the perfumery sector here considered) as tester (preceded by a hyphen) after the word "NOTINO" does not affect that finding. The addition of the generic top level domain ".site", as seen before, does not change the overall impression of the designation as being connected to Complainant's trademark as well.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant demonstrated that all the websites to which the disputed domain names are linked allegedly offer for sale exactly the same categories of products sold through the e-shops marked "NOTINO". The Complainant clearly considers that Respondent has the hope and the expectation that Internet users looking for the brand "NOTINO" will be directed to the websites corresponding to the disputed domain names. The Panel finds that said activity, of course, does not provide a legitimate interest in the disputed domain names under the Policy. Furthermore, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain names as it was never authorized to use the "NOTINO" trademark by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain names. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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 Respondent's website or location.

The Respondent registered the disputed domain names years after the use and registration of the "NOTINO" mark by the Complainant. In consideration of the reputation achieved by "NOTINO" it is clear that the Respondent was surely aware of the Complainant's trademark when he registered the domain names in dispute. Moreover, the Respondent appears to have attempted to benefit commercially from the appropriation of the "NOTINO" mark in the disputed domain names. The use of the famous mark "NOTINO", which is well-known in the perfumery sector, for offering for sale perfumes and cosmetics, clearly indicates that the disputed domain names were chosen by the Respondent to take advantage of the Complainant's mark reputation. This finding leads to the obvious conclusion that the disputed domain names have been registered in bad faith (Research In Motion Limited v. Privacy Locked LLC/Nat Collicot - WIPO Case No. D2009-0320; The Gap, Inc. v. Deng Youqian - WIPO Case No. D2009-0113; AXA S.A. v. P.A. van der Wees - WIPO Case No. D2009-0206; BHP Billiton Innovation v. Ravindra Bala - WIPO Case No. D2008-1059).

The Panel also finds that, by linking the disputed domain names highly similar to "NOTINO" to websites offering perfumes and cosmetics for sale (as made by NOTINO LIMITED), the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain, by causing a likelihood of confusion with the trademark "NOTINO" as to the source, sponsorship, affiliation or endorsement of its websites and the products promoted therein.

As the conduct described above clearly falls within paragraph 4(b)(iv) of the Policy (Triumph International Vietnam Ltd v. Tran Quoc Huy - WIPO Case No. D2017-0340), the Panel concludes that the Respondent registered and is using the disputed domain names in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOTINO.ART**: Transferred
2. **INONTINO.COM**: Transferred
3. **I-NOTINO.SITE**: Transferred
4. **NOTINO-TESTER.SITE**: Transferred

PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION 2021-06-23

Publish the Decision
