

Decision for dispute CAC-UDRP-103858

Case number CAC-UDRP-103858

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Domain names nuxeparis.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization LABORATOIRE NUXE

Complainant representative

Organization Marks & Clerk France

Respondent

Name NAZ BAKIR

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 has annexed to the Complaint as annex the details of a long series of registered trademarks for NUXE PARIS (“the NUXE PARIS trademark”) which are in evidence. That annex shows that the Complainant has very extensive trademark registrations for NUXE PARIS which are sufficient to demonstrate its standing to bring the present Complaint. It is true that many of the trademarks include an illustration and that they are, at least in part, design trademarks. However, they are also word trademarks as the words NUXE PARIS appear prominently on the marks and there is no doubt that the words are a prominent part of the trademarks and that they establish trademark rights sufficient to show the standing of the Complainant in this proceeding.

In particular, the Panel identifies two trademarks to establish that standing beyond question, which are:

(a) The French trademark registered at the National Institute of Industrial Property, No. 97687052, being the trademark for NUXE PARIS, registered by the Complainant on October 7, 1997; and

(b) the United States trademark, registered at the United States Patent and Trademark Office, No. 2447296, being the

trademark for NUXE PARIS, registered by the Complainant on May 1, 2001.

The Complainant is the registered owner of those trademarks.

It is clear that they were registered before the domain name was registered.

FACTUAL BACKGROUND

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

The Complainant is a French company that was incorporated in 1964 and which makes and sells personal care and related products.

It is the owner of several trademarks that include the word NUXE, including NUXE PARIS, that are registered with the trademark authorities in many countries.

It also owns numerous domain names that it uses in its business that include the word "nuxe", particularly <nuxe.paris>.

The Complainant has become concerned at the fact that the disputed domain name <nuxeparis.com> has been registered and, although it has not yet been used for an active website, the Complainant's concern is that it could be acquired by a party who would use it to tarnish the Complainant's trademark, brand and good reputation. That concern has been underlined by the fact that the Respondent has put the domain name up for sale and that it could be acquired by such a party. Accordingly, the Complainant has filed this Complainant to recover the domain name.

PARTIES CONTENTIONS

CONTENTIONS OF THE PARTIES

A. COMPLAINANT

1. The Complainant is a French company which makes and sells personal care and related products.
2. The Complainant is the registered owner of several trademarks including NUXE PARIS.
3. The Respondent has registered and is the domain name holder of the <nuxeparis.com> domain name ("the disputed domain name").
4. The disputed domain name is identical to the NUXE PARIS trademark. The domain name is also identical to at least one the Complainant's domain names, <nuxe.paris>.
5. The disputed domain name was registered improperly because it was made with the intention of infringing the Complainant's prior rights in the NUXE PARIS trademark.
6. The disputed domain name was registered with the intention of infringing the Complainant's NUXE PARIS trademark and misleading and confusing the Complainant's clients and potential clients and putting the domain name up for sale for the benefit solely of the Respondent.
7. The disputed domain name is inactive, showing that the registration was not made in good faith.
8. The disputed domain name is currently advertised as being for sale.
9. The Respondent has no rights or legitimate interests in the disputed domain name. That is so because the Complainant has never given any permission to the Respondent to make any use of the Complainant's mark in a domain name or elsewhere, apply for registration of the disputed domain name, use it in the context of beauty or otherwise or put it up for sale.
10. Nor has the Respondent made anything like a fair use of the disputed domain name.
11. The Respondent has registered and used the domain name in bad faith. That is so because the Respondent must have known of the Complainant's rights to its prominent NUXE PARIS and NUXE trademarks and their use in the fields of cosmetics and beauty products. A simple Google search would have made this plain to the Respondent and thus would have put the Respondent on notice that its registration of the domain name would be in bad faith and also that its use by the Respondent in possessing the domain name and putting it up for sale would also be in bad faith.

12. Moreover, there is no legitimate reason for the registrant to register and retain the domain name and put it up for sale. The clear intention of the Respondent in acquiring the domain name was to mislead and divert the Complainant's present and potential clients.

13. In sum, the conduct of the Respondent in registering and retaining the domain name and putting it up for sale is a clear case of cybersquatting.

B. RESPONDENT

No administratively compliant Response has been filed by the Respondent.

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated June 11, 2021 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint had not sufficiently identified the Respondent.

The notification invited the Complainant to have regard to the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder.

On June 11, 2021, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The 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 domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the NUXE PARIS trademark and as such has rights in that trademark.

The Panel next finds that the <nuxeparis.com> disputed domain name is identical and/or confusingly similar to the NUXE PARIS trademark for the following reasons.

First, the domain name includes the entirety of the NUXE PARIS trademark and the domain name does not contain any content other than the trademark and the “.com” top level domain. Accordingly, the domain name would inculcate in the mind of the user the idea that the domain name was an official domain name of the Complainant as it contained only the NUXE PARIS trademark.

Secondly, the domain name would convey to the objective bystander that it related in particular to the activities of the Complainant in Paris and/or that the owner of the domain name was based in Paris and was the well-known Complainant.

It is also now well established that the addition of a generic Top-Level Domain, such as “.com” in the present case, cannot negate identity or confusing similarity that is otherwise present, as it is in the present case.

Accordingly, the domain name is identical and/or confusingly similar to the Complainant’s trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] 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 [respondent] (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 [respondent] are 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The Complainant has proved that it owns the NUXE PARIS trademark and that the Respondent has registered a domain name that is virtually an exact copy of the trademark and it now trying to sell it.

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the trademark NUXE PARIS and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that the Respondent is not commonly known by the domain name under Policy paragraph 4(c)(ii).

The disputed domain name is inactive and does not point to a legitimate website or page promoting a business or some other legitimate activity but merely advertises that the domain name is for sale. It is now well established that such conduct suggests that the domain name holder has acquired the domain name with the intention of selling or renting it to the Complainant or a competitor or that, taken together with all the circumstances, the Respondent was motivated only by the illegitimate purpose of selling or renting the domain name for money and that this cannot give rise to a right or legitimate interest in the domain name. The Panel so holds in the present proceeding.

The Panel also agrees with the submission of the Complainant that the inference can be drawn that the disputed domain name was registered with the intention of infringing the Complainant's trademark and misleading and confusing the Complainant's clients and potential clients.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four 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.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b) (i) of the Policy and probably within other provisions of paragraph 4 (b) as well.

That is so for the following reasons.

First, the Complainant submits that the Respondent must have been aware of Complainant and its well-known trademark at the time of registration of the disputed domain name. The Panel agrees. Because of the fame and strong reputation of the NUXE PARIS trademark, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the disputed domain name. The Panel agrees with the submission of the Complainant that the Respondent must have known of the Complainant's rights to its prominent NUXE PARIS and NUXE trademarks and their use in the fields of cosmetics and beauty products. A simple Google search would have made this plain to the Respondent and thus would have put the Respondent on notice that its registration of the domain name would be in bad faith. By that means the Respondent, in registering the domain name deceptively and without any authority to do so, must be taken to have created a likelihood of confusion, probably with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Alternatively, the Respondent must have thought and hoped that it could force the Complainant or a competitor to buy the domain name and to that end acquired it and put it up for sale. There is no other logical explanation for that conduct. Accordingly, the domain name was registered in bad faith.

Secondly, the Complainant submits correctly that the disputed domain name has been put up for sale and it exhibits the advertisement to that effect. The Panel accepts the Complainant's evidence. Thus, the Complainant has proved that the Respondent has used the domain name in bad faith.

Thirdly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the NUXE PARIS mark and in view of the conduct that Respondent has engaged in when using the domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

The Complainant's submission on all of these matters is supported by prior UDRP decisions too numerous to mention.

The Complainant has therefore made out its case and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. NUXEPARIS.COM: Transferred

PANELLISTS

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|------|-------------------------|
| Name | The Hon. Neil Brown, QC |
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DATE OF PANEL DECISION 2021-07-08

