

Decision for dispute CAC-UDRP-103850

Case number CAC-UDRP-103850

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Domain names notinos.club

Case administrator

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

Complainant

Organization NOTINO LIMITED

Respondent

Name Claudiu Badea

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, NOTINO LIMITED, is the owner of the following trademarks:

- „NOTINO“, No. 015221815, verbal;
- „NOTINO TODAY IS YOURS“, No. 015944127, figurative;
- „NOTINO TRY&BUY“, No. 016743965, figurative;
- „NOTINO TRY&BUY“, No. 016804049, figurative;
- „NOTINO“, No. 017471574, verbal;
- „NOTINO“, No. 018071749, figurative.

FACTUAL BACKGROUND

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

The applicant NOTINO LIMITED, reg. No.: 248505, a company with its registered seat at 1015 Nicosia, Athinon, 5, Hourdovadgis House, Cyprus (hereinafter the „NOTINO LIMITED“), is the sole shareholder of the company Notino, s.r.o., reg. No.: 27609057, with its registered seat at Londýnské náměstí 881/6, Štýřice, 639 00 Brno, the Czech Republic (hereinafter the „Notino“).

NOTINO LIMITED is the holder of the domain <notino.cz> and other variations (such as <notino.sk>, <notino.pl>, <notino.it>, <notino.dk>, <notino.hu>, etc.), on which Notino runs e-shops with cosmetics, perfumes and other related goods in almost all the European Union and also outside the EU and the brand and eshops are well establish within the EU and its customers.

NOTINO LIMITED is also the owner of the following trademarks:

- „NOTINO“, No. 015221815, verbal;
- „NOTINO TODAY IS YOURS“, No. 015944127, figurative;
- „NOTINO TRY&BUY“, No. 016743965, figurative;
- „NOTINO TRY&BUY“, No. 016804049, figurative;
- „NOTINO“, No. 017471574, verbal;
- „NOTINO“, No. 018071749, figurative.

Those marks are valid, among others, for Classes 35 and 39 of the Nice Classification, which protect retail services and the transport of goods to customers.

Notino is the owner of the corporate name “Notino, s.r.o.”, as shown in the extract from the commercial register of Notino.

On the e-shops www.notino.cz (and other variations), Notino sells cosmetics and other goods to the end-customers. All the services provided are protected by the NOTINO trademarks.

The disputed domain names <notinos.club> was registered by the Respondent at the registrar Go Daddy, LLC.

After entering the disputed domain name into an Internet browser and coming to the website www.notinos.club, the webpage is blank.

PARTIES CONTENTIONS

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, 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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (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.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The disputed domain name is confusingly similar to the Complainant's trademarks and company name. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

- a) disregarding the top-level suffix in the domain name (i.e. ".club"); and
- b) finding that the mere adding, deleting or substituting letters or numbers of the Complainant's registered marks does not in any way automatically preclude a finding of confusing similarity. See e.g. WIPO/D2000-0588 (gameb0y), WIPO/D2000-0999 (<telstraa.com>), CAC/101449 (<boehringer-inqelheim.com>), CAC/101436 (<boehringer-ingl1heim.com>) and CAC/101517 (<boehringeringelhein.com>).

The Panel agrees with the Complainant that the addition of the letter "S" in the disputed domain name <notinos.club> is not sufficient to prevent a likelihood of confusion from arising. The dominant and distinctive element NOTINOS of the disputed domain name is certainly visually confusingly similar and for all intents and purposes phonetically nearly identical to the Complainant's mark and company name NOTINO. Additionally, the addition of the letter "S" could simply be seen by members of the relevant public as the plural form of the name in question, thus making the similarity even more pronounced.

As a result, it is held that there is a likelihood of confusion. The Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name. Neither does the Complainant have any kind of relationship with the Respondent. The Respondent has not been granted an authorization or license or any other approval from the Complainant whether express or implied to use the NOTINO marks or identical or

confusingly similar marks. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has established that the disputed domain name resolves to a website which is free of content. In previous decisions, this has been considered an indication of bad faith if the totality of circumstances supported this finding and the Respondent did not refute the allegation of bad faith.

In particular, this was held if the Respondent did not submit a response or failed to provide any evidence of actual or intended use in good faith. In this case, the Respondent submitted no response at all.

It was also held that this was more likely if the Complainant's mark was distinctive or had a reputation. The marks containing the element NOTINO are not descriptive and are found to be distinctive.

It has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. Making use of this opportunity, it was easy to establish that the earlier rights are registered by Europe's largest online retailer for perfumes and cosmetics which achieved a record annual turnover of over 560 million euros in 2020. This corresponds to an increase of more than EUR 190 million compared to the previous year and an increase of 42% compared to the previous year (see <https://newsbeezer.com/>). The mark is therefore widely used, and it may be considered that the Respondent was well aware of the mark when the domain was registered on June 2, 2020. For that reason, it seems implausible that the domain could actually be put to use which would be considered good faith.

The information above was readily available in the public domain and was taken into consideration for this decision. However, the failure to provide such information with the complaint is neither good practice, nor is it acceptable to all panels and panelists. The Complainant should therefore take heed to provide the information required to adjudicate the Complainant's case with the due diligence expected from a professional in future.

Nevertheless, the information provided, and the totality of the circumstances of the case lead to the conclusion that it has been established to the satisfaction of the Panel that the disputed domain name was registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. NOTINOS.CLUB:

PANELLISTS

Name	Udo Pfléghar, B.A.
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DATE OF PANEL DECISION 2021-07-28

