

Decision for dispute CAC-UDRP-103965

Case number CAC-UDRP-103965

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Domain names jonachaussures.online

Case administrator

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

Complainant

Name Joseph NAKAM

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Stephen Pressler

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 is the registrant of the following trademarks:

- international trademark No. 625324 "JONAK", registered on October 14, 1994, for goods and services in classes 18 and 25;
- EU trademark No. 2580223 "JONAK", registered on August 7, 2003, for goods and services in classes 18 and 25.

The disputed domain name was registered by the Respondent on June 21, 2021.

FACTUAL BACKGROUND

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

The Complainant operates in the field of women's footwear under the trade name "JONAK".

The Complainant is the owner of several trademarks "JONAK".

The Complainant also uses several domain names including the trademark JONAK, such as the domain name <jonak.fr> registered and used for its official website since 1999.

The disputed domain name was registered on June 21, 2021. It redirects to a website purporting to be an online store selling the Complainant's JONAK products at discounted prices.

The Complainant asserts that the deletion of the letter "K" in the trademark JONAK and the addition of the term "CHAUSSURES" (meaning "SHOES" in French, i.e. a reference to the Complainant's activities) are not sufficient to escape the finding that the domain name is confusingly similar to the trademark JONAK. It does not change the overall impression of the designation as being connected to the Complainant's trademark JONAK. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark.

Thus, the disputed domain name is confusingly similar to the Complainant's trademark JONAK.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name.

The Complainant contends that the Respondent is not a licensee or distributor of the Complainant, he has no rights or legitimate interests in respect of the disputed domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark JONAK, or apply for registration of the disputed domain name by the Complainant.

The Complainant asserts that the disputed domain name resolves to a website at which is displayed the Complainant's trademark and a range of the Complainant's goods purportedly being offered for sale at discount prices. Furthermore, there is no information/disclaimer for identifying the owner of website.

The only information regarding the manager of the website is the mention of the name "DoraSale.co" in the privacy page. This company is mentioned in various other privacy pages for different well-known trademark, with domain names including parts of third parties' trademarks.

Therefore, the Complainant contends that the Respondent has used the disputed domain name to promote a fake web shop purporting to sell the Complainant's products, in an effort to induce unsuspecting Internet users into making payments for goods that the Respondent has no intention of providing.

Accordingly, the Respondent has no rights or legitimate interests in the disputed domain name.

The disputed domain name was registered many years after the Complainant first registered its JONAK trademark. Indeed, the trademark is registered since 1994.

Furthermore, the Respondent registered the disputed domain name without having any authorization from the Complainant to make use of its trademark or any variation thereof, in a domain name or otherwise, with intent to use it in an attempt to create a misleading impression of association with the Complainant in the furtherance of a fraudulent scheme. Indeed, the misspelling of the trademark JONAK associated with the French term "CHAUSSURES", meaning "SHOES", can only target the Complainant and its trademark, as the trademark JONAK covers class 25 for shoes, and the brand JONAK is used in connection with shoes.

Moreover, the Complainant's trademark and logo are displayed on the website.

Thus, the Complainant contends that the Respondent has knowledge of the Complainant's rights prior to the registration of the disputed domain name, which is a hallmark of bad faith.

Besides, by using the disputed domain name to misleadingly hold itself out as the Complainant and to promote a fake web shop targeting customers of the Complainant, the Respondent has attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and goods purportedly advertised therein.

Finally, the Respondent's registration of the disputed domain name using a privacy service, together with the lack of contact information about the owner on the Respondent's website, is further evidence of bad faith.

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

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

- (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.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and,

if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "JONAK", identified in section "Identification of rights" above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain name.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

It is well established that a domain name which contains a common or obvious misspelling of a trademark normally will be found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principal component of the domain name (see, for example, WIPO Case No D2016-2545).

In the present case, the Panel considers that the disputed domain name is confusingly similar to the Complainant's "JONAK" trademark for the following reasons: (a) "JONAK" is a distinctive word; (b) the only difference between the "JONAK" trademark and the disputed domain name is that in the latter the final letter "K" is missing and the generic word "chaussures" ("shoes" in French) has been added; (c) the fact of deleting the letter "K" in the disputed domain name and adding the word "chaussures" does not create any new word, or give the disputed domain name any distinctive meaning; (d) the disputed domain name is a deliberate misspelling of the Complainant's "JONAK" trademark, with the only addition of the generic term concerning the type of product sold; and (e) visually the disputed domain name is so close to the Complainant's "JONAK" trademark, with the addition of the generic term "chaussures", that confusion is inevitable between them.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or
- (iii) [the Respondent] [is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Respondent is not identified in the Whois database as the disputed domain name;
- the Respondent is not commonly known by the disputed domain name;
- the Respondent is not a licensee or distributor of the Complainant;
- the Respondent is not related with the Complainant in any way;
- the Complainant does not carry out any activity for, nor has any business with the Respondent;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- neither license 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 is used to host a website to impersonate the Complainant and attempt to mislead consumers into thinking that the "JONAK" products purportedly offered for sale at discounted prices on that website originate from the Complainant;
- in the above-mentioned website there is no information or disclaimer identifying the website's owner.

Taking into account the fact that, based on the information of the Whois database, the Respondent is not commonly known by the disputed domain name, that no business nor authorization exists between the Complainant and the Respondent, and that a website impersonating the Complainant was used, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] 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 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 [the Respondent's] 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 [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel accepts the Complainant's argument that the Respondent had knowledge of the Complainant's trademark when registering the disputed domain name. Indeed, the disputed domain name, registered many years after the registration of the Complainant's trademark, contains a misspelling of the Complainant's trademark associated with the generic word "chaussures" and the website contains information about products bearing the Complainant's trademark, therefore it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "JONAK" when registering the disputed domain name.

Furthermore, the Panel accepts the Complainant's unchallenged assertions that, by using the disputed domain name to misleadingly hold itself out as the Complainant and to promote a fake web shop targeting customers of the Complainant, the Respondent has attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and goods purportedly advertised therein. Indeed, the website gives the impression to be endorsed or connected with the Complainant and there is no disclaimer of information identifying the website's owner (which is not even available in the Whois search because of the use of a privacy service).

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. JONACHAUSSURES.ONLINE: Transferred

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION 2021-09-02

Publish the Decision
