

Decision for dispute CAC-UDRP-104392

Case number CAC-UDRP-104392

Time of filing 2022-03-03 09:25:08

Domain names zadigstore.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization ZV HOLDING

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Luis Alberto Fernandez Garcia

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 owner of the international trademark No. 907298 ZADIG & VOLTAIRE® registered since September 15, 2006 in classes 03, 14, 16, 18, 20, 24, 25, 35, 43.

In addition, the Complainant owns the domain name <zadig-et-voltaire.com> created on May 16, 2002.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS:

In accordance with the Registrar's verification dated March 03, 2022, the language of the Registration Agreement is Spanish, however, the Complainant requested change of the language to English based on the fact that the disputed domain name is constituted of the Complainant's trademark and the English term "STORE".

II. ABOUT THE COMPLAINANT:

The Complainant is a French company in the fashion industry established in 1997 by Thierry Gillier. The brand ZADIG & VOLTAIRE stands for ready-to-wear fashion, accessories and perfumes.

The Complainant is the owner of trademarks "ZADIG & VOLTAIRE®" as well one domain name, including the term "ZADIG & VOLTAIRE®" since 2006 & 2002 respectively.

The disputed domain name <ZADIGSTORE.COM> was registered on February 16, 2022 by Luis Alberto Fernandez Garcia based in Spain and it resolves to a website purporting to be an online store selling the Complainant's ZADIG & VOLTAIRE products at discounted prices.

According to Complainant's non-contested allegations, the Respondent has no rights or legitimate interest in respect of the disputed domain name and he is not related in any way to the Complainant's business.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is Spanish.

Respondent did not reply to the Complaint.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

First element: Similarity

The Complainant states that the disputed domain name <ZADIGSTORE.COM> is confusingly similar to its trademark ZADIG & VOLTAIRE®.

The Complainant asserts that the disputed domain name incorporates the first and main part (ZADIG) of Complainant's trademark ZADIG & VOLTAIRE® in its entirety. The addition of the term "STORE" refers to the Complainant's shops. In this regard, Complainant indicates that the addition does not prevent a finding of confusing similarity as the Complainant's trademark remains clearly recognizable.

Second element: Rights or legitimate interest

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the Respondent is not related in any way to the Complainant's business.

The Complainant asserts that the Respondent is not affiliated with him nor authorized by him in any way to use the trademark ZADIG & VOLTAIRE®. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Complainant indicates that the disputed domain name is used to host the website to impersonate Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from Complainant. The Complainant argues that such use demonstrates neither a bona fide offering of goods nor a legitimate interest of Respondent.

Third element: Bad faith

The Complainant indicates that the trademark ZADIG & VOLTAIRE® had been used and registered by Complainant before the registration of the disputed domain name and, therefore, it is more likely that Respondent had Complainant's mark in mind when registering the disputed domain name.

The Complainant indicates that the Respondent should have known about Complainant's rights, as such knowledge is readily obtainable through a simple browser search and also due to Complainant's nature of business, provided also online, namely online sales.

In addition, the Complainant argues that the content of the website gives the impression that it originates from Complainant, prominently displaying ZADIG & VOLTAIRE® signs on the website and with this giving the false impression that the website comes from Complainant. In the Complainant's view, this is an additional indication of the registration in bad faith since the likelihood of confusion is reinforced as Internet users are likely to consider the disputed domain name as in some way endorsed by or connected with Complainant.

RESPONDENT:

Respondent did not reply to the Complaint.

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

I. Language of proceedings

Before deciding on the merits, the Panel will decide on the request made by the Complainant concerning the change of language of proceedings.

In accordance with paragraph 11 of the UDRP Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant has requested a change of the language of proceedings (from Spanish to English) based on the following two facts: i) The domain is constituted of the Complainant's trademark and English term "STORE" and ii) the complaint should be in English for better understanding of the parties.

The paragraph 10 of the UDRP Rules vests the Panel with the authority to conduct the administrative proceedings in such a manner as it considers appropriate with the Policy and the Rules as long as the parties are treated with equality, and that each party is given a fair opportunity to present its case.

In light of the above, panels have found that some scenarios may give the possibility to grant a change in the language of proceedings such as: (i) any content on the webpage under the disputed domain name, (ii) potential unfairness or unwarranted delay in ordering the Complainant to translate the complaint, (iii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (iv) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.

(see paragraph 4.5. WIPO Overview 3.0).

As stated by the Complainant, the disputed domain name is composed of the Complainant's trademark ZADIG and the

English word “STORE” which gives an indication that the Respondent understands the English language. Since Respondent did not reply to the Complaint, the Panel does not find any element which could impede the use of English as the language of proceedings.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner and therefore, the Panel does not see any need to put the Complainant into a disadvantage of making him to translate the Complaint into Spanish and to conduct the proceeding in Spanish.

In light of the above, the Panel determines that English be the language of the proceeding

II. Substantive issues.

(A) THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE TRADEMARK ZADIG & VOLTAIRE® OF THE COMPLAINANT.

The Uniform Domain Name Dispute Resolution Policy (the Policy) in its Paragraph 4(a)(i) indicates the obligation of Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

The Complainant has submitted evidence showing the ownership of the international trademark ZADIG & VOLTAIRE® dated September 15, 2006 in classes 03, 14, 16, 18, 20, 24, 25, 35, 43.

From the Panel’s perspective, the disputed domain name <ZADIGSTORE.COM> comprises the exact reproduction of the term “ZADIG” – which is part of Complainant’s trademark ZADIG & VOLTAIRE®, followed by the generic word “STORE”.

Furthermore, the addition of the Top-Level Domain Name “.com” in a domain is considered as a standard registration requirement and, therefore, it should be disregarded under the first element confusing similarity test (see paragraph 1.11 WIPO Overview 3.0).

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is confusingly similar to Complainant’s mark.

(B) RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach by UDRP panels, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it (see WIPO Jurisprudential Overview, version 3.0., paragraph 2.1).

The Complainant indicates that the Respondent is not affiliated nor authorized in any way to use the trademark ZADIG & VOLTAIRE®. Furthermore, the Complaint argues that it does not carry out any activity for, nor has any business with the Respondent. Finally, the Complainant has not granted a license or authorization to the Respondent to make any use of the trademark ZADIG & VOLTAIRE®.

In accordance with Complainant’s evidence, the website associated with the disputed domain name resolves to an active site showing an online shop offering Complainant’s goods (e.g. bags). At the website, the Complainant’s trademark ZADIG & VOLTAIRE® is also displayed. As indicated by the Complainant, there is no disclaimer at the website.

When it comes to the selling of original goods in websites, previous panels have accepted that resellers, distributors and service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. In this regard, the following cumulative requirements (the “Oki Data test”) will be applied in the specific conditions of a UDRP case:

(i) the respondent must actually be offering the goods or services at issue;

- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

Cases applying the Oki Data test usually involve a domain name comprising a trademark plus a descriptive term (e.g., "parts", "repairs", or "location"), whether at the second-level or the top-level.

(see paragraph 2.8.1. WIPO Overview 3.0).

From the evidence presented by the Complainant, it is clear that the Respondent failed at least in one of the elements of the Oki Data test, i.e. the website linked to the disputed domain name does not disclose accurately and prominently the registrant's relationship with the trademark holder.

Since Respondent did not reply to this Complaint and did not provide with evidence of the types specified in paragraph 4 (c) of the Policy, or of any circumstances, giving rise to rights or legitimate interests in the disputed domain name, the Panel concludes that the Respondent does not have any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH IN ACCORDANCE WITH THE POLICY.

Paragraph 4(a)(iii) of the Policy indicates that Complainant must assert that the Respondent registered and is using the disputed domain name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in 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 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 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 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.

The evidence submitted by Complainant confirms that its trademark ZADIG & VOLTAIRE® is distinctive. The Panel shares the Complainant view that by doing a simple browser search the Respondent should have been made aware of the existence of Complainant's rights. In this regard and absent of Respondent's reply, the Panel finds that Respondent, prior to the registration of the disputed domain name was aware of Complainant's trademark, in particular since the disputed domain name was registered on February 16th, 2022 and Complainant's trademark was registered long before the registration of the disputed domain name.

Based on the above, the Panel is of the opinion that Respondent acquired the disputed domain name with the only intention to attract for commercial gain internet users to the Respondent's website. The lack of reply to this Complaint is also a strong indication that the Respondent registered the disputed domain name in bad faith.

As mentioned by the Complainant, the Respondent is not identified in the Whois database of the disputed domain name. In fact, it seems that the Respondent is using "Private Whois" as Registrant's name.

Past Panels have found the following concerning the use of privacy and proxy registration services:

There are recognized legitimate uses of privacy and proxy registration services; the circumstances in which such services are used, including whether the respondent is operating a commercial and trademark-abusive website, can however impact a panel's assessment of bad faith.

In terms of underlying respondent identity, panels treat privacy and proxy services as practical equivalents for purposes of the UDRP, and the fact that such services may be employed to prevent the complainant and panel from knowing the identity of the actual underlying registrant of a domain name does not prevent panel assessment of the UDRP elements.

Where it appears that a respondent employs a privacy or proxy service merely to avoid being notified of a UDRP proceeding filed against it, panels tend to find that this supports an inference of bad faith; a respondent filing a response may refute such inference.

Panels additionally view the provision of false contact information (or an additional privacy or proxy service) underlying a privacy or proxy service as an indication of bad faith.

In some cases, particularly where the respondent does not avail itself of the opportunity to respond to claims based on the timing of the registration of the disputed domain name (such as a materially relevant change in underlying registrant), panels have been prepared to infer that the use of a privacy or proxy service may seek to mask the timing of the respondent's acquisition of the domain name.

Panels have also viewed a respondent's use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual underlying registrant as an indication of bad faith. (see paragraph 3.6. WIPO Overview 3.0).

Therefore, the Panel concludes that Respondent registered and is using the disputed domain name in bad faith and thus has 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. ZADIGSTORE.COM: Transferred

PANELLISTS

Name	Victor Hugo Garcia Padilla, LL.M.
------	-----------------------------------

DATE OF PANEL DECISION 2022-04-03

Publish the Decision
