

Decision for dispute CAC-UDRP-104653

Case number **CAC-UDRP-104653**

Time of filing **2022-06-17 09:11:18**

Domain names **jonak-outlet.shop**

Case administrator

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

Complainant

Name **Joseph NAKAM**

Complainant representative

Organization **NAMESHIELD S.A.S.**

Respondent

Name **Amanda Gorman**

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 owner of the international trademark No. 625324 "JONAK", which was registered on October 14, 1994 and the European trademark No. 002580223 "JONAK", which was registered on February 15, 2002 (hereinafter referred to as the "Trademark").

FACTUAL BACKGROUND

The Complainant is the CEO of the company KARINE, operating under the trade name "JONAK", which specializes in women's footwear.

Apart from the mentioned trademarks, the Complainant also owns several domain names including the Trademark, such as the domain name <jonak.fr>, which is used for its official website.

The disputed domain name <jonak-outlet.shop> was registered on June 9, 2022 and is connected to an active website, which seems to sell "jonak" products at a discounted price.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the Trademark.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In this regard, the Complainant states that the Respondent is not commonly known by the disputed domain name, that it is not affiliated with nor authorized by the Complainant in any way, that the Complainant does not carry out any activity for, nor has any business with the Respondent, and that neither license nor authorization has been granted to the Respondent to make any use of the Trademark or apply for registration of the disputed domain name by the Complainant.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It contends that the Respondent has registered Complainant's well-known Trademark with full knowledge and that Respondent's use of the disputed domain name as a website to sell counterfeit or unauthorized versions of Complainant's products in direct competition with him establishes bad faith registration and use of the disputed domain name under para. 4(a)(iii) of the Policy.

RESPONDENT:

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

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; 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.

1. The Panel accepts that the disputed domain name is confusingly similar to the Trademark as it fully incorporates it. It is well established that a domain name that wholly incorporates a trademark may be confusingly similar to such trademark for purposes

of the Policy, and the addition of the generic term, such as "outlet" does not limit this similarity. The Panel agrees that the addition of the generic TLD ".shop" does not affect the confusing similarity of the disputed domain name.

2. The Complainant has presented and substantiated a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

Panels have recognized that resellers, distributors, or 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. Outlined in the "Oki Data test", the following cumulative requirements 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.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark." (WIPO Overview 3.0, section 2.8)

In this case, the Respondent's website does not accurately or prominently disclose the Respondent's relationship with the Complainant, in particular that it is not an authorized dealer or has any particular connection with the Complainant. Rather, its prominent display of the JONAK Trademark, its reproduction of the Complainant's logo and the absence of a disclaimer or any explanation as to the identity of the operator of the Respondent's Website results in the impression that the Respondent's Website is an official website of the Complainant. Even in the event that the Respondent is reselling genuine JONAK products, its use of the disputed domain name for the Respondent's website in the circumstances described above does not grant rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent did not deny these assertions in any way and therefore failed to prove any rights or legitimate interests in the disputed domain name.

3.1 The Panel is satisfied that the Respondent registered the disputed domain name with full knowledge of the Complainant and its rights in the Trademark as the Trademark is highly distinctive and well-established. The Respondent's website contains numerous references to the Complainant, including purporting to offer the Complainant's products for sale and reproducing the Complainant's logo. The registration of the disputed domain name in awareness of the JONAK Trademark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

3.2 Furthermore, the Respondent registered the disputed domain name for the purposes of operating a website specifically to sell either the Complainant's products or counterfeit products that compete with the Complainant's. The Respondent is using the disputed domain name, being identical to the JONAK Mark, to sell products, be they genuine or otherwise, in competition with the Complainant and without the Complainant's approval and without meeting the Oki Data test. Consequently, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant and the Complainant's JONAK Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website.

Accordingly, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith 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. **JONAK-OUTLET.SHOP**: Transferred

PANELLISTS

Name	Stefania-Despoina Efstathiou, LL.M. mult.
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DATE OF PANEL DECISION	2022-07-21
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Publish the Decision