

Decision for dispute CAC-UDRP-104651

Case number CAC-UDRP-104651

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Domain names zadigvoltairefr.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Z&V

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Qin Deng

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 submitted evidence that it is the registered owner of the following trademarks:

- the European Union trademark no. 005014171 for the "ZADIG & VOLTAIRE" word in class 3 having protection since 17 March 2006; and
 - the international trademark registration no. 907298 for the "ZADIG & VOLTAIRE" word, registered on 15 September 2006 in classes 3, 14, 16, 18, 20, 24, 25, 35 and 43 designating numerous countries around the world and having its basic registration in France.
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FACTUAL BACKGROUND

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

The Complainant, operating under the brand ZADIG & VOLTAIRE, 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.

In addition to the asserted trademarks, the Complainant also holds a domain names portfolio comprising the same distinctive wording "ZADIG & VOLTAIRE", such as the domain name <zadig-et-voltaire.com> registered and used for the Complainant's official website since 16 May 2002.

The disputed domain name <zadigvoltairefr.com> was registered on 9 June 2022 and redirects to a website purporting to be an online store selling the Complainant's ZADIG & VOLTAIRE products at discounted prices.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

The Complainant states that the disputed domain name is confusingly similar to its trademark "ZADIG & VOLTAIRE" as it incorporates the Complainant's trademark, without the "&". The Complainant contends that it does not eliminate the likelihood of confusion with the trademark and refers to earlier UDRP case law according to which ampersands are prohibited characters in domain names and the omission of ampersands is therefore disregarded from the similarity analysis (Forum Case No. FA 1764056).

Moreover, the Complainant asserts that the addition of the term "FR" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and branded goods "ZADIG & VOLTAIRE". It does not change the overall impression of the designation as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and the domain name associated.

The Complainant also mentions that it is well-established in UDRP decision-making that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (WIPO Case No. D2003-0888).

Furthermore, the Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Thus, the Complaint concludes that the disputed domain name is confusingly similar to its trademark "ZADIG & VOLTAIRE".

Furthermore, the Complainant points to the established case law on prima facie case.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name.

The Respondent is not known by the Complainant. The Complainant contends that Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 "ZADIG & VOLTAIRE" or apply for registration of the disputed domain name by the Complainant.

Furthermore, the domain name is used to host the website to impersonate the Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from Complainant. Such use demonstrates neither a bona fide offering of goods nor a legitimate interest of Respondent. Furthermore, there is no information/disclaimer on the page of the website to identify its owner. Therefore, 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.

Accordingly, the Complainant is of the view that the Respondent has no rights or legitimate interests in the disputed domain name.

Turning to the bad faith argument, the Complainant states that the disputed domain name is confusingly similar to its trademark "ZADIG & VOLTAIRE" which was registered several years before the registration of the disputed domain name. The Complainant is a worldwide and well-known fashion company, and the Respondent makes references to the Complainant's products and trademarks on the website. On those facts, given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks.

The Complainant further finds that Respondent registered and uses the domain name in bad faith to create confusion with Complainant's trademarks for commercial gain by using the confusingly similar domain name to resolve to a website offering counterfeit or unauthorized versions of Complainant's products in direct competition with the Complainant's products. Using a confusingly similar domain name to trade upon the goodwill of a complainant can evince bad faith under the Policy.

Based on the above, the Complainant contends that the Respondent acquired the disputed domain name with the only intention to attract for commercial gain Internet users to the Respondent's website as mentioned in CAC Case No. 104392, ZV HOLDING v. Luis Alberto Fernandez Garcia.

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

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"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall 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.

According to Paragraph 4(a) of the Policy, a complainant must prove each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainant demonstrated that it owns the asserted trademark registrations for the word mark "ZADIG & VOLTAIRE" which were obtained many years before the registration of the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

The disputed domain name incorporates the Complainant's trademark "ZADIG & VOLTAIRE" in its entirety. It differs from the Complainant's trademark only insofar as it incorporates the abbreviation "fr" and the gTLD ".com", while excluding the ampersand "&".

It is well established that the generic top-level suffix ".com" may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The adding of the suffix "-FR" must be considered as insufficient to prevent or diminish confusing similarity. This is true especially given that "FR" is widely recognized as the country code for France and the suffix would very likely be perceived as a geographical designation, in this case linked to the origins and headquarters of the Complainant, thus lacking distinctive character. This finding is consistent with earlier decisions of CAC (see CAC Case No. 101270 and CAC Case No. 101503).

Finally, with respect to the ampersand, previous UDRP panels have held that the symbol "is not used in the creation of domain names and that the functional equivalent of the ampersand is the word 'and' or the deletion of the sign" (see WIPO Cases No. D2000-0501 and D2003-0553).

With that in mind the Panel believes that, for the purposes of the similarity analysis, a proper comparison would be between "ZADIG VOLTAIRE" and "zadigvoltaire" which are basically identical.

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not known as the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy, nor is it affiliated with or authorized by the Complainant to use its trademark for commercial activities. Furthermore, it was demonstrated by evidence submitted by the Complainant that the disputed domain name is used to host a website that creates the impression that it belongs to the Complainant and attempts to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from the Complainant. Such use is neither a bona fide offering of goods nor a legitimate interest of the Respondent. Even if the Respondent used the domain name for reselling of the Complainant's products, the Panel has to agree with the Complainant that the website linked to the disputed domain name does not disclose accurately and prominently the Respondent's relationship with the Complainant as the trademark holder, thus failing the test established in the decision WIPO Case No. D2001-0903 (Oki Data Americas, Inc. v. ASD, Inc.).

The Panel has therefore determined that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainant states, in summary: (a) that the disputed domain name is confusingly similar to its trademark; (b) that the Respondent had actual knowledge of the Complainant's trademarks; and (c) that the Respondent acquired the disputed domain name with the only intention to attract for commercial gain Internet users to the Respondent's website.

The Panel has already found that the disputed domain name is confusingly similar to the Complainant's trademark "ZADIG & VOLTAIRE". It is well established that the mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith.

In addition, the Panel believes that the Complainant submitted evidence that sufficiently demonstrates the Respondent must have (or should have) been aware of the existence of the Complainant, its trademark as well as its domain names. It is difficult to find any good faith reason for the registration of the disputed domain name by the Respondent.

Regarding the use of the disputed domain name which contains a website that mimics the Complainant's website, including the Complainant's trademark and logo, and allegedly offers counterfeit or unauthorized versions of the Complainant's products, in the absence of any plausible explanation by the Respondent, the Panel finds this a blatant example of bad faith use of a domain name. Also, the Panel must agree with the Complainant in that the Respondent clearly acquired the disputed domain name with the intention to attract for commercial gain Internet users to the Respondent's website.

With that in mind, the Panel concludes that several signs of bad faith in registering and use of the disputed domain name by the Respondent can be found in this case. Therefore, the Panel finds that the disputed domain name has been registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. ZADIGVOLTAIREFR.COM: Transferred

PANELLISTS

Name
Mgr. Vojtěch Chloupek

DATE OF PANEL DECISION 2022-07-25

Publish the Decision
