

Decision for dispute CAC-UDRP-104877

Case number CAC-UDRP-104877

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Domain names isabel-marantus.com

Case administrator

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

Complainant

Organization IM PRODUCTION

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Xue Han

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 holder of various trademarks including the following:

- ISABEL MARANT, International trademark registration No. 1284453 registered on November 16, 2015 in classes 4, 8, 11, 16, 20, 27 and 28;
 - ISABEL MARANT, EU trademark registration No. 001035534 registered on May 3, 2000 in classes 3, 14 and 25.
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FACTUAL BACKGROUND

The Complainant is a French company specializing in the manufacture and marketing of ready-to-wear, shoes, handbags and jewellery.

The Complainant is the owner of several word marks for ISABEL MARANT, registered in several classes and covering various countries, including in China where the Respondent is located. The Complainant also owns the domain name <isabelmarant.com>, which resolves to the Complainant's official website.

The disputed domain name <isabel-marantus.com> has been registered on September 16, 2022 by the Respondent. According to evidence provided by the Complainant, the disputed domain name resolved to a website purporting to be an online store selling

clothing products at discounted prices. The disputed domain name currently resolves to a blocked page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant considers the disputed domain name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent's name does not correspond to the disputed domain name and thus not commonly known by the disputed domain name. Also, according to the Complainant, the Respondent has not been authorized to use the Complainant's trademark and is not related in any way with the Complainant. The Complainant finds that the use of the disputed domain name demonstrates neither a bona fide offering of goods nor a legitimate interest of the Respondent. Finally, the Complainant considers that the disputed domain name was registered and is being used in bad faith. The Complainant contends that given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademark. According to the Complainant, the Respondent registered and uses the domain name in bad faith to create confusion with the Complainant's trademarks for commercial gain by using the confusingly similar disputed domain name to resolve to a website offering counterfeit or unauthorized versions of the Complainant's products in direct competition with the Complainant's products.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions.

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

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the complainant to make out its case, and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. The standard of proof is the balance of probabilities.

Thus, for the complainant to succeed, it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of

probabilities, that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. The Respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Confusing similarity of the disputed domain name with existing rights

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant is the holder of registered ISABEL MARANT trademarks, which are used in connection with the Complainant's fashion business, it is established that there is a trademark in which the Complainant has rights.

The disputed domain name <isabel-marantus.com> incorporates the Complainant's ISABEL MARANT trademark in its entirety, merely adding a hyphen between the two words and the letters "US", which can be considered as referring to the abbreviation for "United States". In the Panel's view, these small additions do not prevent the Complainant's trademark from being recognizable within the disputed domain name (see section 1.8 of the WIPO Overview 3.0).

It is well established that the Top-Level Domains ("TLDs") such as ".com" may be disregarded when considering whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

For these reasons, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent (see section 2.1 WIPO Overview 3.0 and *Champion Innovations, Ltd. V. Udo Dussling (45FHH)*, WIPO case No. D2005-1094; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO case No. D2003-0455; *Belupo d.d. v. WACHEM d.o.o.*, WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is "Xue Han". The Respondent's use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Generally speaking, UDRP panels have found that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 WIPO Overview 3.0). In this case, the disputed domain name incorporates the Complainant's ISABEL MARANT trademark in its entirety and merely adds the letters "US" at the end, which can be considered as referring to the abbreviation for "United States". Therefore, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the WIPO Overview 3.0).

According to the Complainant's evidence, the disputed domain name resolved to a website mentioning the Complainant's ISABEL MARANT trademark numerous times and purporting to be an online store selling products similar or even identical to the Complainant's products at discounted prices. Moreover, the website does not accurately and prominently disclose the Respondent's identity. The Panel finds that such use does not amount to a bona fide offering of goods or services. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13 of the WIPO Overview 3.0).

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Based on the available record, the Panel finds that the Complainant has established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the disputed domain name, under paragraph 4(a)(ii)

of the Policy.

3. Bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070). In the instant case, the Panel finds that the Respondent must have had knowledge of the Complainant's rights in the ISABEL MARANT trademark at the moment it registered the disputed domain name:

- the disputed domain name is almost identical to the Complainant's distinctive ISABEL MARANT trademark except for the addition of two letters;
- some of the Complainant's trademarks were registered more than 20 years before the registration of the disputed domain name. At least one of the Complainant's trademarks was registered in China, where the Respondent is located, more than 5 years before the registration of the disputed domain name;
- at least one previous UDRP panel has confirmed the well-known character of the Complainant's mark in China;
- the website linked to the disputed domain name mentioned the Complainant's ISABEL MARANT trademark numerous times, and appeared to sell products similar or even identical to the Complainant's products.

In view of the use of the disputed domain name as described above, 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's mark as to the source, sponsorship, affiliation, or endorsement of the website or of a product or service on the website.

Moreover, given that the use of a domain name for per se illegitimate activity such as impersonation, the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith (see section 3.1.4 WIPO Overview 3.0).

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **isabel-marantus.com**: Transferred

PANELLISTS

Name	Flip Petillion
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DATE OF PANEL DECISION 2022-11-03

Publish the Decision
