

Decision for dispute CAC-UDRP-104916

Case number CAC-UDRP-104916

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Domain names bobbiesoutlet.shop

Case administrator

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

Complainant

Organization BOLZE & MOOGY

Complainant representative

Organization IP TWINS

Respondent

Name Denice Duo

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 relies on several trademark rights in the term BOBBIES, and in particular the following trademarks, registered well before the registration of the disputed domain name:

- French trademark BOBBIES N° 4291854 registered on 4 August 2016, designating goods in international classes 14 and 18;
- United States trademark BOBBIES (device) N° 79112915 registered on 14 May 2013, designating goods in international classes 18 and 25.

The Complainant claims to be the owner of <bobbies.fr> registered on 20 November 2009 and <bobbies.com>, which is actively used in connection with the Complainant's official website.

FACTUAL BACKGROUND

The Complainant is BOLZE & MOOGY, a French shoes and leather goods manufacturing and distribution company.

It operates in 8 stores in France and the United Kingdom, and has over 400 resellers across 50 countries in Europe, America, Africa and the Middle-East.

The Complainant submits that its earlier trademarks BOBBIES enjoy a wide-spread continuous reputation in relation with shoes and leather goods. The Complainant's Instagram page is followed by over 350.000 users.

The disputed domain name is <bobbiesoutlet.shop>. It was registered on 13 August 2022 and resolved to a website presenting and selling BOBBIES branded goods with a reduction of 85% on the displayed price.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

CONTENTIONS OF COMPLAINANT:

On the confusing similarity.

The disputed domain name is similar to the point of confusion to the earlier trademarks BOBBIES.

The trademarks of the Complainant are reproduced identically in the disputed domain name, and in attack position.

The second part of the domain name consists of the generic term "outlet". It is established case law that the addition of generic terms to a trademark in a domain name does nothing to diminish the likelihood of confusion arising from that domain name.

Adding this term only reinforces that risk. The Internet user of average attention will likely believe that the disputed domain name is either associated with or sponsored by the Complainant in connection with its business.

The ".shop" extension is not significant to determine whether the disputed domain name is identical or confusingly similar to the Complainant's trademarks.

The Complainant submits it has established rights in the term BOBBIES and that the disputed domain name is confusingly similar to its earlier trademarks.

- The Respondent does not have any rights or legitimate interest in the disputed domain name

At the time of original filing of the Complaint, the Whois available data did not provide the name of the registrant.

Firstly, the Complainant performed searches and found no BOBBIES trademark owned by the Respondent. From this finding, the Complainant asserts that the Respondent has acquired no trademark in the terms BOBBIES which would have granted the Respondent rights in the disputed domain name.

Secondly, the Respondent imitates the Complainant's earlier registered trademarks BOBBIES in the disputed domain name without any license or authorization from the Complainant, which is strong evidence of the lack of legitimate interest.

Thirdly, the Complainant puts forth that the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain name in relation to a bona fide offering of goods or services. On the contrary, the disputed domain name is actively used in connection with a website reproducing the name and logo of the Complainant, and offering BOBBIES-branded goods for sale at extremely low prices, with discounts up to 85% off the displayed price.

The website gives the false impression that it is owned, operated or endorsed by, or affiliated with, the Complainant. Accordingly, such use should not be considered to be a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903.

Fourthly, the registration and extensive use by the Complainant of the BOBBIES trademarks predate by far the registration of the disputed domain name.

Considering all these elements, the Respondent should be considered as not having any right or legitimate interest in respect of the disputed domain name. The second condition of the Policy should be deemed satisfied.

- The disputed domain name has been registered and is being used in bad faith

Firstly, the Complainant submits that the Complainant and its trademarks enjoy a long-standing reputation so much so that it is inconceivable that the Respondent ignored the Complainant or its earlier rights on the term BOBBIES.

The Respondent had the Complainant's name and trademark in mind when registering the domain name. This is simply evidenced by the use of the disputed domain name in connection with a website impersonating the Complainant.

A simple search on an online search engine provides results only related to the BOBBIES trademarks.

Secondly, the Complainant submits that it is highly likely that the Respondent chose the disputed domain name in the hope and

expectation that Internet users receiving e-mails from the disputed domain names believe that it originates from the Complainant, and will provide personal or banking details in confidence.

Such use of domain name must necessarily be seen as a bad faith use of the disputed domain name under the Policy.

The Complainant thus states that the Respondent acquired and is using the disputed domain name to attract Internet users by creating a likelihood of confusion with the Complainant's earlier marks, and to intentionally deceive Internet users.

Thirdly, the Complainant's BOBBIES trademark registrations significantly predate the registration date of the disputed domain name.

Fourthly, the current use of the disputed domain name in connection with an online store is further evidence of bad faith on the part of the Respondent. Indeed, it is clear that the Respondent is actively trying to benefit from the renown and fame of the Complainant and its brands to make commercial gain, by creating confusion in the mind of the Internet user of average attention.

The Complainant reiterates that the Respondent reproduces the trademarks of the Complainant as well as copyright visual resources of the Complainant in an active website, offering BOBBIES-branded goods for sale. The Complainant alleges that the active website linked to the disputed domain name is rather used for fake sales, with the sole intention of defrauding Internet users of average attention.

The Panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith.

Considering all the elements above, the Complainant contends that the disputed domain name was registered and is being used in bad faith by the Respondent. The combination of all the elements listed and detailed above unequivocally show that the Respondent has acted in bad faith, in line with the Policy.

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant is a French company that owns several BOBBIES trademarks, such as the French trademark BOBBIES N° 4291854 registered on 4 August 2016, designating goods in international classes 14 and 18.

The disputed domain name is < bobbiesoutlet.shop>.

The disputed domain name wholly incorporates the BOBBIES trademark.

It only differs from the BOBBIES trademark by the addition of the generic term "outlet".

Adding this generic term does not avoid the alleged confusing similarity.

Thus, the disputed domain name is confusingly similar to the BOBBIES trademark.

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

(i) before any notice to it 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 has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial 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.

The Complainant asserts that the Respondent is not related in any way with the Complainant and that it did not grant neither license nor authorization to use the BOBBIES trademarks or to register the disputed domain name. This allegation was not contested by the Respondent.

As already explained, the Respondent used the disputed domain name in connection with a website reproducing the name and logo of the Complainant, and offering BOBBIES-branded goods for sale at extremely low prices, with discounts up to 85% of the displayed price.

The website gives the false impression that it is owned, operated or endorsed by, or affiliated with, the Complainant. Accordingly, such use is not a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy.

The Respondent did not answer the complaint to rebut the arguments set forth in the Complaint

Therefore, the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in respect to the disputed domain name.

The Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the disputed domain name.

It provides that:

“For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, 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 the respondent has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the 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 the respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the 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 your 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 or service on the respondent’s website or location.”

The BOBBIES French trademark was registered in 2016, whereas the disputed domain name was registered on 13 August 2022.

The Panel finds that the BOBBIES trademark is distinctive. It is popular on the social networks, like Instagram.

Given the use of the disputed domain name, resolving to a website which impersonates the Complainant, it is reasonable to assume that the Respondent was well aware of the BOBBIES trademarks before the registration of the disputed domain name and that it registered it to target the internet users looking for BOBBIES branded goods.

The Panel is of the opinion that it is sufficient evidence for a finding of bad faith registration.

The Respondent has intentionally attempted to illegitimately attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s BOBBIES trademark, in the meaning of paragraph 4(b)(iv) of the Policy.

The Panel is of the opinion that it is sufficient evidence for a finding of bad faith use.

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

The disputed domain name incorporates the prior BOBBIES trademark.

The addition of the generic term "outlet" does not avoid the confusing similarity.

The Respondent did not answer to the complaint and the Complainant made a prima facie case that the disputed domain name was registered without right or legitimate interest and that it was registered and used in bad faith.

The disputed domain name resolved to a website presenting and offering BOBBIES branded goods with 85% reduction on the displayed price, and is therefore making a commercial use of the disputed domain name.

It was never authorized by the Complainant to register and use the disputed domain name.

The Respondent was well aware of the BOBBIES trademark when it registered the disputed domain name, to target and attract the internet users searching for BOBBIES branded goods.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **bobbiesoutlet.shop**: Transferred

PANELLISTS

| | |
|------|-------------------------------------|
| Name | Marie-Emmanuelle Haas Avocat |
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DATE OF PANEL DECISION **2022-11-22**

Publish the Decision
