

## Decision for dispute CAC-UDRP-104977

Case number CAC-UDRP-104977

Time of filing 2022-11-08 08:54:50

Domain names jonakparissolde.com

### Case administrator

Organization Denisa Bilík (CAC) (Case admin)

### Complainant

Name Joseph NAKAM

### Complainant representative

Organization NAMESHIELD S.A.S.

### Respondent

Name xue yu

#### 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 CEO of the company KARINE, operating under the trade name "JONAK". JONAK specializes in women's footwear.

The Complainant is the owner of several trademarks containing "JONAK", such as:

- The international trademark No. 625324 JONAK, which was registered on October 14<sup>th</sup>, 1994;
- The European trademark No. 002580223 JONAK, which was registered on February 15<sup>th</sup>, 2002.

The Complainant also owns several domain names including the trademark JONAK®, such as the domain name <jonak.fr> registered and used for its official website since January 31<sup>st</sup> 1999.

The disputed domain name <jonakparissolde.com> was registered on October 27<sup>th</sup>, 2022. It redirects to a website selling shoes.

#### FACTUAL BACKGROUND

**A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights**

The Complainant states that the disputed domain name is confusingly similar to its trademark JONAK®.

The disputed domain name incorporates the Complainant's trademark in its entirety. The addition of the terms "PARIS" and "SOLDE" (meaning "OUTLET") is not sufficient to escape the finding that the domain name is confusingly similar to the trademark JONAK®. It does not change the overall impression of the designation as being connected to the Complainant's trademark JONAK®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark. It is well-established 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, Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin).

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. See WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.").

Finally, the Complainant's rights over the term "JONAK" have been confirmed by several Panels. See for instance CAC Case No. 104653, Joseph NAKAM v. Amanda Gorman <jonak-outlet.shop>; CAC Case No. 104666, Joseph NAKAM v. Amanda Gorman <jonakkonline.com>.

#### **B. The Respondent has no rights or legitimate interests in respect of the domain name**

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

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. See for instance Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).").

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 JONAK®, or apply for registration of the disputed domain name by the Complainant.

Furthermore, the domain name redirects to a website selling shoes, which compete with the products provided by the Complainant. Past Panels have held that using a disputed domain name to offer related products to that of a complainant is not a use indicative of rights or legitimate interests.

See for instance Forum Case No. FA 1659965, General Motors LLC v. MIKE LEE ("Past panels have decided that a respondent's use of a domain to sell products and/or services that compete directly with a complainant's business does not constitute a bona fide offering of goods or services pursuant to Policy paragraph 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy paragraph 4(c)(iii).").

#### **C. The domain name was registered and is being used in bad faith**

The Complainant states that the disputed domain name <jonakparissolde.com> is confusingly similar to its trademark JONAK®. The trademark was registered several years before the registration of the disputed domain name, and the Complainant is a worldwide and well-known fashion company. See CAC Case No. 104653, Joseph NAKAM v. Amanda Gorman ("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.").

On those facts, given the distinctiveness of the Complainant's trademarks and reputation, according to the Complainant it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks. Please see for instance WIPO Case No. D2004-0673, Ferrari S.p.A v. American Entertainment Group Inc.

Moreover, the disputed domain name redirects to a website selling shoes, which compete with the products provided by the Complainant. Using a domain name in order to offer competing products is often held to disrupt the business of the owner of the relevant mark is bad faith. See Forum Case No. FA 768859, Instron Corporation v. Andrew Kaner c/o Electromatic a/k/a Electromatic Equip't ("Complainant asserts that Respondent registered and is using the disputed domain names to disrupt Complainant's business, because Respondent is using the disputed domain names to operate a competing website. The Panel finds that Respondent has registered and used the disputed domain names in bad faith according to Policy paragraph 4(b)(iii).").

Finally, by using the disputed domain name, the Complainant contends 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 trademarks 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, as mentioned by Policy, paragraph 4(b)(iv). See Forum Case No. 94864, Southern Exposure v. Southern Exposure, Inc. ("The Respondent is using the domain name to attract Internet users to its website by creating confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Complainant's website. Policy paragraph 4(b)(iv). The Respondent registered and used the domain name in question to profit from the Complainant's mark by attracting Internet users to its competing website. This is evidence of bad faith.").

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

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#### PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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#### 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).

This is a case of adding a generic term "solde" and a geographical term "Paris" to a somewhat well-known trademark - the addition of these generic elements does not take away the confusing similarity between the trademark and the disputed domain name. Furthermore it is well-established practice that the specific top level of a domain name such as ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

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#### 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).

The Complainant has informed that the Respondent is not affiliated with nor authorized by the Complainant in any way.

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#### 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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark JONAK and the distinctive nature of this mark, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark. The Panel, therefore, finds that the disputed domain name was registered in bad faith.

The disputed domain name does currently resolve to an active website selling shoes. The Panel finds it evidenced that the Respondent registered and is using the disputed domain name to disrupt Complainant's business, as the Respondent is using the disputed domain name to operate a competing website. The Panel therefore finds that the Respondent has registered and uses the disputed domain names in bad faith.

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

ii. the Respondent has no rights or legitimate interests with respect to the disputed domain name; and

iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel, therefore, came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

The disputed domain name is therefore deemed confusingly similar.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website were used by the Complainant long before the disputed domain name was registered. The present use of the disputed domain name is for marketing goods similar to the Complainant's goods.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **jonakparissolde.com**: Transferred

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## PANELLISTS

Name	Lars Karnoe
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DATE OF PANEL DECISION 2022-12-13

Publish the Decision

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