

Decision for dispute CAC-UDRP-105023

Case number CAC-UDRP-105023

Time of filing 2022-11-29 09:02:56

Domain names isabelmarantd.com

Case administrator

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

Complainant

Organization IM PRODUCTION

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization Downs

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 owner of the ISABEL MARANT trademark registrations in several countries, including but not limited to:

- European trademark ISABEL MARANT® #001035534, registered since December 23, 1998; and
- International trademark ISABEL MARANT® #1284453, registered since November 16, 2015.

In addition, the Complainant also owns multiple domain names consisting in the wording "ISABEL MARANT", such as <isabelmarant.com> registered since April 20, 2002.

FACTUAL BACKGROUND

The Complainant is a French company specializing in the manufacture and marketing of ready-to-wear, shoes, handbags and jewellery. The Complainant markets these products under the brand "ISABEL MARANT", and now has stores around the world.

The Respondent appears to be an individual based in the United States.

The disputed domain name <isabelmarantd.com> was registered on November 15, 2022, and redirects to a website purporting to be an online store selling the Complainant's ISABEL MARANT products at discounted prices.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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).

First, the Complainant claims rights in the ISABEL MARANT mark through its global trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

Second, the Complainant claims that its ISABEL MARANT mark is a well-known and distinctive trademark, and the additional "characters 'td'" [sic] is not sufficient to avoid the likelihood of confusion. Having compared the disputed domain name and Complainant's ISABEL MARANT mark, it appears to the Panel that the difference between them is only a character "d". However, it does not prevent the Panel from coming to the conclusion that the disputed domain name is confusingly similar to Complainant's ISABEL MARANT trademark.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondents lack rights and legitimate interests in the disputed domain names, and the burden of prove then shifts to the Respondents to show they do have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant contends that the Respondent is not identified in the Whois database as the disputed domain name and was not commonly known by the disputed domain name as well. In addition, the Complainant has not authorized the Respondent to make any use of the Complainant's trademark ISABEL MARANT®, or apply for registration of the disputed domain name by the Complainant. The Respondent has no rights or legitimate interests in respect of the disputed domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Second, the Complainant further alleges that the disputed domain name is being used to host the Website to impersonate 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, the Respondent has neither disclosed its relationship with the Complainant nor included any identifiable information of itself. 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.

Having reviewed the website resolved by the disputed domain name, the Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has rights or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertion within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant reiterates that it has been the rights owner of the distinctive ISABEL MARANT trademarks since at least 1998 which is more than 20 years before the registration of the disputed domain name. Therefore, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark. Actual knowledge of a

complainant's rights in a mark prior to registering a confusingly similar domain name evinces bad faith under paragraph 4(a)(iii) of the Policy. See ARCELORMITTAL (SA) v. acero, 102399 (CAC 2019-04-22). The Panel is of the view that at the time of registration of the disputed domain name, the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks and that registration of domain name containing well-known trademarks constitutes bad faith per se. The Panel agrees with Complainant and finds that Respondents should have actual knowledge of Complainant's mark, demonstrating bad faith registration under paragraph 4(a)(iii) of the Policy.

Second, the Complainant alleges 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 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 paragraph 4(b)(iv) of the Policy. See TOD'S S.p.A. v. Wei Xifeng, 103839, (CAC 2021-06-28) ("Using a confusingly similar domain name in a manner disruptive of a complainant's business by trading upon the goodwill of a complainant for commercial gain evinces bad faith under paragraph 4(b)(iii) & (iv) of the Policy. See also Intesa Sanpaolo S.p.A. v. Abayomi Ajileye, 102396 (CAC 2019-04-25) and ROGER VIVIER S.P.A. v. linannan, 103788 (CAC 2021-06-08). Complainant has provided screenshots of the resolving website, which displays the ISABEL MARANT mark and various images of dresses for sale. Complainant also points out that the goods offered on Respondent's website are counterfeit given the heavily discounted prices. Accordingly, the Panel agrees that Respondent disrupts Complainant's business and attempted to commercially benefit off Complainant's mark in bad faith under paragraph 4(b)(iv) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **isabelmarantd.com**: Transferred

PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION 2022-12-30

Publish the Decision
