

Decision for dispute CAC-UDRP-105024

Case number	CAC-UDRP-105024
Time of filing	2022-11-29 09:03:49
Domain names	FR-ISABELMARANT.COM

Case administrator

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

Organization	IM PRODUCTION
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Mercy Mercy
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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 <FR-ISABELMARANT.COM>.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks including the wording "ISABEL MARANT" in several countries, such as the international trademark ISABEL MARANT n° 1284453, registered since November 16, 2015, and the European trademark ISABEL MARANT n° 001035534 registered since December 23, 1998.

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

FACTUAL BACKGROUND

The Complainant is a French company specializing in manufacturing and marketing ready-to-wear, shoes, handbags and jewellery. The Complainant markets these products under the brand "ISABEL MARANT".

The disputed domain name <FR-ISABELMARANT.COM> was registered on November 17, 2022, and redirects to a website purporting to be an online store selling ready-to-wear fashion and accessories for women.

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

PARTIES' CONTENTIONS:

COMPLAINANT:

I. The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the disputed domain name <FR-ISABELMARANT.COM> is confusingly similar to its well-known and distinctive trademark ISABEL MARANT mark and its domain names associated. Adding a hyphen and the abbreviation "FR" (for France) is not sufficient to escape the finding that the disputed domain name is confusingly similar to the ISABEL MARANT mark.

Furthermore, the Complainant contends that the addition of the gTLD ".COM" is not relevant in the appreciation of confusing similarity and refers to the 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.").

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

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant further contends that the 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 ISABEL MARANT, or apply for registration of the disputed domain name by the Complainant.

Finally, the Complainant provides that the website in relation to the disputed domain name <FR-ISABELMARANT.COM> resolves to an online store selling ready-to-wear fashion and accessories for women, which compete with the products provided by the Complainant. Past panels have held that using a disputed domain name to offer related services to that of a complainant is not a use indicative of rights or legitimate interests - 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 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy 4(c)(iii).").

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

According to the Complainant, the disputed domain name <FR-ISABELMARANT.COM> is confusingly similar to its trademark ISABEL MARANT. The trademark was registered several years before the registration of the disputed domain name. The addition of the term "FR" cannot be coincidental, as it directly refers to the Complainant's country of establishment.

The Complainant further states that given the distinctiveness of the Complainant's trademarks 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.

Furthermore, the disputed domain name resolves to an online store selling ready-to-wear fashion and accessories for women, which compete with the products offered by the Complainant. Using a domain name in order to offer competing services has often been held to disrupt the business of the owner of the relevant mark and constitutes bad faith.

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 or other online 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, as mentioned by Policy, paragraph 4(b) (iv).

PARTIES CONTENTIONS

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
2. that 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.

- 1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights

The Complainant has provided evidence and proved to be the owner of the ISABEL MARANT trademark.

The Panel finds that the disputed domain name <FR-ISABELMARANT.COM> fully incorporates the Complainant's ISABEL MARANT trademark. Essentially, the Respondent has appropriated the trademark ISABEL MARANT by adding a hyphen and the abbreviation "FR" (for France) to presumably lead consumers to believe that it is affiliated with the Complainant. Previous UDRP panels have found that the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for the purposes of the Policy (see, e.g., Oki Data Americas Inc. v ASD, Inc., WIPO Case No. D2001-0903).

Additionally, the disputed domain name not only fully incorporates the ISABEL MARANT trademark but also includes a purely generic top-level domain ("gTLD") "com". Previous UDRP panels have also held that the gTLD ".com" is not to be taken into account when assessing whether a domain name is identical or confusingly similar to a trademark. See e.g., Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (Forum January 22, 2016). Moreover, the "use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark."

The Panel finds that the disputed domain name <FR-ISABELMARANT.COM> shows a clear visual, phonetic and conceptual resemblance to the Complainant's ISABEL MARANT mark, and could confuse Internet users into thinking that the disputed domain name is associated with the Complainant or its trademarks.

In these circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark ISABEL MARANT for the purposes of the first element of the Policy.

- 2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0,

paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the ISABEL MARANT mark as part of its domain name. The Respondent is not in any way affiliated with the Complainant, nor is it authorized to register the disputed domain name. The disputed domain name <FR-ISABELMARANT.COM> resolves to an online store selling ready-to-wear fashion and accessories for women, which compete with the products provided by the Complainant. This, according to the Panel, is clearly not a use indicative of rights or legitimate interests.

In the present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name for the purposes of the second element of the Policy.

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

The Panel agrees with the Complainant that its trademark ISABEL MARANT is distinctive and well-known globally. The registration of the Complainant's well-known trademark ISABEL MARANT predates the registration of the disputed domain name. Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. Since the Complainant is present in France, the addition of the abbreviation "FR" worsens the likelihood of confusion between the disputed domain name and the Complainant's trademark. The Panel finds that such actions constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy, which provides: "by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site 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 respondent's web site or location or of a product or service on respondent's web site or location."

The fact that the Respondent has registered the disputed domain name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge of the Complainant's trademark and that it had such knowledge before the registration and use of the disputed domain name.

Further, the disputed domain name <FR-ISABELMARANT.COM> resolves to an online store selling ready-to-wear fashion and accessories for women, which compete with the products provided by the Complainant. The Panel thus takes the view that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or location by creating a likelihood of confusion with the Complainant's mark. This further suggests that the Respondent's sole intention in registering the disputed domain name was to take unfair advantage of the Complainant's ISABEL MARANT mark and reputation, and suggests registration and use in bad faith.

Accordingly, the Panel concludes that the Complainant has satisfied the third element of the Policy, that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FR-ISABELMARANT.COM**: Transferred

PANELLISTS

Name	Barbora Donathová
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DATE OF PANEL DECISION	2023-01-01
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Publish the Decision
