

Decision for dispute CAC-UDRP-104760

Case number	CAC-UDRP-104760
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Time of filing	2022-08-01 09:06:01
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Domain names	isabel-marant.store
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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	Chengjun Yang
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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.

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 16th, 2015 and the European trademark ISABEL MARANT® n°001035534 registered since December 23rd, 1998.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL

The Complainant states that the disputed domain name is identical to the Complainant's well-known trademark "ISABEL MARANT" and its domain name, as it bears the Complainant's trademark as a whole except for a hyphen, which is ignored in the comparison.

The Complainant refers to earlier decision WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios

S.A., where it was decided that the top level “.com”, “.org” or “.net” is not relevant in deciding the similarity.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant states that the disputed domain name <isabel-marant.store> is identical to its well-known trademark ISABEL MARANT® and all Google results for the term “ISABEL MARANT” refers to the Complainant and its trademark.

Thus, it is stated that given the distinctiveness of the Complainant's trademark and its reputation, the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark. The case of WIPO Case No. D2016-2097, IM Production v. Erica Wong was given as a reference (“The Panel is satisfied that the ISABEL MARANT trade mark is sufficiently well-known in China that, in all likelihood, the Respondent would have been aware of the Complainant's trade mark at the time the disputed domain name was registered.”).

The Complainant indicates that 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 domain name for a website offering counterfeit or unauthorized versions of Complainant's products in direct competition. The cases as follows were provided as example:

- Forum Case No. 1612750, Xylem Inc. and Xylem IP Holdings LLC v. YinSi BaoHu YiKaiQi, (“The Panel agrees that Respondent's use of the website to display products similar to Complainant's, imputes intent to attract Internet users for commercial gain, and finds bad faith per Policy 4(b)(iv).”);

- Forum Case No. FA 1760517, Bittrex, Inc. v. Wuxi Yilian LLC (finding bad faith per Policy 4(b)(iv) where “Respondent registered and uses the <bittrex.com> domain name in bad faith by directing Internet users to a website that mimics Complainant's own website in order to confuse users into believing that Respondent is Complainant or is otherwise affiliated or associated with Complainant.”).

Based on the above, the Complainant contends that Respondent acquired the disputed domain name with the only intention to attract for commercial gain internet users to the Respondent's website as mentioned on CAC Case N° 104392, ZV HOLDING v. Luis Alberto Fernandez Garcia, or in CAC Case No. 104561, IM PRODUCTION v. Guilan Wei.

Accordingly, the Complainant alleges that the disputed domain name was registered and is being used in bad faith.

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

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

B. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

The Panel will therefore deal with each of these requirements in turn.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of "ISABEL MARANT" trademark.

The Panel finds that the disputed domain name is identical to the Complainant's "ISABEL MARANT" trademark and the addition of hyphen is not sufficient to vanish the identity.

Moreover, the addition of the gTLD ".STORE" is not enough to abolish the identity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is identical with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. 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 domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a

name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

It is understood from the explanations of the Complainant that the Respondent and the Complainant has no relationship or agreement on the use of the disputed domain name. In the absence of a response, the Panel considers that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Panel concludes that the Complainant's "ISABEL MARANT" trademark is of distinctive character and has a certain reputation (see e.g. WIPO Case No. D2016-2097, IM Production v. Erica Wong).

Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the "ISABEL MARANT" trademark, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the use of the identical domain name for commercial gain on a website offering counterfeit or unauthorized versions of Complainant's products in direct competition with the Complainant's products is considered use in bad faith to create confusion with Complainant's trademarks. (see e.g. Forum Case No. 1612750, Xylem Inc. and Xylem IP Holdings LLC v. YinSi BaoHu YiKaiQi, CAC Case N° 104392, ZV HOLDING v. Luis Alberto Fernandez Garcia, CAC Case No. 104561, IM PRODUCTION v. Guilan Wei.) Especially considering they sell Complainant's products or their counterfeit at discounted prices without the knowledge of the Complainant.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. ISABEL-MARANT.STORE: Transferred

PANELLISTS

Name Mrs Selma Ünlü

DATE OF PANEL DECISION 2022-09-07

Publish the Decision