

Decision for dispute CAC-UDRP-105089

Case number CAC-UDRP-105089

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Domain names isabelmarantsal.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization IM PRODUCTION

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization Fundacion Comercio Electronico

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

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

The Disputed Domain Name <isabelmarantsal.com> was registered on 5 December 2022 and redirects to a parking page with commercial links.

FACTUAL BACKGROUND

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

The Disputed Domain Name <isabelmarantsal.com> was registered on 5 December 2022 and redirects to a parking page with commercial links.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

A. The disputed 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 <isabelmarantsal.com> is confusingly similar to its well-known and distinctive trademark ISABEL MARANT® and its domain names associated. The addition of letters "SAL" is not sufficient to avoid the likelihood of confusion. It is well-established that a disputed domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP. Moreover, past UDRP Panels commonly stated that the gTLD ".COM" is not relevant in the appreciation of confusing similarity while the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar.

The Complainant recalls previous UDRP decisions as follows:

- WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin;
- CAC Case No. 104297, IM PRODUCTION v. LIUQINGRU <isabelmarant.xyz>;
- WIPO Case No. D2021-4246, IM Production v. Shixiao Ai <isabelmarantbottes.com>;
- CAC Case No. 103810, IM PRODUCTION v. Xing Chun Ding <isabelmarantrakuten.com>;
- WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.

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

The Complainant contends that it is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the Disputed Domain Name. The Respondent alleges that the Respondent is not identified in the Whois database as the Disputed Domain Name. The Respondent is not commonly known by a Disputed Domain Name if the WHOIS information is not similar to the Disputed Domain Name.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name <isabelmarantsal.com> 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. 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. The Respondent's use of a Disputed Domain Name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use. Furthermore, the Disputed Domain Name resolves to a parking page with commercial links. Thus, an operation of a pay-per-click website at a confusingly similar Disputed Domain Name does not represent a bona fide offering of goods or services or a legitimate noncommercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the Respondent is itself commercially profiting from the click-through fees. Respondent's use of a Disputed Domain Name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.

The Complainant recalls previous UDRP decisions as follows:

- Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group;
- Forum Case No. FA 970871, Vance Int'l, Inc. v. Abend;
- WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.;
- WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe.

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

The Complainant states that the Disputed Domain Name <isabelmarantsal.com> is confusingly similar to its trademark ISABEL MARANT®. The trademark was registered several years before the registration of the Disputed Domain Name. The trademark ISABEL MARANT® is sufficiently well-known worldwide 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. Given the distinctiveness of the Complainant's trademark 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.

The Complainant recalls previous UDRP decisions as follows:

- WIPO Case No. D2005-0517Caesars World, Inc. v. Forum LLC;
- WIPO Case No. D2009-0462Compart AG v. Compart.com / Vertical Axis Inc.,;
- WIPO Case No. D2016-2097, IM Production v. Erica Wong.

The Complainant contends that if the Disputed Domain Name resolves to a parking page with commercial links the Respondent has attempt to attract Internet users for commercial gain to his own website for its commercial gain, which is an evidence of bad faith. Whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for. The content appearing on the website to which the Disputed Domain Name resolves cannot but evoke a presumption that the Respondent has allowed the Disputed Domain Name to be used with the intent to attract Internet users by a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website. Accordingly, the Disputed Domain Name should have been registered and is being used in bad faith.

The Complainant recalls previous UDRP decisions as follows:

- WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC;
- WIPO Case No. D2022-4227, Taojing International Limited Zenni Optical, Inc. v. Carolina Rodrigues, Fundacion Comercio Electronico;
- WIPO Case No. D2022-4222, Universal Services of America, LP d/b/a Allied Universal v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico.

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.

LANGUAGE OF PROCEEDINGS

The language of the proceeding is English. The English as language of this proceedings comes into effect in accordance with Paragraph 11 of the UDRP Rules. The Complainant sued to decide first about the language of proceedings contending to be the English.

The Panel cannot find any reason to determine other language of the proceedings as the English because it is evidenced that the language of the registration agreement of the Disputed Domain Name <isabelmarantsal.com> is English despite that the Respondent is obviously based on Cyprus.

The other Parties' agreement on language of the proceedings was neither contended nor proved.

PRINCIPAL REASONS FOR THE DECISION

In order to succeed in its claim, the Complainant has to prove that all of the elements enumerated in paragraph 4(a) of the UDRP Policy have been satisfied:

(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.

The Panel reviewed carefully the Complaint and the evidence provided by the Complainant. The Respondent filed neither administratively compliant Response nor provided the Panel with any evidence. Therefore, the Panel based its finding and the Decision on the evidence presented by the Complainant and available websites and public information concerning the Disputed Domain Name, namely the WHOIS databases.

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHT

The Panel finds that Disputed Domain Name <isabelmarantsal.com> is confusingly similar to the Complainant's well-known and distinctive trademark ISABEL MARANT® and its domain names associated. The addition of letters "SAL" is not sufficient to avoid the likelihood of confusion. It is well-established that a Disputed Domain Name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP Policy. Moreover, the gTLD ".COM" is not relevant in the appreciation of confusing similarity while the specific top level of a Disputed Domain Name such as ".com", ".org" or ".net" does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar.

The Panel therefore considers the Disputed Domain Name to be confusingly similar to the trademark ISABEL MARANT® in which the Complainant has rights and the conduct of the Respondent falls within the meaning of paragraph 4(a)(i) of the Policy.

B. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Panel concludes that 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, Respondent carries the burden of demonstrating rights or legitimate interests in the Disputed Domain Name. The Panel does not find that the Respondent is identified in the Whois database by the Disputed Domain Name. The Panel concluded that the Respondent should have already performed a similar search before registering the Disputed Domain Name and should have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in many other countries worldwide. Nevertheless, the Panel finds that the evidence shows that the Respondent obviously knew about the Complainant and its trademark ISABEL MARANT® when it registered the Disputed Domain Name and chose to register the Disputed Domain Name as such.

It was not proven that the Respondent has rights or legitimate interests in respect of the Disputed Domain Name <isabelmarantsal.com> and is related in any way with the Complainant and does carry out any legitimate activity for, or has any business with the Respondent. The Panel finds that neither license nor authorization of the Complainant 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. It is proven that the Disputed Domain Name resolves to a parking page with commercial links so that it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

The Panel therefore finds that the Respondent does not have rights or legitimate interests in the Disputed Domain Name and its conduct falls within the meaning of paragraph 4(a)(ii) of the Policy).

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

REGISTRATION OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Disputed Domain Name <isabelmarantsal.com> is confusingly similar to Complainant's trademark ISABEL MARANT®. The trademark was registered several years before the registration of the Disputed Domain Name. Thus, given the distinctiveness of the Complainant's trademark and its reputation, the Panel infers that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark. The trademark ISABEL MARANT® is sufficiently well-known worldwide 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 Panel concludes that the Respondent registered the Disputed Domain Name incorporating the trademark ISABEL MARANT® intentionally in order to take advantage of reputation of the trademark ISABEL MARANT® and the Complainant's goodwill.

THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

The Panel finds that the Disputed Domain Name resolves to a parking page with commercial links. The Panel concludes that by using the Disputed Domain Name, 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 mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. It was proven that after the Registrar Verification, the Respondent appears under its name Fundacion Comercio Electronico (Carolina Rodrigues), Cyprus which is a different denomination as the Complainant alike which leads to the conclusion of the Panel that the Respondent might provide false WHOIS data.

The Panel therefore finds that the Respondent registered and used the Disputed Domain Name in bad faith and its conduct falls within the meaning of 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

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

1. **isabelmarantsal.com**: Transferred

PANELLISTS

Name	Vojtěch Trapl
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DATE OF PANEL DECISION 2023-01-30

Publish the Decision
