

## Decision for dispute CAC-UDRP-105127

Case number	CAC-UDRP-105127
Time of filing	2023-01-16 09:11:53
Domain names	sezane-fr.com, sezane-outlet.com

### Case administrator

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

Organization	BENDA BILI
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### Complainant representative

Organization	NAMESHIELD S.A.S.
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### Respondents

Name	Mark Kean
Name	Courtney Davis

#### 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 names.

#### IDENTIFICATION OF RIGHTS

The Complainant is a registered owner of a following trademark containing a word element "SEZANE" (or "SÉZANE"):

(i) SÉZANE (word), International (WIPO) Trademark registration date 3 June 2013, trademark registration no. 1170876, registered for goods in the international classes 14, 18, and 25.

besides other trademarks consisting of the "SEZANE" (or "SÉZANE") denomination.

(collectively referred to as "Complainant's Trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domain ("gTLD") and country-code Top-Level Domain ("ccTLD") containing the term "SEZANE" as for example <sezane.com>.

#### FACTUAL BACKGROUND

The Complainant (BENDA BILI) is a company specialized in ready-to-wear collections and accessories for women and trading under its commercial name and trademark SEZANE. The term "SEZANE" is a contraction of the first name and last name of the Complainant's founder and President Morgane Sezalory. SEZANE's clothing and accessories are available only through its online shop.

Both disputed domain names were registered on 21 October 2022 and are held by the Respondents.

Both domain names websites (i.e. website available under internet address containing the disputed domain names) have a very similar look and feel and overall appearance and serves as a simple e-shop offering for sale products directly competing with those of the Complainant.

The Complainant seeks transfer of the disputed domains names to Complainant.

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#### PARTIES CONTENTIONS

##### COMPLAINANT:

##### CONFUSING SIMILARITY

The Complainant states that:

1. The disputed domain names are confusingly similar to Complainant's Trademarks as they both incorporate the "SEZANE" word element of the Complainant's trademarks in its entirety.
2. The addition of the term "FR" that stands for France or "OUTLET" as a generic term respectively, is not sufficient to escape the finding that the disputed domain names are confusingly similar to Complainant's trademarks, as it does not prevent the likelihood of confusion between the disputed domain names and the Complainant.

The Complainant refers to previous domain name decisions in this regard.

Thus, according to the Complainant the confusing similarity between Complainant's trademarks and the disputed domain names is clearly established.

##### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

1. The Respondent has not been commonly known by the disputed domain names.
2. The Complainant has not authorized, permitted or licensed the Respondent to use Complainants' trademarks in any manner. The Respondent has no connection or affiliation with any of the Complainants whatsoever. On this record, Respondent has not been commonly known by the any of the disputed domain name.
3. On the contrary, the disputed domain names were used for attracting internet users to goods provided by the Respondent that are directly competing with the goods of the Complainant.

The Complainant refers to previous domain name decisions in this regard.

##### BAD FAITH REGISTRATION AND USE

The Complainant states that:

1. Seniority of the Complainants' Trademarks predates the registration of corresponding disputed domain name.
2. Furthermore, the Complainants' Trademarks have received widespread recognition. Therefore the Respondent must have been aware of such trademarks and their reputation. This clearly indicates bad faith registration of disputed domain names by the Respondent.
3. The disputed domain names links to online stores that offer goods that compete with the products offered by the Complainant. Using a domain name in order to offer competing services is often been held to disrupt the business of the owner of the relevant mark is bad faith.

The Complainant refers to previous domain name decisions in this regard.

## RESPONDENT:

The Respondent has not provided any response to the Complaint.

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## RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

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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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

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## BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

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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

### RIGHTS

Since the disputed domain names and the Complainants' trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain names are confusingly similar to the Complainants' trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the disputed domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name in question.

Applying the principles described above, the Panel contends that incorporation of the "SEZANE" element of Complainant's trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain names constitutes confusing similarity between Complainant's trademark and the disputed domain names.

The addition of the term "FR" (as an abbreviated geographical identifier for France) or "OUTLET" (as a generic term meaning a retail sales establishment) is not sufficient to escape the finding that the disputed domain names are confusingly similar to Complainant's trademarks, as it does not prevent the likelihood of confusion between the disputed domain names and the Complainant, Complainant's trademarks and its business.

For sake of completeness, the Panel asserts that the top-level suffix in the disputed domain name (i.e. the ".com") must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant's assertions that the Respondent is not commonly known by either disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in these names. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a) (ii) of Policy).

The Panel also asserted whether use of the disputed domain names for promotion and offer to sale of products similar to those of the Complainant satisfy the Oki Data Test.

In general, in previous cases the Panels have recognized that resellers or distributors using a domain name containing the Complainant's trademark to undertake sales related to the Complainant's goods may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the Oki Data Test (as introduced in Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), the following cumulative requirements shall be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the (Complainant's authentic) trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

Here, the Panel concurs that requirement under a letter (ii) is clearly not met. The goods offered through the domain names websites do not originate from the Complainant and they are not genuine SÉZANE trademarked goods.

Also it is clear that the e-shops available on the domain names websites are scam and fictitious as it is not possible to complete the order process thereupon (i.e. it is not possible to buy any goods on such e-shops).

As a result, 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 Panel finds it grounded that the Respondent registered and used the disputed domain names in bad faith.

As described above, the Complainant has proven that the Respondent has used (at least for some time) the disputed domain names for promotion and offer offering goods and services (i) likely with intention to free-ride on reputation and goodwill of Complainant's trademarks and business and, even more importantly, (ii) in a manner that was detrimental both to the customers as well the Complainant and its business.

Such unfair use of the disputed domain names for promotion of Respondent's activities (sale of goods) cannot be considered as use thereof in good faith and in compliance with fair business practices.

Thus, the Panel has taken a view that both disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) 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. **sezane-fr.com**: Transferred
2. **sezane-outlet.com**: Transferred

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#### PANELLISTS

Name	Jiří Čermák
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DATE OF PANEL DECISION 2023-02-15

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Publish the Decision

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