

Decision for dispute CAC-UDRP-105269

Case number	CAC-UDRP-105269
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Time of filing	2023-03-08 08:30:53
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Domain names	agathapascher.com
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Case administrator

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

Organization	AGATHA
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Gjdhn Koltg
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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 is the owner of the following trademark registrations for the sign “AGATHA” (the “AGATHA trademark”):

- the International trademark AGATHA with registration No.579692, registered on 29 November 1991 for goods in International Classes 3, 14, 18 and 25; and
- the International trademark AGATHA with registration No.774779, registered on 24 December 2001 for goods in International Class 9.

FACTUAL BACKGROUND

The Complainant operates under the name “AGATHA PARIS”. It is a French jewellery company.

The Complainant is the owner of the domain names <agatha.fr> and <agathaparis.com>.

The disputed domain name <agathapascher.com> was registered on 23 April 2021 and redirects to an online store selling AGATHA-branded jewellery products at discounted prices.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to its AGATHA trademark, as it incorporates the trademark entirely with the addition of the French dictionary words “*pas cher*” (meaning “*cheap*” in English), which addition is not sufficient to eliminate the confusing similarity between the disputed domain name and the AGATHA trademark.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant asserts that the Respondent is not commonly known by the disputed domain name and is not affiliated with or authorized by the Complainant to use the Complainant's AGATHA trademark. The Complainant points out that the disputed domain name is used to host a website that impersonates the Complainant and attempts to mislead consumers into thinking that the goods offered for sale on the website originate from the Complainant, and there is no disclaimer on the website to identify its owner. According to the Complainant, the Respondent has therefore failed at least in one of the elements of the Oki Data test, because the website linked to the disputed domain name does not disclose accurately and prominently the registrant's relationship with the trademark holder.

The Complainant states that the disputed domain name was registered and is being used in bad faith. It is confusingly similar to the AGATHA trademark, which was registered twenty years before its registration, and the website associated to it makes references to the Complainant's products, trademarks and logo without disclosing the lack of relationship between the Parties. On those facts, the Complainant asserts that the Respondent has registered the disputed domain name with knowledge of the Complainant's trademark, and uses it in bad faith to create confusion with this trademark for commercial gain by offering counterfeit or unauthorized versions of the Complainant's products in direct competition with the Complainant.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the

Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ...”

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the AGATHA trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence “agathapascher”, which reproduces the AGATHA trademark entirely with the addition of the French dictionary words “pas cher”, meaning “cheap” in English. The addition of this non-distinctive element has a low effect on the overall impression made by the disputed domain name, in which the AGATHA trademark is easily distinguishable. As discussed in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “WIPO Overview 3.0”), in cases where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Taking all the above into account, the Panel finds that the disputed domain name is confusingly similar to the AGATHA trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because there is no relationship between the Parties and Respondent is not commonly known under the disputed domain name. The Complainant points out that the disputed domain name resolves to a website that attempts to impersonate the Complainant and misleads consumers into thinking that the website belongs to or is affiliated to the Complainant, and offers to them counterfeit or unauthorized versions of the Complainant’s products in direct competition with the Complainant without disclosing the lack of relationship between the Parties. Thus, the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not provided a plausible explanation for the registration and use of the disputed domain name. It has not asserted that the goods offered on its website are original or that it has received authorization by the Complainant.

The circumstances of this case therefore do not support a finding that the Respondent has rights and legitimate interests in the disputed domain name. It is confusingly similar to the Complainant’s AGATHA trademark and its composition may create an impression that the disputed domain name represents an official online location of the Complainant where its products are offered for sale at discounted prices, and there is no disclaimer for the lack of relationship with the Complainant. The Respondent thus fails in at least one of the elements of the Oki Data test, as the website linked to the disputed domain name does not disclose accurately and prominently the registrant’s relationship with the trademark holder and does not meet requirements of the Oki Data test. See section 2.8.1 (iii) of the WIPO Overview 3.0.

Taking all the above into account, the Panel concludes that it is more likely than not that the Respondent, being aware of the goodwill of the AGATHA trademark, has registered and used the disputed domain name targeting this trademark in an attempt to exploit its goodwill by confusing Internet users that the disputed domain name is affiliated to the Complainant, and attracting them to its website where what appear as AGATHA-branded goods are offered for sale at discounted prices. The Panel does not regard such conduct as legitimate and giving rise to rights or legitimate interests of the Respondent in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The registration of the Complainant’s AGATHA trademark predates with twenty years the registration of the disputed domain name, which reproduces this trademark entirely with the addition of the French words for “cheap”, and the associated website offers for sale products marked with the Complainant’s AGATHA trademark at discounted prices. The website includes no disclaimer for the lack of relationship between the Parties and does not identify the provider of the goods offered. There is no information as to whether these goods are authentic. All this may lead Internet users to believe that the disputed domain name and the website to which it resolves represent an official online location of the Complainant where its goods are offered for sale at low prices. The Panel is therefore of the view that the Respondent is more likely to have registered and used the disputed domain name with knowledge of the Complainant’s AGATHA trademark and with the intention of taking advantage of its goodwill by impersonating the Complainant and diverting the Complainant’s customers to its website to offer them goods of unclear origin at discounted prices in competition with the Complainant for commercial gain.

This satisfies the Panel that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **agathapascher.com**: Transferred

PANELLISTS

Name	Assen Alexiev
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DATE OF PANEL DECISION	2023-04-01
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Publish the Decision
