

Decision for dispute CAC-UDRP-105295

Case number	CAC-UDRP-105295
Time of filing	2023-03-23 10:03:17
Domain names	fermobhome.com, outletfermob.com

Case administrator

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

Organization	FERMOB
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	GNN
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of a number of registered trademarks "FERMOB" including French trademark n° 3243498 registered on 1 September 2003 (duly renewed), European trademark n° 6952758 filed on 22 May 2008 and registered on 29 January 2009 (duly renewed), International trademark n° 829242 registered on 1 March 2004 (duly renewed) claiming a protection in particular in Australia, Republic of Korea, Turkey, Switzerland, Russian Federation.

The Complainant indicates that it also owns an important domain names portfolio, but provides only copy of Whois database of the domain name <fermob.com> registered since 24 December 1996.

FACTUAL BACKGROUND

The Complainant is a French company, established in 1989, that designs and manufactures metal and coloured outdoor furniture. The Complainant's brand is FERMOB and, in addition to its FERMOB trade marks, it owns the domain name <fermob.com>.

All two (2) disputed domain names:

<fermobhome.com>

<outletfermob.com>

were registered on 16 February 2023.

It has to be noticed that neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court (CAC). Thus, the CAC is unaware whether the written notice was received by the Respondent or not. As far as the e-mail notice is concerned, the CAC received notifications that the e-mails sent to connectresellerprivacy@aol.com, postmaster@fermobhome.com, postmaster@outletfermob.com, were returned back as undelivered.

The Respondent did not connect to the platform.

PARTIES CONTENTIONS

Complainant:

The disputed domain names are confusingly similar to a trade mark in which the Complainant has rights. It contains the Complainant's FERMOB trade mark in its entirety, and are completed by the adding of a generic terms i.e. "home" and "outlet".

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not commonly known by the disputed domain names. The Complainant has not granted a licence or other authorisation to the Respondent to make use of its FERMOB trade marks. The disputed domain names are a usual cybersquat version of the Complainant's mark, registered in order to mislead Internet users.

The Respondent has registered and is using the disputed domain names in bad faith. The Complainant's FERMOB trade mark does not have any meaning or significance, except in relation to the Complainant. Given the significance of the Complainant's mark, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's mark. Moreover, the generic terms added on the Complainant's mark was intentionally designed to be confusingly similar to it and can be seen as evidence of bad faith. The fact that the Respondent has not been able to demonstrate any good faith activity and that it is not possible to conceive of any plausible actual or contemplated use of the disputed domain names by the Respondent that would not be illegitimate, establishes bad faith registration and use.

Respondent:

No administratively compliant Response has been filed.

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).

FERMOB, has shown to be the owner of at least FERMOB, French trademark n° 3243498, European trademark n° 6952758 filed on 22 May 2008 and International trademark n° 829242 for goods and services in classes 11, 20 and 21. The disputed domain names <fermobhome.com> and <outletfermob.com> incorporate the Complainant's earlier FERMOB trademark in its entirety and that the addition of the generic terms "outlet" or "home", is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark FERMOB and that, according to other UDRP panels, "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin).

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain names (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v. Tina Smith, WIPO Case No. D2008-0820 Titoni AG v. Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

For all reasons mentioned above, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the complainant to establish a prima facie case that the respondent lacks rights or legitimate interests in the domain name to shift the

burden of proof to the respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the FERMOB trademark in a domain name, and that it had never licensed its trademarks to the Respondent.

Furthermore, the domain names are used to host websites to impersonate the Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the websites originate from Complainant. Such use demonstrates neither a bona fide offering of goods nor a legitimate interest of Respondent ("Arkema France v. Aaron Blaine, WIPO Case No. D2015-0502"). Furthermore, there is no information/disclaimer on the page of the websites to identify its owner.

Therefore, the Respondent failed at least in one of the elements of the Oki Data test, i.e. the websites linked to the disputed domain names do not disclose accurately and prominently the registrant's relationship with the trademark holder.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain names.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. Yet, the Respondent has not filed any Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the seniority and reputation of the Complainant's trademark and the fact that the disputed domain names fully incorporate this trademark (even in combination with a descriptive term), it is evident that, at the respective times of the registrations of the disputed domain names, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain names correspond to active websites, though not strictly speaking copycat websites, it is clear that the websites have been set up with the intention of creating a connection with the Complainant's genuine site. The Respondent registered and uses the domain names in bad faith to create confusion with Complainant's trademarks for commercial gain by using the confusingly similar domain names to resolve to websites offering potential counterfeit or at least, according to the Complainant, unauthorized versions of their products, thus in direct competition.

Further, it seems that the Respondent has adopted a certain identical pattern of conduct by registering similar domain names that incorporate trademarks of third parties, in combination with descriptive terms. The Panel has accordingly traced at least four similar UDRP decisions, nos. 105243, 105209 and 105001, issued late 2022, and early 2023 where the same Respondent was involved and where the Panels transferred the relevant domain names to the complainants.

Therefore, the Panel finds it clear that the disputed domain names were used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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

As the Respondent did not file an administratively compliant Response, pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate. Thus, the Panel considers the contentions of the Complainant as conceded by the Respondent.

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements in order to succeed in its Complaint:

(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Rights

The Panel finds that the disputed domain names are confusingly similar to the Complainant’s FERMOB trade mark. For the purpose of the comparison, the generic Top-Level Domain “.com” is not taken into account as it is a technical requirement of registration. The disputed domain names contain the Complainant’s mark in full, completed by a generic terms i.e. “outlet” or “home”. Where a complainant’s mark is recognizable within a domain name, the addition of other terms, irrespective of their meaning, will not prevent a finding of confusing similarity; see CAC Case No. 102382, MAJE v enchong lin.

Rights and legitimate interests

The Policy sets out at paragraph 4(c) examples of circumstances, without limitation, by which a respondent may demonstrate rights or legitimate interests in a disputed domain name. These are, in summary: (i) if the respondent has been using the domain name in connection with a bona fide offering of goods and services or has made demonstrable preparations to do so; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate noncommercial or fair use of the domain name.

The fact that the disputed domain names are used to host websites to impersonate the Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the websites originate from Complainant. Such use demonstrates neither a bona fide offering of goods nor a legitimate interest of Respondent (“Arkema France v. Aaron Blaine, WIPO Case No. D2015-0502”).

The Complainant having made out a prima facie case in relation to the second element, the burden of proof shifts to the Respondent to rebut it; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. In the absence of any response by it to the Complaint, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad faith

The distinctive nature of the Complainant’s FERMOB mark as at the date of registration is such that the Panel finds, on a balance of probabilities, that the Respondent registered the disputed domain names with an awareness of the Complainant and its mark and in order to take unfair advantage of that mark. The Panel finds the Respondent’s registration of the disputed domain names in these circumstances in to have been in bad faith.

Further, it seems that the Respondent has adopted a certain identical pattern of conduct by registering similar domain names that incorporate trademarks of third parties, in combination with descriptive terms. The Panel has accordingly traced at least four similar UDRP decisions, nos. 105243, 105209 and 105001, issued late 2022, and early 2023 where the same Respondent was involved and where the Panels transferred the relevant domain names to the complainants.

The Panel therefore finds that the disputed domain names were both registered and are being used in bad faith.
For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **fermobhome.com**: Transferred
- 2. **outletfermob.com**: Transferred

PANELLISTS

Name **David-Irving Tayer**

DATE OF PANEL DECISION **2023-04-23**

Publish the Decision