

Decision for dispute CAC-UDRP-105305

Case number	CAC-UDRP-105305
Time of filing	2023-03-27 09:54:07
Domain names	baratoisabelmarant.store

Case administrator

Name	Olga Dvořáková (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	Evcs Rxvw
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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:

- International trademark "ISABEL MARANT" no. 1284453, registered since November 16, 2015; and
- European trademark "ISABEL MARANT" no. 001035534 registered since December 23, 1998.

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

FACTUAL BACKGROUND

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 trademark or brand "ISABEL MARANT" and has stores around the world.

The disputed domain name <baratoisabelmarant.store> was registered on August 22, 2022.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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).

The Panel accepts the Complainant's rights arise by reason of its ownership of the registered trademark "ISABEL MARRANT". The question is whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

The Complainant asserts that the disputed domain name is confusingly similar to its trademark "ISABEL MARANT" and its associated domain name.

Determining whether a disputed domain name is identical or confusingly similar to a trademark involves comparing them side by side. An exact character-for-character match makes a disputed domain name identical to the trademark. However, if the disputed domain name incorporates non-distinctive or generic terms with the dominant part of the trademark, it may be found to be confusingly similar.

It is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP". See WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin.

Here, the term "BARATO" is added before the trademark "ISABEL MARANT" to form the disputed domain name. Adding a non-distinctive term does not alter the overall impression in the eyes of internet consumers and does not avoid a finding of confusing similarity. See UEFA v Wei Wang easy king CAC-UDRP 104875.

Further, the Complainant contends the term "BARATO" is a Spanish word, translated into English to mean "cheap", and its addition to the Complainant's trademark to form the disputed domain name is not sufficient to avoid the likelihood of confusion.

The Panel accepts this contention, and further considers that the "ISABEL MARANT" trademark appears to be the dominant element in the disputed domain name that seeks to create the impression that it is "cheap ISABEL MARANT" goods offered for sale from the disputed domain name website.

It is also trite to state that the addition of the gTLD ".STORE" does not add any distinctiveness to the disputed domain name and will be disregarded for the purposes of considering this ground.

Accordingly, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark "ISABEL MARANT" and this ground is made out.

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).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainant contends the Respondent has no rights in the disputed domain name for the following reasons:

1. The Respondent is not known as the disputed domain name.
2. The Respondent is not related in any way with the Complainant.
3. The Complainant does not carry out any activity for nor has any business with the Respondent.
4. The Complainant has not licensed nor authorized the Respondent to make use of the Complainant's trademark nor to apply for the registration of the disputed domain name.
5. The Respondent uses the disputed domain name to disrupt the Complainant's business and to attract users by

impersonating the Complainant.

The Complainant has adduced evidence of the reputation of the "ISABEL MARRANT" trademark or brand, and asserts that there is no credible, believable, or realistic reason for registration or use of the disputed domain name other than to take advantage of the Complainant's rights and brand reputation.

At the time of writing this decision, the Panel on its own accord conducted an internet search of the disputed domain name website, which shows an active website both in the Spanish language or English language offering products that appear to be branded or described as "ISABEL MARANT".

The Panel infers that the Respondent is offering for sale and/or advertising the sale of products that are not authorised by the Complainant.

Using domain names for activity that includes sale of counterfeit goods or unauthorized goods is prima facie evidence that no lawful rights have been conferred nor legitimate interests exist for a bona fide use of the domain name.

The evidence here shows that the Respondent is not commonly known by the disputed domain name, nor the Respondent has legitimate interest over the disputed domain name. Past panels have held that a respondent is not commonly known by a disputed domain name if the WHOIS information is not similar to the disputed domain name. See, for example, Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group.

The Panel infers from the evidence that the Respondent is not making a legitimate commercial or fair use of the disputed domain name but rather it is riding on the reputation of the Complainant to best serve its own unauthorised activity for commercial gain or otherwise using the disputed domain name. See Forum Case FA2206002001717 Comme Des Garcons, Ltd. and Comme Des Garcons Co., Ltd. v. Lina543 Valen354345cia.

The Panel considers that it is probable that the Respondent is using the disputed domain name to impersonate the Complainant. By using the Complainant's trademark without authorization, it is likely to mislead a consumer into purchasing goods branded with the Complainant's trademark. The Panel considers that it is irrelevant for the purpose of paragraph 4(a)(ii) of the Policy whether the goods offered by the Respondent are genuine or counterfeit goods of the Complainant.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Given the evidence adduced by the Complainant of its portfolio of trademarks and well-known reputation of its trademark which the Panel accepts as evidencing the strength of its reputation, the Panel accepts and finds that the Respondent has no rights or legitimate interests to the disputed domain name.

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).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The Complainant contends that given the distinctiveness of the Complainant's trademark and its reputation that 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 cites two cases where the respective Panels was satisfied that the "ISABEL MARANT" trademark was sufficiently well-known. See WIPO Case No. D20162097, IM Production v. Erica Wong; WIPO Case No. DME2022-0024 IM Production v. TENGFEI WANG.

The evidence shows, and the Panel accepts, that the Complainant's trademark "ISABEL MARANT" is well-known all around the world. The Complainant's trademark was clearly registered prior to the registration of the disputed domain name. In addition, the Complainant has never authorized the Respondent to use the "ISABEL MARANT" trademark nor to register the disputed domain name.

The Panel considers that the Respondent's use of the disputed domain name as an active website to sell goods bearing the Complainant's trademark or brand is irrefragable evidence that the Respondent knew of the Complainant's trademark. The Panel infers that the Respondent registered the disputed domain name incorporating the "ISABEL MARANT" trademark with the Spanish word "BARATO" to take advantage of reputation of Complainant's trademark and business goodwill. This is evidence of registration in bad faith.

Use in bad faith

The Panel has already accepted the Complainant's well-known reputation in its "ISABEL MARRANT" trademark. The Panel notes that there is an active commercial website under the disputed domain name that purports to sell products that are associated the Complainant's "ISABEL MARRANT" trademark or brand. The Panel is prepared to accept that this evidences actual knowledge.

By using the domain name, the Complainant contends that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

Thus, the Panel accepts that the Respondent is using the disputed domain name to benefit its own commercial interests which are not authorized by the Complainant. Using the Complainant's trademark in the disputed domain name to capitalize on the Complainant's goodwill is evidence of bad faith.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent and used in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On April 18, 2023 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

That neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court.

As far as the e-mail notice is concerned, CAC received a notification that the e-mail notice sent to <postmaster@baratoisabelmarant.store> was returned back undelivered as the e-mail address had permanent fatal errors. The e-mail notice was also sent to <evcsrxvw@vipmaill.com>, but CAC never received any proof of delivery or notification of undelivery. No further e-mail address could be found on the disputed site.

The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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

The Complainant owns the international trademark "ISABEL MARRANT" and the domain name <isabelmarrant.com> which is used in connection with its goods or services.

The Respondent registered the disputed domain name <baratoisabelmarant.store> on August 22, 2022. The disputed domain name appears to be an active website displaying goods, both in the Spanish language or the English language, offered for sale bearing the Complainant's trademark or brand.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is confusingly similar to the Complainant's widely known "ISABEL MARRANT" trademark.
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- (c) The disputed domain name has been registered and is being 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. baratoisabelmarant.store: Transferred

PANELLISTS

Name	William Lye OAM KC
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DATE OF PANEL DECISION 2023-04-25

Publish the Decision
