

Decision for dispute CAC-UDRP-105321

Case number CAC-UDRP-105321

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Domain names esisabelmarant.com

Case administrator

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

Complainant

Organization IM PRODUCTION

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization Evcs Rxvw

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 numerous trademarks worldwide consisting of the term "ISABEL MARANT", such as the international trademark "ISABEL MARANT" n° 1284453, registered since November 16, 2015 and the European trademark "ISABEL MARANT" n°001035534 registered since December 23, 1998.

The Complainant is also the owner of several domain names, incorporating the trademark "ISABEL MARANT", such as <isabelmarant.com> registered since April 20, 2002.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

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 it has stores around the world.

The disputed domain name <esisabelmarant.com> was registered on August 22, 2022 (hereinafter, the "Disputed Domain Name"). In accordance with the Complainant's allegation, the Disputed Domain Name redirects to a website purporting to be an online store selling the Complainant's "ISABEL MARANT" products at discounted prices.

The language of the registration agreement is English.

The above facts asserted by the Complainant are not contested by the Respondent.

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).

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a Disputed Domain Name should be transferred or cancelled:

- (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 in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and are being used in bad faith.

The Panel has reviewed in detail the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of different trademarks registrations pertaining the term "ISABEL MARANT" for different products, such as perfumery, perfumes, soaps, jewellery, clothing for men, women and children, among many others.

The Complainant's trademarks were registered prior to 2022, the year of the creation date of the Disputed Domain Name.

In the current case, the Disputed Domain Name is composed of the term "ES" - which is the common abbreviation for the country Spain – plus the incorporation of the trademark "ISABEL MARANT".

In assessing confusing similarity, the Panel finds the Disputed Domain Name is confusingly similar to the Complainant's trademark, as it incorporates the entirety of the ISABEL MARANT trademark plus the addition of the term ES. In this regard, UDRP panels agree that 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. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 ("WIPO Jurisprudential Overview 3.0.).

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a Disputed Domain Name and the Complainant's trademark as it is technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Name is confusingly similar to Complainant's "ISABEL MARANT" mark.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this vein, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the Disputed Domain Name on behalf of the Respondent such as:

- (i) before any notice to Respondent of the dispute, Respondent is using or provides with demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) The Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent did not reply to the Complaint despite the efforts made by this Center to notify the Complaint. In this regard, the Complainant has confirmed that the Disputed Domain Name is not connected with or authorized by the Complainant in any way. Moreover, the Complainant has confirmed that no license or authorization has been granted to the Respondent to make use of the Complainant's trademark.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the Disputed Domain Name.

The Respondent's name "Evcs Rxvw" provided in the Registrar's verification dated March 29th, 2023 is all what it links the Disputed Domain Name with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Name.

In terms of the evidence provided by the Complainant, the website linked to the Disputed Domain Name has been used to offer the Complainant's products. In this regard, the Complainant argues that by offering its products via the website, the Respondent attempts to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from Complainant.

Past panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name provided the following cumulative requirements ("Oki Data test") are taken into account:

- (i) the Respondent must actually be offering the goods or services at issue;
- (ii) the Respondent must use the site to sell only the 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.

See paragraph 2.8 of WIPO Jurisprudential Overview 3.0.

From the evidence presented by the Complainant and not contested by the Respondent, it is clear that the Respondent is offering

the Complainant's products and services without disclosing the Respondent's relationship via a disclaimer of explanation with the Complainant and the Respondent is also using the Complainant's trademark at the top of the website without proper authorization. This use does not meet the criteria laid down in the Oki Data test and, therefore, the Respondent cannot be considered as acting with goodwill since the current use makes the Panel to believe that the Disputed Domain Name was registered with intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Therefore, the Panel neither finds a bona fide offering of goods and service nor legitimate non-commercial or fair use of the Disputed Domain Name.

In light of the reasons above mentioned, the Panel concludes that the Complainant has satisfied the second element of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

1. circumstances indicating that the Respondent has registered or 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 the Respondent's documented out-of-pocket costs directly related to the domain name; or
2. The Respondent has 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 Respondent has engaged in a pattern of such conduct; or
3. The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
4. by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

For the current case, the evidence at hand confirms that Complainant's "ISABEL MARANT" trademark is distinctive and it has a strong reputation in the business of manufacturing, marketing and selling shoes, handbags, ready-to-wear, jewellery and couture collections. In addition, the Complainant's trademarks were registered long before the Disputed Domain Name was created. In fact, the Complainant referred to WIPO Case No. D2016-2097 IM Production v. Erica Wong where the Panel confirmed that the trademark ISABEL MARANT is sufficiently well-known in China. Based on those elements, the Panel is of the opinion that Respondent knew or should have known that the registration of the Disputed Domain Name would be confusingly similar to the "ISABEL MARANT" trademarks, in particular since the Respondent is located in China in accordance with the Registrar's verification.

Furthermore, the Complainant provided with evidence showing that the Disputed Domain Name was set up by the Respondent to create a website which offers non-authorized versions of Complainant's products with the purpose to mislead internet consumers who are attempting to purchase authorized products through the Disputed Domain Name. In this sense, the Complainant has confirmed that no authorization was granted to the Respondent to register the Disputed Domain Name and no counterargument has been submitted by Respondent, specifically to indicate the reason of a lack of disclaimer at the website. This is a clear indication that the Disputed Domain Name was set up with the only intention to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Name and the Complainant's "ISABEL MARANT" trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact that the Disputed Domain Name is being used for a website offering non-authorized products of the Complainant's with the purpose to mislead internet consumers, and d) the fact that the Respondent does not meet the criteria laid down at the Oki Data test, the Panel draws the inference that the Disputed Domain Name was 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. **esisabelmarant.com**: Transferred

PANELLISTS

Name	Victor Garcia Padilla
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DATE OF PANEL DECISION 2023-05-01
