

Decision for dispute CAC-UDRP-105494

Case number CAC-UDRP-105494

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Domain names notino.ltd

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization NOTINO LIMITED

Respondent

Name Eduard Voiculescu

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 the following EU trademarks:

- NOTINO, registration number 015221815; registered 28 June 2016 in classes 16, 35, 38 and 39;
- NOTINO TODAY IS YOURS, registration number 015944127, registered 27 January 2017 in classes 16, 35, 38 and 39;
- NOTINO TRY&BUY, registration number 016743965, registered 18 September 2017 in classes 3, 16, and 35;
- NOTINO TRY&BUY, registration number 016804049, registered 3 October 2017 in classes 3, 16, and 35;
- NOTINO, registration number 017471574, registered 9 March 2018 in classes 35 and 41;
- NOTINO, registration number 018071749, registered 11 September 2019 in classes 3, 16, 35, 38, 39 and 41;
- NOTINO, registration number 018537464, registered 11 December 2021 in classes 3, 10, and 21; and
- NOTINO, registration number 018537465, registered 11 December 2021 in classes 3, 10, and 21.

FACTUAL BACKGROUND

The Complainant is a company with its registered seat in Cyprus. It is the sole shareholder of Notino, s.r.o. (Notino), which has its registered seat in the Czech Republic.

The Complainant own numerous EU trademarks for NOTINO that predate the registration of the disputed domain name. It also owns domain names such as <notion.ro>, <notino.cz>, <notino.sk>, <notino.it>, <notino.dk> and others, which Notino uses to run e-shops offering cosmetics, perfumes, and other related goods in the European Union and also outside the EU. The NOTINO brand and e-shops are well establish within the EU.

The Respondent registered the disputed domain name on 14 February 2023 using a privacy service.

On 14 June 2023, the CAC received the following email reaction from the Respondent to the Commencement of Administrative proceeding in this case: "I do not use this site. Notino.ltd. Make me an offer. I sell it to you. Ok? I sell you the domain name."

PARTIES CONTENTIONS

In summary the Complainant asserts that the disputed domain name is interchangeable, both orally and visually with the NOTINO trademarks and the company name Notino s.r.o. It says the second-level domain, NOTINO, in the disputed domain name is identical to the second-level domain names held by the Complainant and which are used to operate Notino's e-shops.

The Complainant asserts that the Respondent has no right or legitimate interest in the disputed domain name. The Respondent is not entitled to use the Complainant's trademark in the disputed domain name and doing so violates the Complainant's rights in its NOTINO trademarks and the company name, Notino.

The Complainant asserts that the disputed domain name has been registered and is being used in bad faith as it clearly feeds on the reputation of the NOTINO brand and the Complainant's well-established e-shop business activities. It says the Respondent is acting in bad faith in using the disputed domain name to run the same business activities of the Complainant. The e-shop using the disputed domain name offers cosmetics, perfumes and other related goods to customers. These are the same categories of products that Notino offers and which are protected by the NOTINO trademarks. The Complainant asserts that the Respondent is cybersquatting and intends, for commercial gain, to misleadingly divert consumers and to tarnish the NOTINO trademarks.

No administratively compliant Response has been submitted.

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

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements:

- (i) the disputed 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 the disputed domain name; and
- (iii) the disputed domain name has been registered and used in bad faith.

Paragraph 15(a) of the Rules provides that the Panel must decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable. Paragraph 14(b) of the Rules allows the Panel to draw such inferences as are appropriate from the Respondent's failure to reply to the Complainant's assertions and evidence or to otherwise contest the Complaint. In the absence of a Response, the Panel's decision is based upon the Complainant's assertions and evidence and inferences drawn from the Respondent's failure to submit a Response.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name is comprised of the Complainant's trademark NOTINO and the top-level domain ".ltd". The Complainant's trademark NOTINO is clearly visible in the disputed domain name. The top-level domain, such as ".ltd", is a standard registration requirement can be disregarded when assessing whether the disputed domain name is identical or confusingly similar

to the Complainant's mark.

Ignoring the ".ltd" suffix, the Panel finds that that the disputed domain name is identical to the Complainant's trademark, NOTINO, and that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

The Respondent may demonstrate that he has rights or legitimate interests in the disputed domain name for purposes of Paragraph 4(a)(ii) of the Policy as follows:

- i. before any notice of the dispute, he has used, or has demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services; or
- ii. he has been commonly known by the domain name; or
- iii. he is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant has submitted evidence of its trademarks and its company name and has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof now shifts to the Respondent to show he has rights or legitimate interests (See Croatia Airlines d.d. v. Modern Empire Internet Ltd, WIPO case number D2003-0455).

The Respondent has not filed a Response. There is nothing to indicate that the Respondent has used, or has demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or that he is commonly known by the disputed domain name; or that he is making a legitimate non-commercial or fair use of the disputed domain name. Using the disputed domain name to run an e-shop offering the same products as the Complainant is not a bona fide offering of goods or services.

Having considered evidence presented and the factors outlined above, the Panel finds that the Respondent has no rights or legitimate interest in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C. REGISTERED AND BEING USED IN BAD FAITH

Paragraph 4(b) of the Policy sets out the following circumstances to be evidence that a registrant has registered and used a domain name in bad faith:

- (i) circumstances indicating that the registrant has registered or has 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 the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the registrant 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 the registrant has engaged in a pattern of such conduct; or
- (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the registrant 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 mark as to the source, sponsorship, affiliation or endorsement of its Website or location or of a product or service on its Website or location.

The Complainant's trademarks predates the registration of the disputed domain name by many years and is identical to the NOTINO trademark. An internet search by the Respondent before registering the disputed domain name would have revealed the Complainant, its NOTINO mark, its shops and online offering of beauty products.

In addition, the Respondent appears to be deliberately targeting the Complainant. The combination of the NOTINO trademark and the top-level domain ".ltd" which is an abbreviation of "limited", results in the disputed domain name being virtually the same as the Complainant's company name, Notino Limited. It also appears from the Panel's own research that the Respondent was the Respondent named in Notino Limited v Eduard Voiculescu, CAC-UDRP case number 103754, in which the panellist transferred the domains <notino.art>, <inontino.com>, <i-notino.site>, and <notino-tester.site> to the Complainant.

The Respondent has used a privacy service to conceal his identity. He has given no reason for registering a domain name that incorporates the Complainant's trademark and mirrors the Complainant's corporate name. He has used the disputed domain name to run an e-shop offering the same products as the Complainant, indicating he is intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark. The Respondent's reaction when notified of the Complaint was to offer to sell the disputed domain name.

Considering these factors, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

Accepted

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

1. notino.ltd:

PANELLISTS

Name	Veronica Bailey
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DATE OF PANEL DECISION 2023-07-21

Publish the Decision
