

Decision for dispute CAC-UDRP-105766

Case number	CAC-UDRP-105766
Time of filing	2023-09-06 10:10:03
Domain names	sezane-boutique.com

Case administrator

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

Organization	BENDA BILI
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Stephen Terrell
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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 has established by evidence that it is the registered owner of the International trademark for SÉZANE, registered No. 11708 and registered on June 3, 2013. The evidence is a certification of the registration of the trademark provided by the World Intellectual Property Organization which the Panel has examined and finds to be in order.

The Complainant has therefore established its standing to bring this proceeding

FACTUAL BACKGROUND

The Complainant is a French company engaged in the provision of ready-to-wear clothing collections and accessories for women that trades under the commercial name and trademark SÉZANE, which invokes the name of the founder and President of the business Morgane Sezalory.

It is the owner of several trademarks which it uses in its business, notably the International trademark for SEZANE No. 1170876 registered on June 3, 2013 referred to above.

It is also the owner of numerous domain names that include the name of the SÉZANE business, such as <sezane.com> which was registered on April 3, 2003 and which it uses in its business.

It has come to the notice of the Complainant that the disputed domain name was registered on August 31, 2022 and that it has been used to divert internet users to a parking page used to promote similar businesses with similar products to those of the Complainant.

This is deleterious to the Complainant's business and it has therefore filed this Complaint to obtain the transfer of the registration of the disputed domain name from the Respondent to itself.

PARTIES CONTENTIONS

COMPLAINANT

The disputed domain name is confusingly similar to the SÉZANE Trademark in which the Complainant has rights.

That is so because it includes the entirety of the trademark and adds to it a hyphen and the generic word "boutique". The addition of this generic word to the trademark cannot negate the confusing similarity between the domain name and the trademark because the overall impression of the domain name is still that it is connected with the trademark. Also, the gTLD ".com" in the domain name is not taken into account in making this comparison.

The Respondent has no rights or legitimate interests in the dispute domain name. The Complainant must first make out a prima facie case and, if it is made out, the onus of proof then moves to the Respondent to disprove this element. The prima facie case is made out in the present proceeding because the Respondent is not commonly known by the domain name, is not affiliated with or authorised by the Complainant to register or use the disputed domain name and it has no business with the Complainant. Moreover, the disputed domain name resolves to a webpage featuring products of the same genre as those produced by the Complainant under its trademark.

The disputed domain name was registered and used in bad faith. That is so because the facts show that the Respondent must have had actual knowledge of the Complainant's trademark. The Respondent's intention therefore must have been to create confusion with the Complainant and its mark, particularly as the word "boutique" is a French word and the renown of the Complainant is such that it is well-known as a French company.

Moreover, the registration of a confusingly similar domain name and using it for third parties' advertisements and links show bad faith registration and use of the domain name.

The Complainant has made out its case by the foregoing and the disputed domain name should therefore be transferred to the Complainant.

RESPONDENT

Respondent did not file 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.

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative compliance

By notification dated September 6, 2023 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint did not provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and fax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the CAC to send the Complaint as described in Paragraph 2(a) [Rules, Paragraph 3(b)(v)]. The notification invited the Complainant to have regard to the Registrar’s verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. On September 6, 2023, the Complainant filed an Amended Complaint and the CAC determined also on September 6, 2023 that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The 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 domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts, that the Complainant is the registered owner of the International Trademark for SÉZANE, registered number 1170876, registered on June 3, 2013 (“the SÉZANE trademark.”)

It will be seen therefore that the trademark was registered well before the disputed domain name was registered, which was on August 31, 2023, as is demonstrated by annex to the Complaint. The Complainant has verified that the Respondent is the registrant of the disputed domain name.

The Panel next finds that the disputed domain name is confusingly similar to the SÉZANE trademark for the following reasons.

First, the domain name includes the entirety of the SÉZANE trademark. Accordingly, it is clear that the domain name has been inspired by and is an attempt to copy the trademark. It is also clear and has been held many times in prior UDRP decisions that when internet users see an entire trademark used in a domain name in this way, they naturally conclude that the domain name is an official domain name of the trademark owner. Secondly, the domain name also includes a hyphen and, as a suffix to the trademark, the generic word “boutique” which is internationally known as the French word for “shop”, hence raising the implication that the domain name means the shop where Sézane goods are sold, which is not correct. Internet users who see the entire domain name would then naturally conclude

that the entire domain name is an assertion that it is related to the Complainant itself and/or that it was authorised by the Complainant, neither of which is true. Internet users would also conclude that the entire domain name would lead to an official website of the Complainant, which is also not true.

Finally, the hyphen and the “dot.com” suffix, both of which are present in the domain name, are disregarded for the purposes of assessing confusing similarity, as they could not negate the clear impression that the domain name is confusingly similar to the trademark, which it clearly is.

The Panel therefore finds that the disputed domain name is confusingly similar to the SÉZANE trademark and that this conclusion is consistent with the prior UDRP decisions cited by the Complainant.

The Complainant has thus made out the first of the three elements that it must establish.

Rights and Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your use of, or 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) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate noncommercial 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests and that when such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel, after considering all of the unchallenged evidence in the Complaint, finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

That *prima facie* case is made out from the following considerations:

- The Complainant has clearly established its rights in the SÉZANE mark.
- The evidence of the Complainant is that the Respondent is not related in any way to the Complainant or its business, is not affiliated with the Complainant or authorized by it in any way to use the SÉZANE trademark and does not carry out any activity for, nor has any business with, the Complainant.
- The evidence shows that the Respondent is not commonly known by the domain name under paragraph 4(c)(ii) of the Policy.
- The evidence is that no licence nor authorisation has been granted by the Complainant to the Respondent to make any use of the trademark or to register the disputed domain name.
- The disputed domain name resolves to a webpage page which contains a series of links to advertisements of commercial enterprises all of which indicate that they are offering women’s apparel for sale, which is the field in which the Complainant conducts its business and which therefore are themselves operating in competition with the Complainant. On any test, such conduct cannot give rise to a right or legitimate interest in the domain name.
- There is no evidence that the Respondent is commonly known by the domain name and all of the evidence is to the contrary.
- There is no evidence that the Respondent has used or made demonstrable preparations to use the domain name for a *bona fide* offering of goods or services.
- There is no evidence that 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. All of the evidence is that the Respondent’s activities are commercial and they are being engaged in to divert consumers and hence to tarnish the Complainant’s trademark.
- None of this conduct is *bona fide* or legitimate and none of it comes within any of the criteria for a right or legitimate interest in a domain name that are set out in paragraph 4(c) (i) – (iii) of the Policy. Nor is there any evidence to show that the Respondent could in any other way show a right or legitimate interest in the domain name.

These facts give rise to the *prima facie* case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the *prima facie* case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive.

The four specified circumstances are:

(i) 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

(ii) 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 the respondent has engaged in a pattern of such conduct; or

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

(iv) 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 or service on the site or location.

There is no need to repeat all of the details already set out under Rights and Legitimate interests, but the conduct of the Respondent in registering the domain name clearly amount to bad faith registration and its conduct since the registration by retaining the domain name and putting the Complainant at the risk of its being used to its detriment and in breach of its trademark, which clearly amounts to bad faith registration and use.

That is so for the following reasons:

First, the Respondent must have been aware of the existence of the Complainant and its prominent reputation when it registered the disputed domain name, because the Respondent chose the name of the domain name itself and then made an addition to it by adding the suffix "boutique" to suggest that it relates to a shop where the Complainant's products may be purchased. Thus, the Respondent had actual knowledge of the Complainant and its trademark which has long been regarded as a ground for finding bad faith registration and, by retaining the domain name, its use. The Panel therefore finds that it is highly likely that the Respondent chose the trademark, made the addition of "boutique" and registered the domain name to invoke the existence and activities of the Complainant for an improper purpose and therefore in bad faith.

Secondly, the conduct of the Respondent may well bring the case within the provisions of paragraph 4(b) (i) of the Policy, that being an additional explanation for registering the domain name and for retaining it.

Thirdly, the same considerations bring the case within the provisions of paragraph 4(b) (iii) of the Policy. That is so because the Respondent has made itself a competitor of the Complainant by advertising and promoting the sale of competitive products.

Fourthly, the same conduct of the Respondent leads to the conclusion that the Respondent, in registering the domain name deceptively and without any authority to do so, must have intended to create a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Thus, the matter comes within the provisions of paragraph 4(b) (iv) of the Policy.

Fifthly, there is no conceivable ground for concluding that the Respondent was acting in good faith, as the Respondent is clearly targeting the Complainant deceptively, which is an act of bad faith.

Finally, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the SÉZANE mark and retaining it, the Respondent registered and used the disputed domain name in bad faith within the generally accepted meaning of that expression.

As the Complainant rightly submits, such conduct of the Respondent has been held by previous UDRP panels to constitute bad faith registration and use.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

Accepted

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

1. **sezane-boutique.com**: Transferred

PANELLISTS

Name	Neil Brown
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DATE OF PANEL DECISION **2023-10-09**

Publish the Decision
