

Decision for dispute CAC-UDRP-106024

Case number	CAC-UDRP-106024
Time of filing	2023-12-01 07:39:41
Domain names	jonakshoponline.com, jonakpariss.com, jonakoutlets.shop, jonakbrandshop.com

Case administrator

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

Name	Joseph NAKAM
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Raffaella Damore
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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 a French company formed in Paris in 1984, where its CEO is Mr. Joseph NAKAM. The Company operates under the trade name of "JONAK". JONAK specializes in women's footwear.

The Complainant owns the following Trademarks:

- International Trademark, Reg. No. 625324, JONAK, registered on October 14, 1994 and in force until October 14, 2024;
- EUIPO Trademark, Reg. No. 002580223, JONAK, filed on February 15, 2002, registered on August 27, 2003 and in force until February 15, 2032.

FACTUAL BACKGROUND

The Complainant is a French company formed in Paris in 1984, where its CEO is Mr. Joseph NAKAM. The Company operates under the trade name of "JONAK". JONAK specializes in women's footwear.

The Complainant also owns the domain name comprising its Trademark JONAK, being <jonak.fr> registered and used for its official website since January 31, 1999.

The disputed domain names were registered between October 30, 2023 and November 14, 2023 by the same Registrant as follows: <jonakshoponline.com> registered on **October 30, 2023**; <jonakpariss.com> registered on **November 10, 2023**; <jonakoutlets.shop> registered on **November 13, 2023**; and <jonakbrandshop.com> registered on **November 14, 2023**.

By the time of this Decision, the disputed domain names websites resolve as follows: <jonakshoponline.com> and <jonakoutlets.shop> resolve to inactive websites, and <jonakpariss.com> and <jonakbrandshop.com> resolve to “under maintenance” blank websites.

PARTIES CONTENTIONS

Complainant Contentions:

The Complainant's primary contentions can be summarized as follows:

- The Complainant contends that the disputed domain names are confusingly similar to its Trademark JONAK, which is incorporated in its entirety on each disputed domain name; that the addition of the letters or generic terms are not sufficient to escape the finding that the domain names are confusingly similar to the trademark JONAK.
- The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names due to is not commonly known by the disputed domain names since the Whois information was not similar to each disputed domain names; that the Respondent is not affiliated with nor authorized by the Complainant in any way, that does not carry out any activity for, nor has any business with the Respondent; that neither license nor authorization has been granted to the Respondent to make any use of the Complainant's Trademark JONAK, or apply for registration of the disputed domain names by the Complainant.
- The Complainant contends that the disputed domain names <jonakshoponline.com> and <jonakoutlets.shop> website's inactivity confirms that the Respondent has no demonstrable plan to use the disputed domain name; that the disputed domain name <jonakpariss.com> resolves to a website for selling clothes at discounted price, meaning that it was registered in order to create a likelihood of confusion with the Complainant and its trademarks; that the disputed domain name <jonakbrandshop.com> redirects to the website displaying the Complainant's trademark and logo JONAK, and allegedly selling the Complainant's products and used to host a website in order to impersonate Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from the Complainant; that the Respondent failed at least in one of the elements of the *Ok! Data test*, i.e. the website linked to the disputed domain name does not disclose accurately and prominently the registrant's relationship with the trademark holder. Showing with it, neither a *bona fide* offering of goods nor a legitimate interest of Respondent.
- The Complainant contends that the disputed domain names were registered and are being used in bad faith due to: the Complainant Trademarks JONAK were registered several years before the registration of the disputed domain names; that the Complainant is a worldwide and well known fashion company, citing CAC Case No. 104653, *Joseph NAKAM v. Amanda Gorman*; that given the distinctiveness of the Complainant's trademarks and reputation, it was reasonable to infer that the Respondent has registered the domain names with full knowledge of the Complainant's trademarks; that the incorporation of the Complainant's Trademark plus the inactivity of <jonakshoponline.com> and <jonakoutlets.shop> evidence bad faith registration and use, citing *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 and *CBS Broadcasting, Inc. v. Dennis Toeppen*, WIPO Case No. D2000-0400; that the Respondent uses the disputed domain name <jonakpariss.com> to divert Internet users searching for Complainant's website to Respondent's competing website, and to create a likelihood of confusion with Complainant's mark for Respondent's commercial gain by offering competing products; and that the Respondent registered and uses the domain name <jonakbrandshop.com> in bad faith to create confusion with Complainant's trademarks for commercial gain by using the confusingly similar domain name to resolve to website offering counterfeit or unauthorized versions of Complainant's products in direct competition with the Complainant's.

Response

The Respondent did not reply to any of the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

In accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

- (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 respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will consider each of these requirements in turn.

1. Identical or Confusingly Similar

The Complainant has proved before the Panel, that owns Trademark Rights over the term JONAK since 1994, which precedes the registration of the disputed domain names.

The disputed domain names <jonakshoponline.com>, <jonakpariss.com> <jonakoutlets.shop> and <jonakbrandshop.com>, are composed by Complainant's Trademark JONAK on its entirety, and/or a descriptive and/or a geographical term as 'shop online', 'pariss' with an additional 's', outlets' and 'brand shop', which according to the evidence are intrinsically related to Complainant's business activity or (main) location, with it, enhancing rather than mitigating a finding of confusing similarity between the disputed domain names and the Complainant's Trademark JONAK (see WIPO Overview 3.0, section 1.8.)

In relation to the strings, it is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLDs ".com" and ".shop", are viewed as standard registration requirements and as such are disregarded under the first element confusing similarity test (see WIPO Overview 3.0, section 1.11.1).

Therefore, the disputed domain names <jonakshoponline.com>, <jonakoutlets.shop>, <jonakpariss.com> and <jonakbrandshop.com> are confusingly similar to Complainant's JONAK Trademark.

2. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent may establish rights or legitimate interests in the disputed domain names by demonstrating any of the circumstances, but without limitation, described in paragraph 4(c) of the Policy.

As multiple UDRP panelists have recognized, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy "may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element" (see WIPO Overview 3.0, section 2.1).

The Respondent has not submitted its Response and or any communication rebutting the Complainant's contentions.

According to the evidence submitted by the Complainant, this Panel finds that:

- (1) there is no evidence that the Respondent has become commonly known by the terms "jonakshoponline.com", "jonakpariss.com", "jonakoutlets.shop" and "jonakbrandshop.com";
- (2) the Respondent is not associated or affiliated with the Complainant; the Complainant has not granted any rights to the Respondent to use its Trademark JONAK, or has granted any kind of license to offer any product or service, or any rights to apply for registration of any the disputed domain names;
- (3) there is no evidence, prior of the present dispute, of the Respondent's use of or demonstrable preparation to use the disputed

domain names in connection with a bona fide offering of goods or services, in contrary: according to the submitted evidence, the Respondent purposely chose a recognized Trademark as JONAK, intentionally added generic terms and/or a geographical term as Paris (misspelling it by the addition of an “s” letter), terms all related to the Complainant’s business activity and/or its main location, register them as domain names, to passively held them, as in the case of <jonakshoponline.com> and <jonakoutlets.shop> and to point them as active websites, as in the case of <jonakpariss.com> to sell clothes at discounted price and as in the case of <jonakbrandshop.com>, to impersonate the Complainant, reproduce the Trademark and logo JONAK, and to offer counterfeit or unauthorized versions of Complainant’s products, with all of it, generating a disastrous confusion among the users who seeks or expects to find the Complainant on the Internet. Furthermore, this Panel finds that the Respondent’s use did not fulfil any of the accumulative requirements established by the Oki Data test (see WIPO Overview 3.0, section 2.8; Joseph NAKAM v. Amanda Gorman, CAC Case No. 104653 and Joseph NAKAM (Joseph NAKAM) v. Brigitte Bellamy, CAC Case No. 104978).

Therefore, to the satisfaction of the Panel, the Complainant has made out its *prima facie* case. No Response or any communication from the Respondent has been submitted. In the absence of a Response, this Panel accepts Complainant’s undisputed factual assertions as true. Thus, the Panel concludes, that the Respondent has no rights or any legitimate interest in respect of any of the disputed domain names.

3. Registered and Used in Bad Faith

3.1 Registration in Bad Faith:

According with the submitted evidence in this Case, the Complainant acquired its Trademark Rights over the term JONAK at least since 1994. The disputed domain names were registered between October 30, 2023 and November 14, 2023. Also, this Panel finds that according with the submitted evidence, and as previous UDRP panelists have recognized, the Complainant is a worldwide and well known fashion company and Trademark (see Joseph NAKAM v. Amanda Gorman, CAC Case No. 104653 and Joseph NAKAM v. xue yu, CAC Case No. 104977), therefore this Panel accepts that given the distinctiveness of the Complainant’s trademark and reputation, it is reasonable to infer that the Respondent has registered the domain names with full knowledge of the Complainant’s trademark.

According to the WIPO Overview 3.0, section 3.1.3:

“Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark: (i) **actual confusion**, (ii) **seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent’s commercial benefit, even if unsuccessful**, (iii) **the lack of a respondent’s own rights to or legitimate interests in a domain name**, (...) and (vi) **absence of any conceivable good faith use**.(...)”. (emphasis added).

In addition, the WIPO Overview 3.0, section 3.2.2 has established that:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. (...)” (emphasis added).

As described along this Decision, the disputed domain names <jonakshoponline.com> and <jonakoutlets.shop> have remained inactive. According to the submitted evidence by November 16, 2023 the disputed domain name <jonakpariss.com> resolved to a website (with sort of Complainant’s *look and feel*) for selling women’s clothes at discounted price and <jonakbrandshop.com> resolved to a website who sought, without doubts, to impersonate the Complainant business and intangible assets. By the time of this Decision the latest disputed domain names’ websites resolve to “under maintenance” blank websites with no active content as such, changes that, to this Panel, strongly emphasizes the Respondent’s awareness.

Therefore, considering the facts and the submitted evidence, in particular that all the disputed domain names are based on the Complainant’s Trademark JONAK, and that the Respondent is taking a “free-ride” on the Complainant’s goodwill and trademark reputation, to this Panel, it is clear that the Respondent knew about Complainant at the time of the registration of each disputed domain name. Also, to this Panel, it is clear, that the Respondent has incurred in Paragraph 4.b.(iv) of the Policy. Thus, the disputed domain names have been registered in bad faith.

3.2 Bad Faith Use:

Given that by the time of this Decision all the disputed domain names are inactive, this Panel considers the following factors related to the Passive Holding Doctrine, which are evident in this case, being (see WIPO Overview 3.0, section 3.3):

- (i) the high degree of distinctiveness and reputation of the Complainant’s business and Trademark JONAK;
- (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;

- (iii) the respondent's use of a Privacy Service, to conceal its identity and
- (iv) the implausibility of any good faith use to which the domain names may be put.

Therefore, this Panel concludes that, all the disputed domain names are being used in faith as well.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **jonakshoponline.com**: Transferred
- 2. **jonakpariss.com**: Transferred
- 3. **jonakoutlets.shop**: Transferred
- 4. **jonakbrandshop.com**: Transferred

PANELLISTS

Name	María Alejandra López García
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DATE OF PANEL DECISION	2024-01-05
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Publish the Decision