Decision for dispute CAC-UDRP-106116

Case number	CAC-UDRP-106116
Time of filing	2023-12-28 09:20:51
Domain names	zadig-et-voltaire-outlet.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Z&V

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Fashion Luxe

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, trading as ZADIG & VOLTAIRE, is a French company producing ready-to-wear fashion, accessories and perfumes and is the owner of European Union Trade Mark ZADIG & VOLTAIRE registration number 005014171, registered since June 8 , 2007 for goods in class 3.

FACTUAL BACKGROUND

The Complainant has an established Internet presence and additionally owns a portfolio of Internet domain names which incorporate its ZADIG & VOLTAIRE trademark, including <zadig-et-voltaire.com> which it has registered and has used as the address for its official website since May 16, 2002.

The disputed domain name <zadig-et-voltaire-outlet.com> was registered on December 20, 2023 and resolves to a website purporting to be an online store selling the Complainant's ZADIG & VOLTAIRE products at discounted prices.

There is no information available about the Respondent, except for that provided in the Complaint, the Registrar's WhoIs and the information provided by the Registrar in response to the request by the Centre for details of the registration of the disputed domain name for the purposes of this proceeding. The Registrar has confirmed that the Respondent is the registrant of the disputed domain name.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant claims rights in the ZADIG & VOLTAIRE mark established by its ownership of the abovementioned European Union Trade Mark and its use of if the mark in the sale of ready-to-wear fashion products.

The Complainant alleges that the disputed domain name is identical or confusingly similar to the Complainant's ZADIG & VOLTAIRE MARK as it fully incorporates the trademark, albeit with the ampersand replaced by the French equivalent word "et", in combination with the term "outlet" and the generic Top Level Domain ("gTLD") extension <.com>.

The Complainant contends that the presence of the additional elements within the disputed domain name does not eliminate the likelihood of confusion with the trademark and the disputed domain name creates the overall impression of the designation as being connected to Complainant's trademark and the Complainant's official domain name <zadig-et-voltaire.com>. Citing Holding v. Zhang Wei WIPO Case No. DCO2020-0015, ZV <zadig-etvoltaire.co> ("The Complainant's ZADIG & VOLTAIRE mark is clearly recognizable in the disputed domain name. The inclusion of hyphens ("-") and French word "et" ("and") in the disputed domain name does not serve to dispel the confusing similarity of the disputed domain name to the Complainant's mark. When the relevant trademark is recognizable in the disputed domain name the addition of other terms, whether descriptive, geographical, pejorative, meaningless, or otherwise, does not preclude a finding of confusing similarity under paragraph 4(a)(i) of the Policy. Generic Top-Level Domains ("gTLDs") generally are disregarded when evaluating the identity or confusing similarity of the Complainant's mark to the disputed domain name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the gTLD.").

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain name, arguing that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests, and once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name; and if the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

The Complainant argues that the Respondent is not identified in the WhoIs database by the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WhoIs information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name. Citing Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group Forum Claim FA 1781783, <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy ¶ 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c)(ii).")

The Complainant further alleges that the Respondent is not known is not known by the Complainant's name or mark, and asserts that the Respondent is not affiliated with, nor authorized by, the Complainant in any way; that the Respondent Complainant does not carry out any activity for, nor have any business with the Respondent; and neither license nor authorization has been granted by the Complainant to the Respondent to make any use of the Complainant's ZADIG & VOLTAIRE mark, or apply for registration of the disputed domain name.

Furthermore, the screen capture which is exhibited in an annex to the Complaint shows that the Respondent is using the website to which the disputed domain name resolves to impersonate the Complainant and is attempting to mislead consumers into thinking that the goods purportedly offered for sale on the Respondent's website originate from the Complainant.

The Complainant adds that the "NOTRE HISTOIRE" ("Our Story") section on the Respondent's website makes direct references to the Complainant and its story and philosophy, and argues that such use demonstrates neither a bona fide offering of goods nor a legitimate interest of Respondent. However, because the Complainant has not provided any translation of this exhibit into the language of the proceeding, it would be inappropriate for this Panel to consider this submission.

Furthermore, the website to which the disputed domain name resolves shows that the Respondent identifies itself as FASHION LUXE, registered under the number 347 385 570 or 347 383 570, and a search, the results of which the Complainant has exhibited in an annex to the Complaint shows that no such company is registered under this denomination or these numbers in the French registry of companies

Additionally it is submitted that the website linked to the disputed domain name does not disclose accurately and prominently the registrant's relationship with the trademark holder and the use of the disputed domain name within the address of the Respondent's website fails to meet the test which would permit a reseller to establish a right in the disputed domain name.

The Complainant finally alleges that the disputed domain name was registered and is being used in bad faith, because it is confusingly similar to the Complainant's well-known trademark ZADIG & VOLTAIRE which was registered several years before the registration of the disputed domain name. In this regard the Complainant submits that prior panels established under the Policy have held that the Complainant's ZADIG & VOLTAIRE mark is well-known. See for instance Z&V v. (Wen Jun Yan) WIPO Case No. Case No. D2021-0918, ("The Complainant states that ZADIG & VOLTAIRE is a global, well-known fashion company. The Complainant asserts that given the distinctiveness of its trademarks, and their global reputation it is inconceivable that the Respondent registered the Disputed Domain Names without bad faith.").

The Complainant adds that the ZADIG & VOLTAIRE mark is displayed on the Respondent's website.

The Complainant argues that given the distinctiveness and reputation of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

Moreover, the disputed domain name redirects to a website purporting to be an online store selling the Complainant's ZADIG & VOLTAIRE products at discounted prices. The Complainant asserts that the Respondent registered and is using the disputed domain name in bad faith to create confusion with the Complainant's trademark for commercial gain by using the confusingly similar domain name to resolve to a website offering counterfeit or unauthorized versions of Complainant's products in direct competition with the Complainant's products can evince bad faith under Policy ¶ 4(b)(iv). See Bittrex, Inc. v. Wuxi Yilian LLC Forum Claim FA 1760517, (finding bad faith per Policy ¶ 4(b)(iv) where it was held that the respondent registered and was using the <lbittrex.com> domain name in bad faith by directing Internet users to a website that mimicked the complainant's own website in order to confuse users into believing that Respondent is Complainant or is otherwise affiliated or associated with Complainant.)

Based on the above, the Complainant contends that the Respondent acquired the disputed domain name with the only intention to attract for commercial gain internet users to the Respondent's website as in ZV HOLDING v. Luis Alberto Fernandez Garcia CAC Case N° 104392, and in IM PRODUCTION v. Guilan Wei CAC Case No. 104561.

RESPONDENT:

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

The Complainant's Rights

The Complainant has provided convincing, uncontested evidence that it has rights in the ZADIG & VOLTAIRE mark, established by the ownership of the portfolio of trademark and service mark registrations described above and the reputation and goodwill that it has established in the mark by extensive use in its business marketing fashion goods and accessories.

Confusing Similarity

The Disputed Domain Name <zadig-et-voltaire-outlet.com> consists of the Complainant's ZADIG & VOLTAIRE mark in its entirety, albeit with the word "et" in substitution for the ampersand, in combination with three hyphens and the word "outlet" together with the generic Top-Level Domain ("gTLD") extension <.com>.

The Complainant's ZADIG & VOLTAIRE mark is clearly recognizable as being the initial, dominant and only distinctive element in the disputed domain name.

The substitution of the ampersand by the word “et” in the trademark of a French corporation has no significance, as it is commonly known that they are synonyms.

It is well accepted that confusing similarity is typically established once a complainant’s trademark is incorporated in its entirety in the domain name at issue.

In the present case, the addition of the three hyphens and the descriptive word “outlet” to the Complainant’s mark does not dimmish the confusing similarity between the disputed domain name and the mark.

Neither does, the gTLD extension <.com> does prevent a finding of confusing similarity because in the circumstances of this proceeding, it would be considered to be a necessary technical requirement for a domain name registration,

This Panel finds therefore that the disputed domain name is confusingly similar to the ZADIG & VOLTAIRE mark in which the Complainant has rights, and the Complainant has therefore succeeded in the first element of the test in Policy Paragraph 4(a)(i).

The Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain name arguing that

- the Respondent is not identified in the Whois database as the disputed domain name;
- the Respondent is not known is not known by the Complainant’s name or mark;
- the Respondent is not affiliated with nor authorized by the Complainant in any way;
- the Respondent Complainant does not carry out any activity for, nor has any business with the Respondent;
- neither license nor authorization has been granted by the Complainant to the Respondent to make any use of the Complainant’s ZADIG & VOLTAIRE mark, or apply for registration of the disputed domain name;
- the screen capture which is exhibited in an annex to the Complaint shows that the Respondent is using the website to which the disputed domain name resolves to impersonate the Complainant and is attempting to mislead consumers into thinking that the goods purportedly offered for sale on the Respondent’s website originate from the Complainant;
- the website to which the disputed domain name resolves shows that the Respondent identifies itself as FASHION LUXE, registered under the number 347 385 570 or 347 383 570, and a search, the results of which the Complainant has exhibited in an annex to the Complaint shows that no such company is registered under this denomination or those numbers in the French registry of companies

Additionally, the website linked to the disputed domain name does not disclose accurately and prominently the registrant’s relationship with the trademark holder and the use of the disputed domain name within the address of the Respondent’s website fails to meet the test which would permit a reseller to establish a right in the disputed domain name.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

Respondent has failed to discharge that burden and therefore this Panel must find that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

Complainant has adduced uncontested evidence that it owns and uses the ZADIG & VOLTAIRE mark on the on its fashion and accessories products and on its website at <www. <zadig-et-voltaire.com> since at least May 16, 2007, whereas the confusingly similar disputed domain name was not created until December 20, 2023

The ZADIG & VOLTAIRE mark is a very distinctive combination of two family names, and given the extent of Complainant’s prior rights and reputation, it is implausible that the registrant chose and registered those names in combination and in the identical order, without knowledge of Complainant, its rights and its mark.

This finding is supported by the fact that the exhibited screen capture of the website to which the disputed domain name resolves shows that the disputed domain name is being used within the disputed domain name as a website address which is clearly intended to attract and divert Internet traffic intended for the Complainant.

On the balance of probabilities the disputed domain name was chosen and registered to target and take predatory advantage of the Complainant’s mark and its goodwill in the ZADIG & VOLTAIRE mark.

This Panel finds therefore the disputed domain name was registered in bad faith.

The uncontested evidence adduced by the Complainant further shows that the Respondent is purporting to offer products, purporting to be those manufactured by the Complainant on the website to which the disputed domain name to resolve. The Complainant has argued that because the products are being offered at discounted prices they are, on the balance of probabilities, effectively counterfeit goods. While this is not improbable there is not sufficient evidence on the record to make such a finding.

Nonetheless, the uncontested evidence shows that the Respondent is using the disputed domain name to attract Internet users, and divert their traffic to the Respondent’s website in circumstances where the Respondent has not authorized such use of its trademark, and furthermore the exhibited screen capture shows that the Respondent’s website does not in any way flag that it is in no way associated with the Complainant.

Such intentional unauthorized use of the disputed domain name in an attempt to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s web site constitutes use of the disputed domain name in bad faith for the purposes of the Policy.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, Complainant has therefore succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **zadig-et-voltaire-outlet.com**: Transferred

PANELLISTS

Name	**James Bridgeman**

DATE OF PANEL DECISION 2024-01-24

Publish the Decision