Decision for dispute CAC-UDRP-106190

Case number	CAC-UDRP-106190
Time of filing	2024-01-25 13:02:09
Domain names	zadigeevoltaire.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Z&V

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	fe

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 the European Union trademark ZADIG & VOLTAIRE with registration No. 005014171, registered on 8 June 2007 for goods in International Class 3 (the “ZADIG & VOLTAIRE trademark”).

FACTUAL BACKGROUND

The Complainant was established in 1997. It is a French company in the fashion industry, and markets ready-to-wear fashion, accessories and perfumes under the brand ZADIG & VOLTAIRE.

The Complainant owns the domain name <zadig-et-voltaire.com>, registered on 16 May 2002.

The disputed domain name was registered on 22 January 2024 and resolves to an online store selling third party clothing items at discounted prices.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to its ZADIG & VOLTAIRE trademark, as it reproduces this trademark with the replacement of the ampersand “&” by the letters “ee”, which is not sufficient to avoid the likelihood of confusion.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because there is no relationship between the Parties, the Respondent is not commonly known by the disputed domain name, and the Complainant has not authorized the Respondent to use the ZADIG & VOLTAIRE trademark or to register the disputed domain name.

The Complainant adds that the Respondent is not making a bona fide offering of goods or services through the disputed domain name or carrying out a legitimate non-commercial or fair use of it. Rather, the Respondent uses the disputed domain name to a website purporting to be an online store selling third party clothing products at discounted prices. According to the Complainant, this shows that the domain name was registered to make profit of the notoriety of the Complainant’s ZADIG & VOLTAIRE trademark by offering third party goods in direct competition with Complainant, which is not a bona fide offering of goods or services.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, given the distinctiveness of the Complainant’s ZADIG & VOLTAIRE trademark and its reputation, it is reasonable to infer that the Respondent, who is French, has registered the disputed domain name with knowledge of this trademark. The Complainant maintains that the Respondent registered and uses the disputed domain name to divert Internet users searching for the Complainant’s website to the Respondent’s competing website for commercial gain by offering third party goods in direct competition with the Complainant.

RESPONDENT:

The Respondent did not submit 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.

PRINCIPAL REASONS FOR THE DECISION

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the 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 domain name; and

(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the

Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the ZADIG & VOLTAIRE trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence "zadigeevoltaire", which reproduces the word elements of the ZADIG & VOLTAIRE trademark entirely and only replaces the ampersand with the letters "ee". This replacement has a low effect on the overall impression made by the disputed domain name, in which the ZADIG & VOLTAIRE trademark is easily distinguishable. As discussed in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "WIPO Overview 3.0"), in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Taking all the above into account, the Panel finds that the disputed domain name is confusingly similar to the ZADIG & VOLTAIRE trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name 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.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because there is no relationship between the Parties and Respondent is not commonly known under the disputed domain name. The Complainant also points out that the disputed domain name resolves to a website that offers for sale goods that compete with the goods offered by the Complainant. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not provided a plausible explanation of its registration and use of the disputed domain name.

In the Panel's view, the circumstances of this case do not contradict the prima facie case made by the Complainant and do not support a finding that the Respondent has rights and legitimate interests in the disputed domain name. It is confusingly similar to the Complainant's ZADIG & VOLTAIRE trademark and its composition may create an impression that the disputed domain name represents an official online location of the Complainant, and the evidence in the case shows that the associated website offers clothing products in competition with the Complainant.

All the above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the ZADIG & VOLTAIRE trademark, has registered and used the disputed domain name targeting this trademark in an attempt to exploit its goodwill by confusing Internet users that the disputed domain name is affiliated to the Complainant, and attracting them to its website where goods competing with the Complainant's products are offered. The Panel does note regard such conduct as legitimate and giving rise to rights or legitimate interests of the Respondent in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly

related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The registration of the Complainant's ZADIG & VOLTAIRE trademark predates with decades the registration date of the disputed domain name, which reproduces this trademark almost entirely with minor changes that do not practically distinguish it from the trademark. This may lead Internet users to believe that the disputed domain name and the website to which it resolves represent an official online location of the Complainant. The Respondent's website offers competing third-party products. The Panel is therefore of the view that the Respondent is more likely to have registered and used the disputed domain name with knowledge of the Complainant's ZADIG & VOLTAIRE trademark and with the intention of taking advantage of its goodwill by diverting the Complainant's customers to its website to offer them goods in competition with the Complainant for commercial gain.

This satisfies the Panel that the disputed domain name has been registered and 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. **zadigeevoltaire.com**: Transferred

PANELLISTS

Name	**Assen Alexiev**

DATE OF PANEL DECISION 2024-02-22

Publish the Decision