# Decision for dispute CAC-UDRP-106251

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| Case number | CAC-UDRP-106251 |
| Time of filing | 2024-02-13 10:52:29 |
| Domain names | zadig-voltaire.com |

## Case administrator

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| Name | Olga Slanařová (Case admin) |

## Complainant

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| Organization | Z&V |

## Complainant representative

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| Organization | NAMESHIELD S.A.S. |

## Respondent

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| Name | dcevev evdsvdv |

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

In this proceeding the Complainant relies on the following trademark registration:

- European Union (EU) trademark No. 005014171 “ZADIG & VOLTAIRE” (word), registered on June 8, 2007.

The Complainant also refers to its “ZADIG & VOLTAIRE” domain names portfolio including the domain name <zadig-et-voltaire.com> registered and used for its official website since May 16, 2002.

FACTUAL BACKGROUND

**THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS**

The Complainant states that it is a French company in the fashion industry. Established in 1997 by Thierry Gillier, the brand “ZADIG & VOLTAIRE” is used for ready to-wear fashion, accessories and perfumes.

The disputed domain name was registered on February 8, 2024 and resolves to a website that appears to be an online store selling the Complainant’s “ZADIG & VOLTAIRE” goods at discounted prices.

The Complainant states that the disputed domain name is confusingly similar to its “ZADIG & VOLTAIRE“ trademark since it fully incorporates the Complainant’s trademark without the ampersand (&). The Complainant contends that this doesn’t eliminate the confusing similarity with the trademark. The Complainant also contends that the addition of a hyphen is not sufficient to distinguish the disputed domain name from the Complainant’s trademark.

The gTLD <.com> does not affect confusing similarity.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name and is not known by the disputed domain name.

The Complainant contends that Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither a license nor an authorization has been granted to the Respondent to make any use of the Complainant’s trademark or apply for registration of the disputed domain name.

The disputed domain name is used to host the website to impersonate the Complainant and to mislead consumers into thinking that the goods allegedly offered for sale on the website originate from the Complainant. Such use demonstrates neither a bona fide offering of goods nor a legitimate interest of the Respondent. The Respondent failed at least one of the elements of the “Oki 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.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant’s submissions on the bad faith element of the Policy can be summarized as follows:

1. The Complainant contends that the disputed domain name is confusingly similar to its “ZADIG & VOLTAIRE” trademark, registered several years before the registration of the disputed domain name and refers to previous UDRP decisions recognizing its mark a well-known mark.
2. Given the distinctiveness 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.
3. The Complainant claims that Respondent registered and uses the disputed domain name 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. The Complainant states that using a confusingly similar domain name to trade upon the goodwill of Complainant’s mark can be evidence of bad faith under the Policy par. 4(b)(iv).

Therefore, the Complainant claims the disputed domain name was registered and being used in bad faith.

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PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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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).

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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).

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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

**A. Identical or confusingly similar with the Complainant's trademark**

The Complainant provides evidence of its EU trademark registration. As confirmed by the "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition" ("WIPO Overview 3.0"): "where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case" (see sec. 1.2.1). Therefore, the Complainant has trademark rights for the purpose of the UDRP.

The disputed domain name fully incorporates the Complainant's mark with the omission of the ampersand and the addition of a hyphen.

As stated in WIPO Overview 3.0: "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" (see sec. 1.7).

The Complainant's word trademark "ZADIG & VOLTAIRE" is clearly recognizable within the disputed domain name as it is fully incorporated in the disputed domain name. The only difference between the Complainant's trademark and the disputed domain name is absence of the ampersand and presence of the hyphen. This does not in any way affect confusing similarity.

The gTLD ".com" is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

**B. Rights or Legitimate Interests**

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see **"Julian Barnes v. Old Barn Studios", WIPO Case No. D2001-0121; "Belupo d.d. v. WACHEM d.o.o.", WIPO Case No. D2004-0110**.

The Respondent failed to respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and **CAC Case No. 101284**: "A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant".

The Complainant has made a prima facie case of Respondent's lack of rights or legitimate interests.

The Respondent is not known by the disputed domain name and is identified as an individual with no connection to the Complainant's business, the disputed domain name or any name corresponding to the disputed domain name. The Complainant has not granted any license or authorization to use its trademark to the Respondent and the Complainant is not doing any business with the Respondent.

The disputed domain name was registered on February 8, 2024 and is used for a website that seems to advertise and offer Complainant's goods for sale at discounted prices.

The website by the disputed domain name contains pictures of the Complainant's goods and a sign "Trusted Store" at the bottom of the web page.

Therefore, hypothetically the Respondent could be considered as an unauthorized reseller of Complaint's goods and unauthorized resellers/distributors may under certain circumstances have a legitimate interest under the "Oki Data Test" criteria as outlined in "Oki Data Americas, Inc. v. ASD, Inc.", WIPO Case No. D2001-0903 and 2.8.1 of WIPO Overview 3.0.

The Respondent in this dispute, however, fails to comply with the "Oki Data" requirements, namely it fails to "accurately and prominently disclose the relationship with the trademark holder".

Moreover, it appears that the Respondent actually tried to increase confusion with the Complainant by using the "Trusted Store" sign thus alleging that this website is somehow approved by the Complainant. There is no any information on the website by the disputed domain name that somehow describes registrant's relationship with the Complainant and the Respondent attempts to impersonate the Complainant by using the "Trusted Store" sign.

As noted in WIPO Overview 3.0: "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, **impersonation/passing off**, or other types of fraud) can never confer rights or legitimate interests on a respondent" (see sec. 2.13.1).

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

**C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see sec. 3.1 of WIPO Overview 3.0). Targeting with an intent to take unfair advantage of Complainant's mark is important in establishing bad faith under the UDRP.

As noted by Gerald M. Levine in his treatise, the leading authority on the subject of UDRP and domain name disputes: "knowledge and targeting are prerequisites to finding bad faith registration" and "knowledge of a complainant's mark, if not directly evident or denied, can be inferred or rebutted from website's content, strength of the mark and respective timing of a mark's use in commerce and registration of the domain name" (see "**Domain Name Arbitration**", Gerald M. Levine, "Legal Corner Press", Second Edition, 2019, page 235).

The Panel finds that the Complainant provided sufficient evidence that the disputed domain name was registered and is being used in bad faith.

The Panel's findings are based on the following:

1. The nature of the disputed domain name and the timing of the registration of the disputed domain name – February 8, 2024, many years after the Complainant obtained protection for its trademark and many years after the Complainant started its business. The nature of the disputed domain name as well as its actual use indicate that the Respondent was aware of the Complainant and its trademark when he/she registered the disputed domain name.
2. The strength of the Complainant's trademark that is supported by previous UDRP decisions, e.g. **CAC Case No. 104347:** "Given the distinctiveness of the ZADIG & VOLTAIRE Trade Mark, it would be inconceivable for the Respondent to argue that it did not have knowledge of the Complainant's rights at the time of registration" and **CAC Case No. 104828:** "The fact that the Complainant's trademark is a well-known and that the Respondent makes references to the Complainant's products and trademarks in the website implied that the Respondent had prior knowledge of the Complainant's trademark…" At the same time the Panel notes that the Complainant did not provide sufficient evidence that its mark is well-known. It provided only screenshots of its own website and an extract of the EUIPO website with the trademark registration details as well as details of its own domain name registration. While this is not fatal to the Complainant's position, as other evidence demonstrates targeting and bad faith, the Complainant is advised to provide more evidence in future cases.
3. The nature of use of the disputed domain name and the content of the website by the disputed domain name related to the Complainant and its trademark and impersonating the Complainant (see e.g. **CAC Case No. 104828**: "the Disputed Domain Name is currently used to host the website to impersonate the Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from Complainant"). The Complainant provided evidence that the disputed domain name is used for hosting Complainant's related content and pictures of Complainant's goods along with the "Trusted Store" sign that is misleading and indicates impersonation.
4. A clear absence of rights or legitimate interests as discussed above under the second element analysis coupled with impersonation and with no credible explanation for the Respondent's choice of the disputed domain name and its use. Based on the registrar's info the Respondent seems to have provided fake details such as name, surname and street address. This together with other pieces of evidence indicates bad faith.

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his/her web site, by

creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent takes unfair advantage of the Complainant’s mark.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

## PANELLISTS

| Name | **Igor Motsnyi** |
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DATE OF PANEL DECISION 2024-03-12

Publish the Decision