Decision for dispute CAC-UDRP-106281

Case number	CAC-UDRP-106281
Time of filing	2024-02-20 17:35:57
Domain names	xn--zadigetvoltairebelgi-13b.com , xn--zadigetvoltaireespaa-m7b.com , xn--zadigetvoltaireper-05b.com , xn--zadigetvoltairetrkiye-oic.com , xn--zadigvoltairesterreich-6hc.com

Case administrator

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

Complainant

Organization	Z&V

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Zhang Qiang

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 the owner of the European trademark, EUTM n°005014171, for the word mark, ZADIG & VOLTAIRE, filed on 17 June 2006 and registered on 8 June 2007 in class 3 for Soaps; perfumery, cosmetics, hair lotions. That is a unitary mark valid in all 27 member states.

The Complainant also owns a domain name portfolio, which domains include its distinctive word mark, ZADIG & VOLTAIRE. The main domain name is <zadig-et-voltaire.com> registered since 16 May 2002.

FACTUAL BACKGROUND

Z&V (the Complainant), trading under the name ZADIG & VOLTAIRE, is a French company in the fashion industry. Established in 1997 by Thierry Gillier, the brand ZADIG & VOLTAIRE sells ready-to-wear fashion, accessories and perfumes.

The disputed domain names <zadigetvoltairebelgië.com>, <zadigetvoltaireespaña.com>, <zadigetvoltaireperú.com>, <zadigetvoltairetürkiye.com> and <zadigvoltaireösterreich.com> were all registered by Zhang Qiang on 22 August 2023 and are currently inactive.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant says the disputed domain names are confusingly similar to its registered word mark, ZADIG & VOLTAIRE, and that this is classic typo-squatting, where the ampersand, & sign in the EUTM, is replaced by the French word for, et, (meaning and) or omitted but otherwise the distinctive word mark is included in full. It cites a similar case, WIPO Case No. DCO2020-0015, ZV Holding v. Zhang Wei <zadig-et-voltaire.co> and says the use of the .com and the addition of country names gives the impression that the disputed domain names are the official domains of its sales subsidiaries or branches and compounds the confusion, as does the similarity with the Complainant's own domain name.

The Complainant says the Respondent, Zhang Qiang, is not identified in the Whois database by the disputed domain names and has no legitimate rights or interests and there is no such use.

The Complainant says prior UDRP panels have established that the trademark is well-known. Please see for instance WIPO Case No. Case No. D2021-0918, Z&V v. (Wen Jun Yan). As prior UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. See WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows and WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 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

This Panel concurs that the registered word mark is a well-known mark. The Panel finds the disputed domain names are all confusingly similar to the word mark for the first limb of the Policy, the similarity analysis. They all contain, and indeed start with, the full word mark of the Complainant, combined with endings that are geographic or generic/descriptive terms and have a .com ending. These factors all suggest they are official and does not signal a mere licensee or retailer or distributor—although the suffix is not formally relevant at this limb. Panellists tend to find impersonation when a mark is used in these circumstances.

The real issue in the case is in relation to the second limb of the Policy, namely whether there is any legitimate use. That is, whether the Respondent is making a bona fide offering of goods or services and has a legitimate right or interest in doing so under the second limb of the Policy. At the second limb, a complainant is only required to make out a prima facie case that a respondent lacks rights or legitimate interests and then the burden shifts to the respondent to show it has rights or legitimate interests in the domain name. If it fails to do so, the complainant is deemed to have satisfied the limb in paragraph 4(a) (ii). See WIPO Case No. D2003-

0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd. 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. See the Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>. Here it is very clear that the Respondent, Zhang Qiang, is not known by the name ZADIG & VOLTAIRE in the WHOIS records. There is also no use as such to be bona fide use at the second factor. The Complainant has discharged its burden on this limb.

While passive holding is not Bad Faith per se, it is fact sensitive. Often, where there is no website, the purpose will be for emails. Here we do not know if the MX records are configured which will suggest that the purpose was phishing. In such a case, the Panel is entitled to draw such inferences as are appropriate and they are that registration was not for a legitimate purpose or interest. Here the Respondent has been granted an opportunity to come forward and answer or present compelling arguments that he has rights or legitimate interests in the disputed domain names but has failed to do so. The WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows is apposite. This is sometimes known as the passive Bad Faith test. Where a famous or well-known mark is incorporated into a domain name without any legitimate reason or explanation, Bad Faith can often be inferred. The Respondent did not come forward to explain his reasons for the selection of the disputed domain names. The Panel agrees that the Respondent must have known of the Complainant. The Complainant has discharged its burden.

The Panel finds this is a case of registration and use in bad faith and orders transfer.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **xn--zadigetvoltairebelgi-13b.com** : Transferred
2. **xn--zadigetvoltaireespaa-m7b.com** : Transferred
3. **xn--zadigetvoltaireper-05b.com** : Transferred
4. **xn--zadigetvoltairetrkiye-oic.com** : Transferred
5. **xn--zadigvoltairesterreich-6hc.com** : Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2024-03-26

Publish the Decision