Decision for dispute CAC-UDRP-106320

Case number	CAC-UDRP-106320
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Domain names	zadigeu.shop

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Z&V

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	sdasfasdf cxzcsd

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 has established by evidence that it has rights in the ZADIG & VOLTAIRE trademark by virtue of its registration of the trademark for ZADIG & VOLTAIRE with the European Union Intellectual Property Office (“EUIPO”), registered Number 005014171, which was registered on June 8, 2007 (“the ZADIG & VOLTAIRE trademark”).

FACTUAL BACKGROUND

The Complainant is a prominent French company in the fashion industry which uses the business name Z&V. The Complainant has registered trademark rights in the ZADIG & VOLTAIRE trademark by virtue of its registration of the trademark for ZADIG & VOLTAIRE with the European Union Intellectual Property Office (“EUIPO”).

The Complainant is also the owner of the domain name<zadig-et-voltaire.com> under which it provides its services and which it registered on May 16, 2002.

The Respondent registered the <zadigeu.shop>domain name on January 17, 2024 ("the disputed domain name").

The Complainant has become aware that in registering and using the disputed domain name, the Respondent has copied its ZADIG & VOLTAIRE trademark and has used the disputed domain name for a website on which it purports to be the Complainant and to be offering for sale goods that it falsely claims are products

of the Complainant, whereas in reality they are counterfeit and goods that the Respondent is not authorized to offer for sale.

The Complainant has concluded that the conduct of the Respondent in that regard is misleading to the public, a breach of the Complainant's trademark and damaging to the Complainant and its brand and business. Hence it has brought this proceeding to have the disputed domain name transferred to itself.

PARTIES CONTENTIONS

A. Complainant

Complainant made the following contentions.

1. The Complainant is a prominent French company in the fashion industry and a legal entity which uses the business name Z&V.
2. The ZADIG & VOLTAIRE trademark has become prominent, has attracted substantial goodwill and is uniquely associated with the Complainant's goods and services.
3. The Complainant had acquired its trademark rights in the ZADIG & VOLTAIRE trademark prior to the date when the Respondent registered the disputed domain name.
4. In registering the disputed domain name, the Respondent incorporated in it the dominant portion of Complainant's ZADIG & VOLTAIRE trademark, namely "ZADIG" without any authority to do so, and added the letters "eu", a well-known abbreviation for "Europe" and the generic Top Level Domain ".shop". These changes do not negate the confusing similarity between a domain name and a mark per Policy paragraph 4(a)(i) that is otherwise present, as it is in the present case.
5. The disputed domain name is therefore confusingly similar to the Complainant's ZADIG & VOLTAIRE trademark.
6. The Respondent has no rights or legitimate interests in the disputed domain name. That is so because:

(a) the Respondent is not commonly known by the disputed domain name as the WHOIS records of the domain name show that the registrant of the domain name does not have a name that is even

similar to the domain name;

(b) the Complainant is not affiliated with or authorized by the Respondent in any way;

(c) the Respondent does not carry out any activity for, nor has any business with, the Complainant;

(d) the Complainant has not licensed the ZADIG & VOLTAIRE trademark to the Respondent, and the Complainant has not granted Respondent any right, authorization, or permission to use the

Complainant's trademark in a domain name or in any other way;

(e) the Respondent has caused the domain name to be used to resolve to a website where it impersonates the Complainant and attempts to mislead internet users into thinking that the goods

purportedly offered for sale on the website originated with the Complainant;

(f) the aforesaid website does not disclose accurately and prominently the true relationship between the Complainant and the Respondent;

The Respondent has registered and used the disputed domain name in bad faith. The Respondent has registered and used the disputed domain name in bad faith. because the Complainant contends that:

(a) the disputed domain name is confusingly similar to the ZADIG & VOLTAIRE trademark, it was registered after the registration of the trademark and the trademark is well-known;

(b) the evidence will show that the Respondent registered the disputed domain name with actual knowledge of the Complainant and its trademark rights;

(c) the evidence will show that the Respondent has registered and used the domain name to create confusion with the Complainant's trademark for commercial gain by using it to resolve to the aforesaid website which offers counterfeit or unauthorized versions of the Complainant's products in competition with the Complainant's official and legitimate products and within the meaning of Policy paragraph 4(b)(iv).

11. The Complainant has cited numerous prior UDRP decisions to support its contentions.

12. It is therefore submitted by the Complainant that it has shown all of the elements that it must establish under the UDRP and that the domain name should be transferred from the Respondent to the Complainant.

B. Respondent

The Respondent did not file 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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

A. Administrative compliance

By notification dated March 4, 2024, and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint did not sufficiently identify the Respondent. The notification invited the Complainant to have regard to the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. Also on March 4, 2024, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In that regard, the Panel also notes that the onus is on the Complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

Confusingly Similar

The first question that arises is whether the Complainant has rights in a trademark or service mark on which it may rely. The Complainant has established by evidence that it has registered trademark rights in the ZADIG & VOLTAIRE trademark by virtue of its registration of the trademark for ZADIG & VOLTAIRE with the European Union Intellectual Property Office ("EUIPO"), Registered Number 005014171, registered on June 8, 2007("the ZADIG & VOLTAIRE trademark").

The next question that arises is whether the disputed domain name is identical or confusingly similar to the Complainant's ZADIG & VOLTAIRE trademark. It is clearly not identical because of the extraneous detail the Respondent has added, but it is equally clear that the domain name is confusingly similar to the ZADIG & VOLTAIRE trademark.

That is so because the domain name consists, first, of the dominant portion of the trademark, namely ZADIG. The evidence is clear that the trademark and the business conducted under it are so well known that internet users would certainly regard the word ZADIG as invoking the ZADIG & VOLTAIRE trademark. Internet users would also see the letters "eu" added to the trademark and included in the domain name and would instantly recognize this as the well-known abbreviation for Europe. From that, they would conclude that the domain name was holding itself out to be a domain name for the European operations of the company that traded under the ZADIG & VOLTAIRE trademark, namely the Complainant. Finally, because of the addition of the generic Top Level Domain ".shop", internet users would conclude that the domain name related to the retail operations of the owner of the trademark. In any event, generic top level domains are routinely not taken into account by UDRP panels when considering confusing similarity, as all domain names contain a gTLD.

Accordingly the domain name would be seen, and no doubt was intended to be seen, as a domain name of the Complainant or authorized by it and that it related to the legitimate retail activities of the Complainant in Europe.

The domain name is therefore confusingly similar to the ZADIG & VOLTAIRE trademark.

The Complainant has thus made out the first of the three elements that it must establish.

Rights or Legitimate Interests

It is now well established that the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii) and that, if the prima facie case is made out, the burden then shifts to the Respondent to show that it does have such rights or legitimate interests. See Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (Forum Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)).

The Panel finds on the evidence that the Complainant has made out a prima facie case that arises from the following considerations:

- the Respondent has chosen to take the Complainant's trademark and use it in the disputed domain name, making only the alterations and additions to the trademark mentioned above, generating the clear impression that it referring to and invoking the Complainant's ZADIG & VOLTAIRE trademark and that the Respondent intended to use the domain name for an unauthorized purpose involving the use of the Complainant's trade and branded product name. The Respondent had no right to do any of this, meaning that there is no foundation at all for finding that it had the right to do so or that it gave the Respondent any legitimate interest in the domain name so created;
- the Respondent registered the disputed domain name on January 17, 2024;
- the Complainant had acquired its trademark rights in the ZADIG & VOLTAIRE trademark before the Respondent registered the disputed domain name;
- the Respondent had no right to register the domain name and no legitimate interest in doing so; the intention of the Respondent is very clear and it was to invoke the Complainant's name, trademark and business name and to copy them, which cannot conceivably give rise to a right or legitimate interest in the domain name;
- having registered the disputed domain name, the Respondent set about creating a website that widely uses the ZADIG & VOLTAIRE trademark and the Complainant's products or, more likely, counterfeit products, which shows that the domain name and website have been used to mislead internet users and extract money from them under false pretences;
- that conduct was a clear infringement of the Complainant's ZADIG & VOLTAIRE trademark;
- the evidence of the foregoing matters is contained in the Complainant's annex to the complaint. The Panel has examined that Annex and the detail contained in it. The Annex shows the use the Respondent has made of the domain name which in summary is that the domain name has been used to resolve to web pages that prominently display Complainant's ZADIG & VOLTAIRE trademark; in that regard, it is notable that the website does not merely display the word "Zadig" but the entire trademark ZADIG & VOLTAIRE. Its effect it to say to internet users that if they had any doubt about whether the domain name would lead to the ZADIG & VOLTAIRE, they may rest assured that they have in fact reached the website of Zadig & Voltaire, which is of course untrue and seriously misleading. The Annex also shows that the website uses the nomenclature "@2024 Zadig & Voltaire" and "zadigeu.shop" to continue with its deception. It also offers unrealistically discounted prices, which is another mark of such deception. Moreover, looking at the website, it contains all of the usual accoutrements of such misleading sites and which must mislead internet users. Thus, it provides for alleged shipping arrangements and a returns policy as well as a login facility which is no doubt a trap to acquire personal information from internet users. All of these features show that the Respondent could not conceivably have a right or legitimate interest in the domain name;
- all of the other grounds relied on by the Complainant have been made out on the evidence;
- thus, the Respondent could not possibly be commonly known by the domain name;
- the evidence shows that the Respondent has no licence or authorization to use the ZADIG & VOLTAIRE trademark;
- the evidence shows that the Respondent is impersonating the Complainant and attempting to mislead internet users into thinking that the goods offered for sale on the website originate from the Complainant and are legitimate ZADIG & VOLTAIRE goods which they are not;
- it is clear that the Respondent is not making a bona fide offering of goods or services within the meaning of Policy paragraph 4(c) (i); the offering cannot be bona fide when it is based on falsehoods;
- the evidence also shows that the domain name is not being used for a legitimate non-commercial or fair use; the use of the domain name has been demonstrated to be illegitimate because it is being used to mislead internet users; it also cannot be said to be non-commercial in any sense as it clearly is intended to be used by the Respondent for a financial purpose, namely to make money; nor is it fair, as it is clearly unfair to use a trademark without permission of the trademark owner and to pretend falsely that it is being used with the approval of the Complainant as trademark owner;
- all of the above considerations disprove any suggestion that the Respondent has a right or legitimate interest in the disputed domain name.

All of these matters go to make out the prima facie case against the Respondent.

As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent does not have a right or legitimate interest in the disputed domain name.

The Complainant has thus made out the second of the three elements that it must establish.

Registration and Use in Bad faith

The Complainant has submitted that the Respondent has registered and used the disputed domain name in bad faith on several grounds, namely that:

- the disputed domain name is confusingly similar to the ZADIG & VOLTAIRE trademark, it was registered after the registration of the trademark and the trademark is well-known;
- the evidence will show that the Respondent registered the disputed domain name with actual knowledge of the Complainant and its trademark rights;
- the evidence will show that the Respondent has registered and used the domain name to create confusion with the Complainant's trademark for commercial gain by using it to resolve to the aforesaid website which offers counterfeit or unauthorized versions of the Complainant's products in competition with the Complainant's official and legitimate products and within the meaning of Policy¶4(b)(iv).

The Panel finds that each of the grounds relied on by the Complainant has been made out by the detailed case presented on its behalf. There is no need to repeat the details of the conduct of the Respondent set out above that show that it registered and used the domain name in bad faith. But the substance of the case revealed by the evidence is that the Respondent first registered a confusingly similar domain name, copying the Complainant's name and trademark. It did this after the trademark had been registered and had become widely known.

Next, the Respondent must have had actual knowledge of the Complainant, its business, trademark, products and brands and could not have embarked on the illegal activities revealed by the evidence without having actual knowledge of the Complainant, its trademarks and its products. It knew what its target was and aimed directly at it, up to and including promoting itself as ZADIG & VOLTAIRE in several places on its website and purporting to sell counterfeit or otherwise illegally acquired products. That is made very clear from the illustrations of the products on the website and the Respondent's assertions that they are goods being sold under the imprimatur of the ZADIG & VOLTAIRE trademark.

It terms of the provisions of the Policy, the conduct of the Respondent also clearly comes within Policy paragraph 4(b)(iv). Its modus operandi was to create confusion between its own website and the goods offered on it on the one hand and the Complainant's products offered on its official website on the other. That is hard evidence of bad faith registration and use.

The Respondent's conduct also comes within Policy paragraph 4(b)(iii). It must be inferred that its objective was to disrupt the Complainant's business by diverting potential customers away from the Complainant and to the Respondent, so that the Complainant would sell fewer goods and the Respondent would sell more goods by misleading the Complainant's potential customers.

Moreover, the Respondent clearly passed itself off as the Complainant and tried to extract money from internet users by misleading them, all the time trying to create the false impression that its website originated with and was approved by or linked to the Complainant. If that conduct were not bad faith, those words would have no meaning.

Finally, in addition to and apart from the specific provisions of the Policy and having regard to the totality of the evidence, the Panel finds that, in view of the Respondent's registration of the disputed domain name using the ZADIG & VOLTAIRE trademark and in view of the conduct that the Respondent has engaged in, it registered and has used the domain name in bad faith within the generally accepted meaning of that expression.

The Complainant has thus made out the third of the three elements that it must establish.

The Complainant has correctly cited several prior UDRP decisions that support its contentions on all of the elements required to be proved.

The Complainant has established all of the elements that it must show under the Policy and it is therefore entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **zadigeu.shop**: Transferred

PANELLISTS

Name	**Neil Brown**

DATE OF PANEL DECISION 2024-03-27