Decision for dispute CAC-UDRP-106368

Case number	CAC-UDRP-106368
Time of filing	2024-03-20 14:09:36
Domain names	zadig-us.top

Case administrator

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

Complainant

Organization	Z&V

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Baswvad Wild

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 trademark No. 005014171 ZADIG & VOLTAIRE® registered since June 18, 2007 in class 03. In addition, the Complainant owns the domain name <zadig-et-voltaire.com> created since May 16, 2002.

FACTUAL BACKGROUND

FACTS PROVIDED BY THE COMPLAINANT:

The Complainant is a French company in the fashion industry established in 1997 by Thierry Gillier. The brand ZADIG & VOLTAIRE® stands for ready-to-wear fashion, accessories and perfumes.

The Complainant contends that its trademark "ZADIG & VOLTAIRE®" is widely used in the fashion industry.

The Complainant is the owner of the European trademark ZADIG & VOLTAIRE® since 2007 as well as the domain name <zadig-et-voltaire.com> registered since 2002.

The disputed domain name <ZADIG-US.TOP> (hereinafter, the “Disputed Domain Name”) was registered on March 19, 2024 by Baswvad Wild based in the USA and it resolves to a a website purporting to be an online store selling the Complainant’s ZADIG &

VOLTAIRE products at discounted prices.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the Disputed Domain Name and that the language of the registration agreement is English.

Respondent did not reply to the Complaint.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES CONTENTIONS

COMPLAINANT:

First element: Similarity

The Complainant states that the Disputed Domain Name <ZADIG-US.TOP> is confusingly similar to its trademark ZADIG & VOLTAIRE®. In this regard, the Complainant indicates that the Disputed Domain Name incorporates the first and main part (ZADIG) of Complainant's ZADIG & VOLTAIRE® trademark in its entirety.

In accordance with Complainant, the addition of the geographic term "EU" (short for European Union) does not prevent a finding of confusing similarity as the first and main part (ZADIG) of the ZADIG & VOLTAIRE® trademark remains clearly recognizable [regarding this contention see Panel´s assessment in the PRINCIPAL REASONS FOR THE DECISION part below].

Besides, the Complainant contends that the addition of the new TLD ".TOP" does not change the overall impression of the designation as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the Disputed Domain Name and the Complainant, its trademark and its domain names associated.

Second element: Rights or legitimate interest

The Complainant asserts that the Respondent is not identified in the Whois database as the Disputed Domain Name. Furthermore, the Complainant contends that Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark ZADIG & VOLTAIRE®, or apply for registration of the Disputed Domain Name by the Complainant.

Furthermore, there is no information about the company connected with the Respondent. As to the use of the Disputed Domain Name, the Complainant states that the Disputed Domain Name is 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.

Third element: Bad faith

The Complainant contends that the Disputed Domain name is confusingly similar to its trademark ZADIG & VOLTAIRE®, registered several years before the registration of the Disputed Domain Name. In this vein, the Complainant indicates that its trademark ZADIG & VOLTAIRE® has been established as well-known by prior UDRP panels.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the Disputed Domain Name with full knowledge of the Complainant's trademark.

The Complainant finds 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 Disputed Domain Name to resolve to website offering counterfeit or unauthorized versions of Complainant's products in direct competition with the Complainant's products. Using a confusingly similar domain name to trade upon the goodwill of a complainant can evince bad faith under Policy

Based on the above, the Complainant contends that Respondent acquired the Disputed Domain Name with the only intention to attract for commercial gain internet users to the Respondent's website

RESPONDENT

Respondent did not reply to the Complaint.

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

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE TRADEMARK ZADIG & VOLTAIRE® OF THE COMPLAINANT.

The Uniform Domain Name Dispute Resolution Policy (the Policy) in its Paragraph 4(a)(i) indicates the obligation of Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

The Complainant is the owner of the European trademark ZADIG & VOLTAIRE® since 2007 as well as the domain name <zadig-et-voltaire.com> registered since 2002.

In the current case, the Disputed Domain Name <ZADIG-US.TOP> is composed with the first term of the trademark ZADIG & VOLTAIRE®; i.e. ZADIG followed by a hyphen plus the term US, which it is the common abbreviation of the United States of America.

Here is important to mention that Complainant included an argument referred to the addition of the geographic term “EU” (short for European Union) rather than „US“. From the files at hand and absent of reply from the Respondent, the Panel assumes that Complainant referred to the term US rather than EU and, therefore, the analysis would be focused on the term US.

In assessing confusing similarity, the Panel finds the Disputed Domain Name is confusingly similar to the Complainant’s trademark, as it incorporates the first term of trademarks ZADIG & VOLTAIRE® plus a hyphen and the term US, which it is the common abbreviation of the United States of America. In this regard, UDRP panels agree that where the relevant trademark is recognizable within the Disputed Domain Name (s), the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 (“WIPO Jurisprudential Overview 3.0.).

Furthermore, the addition of the Top Level Domain Name “.top” in a domain is considered as a standard registration requirement and, therefore, it should be disregarded under the first element confusing similarity test (see paragraph 1.11 WIPO Overview 3.0).

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Name is confusingly similar to Complainant’s mark.

2. RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The generally adopted approach by UDRP panels, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it (see WIPO Jurisprudential Overview, version 3.0., paragraph 2.1).

The Complainant indicates that they have not granted authorization to Respondent to use their ZADIG & VOLTAIRE® trademarks. Furthermore, the Complainant asserts that the Respondent is not affiliated with him nor authorized in any way to use the trademark ZADIG & VOLTAIRE®.

The Respondent did not reply to the Complaint despite the efforts made by this Center to notify the Complaint. In this regard, the Complainant has confirmed in the Complaint that the Disputed Domain Name is not connected with or authorized by the Complainant in any way.

The Complainant also confirmed that the Respondent is not a licensee, authorized agent of the Complainant or in any other way

authorized to use Complainant's trademark.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business, or other organization) has been commonly known by the Disputed Domain Name.

The Respondent's name "Baswvad Wild" provided in the Registrar's verification is all what it links the Disputed Domain Name with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Name.

In terms of the evidence provided by the Complainant, the website linked to the Disputed Domain Name shows an online shop offering discounted products purportedly related to Complainant. The Complainant's trademark can be seen at the top of the website.

At the Complaint, the Complainant indicated that the 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 in direct competition with the Complainant's products.

In terms of the current UDRP Practice, UDRP panels have held that the use of a disputed domain name for illegal activity such as the sale of counterfeit goods can never confer rights or legitimate interest on a respondent. However, UDRP panels need to receive from the Complainant circumstantial evidence which can support a credible claim of illegal respondent activity. Some examples, excluded but not limited to, of circumstantial evidence can be: i) evidence that the goods are offered disproportionately below market value, ii) that the goods are only sold under license or through a prescription (especially with pharmaceutical products), iii) that the images of the goods prima facie suggest (e.g., where the relevant logo is distorted) that they are not genuine, iv) that the respondent has misappropriated copyrighted images from the complainant's website, v) that a respondent has improperly masked its identity to avoid being contactable, have each been found relevant in this regard.

See paragraph 2.13.2 of WIPO Jurisprudential Overview 3.0.

From the evidence presented by the Complainant, the goods offered are sold below the market value. Here is important to mention that some original products can be also sharply discounted by vendors of discontinued products, however, the reply of a respondent is key to understand the origin of the products. Absent of this reply, the Panel can rely on Complainant's argument by confirming that the offering and sale by Respondent of presumptively counterfeit trademark products does not establish rights or legitimate interest in the Disputed Domain Name. See for instance the WIPO Decision Case Nr. D2012-1968 Oakley, Inc v. Victoriaclassic.Inc where the Panel established the following:

"… Complainant has alleged that Respondent is offering and selling "counterfeit" OAKLEY products on its websites. By "counterfeit" Complainant presumably means products that are identified by Complainant's trademark and that have an identical or substantially similar appearance to Complainant's products, but that have not been manufactured and/or distributed by or under the authority of Complainant. Complainant has not presented direct evidence that the products offered and sold by Respondent are manufactured and/or distributed by a person(s) other than Complainant (or under its authority). However, Complainant has provided strong circumstantial evidence in the differential between the prices charged by Complainant (and its authorized distributors) for products on their websites comparable in appearance to those offered by Respondent on its websites. Although "original" products may be sharply discounted by vendors of discontinued or "second quality" products, or under some other circumstances, in circumstances such as those present here it would be incumbent upon Respondent to rebut the strong circumstantial evidence presented by Complainant that Respondent is offering and selling counterfeit trademark products. In this regard, the offering and sale by Respondent of presumptively counterfeit trademark products does not establish rights or legitimate interests in the disputed domain names".

One additional element to consider is the fact that the identity of the Respondent is not visible at the "whos is" related to the Disputed Domain Name. Finally, the website linked to the Disputed Domain Name do not show any disclaimer with respect to the relationship with the Complainant.

Based on the elements, the Panel can confirm that use done by the Respondent concerning the Disputed Domain Name cannot confer rights or legitimate interest. In light of the reasons above mentioned, the Panel concludes that the Complainant has satisfied the second element of the Policy.

3. THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH IN ACCORDANCE WITH THE POLICY.

Paragraph 4(a)(iii) of the Policy indicates that complainant must assert that the respondent registered and is using the domain name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or 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 the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 respondent has engaged in a pattern of such conduct; or

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

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

The evidence submitted by the Complainant confirms that its trademark ZADIG & VOLTAIRE® is distinctive and it has a strong reputation in the fashion industry. In fact, the Complainant referred to WIPO Case No. D2021-0918 Z&V v. Wen Jun Yan by which the Panel mentioned that "ZADIG & VOLTAIRE" is not a descriptive term for the fashion service it provides, instead it's an arbitrary mark. Therefore, "ZADIG & VOLTAIRE" itself is highly distinctive as a trademark.

In this regard and absent of the Respondent's reply, the Panel finds that the Respondent, prior to the registration of the Disputed Domain Name was aware of the Complainant's trademark, in particular since the Disputed Domain Name was registered on March 19, 2024 and the Complainant's trademark was registered long before the registration of the Disputed Domain Name.

Furthermore, the Complainant provided with evidence showing that Disputed Domain Name was set up by the Respondent similar to the Complainant's genuine website with the purpose to mislead internet consumers who are attempting to purchase products through the Disputed Domain Name into believing that they are doing so from the Complainant's genuine website or from a website that is in some way connected to or associated with the Complainant. In this sense, the Complainant has confirmed that no authorization was granted to the Respondent to register them and no counterargument has been submitted by Respondent. This is a clear indication that the Disputed Domain Name was set up with the only intention to attract to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

Finally, the Complainant has also demonstrated that the Respondent has been using the website linked to the Disputed Domain Name for the purpose to offer presumptively counterfeit trademark products. This behavior can be also considered as evidence of bad faith.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Name and the Complainant's ZADIG & VOLTAIRE® trademark, b) the lack of reply to this Complaint by Respondent, c) the fact that the Disputed Domain Name is being used to offer and sale by Respondent of presumptively counterfeit trademark with the purpose to mislead internet consumers, the Panel draws the inference that the Disputed Domain Name was registered and is being used in bad faith and thus has satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **zadig-us.top**: Transferred

PANELLISTS

Name	**Victor Garcia Padilla**

DATE OF PANEL DECISION 2024-04-19

Publish the Decision