Decision for dispute CAC-UDRP-106554

Case number	CAC-UDRP-106554
Time of filing	2024-05-24 09:13:57
Domain names	notinos.shop

Case administrator

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

Complainant

Organization	NOTINO EUROPE LTD

Respondent

Name	Leire Alcala

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 <notinos.shop>.

IDENTIFICATION OF RIGHTS

The Complainant owns numerous trademark registrations in the EU for the mark NOTINO as a word mark and figurative mark:

- „NOTINO“, No. 015221815, word;

- „NOTINO TODAY IS YOURS“, No. 015944127, figurative;

- „NOTINO TRY&BUY“, No. 016743965, figurative;

- „NOTINO TRY&BUY“, No. 016804049, figurative;

- „NOTINO“, No. 017471574, word;

- „NOTINO“, No. 018071749, figurative;

- “Notino”, No. 018537465, word;

- “NOTINO“, No. 018537464, figurative.

FACTUAL BACKGROUND

The Complainant NOTINO EUROPE LTD is the sole shareholder of the company Notino, s.r.o. (hereinafter the „Notino“).

Notino is the holder of the domain name <notino.cz> and other variations (such as <notino.sk>, <notino.pl>, <notino.it>, <notino.dk>, <notino.ro> etc.), on which Notino runs e-shops with cosmetics, perfumes, and other related goods in almost all the European Union and also outside the EU. The brand and e-shops are well established within the EU and its customers. The network of Notino e-shops achieved in financial year 2022 turnover over 1 billion EUR and is considered the biggest pure e-commerce beauty reseller in Europe.

The disputed domain name <notinos.shop> was registered on November 25, 2023.

PARTIES CONTENTIONS

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

PARTIES' CONTENTIONS:

COMPLAINANT:

• The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the disputed domain name <notinos.shop> is clearly identical and interchangeable with its trademark NOTINO. The Complainant contends that the second-level domain name ".shop" doesn't have a distinctive character.

Moreover, the interchangeability of the disputed domain name is even supported by the fact that the Respondent operates activities similar to the Complainant's business, i.e. offering cosmetics, perfumes and other related goods to customers.

• Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name and it is not related in any way to the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither authorization has been granted to the Respondent to make any use of the Complainant's trademark NOTINO.

According to the Complainant, the Respondent obviously intends for commercial gain to misleadingly divert consumers and to tarnish the Complainant's trademark NOTINO.

• The disputed domain name has been registered and is being used in bad faith

According to the Complainant, the Respondent has registered the disputed domain name and is using it in bad faith. The Complainant contends that the disputed domain name <notinos.shop> is confusingly similar to its NOTINO trademark. According to the Complainant, this is an obvious case of cybersquatting.

The Complainant also states, that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name. According to the Complainant, the Respondent registered the disputed domain name primarily for the purpose of disrupting the business of the Complainant and by using the disputed domain name, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its web site 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 web site or location or of a product or service on the web site or location.

In conclusion, the Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

RESPONDENT:

No administratively compliant Response has been filed.

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights

The Complainant has provided evidence and proved to be the owner of the European trademark registrations for NOTINO. Essentially, the Respondent has appropriated the trademark NOTINO by adding letter "S" to presumably create a confusing similarity between the Complainant’s trademark and the disputed domain name <notinos.shop> and to lead consumers to believe that it is affiliated with the Complainant.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark NOTINO since the mere addition of the letter "S" does not eliminate any confusing similarity. This is especially true where, as here, the trademark is “the dominant portion of the domain name,” LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents “the most prominent part of the disputed domain name[] which will attract consumers’ attention.” Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768.

Additionally, the disputed domain name not only fully incorporates the NOTINO trademark but also includes a purely generic top-level domain (“gTLD”) “shop”. Previous UDRP panels have also held that the gTLD “.com” is not to be taken into account when assessing whether a domain name is identical or confusingly similar to a trademark. See e.g., Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (Forum January 22, 2016).

In conclusion, the Panel finds that the disputed domain name <notinos.shop> is confusingly similar to the Complainant's trademark NOTINO.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent has no legal right to use the term “NOTINO” as part of its domain name. The Respondent is not in any way connected with the Complainant, nor is it authorized to register the disputed domain name or use its intellectual property rights for its operations as a licensee or in any capacity.

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant’s trademark for its commercial activities.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel finds that the disputed domain name <notinos.shop> is confusingly similar to the Complainant's trademark NOTINO

which is widely known and well-established. 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. The Panel finds that such actions constitute bad faith under paragraph 4(b)(iv) of the Policy, which provides: "by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site 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 respondent's web site or location or a product or service on respondent's web site or location."

The fact that a complainant's trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (see section 3.3, WIPO Overview 3.0).

In the present case, the Panel believes that the Complainant's NOTINO trademark is distinctive and widely used, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

Finally, the Respondent operates activities similar to the Complainant's business, i.e. offering cosmetics, perfumes and other related goods to customers. The Panel agrees with the Complainant that these activities intend to divert consumers and to tarnish the Complainant's trademark NOTINO. The Respondent may be seen to free ride on the reputation of the Complainant and its name and trademark NOTINO.

In addition, the Panel notes that the Respondent's attempt to defraud the Complainant's customers by reproducing the Complainant's website to presumably deceive internet users into believing the website was operated by the Complainant does not constitute good faith of use of the disputed domain name.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy, which is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **notinos.shop**: Transferred

PANELLISTS

Name	**Barbora Donathová**

DATE OF PANEL DECISION 2024-06-21

Publish the Decision