# Decision for dispute CAC-UDRP-106526

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| Case number | CAC-UDRP-106526 |
| Time of filing | 2024-05-15 13:52:37 |
| Domain names | notinoonline.shop |

## Case administrator

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

## Complainant

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| Organization | NOTINO EUROPE LTD |

## Respondent

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| Name | Agim Mulakaj |

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 owns a portfolio of word and figurative trade marks consisting of or incorporating the name NOTINO, including the European Union trade mark NOTINO, registration number 015221815, first registered on 28 June 2016 in international classes 16, 35, 38 and 39; the European Union trade mark NOTINO, registration number 017471574, first registered on 9 March 2018 in international class 35 and 41; the European Union trade mark NOTINO, registration number 018071749, first registered on 11 September 2019 in international classes 3, 16, 35, 38, 39 and 41; the European Union trade mark NOTINO, registration number 018537464, first registered on 11 December 2021 in international class 3, 10 and 21; and the European Union trade mark NOTINO, registration number 018537465, first registered also on 11 December 2021 in international class 3, 10 and 21.

The aforementioned trade mark registrations of the Complainant predate the registration of the disputed domain name.

Furthermore, the Complainant's trading subsidiary company, Notino s.r.o. ("Notino"), owns numerous domain names which consist of or incorporate the name NOTINO, including <notion.cz>; <notino.it>; <notino.pl>; <notino.dk>; and <notino.ro>, which are connected to Notino's official websites through which it informs Internet users and customers about its products and services.

FACTUAL BACKGROUND

The Complainant is the sole shareholder of Notino. Notino runs well established e-shops selling cosmetics, perfumes, and other related goods to end-consumers in almost all the European Union member states as well as outside of the EU. The Complainant asserts that the network of Notino e-shops achieved a turnover of over EUR 1 billion during 2022 and is considered to be the biggest pure e-commerce beauty reseller in Europe.

The disputed domain name <notinoonline.shop> was registered on 20 December 2023. The disputed domain name resolves to an imitation online trading website, using the Complainant's NOTINO trade mark, and offering cosmetics, perfumes and beauty products at highly discounted prices.

PARTIES CONTENTIONS

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The Complainant contends that all three elements of the UDRP have been fulfilled and it therefore requests the transfer of the disputed domain name to the Complainant.

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 trade mark 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 notes that the Complainant not only developed its arguments by reference to the UDRP Rules at best only summarily but also failed to support numerous factual assertions in its complaint with appropriate evidence, and that rather more fulsome submissions would have been helpful to the Panel, including but not limited to matters such as:

- the assertion that the Complainant is the sole shareholder of Notino;
- Notino's business activities and turn-over;
- the domain names used by Notino and their first registration dates;
- the use of the disputed domain name; and
- the three UDRP elements.

While conclusory statements unsupported by evidence will normally be insufficient to prove a complainant's case, even where a respondent is in default by not having filed a response, it has however been commonly accepted by a large number of UDRP decisions that panels may perform limited independent factual research into matters of public record in assessing the merits of a case, based on the wide general powers set out in paragraphs 10 and 12 of the UDRP Rules. Such research may include, in particular, visiting the website linked to the disputed domain name in order to obtain information about a respondent's use of the disputed domain name (see, for example, WIPO Overview 3.0 at paragraph 4.8). The Panel is therefore satisfied that it can take into account the results of its own additional factual research and considered it appropriate in the interest of procedural efficiency to proceed to a decision without inviting further submissions from the Complainant.

The Panel further notes that, while the Complainant is the owner of a portfolio of NOTINO formative trade marks, it does not itself use these trade marks in the course of trade, such use occurring instead through its trading subsidiary, Notino, which is not itself a party to this proceeding. The Panel is satisfied in this regard that, where related parties have rights in the relevant trade mark on which a UDRP complaint is based, the UDRP complaint may be brought by any one of these parties, including the corporate holding company which holds the relevant trade mark rights (see, for example, WIPO Case No. D2008-1368, Embarq Holdings Company LLC v. Domainsbigtime.com <embarqblog.com>; and WIPO Case No. D2010-1728, Endemol Netherland B.V. v. David Williams <Endemoltv.com>).

The Panel is satisfied that all other 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

With regard to the first UDRP element, the Panel finds that the disputed domain name is identical with the Complainant's trade mark NOTINO. Indeed, the disputed domain name incorporates the Complainant's trade mark in its entirety but adds the generic descriptive term "online" as suffix to the Complainant's trade mark. The Panel follows in this respect the view established by

numerous other decisions that a domain name which wholly incorporates a Complainant's registered trade mark may be sufficient to establish confusing similarity for the purposes of the UDRP (see, for example, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin <porsche-autoparts.com>). The Panel further considers it to be well established that the addition of a descriptive term does not allow a domain name to avoid confusing similarity with a trade mark (see, for example, WIPO Case No. D2019-2294, Qantas Airways Limited v. Quality Ads <qantaslink.com>; and CAC Case No. 102137, Novartis AG v. Black Roses <novartiscorp.com>). Other panels have previously found that "[W]here the relevant trademark is recognizable within the Disputed Domain Name, 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 WIPO Overview 3.0, section 1.8; and, for example, WIPO Case No. D2023-2542, Merryvale Limited v. tao tao <wwbetway.com>; and WIPO Case No. D2020-0528, Philip Morris Products S.A. v. Rich Ardtea <global-iqos.com>). Against this background, the Panel finds that the addition of the generic descriptive term "online" is not sufficient to alter the overall impression of the designation as being connected with the Complainant's trade mark and does not prevent a likelihood of confusion between the disputed domain name and the Complainant, its trade mark and Notino's associated domain names. To the contrary, the disputed domain name rather adds to the likelihood of confusion because the addition of the descriptive term "online", in conjunction with the Complainant's trade mark NOTINO, suggests that the disputed domain name links to an official website of Notino, and implies that it is linked to Notino and its business.

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent has made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. The Panel notes that the disputed domain name resolves to a website impersonating Notino's official websites, including an e-commerce functionality, and using the Complainant's trade mark, to sell identical products to those sold by Notino on its own websites. The Panel further notes that the website accessed through the disputed domain name carries a high risk of affiliation with the Complainant and with Notino, suggesting that it is either the Complainant's own website, or are at least endorsed by the Complainant, where this is not the case. Indeed, the website accessed through the disputed domain name does not identify who owns and operates it and does not clearly and prominently identify the registrant's relationship with the Complainant. The Panel follows in this regard the view established by numerous other decisions that respondent's use of a complainant's trade mark to redirect users to a competing site does not support a claim for legitimate interest. The Panel also accepts the Complainant's submissions that the Respondent is not affiliated with or related to the Complainant in any way, and is neither licensed nor otherwise authorised to make any use of the Complainant's trade mark, or to apply for or use the disputed domain name. Furthermore, the Whois information does not suggest that the Respondent is commonly known by the disputed domain name <notinoonline.shop>. 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, as is equally not the case here (see, for example, 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, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy ¶ 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c)(ii)."). Neither is there any indication that the Respondent is making any legitimate non-commercial or fair use of the disputed domain name. Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interest in the disputed domain name.

With regard to the third UDRP element, it is reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be confusingly similar to the Complainant's trade mark, and that he registered the disputed domain name in full knowledge of the Complainant's trade mark. If the Respondent had carried out a Google search for the term "Notino", the search results would have yielded immediate results related to the Complainant and to Notino, its websites, and its connected business, products and services. Indeed, it is likely that the disputed domain would not have been registered if it were not for the Complainant's trade mark (see, for example, WIPO Case No D2004-0673 Ferrari Spa -v- American Entertainment Group Inc). The Panel notes that the Respondent seeks to attract Internet users to his own website for commercial gain, based on the Complainant's trade mark, which constitutes further evidence of bad faith (see, for example, WIPO Case No D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC ("In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.")). By contrast, the Panel finds no basis for the Complainant's unsupported allegation that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the applicant for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name. Nevertheless, for the foregoing reasons, and absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using 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. **notinoonline.shop**: Transferred

## PANELLISTS

| Name | Gregor Kleinknecht LLM MCIArb |
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DATE OF PANEL DECISION 2024-06-18

Publish the Decision