Decision for dispute CAC-UDRP-106634

Case number	**CAC-UDRP-106634**
Time of filing	**2024-06-24 11:26:58**
Domain names	**notinoutlet.shop**

Case administrator

Name	**Olga Slanařová (Case admin)**

Complainant

Organization	**NOTINO EUROPE LTD**

Respondent

Name	**Colin Derby**

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 submitted evidence that it is the owner of the following trademarks (all European Union Trademarks):

- NOTINO (word mark), registration number 015221815, registered on 18 June 2016 in Nice classes 16, 35, 38, and 39;
- NOTINO TODAY IS YOURS (figurative mark), registration number 015944127, registered on 27 January 2017 in Nice classes 16, 35, 38, and 39;
- NOTINO TRY&BUY (word mark), registration number 016743965, registered on 18 September 2017 in Nice classes 3, 16, and 35;
- NOTINO TRY&BUY (figurative mark), registration number 016804049, registered on 3 October 2017 in Nice classes 3, 16, and 35;
- NOTINO (word mark), registration number 017471574, registered on 9 March 2018 in Nice classes 35 and 41;
- NOTINO (figurative mark), registration number 018071749, registered on 11 September 2019 in Nice classes 38, 39, 41, 3, 16, and 35;
- Notino (word mark), registration number 018537465, registered on 11 December 2021 in Nice classes 3, 10, and 21;
- NOTINO (figurative mark), registration number 018537464, registered on 11 December 2021 in Nice classes 3, 10, and 21.

These EU-trademarks are hereafter referred to as the "**Trademarks**".

FACTUAL BACKGROUND

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

The Complainant claims to be the sole shareholder of the Czech company Notino, s.r.o. which runs online shops for cosmetics, perfumes, and related goods in several European Union countries and outside the EU. The Complainant states that its brand and e-shops are well established within the EU. The network of the Notino online shops achieved a turnover of more than 1 billion Euros in 2022 and is considered the biggest pure e-commerce beauty reseller in Europe.

The Complainant claims is the owner of several trademarks comprising the term "NOTINO". The Complainant submitted evidence

that it is the owner of the EU-trademarks that are listed above and that are referred to in this decision as the “Trademarks”.

The Complainant also states that its subsidiary Notino, s.r.o. is the owner of multiple domain names which include the word “NOTINO”, including the domain names <notino.cz>, <notino.sk>, <notino.pl>, <notino.it>, <notino.dk>, and <notino.ro>. The Complainant did not submit evidence that its subsidiary is indeed the owner of such domain names.

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

PARTIES CONTENTIONS

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

1. **Confusing similarity**

The disputed domain name consists of the Complainant's Trademark “NOTINO” with the addition of the word element “utlet” (which refers to the word “outlet”) and the gTLD “.shop”.

The Panel remarks that Section 1.7 of WIPO Overview 3.0, states that, "in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status".

The Panel is of the opinion that the addition of word element “utlet” (referring to the word “outlet”) does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. It seems to the Panel that this word element is solely descriptive.

This is supported by section 1.8 of WIPO Overview 3.0, which states: "Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element".

The gTLD ".shop" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the

Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. **Rights or legitimate interests**

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such appropriate allegations or evidence, the complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then must weigh all the evidence, with the burden of proof always remaining on the complainant.

The Complainant argues that:

- The Respondent is not authorised or licensed by the Complainant to use the Trademarks or to use the disputed domain name;
- The Respondent intends for commercial gain to misleadingly divert consumers and to tarnish the Complainant's Trademarks.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name. The Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but did not do so.

The Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name from the following facts:

- There is no evidence at all that the Respondent is or has been commonly known by the disputed domain name or by the term(s) "NOTINO" or "NOTIN";
- There is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers. On the contrary, it appears that the Respondent is taking advantage of the Complainant's registered Trademarks to attract internet users to its own website where the Respondent sells "NOTINO" branded products.
- The Respondent did not show to have any trademark rights or other rights in the term(s) "NOTINO" or "NOTIN";
- The Respondent does not seem to have any consent or authorisation to use the Trademark(s) or variations thereof and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. **Bad faith**

The Complainant argues the following:

- The disputed domain name is being used to run an online shop for the same categories of products as offered by the Complainant's subsidiary Notino, s.r.o. and that are covered by the Trademarks. The Complainant submitted evidence that the website available through the disputed domain name is being used to sell "NOTINO" branded products that are covered by the Trademarks of the Complainant;
- This is an obvious case of the cybersquatting. The Respondent uses the disputed domain name to divert accidental visitors to its own website;
- The Respondent registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of the corresponding Trademarks or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- The Respondent registered the disputed domain name primarily for the purpose of disrupting the business of the Complainant and its subsidiary;
- The Respondent uses the disputed domain name to intentionally attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location;
- The disputed domain name is being used to parasite on the reputation of the Trademarks and to make customers believe that the domain name is related to the Complainant and/or its subsidiary Notino, s.r.o. .

The Panel weighs these arguments and facts as follows:

- The Panel accepts that the evidence submitted by the Complainant proves that the Respondent uses the disputed domain

name to offer similar products as those of the Complainant (or its subsidiary Notino, s.r.o.) and that seem to be covered by the Complainant's registered Trademarks;
- The offering of "NOTINO" branded products via the disputed domain name is considered as a way of intentionally confusing consumers and intentionally trying to divert traffic away from the website of the Complainant or its subsidiary;
- The Panel concludes that, on the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's Trademarks and the scope of these Trademarks, at the time of registration and use of the disputed domain name.

The Panel also took account of the following elements of fact:

- The Complainant has registered trademark rights to the terms "NOTINO" covering products that the Respondent is offering for sale via the disputed domain name;
- These products offered for sale by the Respondent – via the disputed domain name – are branded "NOTINO" products, confirming the actual knowledge of the Respondent;
- The terms selected by the Respondent ("NOTINO" or "NOTIN") seem to have no meaning in any language and seem only selected for its similarity to the Complainant's registered Trademarks;
- The registration of the Complainant's Trademarks predates the registration of the disputed domain name;
- The disputed domain name is almost identical to the Complainant's "NOTINO" Trademarks", except the omission of the letter "O" and the addition of the descriptive word "OUTLET".

In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the Trademark(s) of the Complainant in mind when registering and subsequently using the disputed domain name.

From these facts, the Panel concludes that the Respondent had actual knowledge of the Trademarks of the Complainant when registering and using the disputed domain name. The Respondent must have had the Trademark(s) of the Complainant in mind when registering and using the disputed domain name. It appears that the Respondent tried to profit from the name and success of the Complainant with the disputed domain name.

For all the reasons stated above, the Panel concludes that the Complainant did prove that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(1)(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. **notinoutlet.shop**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2024-07-18

Publish the Decision