Decision for dispute CAC-UDRP-106622

Case number	CAC-UDRP-106622
Time of filing	2024-06-19 09:43:36
Domain names	notinok.shop

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	NOTINO EUROPE LTD

Respondent

Name	rf fw

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

Complainant claims to have 8 trademark registrations in the European Union:

- „NOTINO“, No. 015221815, verbal;
- „NOTINO TODAY IS YOURS“, No. 015944127, figurative;
- „NOTINO TRY&BUY“, No. 016743965, figurative;
- „NOTINO TRY&BUY“, No. 016804049, figurative;
- „NOTINO“, No. 017471574, verbal;
- „NOTINO“, No. 018071749, figurative;
- “Notino”, No. 018537465, verbal;
- “NOTINO“, No. 018537464, figurative;

Also, Complainant claims to have an International Registration in several countries outside the European Union. All trademarks are registered for i.a. services, i.a. online retail store services relating to cosmetic and beauty products.

The oldest trademark dates back to 2016.

Extracts of the registration certificates were not included.

FACTUAL BACKGROUND

Complainant, Notino Europe Ltd in Nicosia, Cyprus, claims to run 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 as the biggest pure e-commerce beauty reseller in Europe.

For said business, Complainant holds various domain names such as <notino.cz> and <notino.sk>, <notino.pl>, <notino.it>, <notino.dk>, <notino.ro>.

Complainant did not submit any evidence material to substantiate the use of the trademark NOTINO and its reputation.

Respondent RF FW with domicile, Fskml, in France, as it turns out from the Registrar Verification, has registered the domain name <notinok.shop> on 17 December 2023.

Respondent runs a -as claimed by Complainant- similar business of e-shops offering cosmetics, perfumes and other related goods to customers, however the website is only detectable with a mobile phone or if the user deliberately spoofs the user agent because on any computer the website is not displayed. Respondent has developed the website as such that it analyses the User-Agent and, depending on the result, serves tailored content.

The disputed domain name is younger than the trademark registrations of Complainant.

PARTIES CONTENTIONS

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

According to the Policy paragraph 4(a)(i) it needs first to be established that:

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

Complainant's trademark is NOTINO. The disputed domain name is <notinok.shop>.

Amongst other panels it is commonly agreed that for deciding whether the disputed domain name is identical or confusingly similar to a trademark the domain name suffix, here:' .shop', does not have to be taken into account.

Bearing this in mind, it firstly needs to be established if Complainant possesses trademark rights. Complainant mentions European trademarks in its Complainant. Further, Complainant refers to an overview on the website of EUIPO, namely TM View, for the specification of those rights as well as, as the Panel understands it, for the specification of an International Registration at WIPO. No certificates of trademark registration are submitted despite the common practice in domain name dispute cases to do so.

The Panel consequently has to decide whether a simple overview of rights, without any evidence of the rights itself, is sufficient to base a domain name dispute on. The Policy does not provide guidance on this and therefore the Panel has to decide on its own. The Panel is of the opinion that an overview can be manipulated. Moreover, a TM View overview is known for not always being accurate. Therefore, the Panel considers it not sufficient to be submitted as evidence of possessing trademark rights. Only a certificate of registration originating from a trademark register can do so. Unfortunately, on the point of establishing older trademark rights as opposed to the disputed domain name Complainant already fails and the Complaint must be considered as unsuccessful.

Consequently, the case comes to an end here. Nevertheless, the Panel decides to examine the hypothetical situation where it would have accepted the submission of the TM Overview as valid trademark rights to see if the Complaint would succeed.

Suppose the trademark rights as shown in the TM Overview were accepted then the Panel, as a next step, needs to determine whether NOTINO and <notinok> are similar, because identical they are not.

Complainant argues that the two are clearly interchangeable from an oral and visual perspective. Moreover, the interchangeability of the domain is supported by the fact that the disputed domain name links to an e-shop offering cosmetics, perfumes and other related goods to customers, just like the websites of Complainant is doing.

The Panel finds that although the difference between the trademark and disputed domain name is only 1 letter, it cannot be simply said that the two are similar. From an oral perspective, the 'k' at the end of the disputed domain name provides a different sound of the last syllable of the word <notinok>, with the result that the emphasis on the word <notinok> goes to the 3rd syllable whereas the emphasis of the trademark NOTINO is with the 2nd syllable.

Further, the 'k' is not an obvious typo and thus changes the visual appearances as well.

A shortcoming of argumentation leads to the interim conclusion that the Panel is not prima facie convinced of the similarity of the two.

Further, the argument of Complainant that the disputed domain name leads to a website on which similar goods are displayed and therefore the trademark and disputed domain name are interchangeable is, according to the Panel, referring to European Trademark law in which case law has determined that trademark and goods are communicating vessels (HvJ EG 29 September 1998, case C-39/97, Canon/Metro-Goldwyn-Mayer; Canon/Cannon). However, in said case law the enhanced similarity is founded in the reputation of the trademark.

The Panel has seen no evidence of any reputation of Complainant's trademark. The Panel has not even seen any evidence of the use of the trademark by Complainant. Therefore, it cannot accept the argument.

Finally the conclusion is that even if the Panel had accepted the TM View overview as being acceptable evidence of rights then the further arguments of Complainant fail to establish identity or similarity of trademark and disputed domain name. The reasoning of Complainant is too poor.

The Panel concludes that Complainant did not show valid trademark rights and further did not show in a sufficient way that 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).

As the first requirement of the Complaint has not been met the further requirements can be disregarded.

NO RIGHTS OR LEGITIMATE INTERESTS

For the sake of completeness, the Panel here concludes that Complainant did not show that Respondent has no rights or legitimate interest.

BAD FAITH

For the sake of completeness, the Panel here concludes that Complainant did not show that Respondent has bad faith.

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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **notinok.shop**: Remaining with the Respondent

PANELLISTS

Name	**Marieke Westgeest**

DATE OF PANEL DECISION 2024-07-22

Publish the Decision