Decision for dispute CAC-UDRP-106629

Case number	CAC-UDRP-106629
Time of filing	2024-07-17 09:08:28
Domain names	notino-ro.com

Case administrator

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

Complainant

Organization	NOTINO EUROPE LTD

Respondent

Name

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 number of Trademark Registrations for the mark NOTINO including the following:

- European Union Trademark no. 015221815 for NOTINO, registered on June 28, 2016, in international classes 16, 35, 38, and 39;

- European Union Trademark no. 017471574 for NOTINO, registered on March 9, 2018, in international classes 35 and 41;

- European Union Trademark no. 018537465 for NOTINO, registered on December 11, 2021 in international classes 3, 10, and 21.

FACTUAL BACKGROUND

Under the trademark NOTINO, the Complainant runs e-shops with cosmetics, perfumes, and other related goods in almost all the European Union and also in other countries. It owns a number of European Union trademark registrations for the NOTINO trademark. The Complainant owns a number of related domain names such as <notino.cz>, <notino.sk>, <notino.pl>, <notino.it>, <notino.dk>, and <notino.ro>. The notion-ro.com domain name was registered on December 20, 2023 and resolves to an inactive page using a computer web browser but, on a mobile phone browser, resolves to a page displaying the NOTINO mark and offering perfumes and cosmetics for sale.

PARTIES CONTENTIONS

COMPLAINANT:

The notion-ro.com domain name is confusingly similar to the NOTINO trademark.

The Respondent has no rights or legitimate interests in the disputed domain name where it is operating the same line of business as the Complainant and offering the same categories of products.

The disputed domain name was registered and is used in bad faith where the Respondent uses it to confuse users by operating a website that displays the NOTINO trademark and offers perfumes and cosmetics for sale in competition with the Complainant.

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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also GROUPE CANAL + v. Danny Sullivan, 102809 (CAC January 21, 2020) (“the Panel, based on the poorly supported and conclusory allegations of the Complainant, retains that the Complainant has not prevailed on all three elements of the paragraph 4(a) of the Policy and, therefore, rejects the Complaint.”).

1. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrate its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant, 103255 (CAC September 30, 2020) (“it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant’s trade mark(s).”).

The Complainant claims ownership of a number of trademark registrations with the European Intellectual Property Office (EUIPO).

[i] Registration with such national and multi-national offices has been found sufficient to satisfy the threshold requirement of proving trademark rights under Paragraph 4(a)(i) of the Policy. Margaritaville Enterprises, LLC v. Neil Wein, FA 1916531 (FORUM November 9, 2020) ("It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights"). The disputed domain name adds a hyphen and the letters "ro" to the NOTINO trademark as well as the ".com" gTLD. Thus, the Complainant asserts that the second level of the disputed domain name is confusingly similar to the asserted trademark and will lead internet users to wrongly believe that the disputed domain name originates or is endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. Avast Software s.r.o. v. Milen Radumilo, 102384 (CAC April 19, 2019) ("it is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity.").

Also, the extension ".com" typically adds no meaning or distinctiveness to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. Novartis AG v. Wei Zhang, 103365 (CAC December 9, 2020) ("it is generally accepted that the addition of the top-level suffix in the domain name (e.g., '.com') is to be disregarded under the confusing similarity test").

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of a hyphen and two letters thereto in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant's trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Pursuant to Paragraph 4(a)(ii) of the Policy, the Complainant has the burden of making prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name. Cephalon, Inc. v. RiskIQ, Inc., 100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

With reference to Paragraph 4(c)(ii) of the Policy the Complaint states that "[n]o title is known to entitle the holder of the disputed domain to use the name in the domain notino". Further, the Panel notes that the Respondent is identified by the Registrar verification to the CAC as " " (in English this translates to "Aston") and this bears no relation to the NOTINO mark or the words and characters that make up the disputed domain name. The Respondent has not participated in this case and so it does not contest this. As such, the Panel finds no evidence that the Respondent is commonly known by the disputed domain name and its use of the Complainant's trademark on its website does not, alone, support a different conclusion. Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com", D2000-0847 (WIPO October 16, 2000) ("use which intentionally trades on the fame of another" should not be considered. "To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy."). Based upon the available evidence in this case, the Panel cannot conclude that the Respondent is commonly known by the disputed domain name.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. The disputed domain name resolves to a website that makes prominent use of the Complainant's trademark and claims to offer perfumes and cosmetics for sale. Using a confusingly similar domain name to pass oneself off as a Complainant is not a bona fide offering of goods or services or a legitimate non-commercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy. See Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund, FA 1790949 (FORUM July 9, 2018) (finding that the Respondent did not use the disputed domain name to make a bona fide offering of goods or services per Paragraph 4(c)(i) of the Policy or for a legitimate non-commercial or fair use per Paragraph 4(c)(iii) where the website resolving from the disputed domain name featured the Complainant's mark and various photographs related to the Complainant's business). Here, the Complainant claims that the Respondent is "running the same business as Notino" and it provides a mobile phone screenshot showing the prominent display of the NOTINO mark at the top and images of various perfume and cosmetic products. The Complainant's assertion that this use of its trademark is for the purpose of impersonation and commercial gain through passing off appears well-founded and the Respondent has not filed a Response or made any other submission in this case to offer an alternative explanation for its actions. As the Complainant has made out a prima facie case that has not been rebutted by the Respondent, upon a preponderance of the evidence before it the Panel finds that the Respondent fails to make a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

3. The disputed domain name was registered and used in bad faith

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. Further guidance on that requirement is found in Paragraph 4(b) of the Policy, which sets out four examples of possible actions by the Respondent that may satisfy this burden of proof.

Inherently prerequisite to a finding of bad faith under Paragraph 4(a)(iii) of the Policy is some attribution of knowledge of the Complainant's claimed trademark, whether actual or based upon a conclusion that the Respondent should have known of the trademark. See, Domain Name Arbitration, 4.02-C (Gerald M. Levine, Legal Corner Press, 2nd ed. 2019) ("Knowledge and Targeting Are Prerequisites to Finding Bad Faith Registration"); USA Video Interactive Corporation v. B.G. Enterprises, D2000-1052 (WIPO December 13, 2000) (claim denied where "Respondent registered and used the domain name without knowledge of Complainant for a bona fide commercial purpose."). See also, WIPO Overview 3.0, par. 3.1.1 (when examining whether "circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark", Panels may consider such issues as "the respondent's likely knowledge of the complainant's rights"). Here, the Complainant claims that its mark is well known through its operation in the European Union and beyond and its operation of a number of country-specific websites supports this. Further, the Respondent's impersonation activities at its website and its use of a similar two-letter country designation, similar to some of the domain names owned by the Complainant, indicates an intent to create the image that the disputed domain name is simply another in a series of the Complainant's legitimate websites. Based on this evidence and the Respondent's passing off activities, the Panel concludes that it is highly likely that the Respondent had actual knowledge of the Complainant's trademark at the time it registered the disputed domain name.

Next, the Complainant argues that the Respondent registered and uses the disputed domain name in bad faith as the Respondent passes itself off as the Complainant. Using a confusingly similar domain name to pass oneself off as a complainant can demonstrate bad faith under Paragraphs 4(b)(iii) and (iv) of the Policy. See Harley-Davidson Motor Company Inc. v. Liu Peng et al., UDRP-106275 (CAC March 27, 2024) ("use of a disputed domain name to pass off as a complainant and offer competing or counterfeited goods may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv)."). The Complainant asserts that, by use of the disputed domain name, the Respondent "clearly parasites on reputation and name of Notino..." The evidence in this case shows that the Respondent has, for commercial gain, used its website at the disputed domain name to pass itself off as the Complainant to actual and potential customers in furtherance of allegedly promoting the sale of perfumes and cosmetics under the NOTINO trademark. The Respondent has not participated in this case to explain its actions and so, based upon a preponderance of the available evidence, the Panel finds it highly likely that the Respondent registered and uses the disputed domain name in bad faith by disrupting the Complainant's business and by seeking commercial gain through confusion with the Complainant's trademark, per Paragraphs 4(b)(iii) and (iv).

Finally, the Panel notes that the Respondent has been the subject of past UDRP decisions and has been ordered to transfer its domain names. See, e.g., M and M Direct Limited v. a l an L, asdasdaasas Anna Vancini Vancini Domain Admin, Whoisprotection.cc eee qeqe, dasdhuighjbvhjbhjb Geneviève DEMANGE Li Xin Paul Y Cisneros Pranvera Grislin xinxin chen 4242, 2424, D2024-1655 (WIPO July 20, 2024); Jacquemus SAS v. , D2024-0401 (WIPO April 5, 2024); PEGASE v. Chris Lessly, D2023-4643 (WIPO January 24, 2024). Such pattern of prior abuse of trademarks through the registration of confusingly similar domain names has been held to further support a finding of bad faith. bioMérieux v. Carolina Rodrigues (Fundacion Comercio Electronico), UDRP-106614 (CAC July 24, 2024) ("this behavior demonstrates a pattern of conduct by the Respondent of taking advantage of trademarks of third parties without any right to do so and is indicative of the Respondent's bad faith."). As the Respondent has been ordered to transfer abusive domain names in past UDRP decisions, the Panel finds, in the present case, that this further supports its conclusion that the disputed domain name was registered and used in bad faith under Paragraph 4(b)(ii) of the Policy.

In light of the above, the Panel finds firm ground upon which to conclude that the Respondent both registered and used the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

[i] The Complainant is advised that the best practice in UDRP cases is to submit images of trademark registration certificates or screenshots of the official trademark office website showing evidence of the asserted trademark registrations. A mere textual list of registrations typically does not suffice. However, here, the Complaint provides a direct URL for the Complainant's trademark registrations at the EUIPO and the Panel has used this address to view the particulars of the asserted registrations.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **notino-ro.com**: Transferred

PANELLISTS

Name	**Steven Levy**

DATE OF PANEL DECISION 2024-08-12

Publish the Decision