Decision for dispute CAC-UDRP-106751

Case number	CAC-UDRP-106751
Time of filing	2024-07-30 09:40:13
Domain names	nanushkasale.com

Case administrator

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

Complainant

Organization	Nanushka International Zártkörűen Működő Részvénytársaság

Complainant representative

Organization	Oppenheim Ugyvedi Iroda

Respondent

Name	Liu Chuanxiang

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 <nanushkasale.com>.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks comprising the term “NANUSHKA”, among others:

- the EU trademark NANUSHKA n° 012504767 registered since February 15, 2015;
- the EU trademark NANUSHKA n° 018569398 registered since January 15, 2022;
- the international trademark NANUSHKA n° 1222798 registered since March 25, 2014;
- the international trademark NANUSHKA n° 1628640 registered since October 29, 2021;
- the international trademark NANUSHKA n° 1691677 registered since March 25, 2022;
- the Chinese trademark NANUSHKA n° 55022155 registered since December 28, 2022;
- the Chinese trademark NANUSHKA n° 45596822 registered since June 28, 2021;
- the Chinese trademark NANUSHKA n° 55825147 registered since April 7, 2022.

The Complainant, in connection with the distribution of apparel, operates the website under the domain name <nanushka.com> registered on October 26, 2003.

FACTUAL BACKGROUND

The Complainant, Nanushka International Zrt. is a Hungarian private company limited established in 2012. The Complainant specializes in ready-to-wear collections and accessories for women and men and trades under its commercial name and trademark Nanushka. The collections are currently sold in more than 140 physical stores worldwide, including Le Bon Marché, La Rinascente, Nordstrom, Saks Fifth Avenue and Neiman Marcus. In the online channel, Nanushka's products are available through its online store www.nanushka.com and are available in a handful of luxury e-commerce platforms, such as Farfetch, MyTheresa, Browns, Matches Fashion and Net-a-Porter.

The disputed domain name <nanushkasale.com> was registered on July 8, 2022.

PARTIES CONTENTIONS

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

COMPLAINANT:

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

According to the Complainant, the disputed domain name is confusingly similar to the disputed domain name as it fully incorporates the Complainant's trademark NANUSHKA, as the main and dominant element, with an addition of a descriptive word "sale".

Besides, the Complainant contends that the addition of the generic Top-Level Domain suffix ".COM" does not change the overall impression of the designation as being connected to the trademark NANUSHKA. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Therefore, the Complainant argues that the disputed domain name is confusingly similar to the Complainant's NANUSHKA trademark within the meaning of Paragraph 4(a)(i) of the Policy.

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

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is not related in any way with the Complainant.

Neither licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark NANUSHKA, or apply for registration of the disputed domain name by the Complainant.

Therefore, the Complainant contends that the Respondent has no right nor legitimate interest in respect of the disputed domain name, within the meaning of the Paragraphs 4(a)(ii) and (4)(c) of the Policy.

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

The Complainant states that the disputed domain name comprises the Complainant's distinctive trademark NANUSHKA. Thus, given the distinctiveness of the Complainant's trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

In addition, the Complainant provides that the disputed domain name operates a web shop that competes with the Complainant's products and reproduces the Complainant's logo, product images and marketing materials. According to the Complainant, the website includes no information regarding the identity of the provider of the website, the terms and conditions, as well as privacy policy are missing, which indicates bad faith and clear goal of untraceability. Moreover, the products listed under the disputed domain name are counterfeit.

Therefore, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith within the meaning of Paragraph 4(a)(iii) of the Policy.

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 identical or confusingly similar to a trademark in which the Complainant has rights

The Complainant has provided evidence and proved to be the owner of the trademark NANUSHKA.

The Complainant has provided evidence and proved to be the owner of the trademark registrations for NANUSHKA. Essentially, the Respondent has appropriated the term NANUSHKA by adding a descriptive word "sale" to presumably create a confusing similarity between the Complainant’s trademark NANUSHKA and the disputed domain name <nanushkasale.com> 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 NANUSHKA since the mere addition of a descriptive word "sale" 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 NANUSHKA trademark but also includes a purely generic top-level domain (“gTLD”) “com”. 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).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, and could confuse Internet users into thinking that the disputed domain name is associated with the Complainant or its trademarks.

In these circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks.

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 a respondent lacks rights or legitimate interests. Once such 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 does not have a legal right to use the NANUSHKA trademark as part of its domain name. The Respondent is not in any way affiliated with the Complainant, nor is it authorized to register the disputed domain name. Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

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 agrees with the Complainant that its trademark NANUSHKA is distinctive and known. Most of the registrations of the Complainant's trademark predate the registration of the disputed domain name. The Panel finds that there appears no reason why the Respondent would register the Complainant's trademark as part of the disputed domain name, other than to create the impression that it is connected to the Complainant's business. Given the distinctiveness of the Complainant's trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

The disputed domain name is being used in connection with a website allegedly offering for sale counterfeit products falsely identified and labeled as NANUSHKA goods. Moreover, the website reproduces the Complainant's logo, product images and marketing materials. As a result, there is no doubt that the Respondent knew about the existence of the Complainant and its trademarks. In the circumstances, the Panel finds that the Respondent registered the disputed domain name in bad faith.

The Panel concludes that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

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 is in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **nanushkasale.com**: Transferred

PANELLISTS

Name	**Barbora Donathová**

DATE OF PANEL DECISION 2024-08-30

Publish the Decision