Decision for dispute CAC-UDRP-106807

Case number	CAC-UDRP-106807
Time of filing	2024-08-22 09:56:39
Domain names	marcjacobs.moscow

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Marc Jacobs Trademarks, L.L.C.

Complainant representative

Organization	Agency TRIA ROBIT

Respondent

Name	Grigoriy (Григорий) Yurievich (Юрьевич) Livanskiy (Ливанский)

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 holds numerous word trademark registrations across various jurisdictions worldwide, which together establish a family of 'MARC JACOBS' trademarks. In particular, the Complainant holds the following International Registrations designating, among others, Russia, where the Respondent is based:

- International Registration no. 839406 for the word mark 'MARC JACOBS' in class 9 of the Nice Classification, registered on 12 November 2004;
- International Registration no. 864147 for the word mark 'MARC JACOBS' in classes 14 and 21 of the Nice Classification, registered on 16 September 2005;
- International Registration no. 1247493 for a word mark 'MARC JACOBS' in classes 35 and 41 of the Nice Classification, registered on 17 December 2014.

FACTUAL BACKGROUND

The Complainant and its 'MARC JACOBS' trademarks have a long history and are nowadays widely known throughout the world. The brand was created in 1984 and refers to its creator Mr. Marc Jacobs, a famous many award-winning American fashion designer, being a creative director for 16 years (1997-2013) of the world famous fashion house of Louis Vuitton (LVMH). The brand obtained a notorious success over the years and company behind the brand had over 200 retail stores in 80 countries becoming part of the

world largest fashion company LVHM portfolio.

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

Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name was registered and is being used in bad faith.

Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Russian.

Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons.

First, the Complainant submits that it is well-known fact not requiring a proof that English is widely understood and is spoken throughout the world as an international language, including Russia. Therefore, it is highly likely that the relevant Respondent might understand English sufficiently to understand the content of the complaint and annexes.

Furthermore, it is also well-known fact not requiring a proof that Russian language uses a Cyrillic script, however, the disputed domain name is registered in Latin letters instead of using the Cyrillic alternative (a generic top level domain .москва), suggesting that the Respondent has knowledge of languages other than Russian. Moreover, the fact that the disputed domain name incorporates well-known Complainant's brand comprising of Latin characters, this shows a familiarity of the Respondent with brands that are not of Russian and at least some level of compliance with the English language.

Additionally, the Complainant is the company located in the USA and has no knowledge of Russian, but to proceed in Russian, the Complainant would have to retain the services of a translator which would pose a cost that might be potentially higher than the overall cost of the administrative proceeding. This places an unreasonably high financial burden on the Complainant as well as would also cause undue delay in the proceedings since translation may take a significant time.

As it was earlier found by other panels, while applying the provision on the language of the proceeding the Panel considers that it should be also ensured that the parties are treated equally, that each party is given a fair opportunity to present its case and that the proceeding takes place with due expedition.

The Respondent was invited in Russian language to present his objection to the proceedings being held in English. Despite having the opportunity to raise objections or express a preference, the Respondent did not do so.

Whilst there is a language requirement in paragraph 11(a) of the Rules, the Panel has to balance that against the other considerations of ensuring that the proceeding takes place with due expedition and that the parties are treated fairly and given a fair opportunity to present their case. The Panel is of the view that the language requirement should not cause any undue burden on the parties or undue delay (See Navasard Limited v. Dmitrii Sofronov, CAC Case CAC-UDRP-106484).

Having considered all the matters above, and bearing in mind the website to which the disputed domain name resolves, partially provides information in English, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

Substantive Issues

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

The disputed domain name is confusingly similar to the Complainant's trademarks in the sense of Paragraph 4(a)(i) UDRP.

Based on the evidence in the case file, the Panel finds that the Complainant has shown rights in respect of 'MARC JACOBS' trademark for the purposes of the Policy.

In particular, the disputed domain name <marcjacobs.moscow> is identical to the Complainant's trademarks 'MARC JACOBS' since the disputed domain name fully incorporates the relevant trademark.

The Panel notes that the gTLD ".moscow" is required only for technical reasons and, as is common in proceedings under the UDRP, is generally ignored for the purposes of comparison of the Complainant's trademarks to the disputed domain name.

Therefore, it must be concluded that the Complainant holds the valid trademark rights to invoke and the disputed domain name is confusingly similar to the Complainant's trademarks for the purposes of Paragraph 4(a)(i) UDRP. As a result, the first UDRP element is fully met.

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

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name. Furthermore, the Complainant alleges that the Respondent has no trademark rights in 'marc jacobs' or any similar term and is not known by such name, and that the Respondent has not used or prepared to use the disputed domain name in connection with a bona fide offering of goods or services or a legitimate non-commercial or fair use.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

UDRP provides means of defences for respondents to demonstrate rights or legitimate interests in a domain name UDRP Paragraph 4(c). The Panel is of the opinion there is no sufficient evidence that the disputed domain name could fall in these "safe harbours" provided by the UDRP.

(i) <u>There is no evidence that the relevant Respondent has ever used the disputed domain name in connection with a bona fide offering of goods or services</u>

The disputed domain name <marcjacobs.moscow> is currently used for a website representing the internet (online) shop offering bags under 'MARC JACOBS' trademark. However, the fact that the relevant website is selling goods marked with the relevant trademark does not give a right to use the relevant trademark in the domain name without a permission of the Complainant. Therefore, such use cannot constitute a bona fide use and cannot be legitimate per se as is made without a permission from the right-holder.

Furthermore, the relevant Respondent or the entity displayed at the relevant website is not known to the Complainant and is not connected or affiliated with the Complainant in any manner. The Complainant has not permitted, licensed or otherwise consent the relevant Respondent to use the relevant trademarks in any way. In other words, the Respondent cannot be considered to be an

authorized distributor or reseller of the Complainant and therefore cannot have a legitimate interest in the disputed domain name. At the same time it should be noted that the “Oki Data” (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903, <okidataparts.com>) defence could not be applied in the given case since the website under the relevant disputed domain name does not disclose or explain any relationship with the right-holder but is trying to misled Internet users in relation to a possible affiliation with the Complainant by using very similar design of the website and the relevant trademarks thus making an false impression of being one of the authorized distributors.

(ii) There is no evidence that the Respondent could be commonly known by the relevant disputed domain name

Particularly, the website under the disputed domain name <marcjacobs.moscow> in its ‘Contacts’ section displays ‘IP Livansky Grigory Yuryevich’ (ИП Ливанский Григорий Юрьевич) as the holder/operator of the website. Obviously, that name is sufficiently different from the name used for the disputed domain name and as such does not give any legitimate right or interest for the disputed domain name to the Respondent. The Complainant does not have any information on that entity and there is no any evidence that the mentioned entity could be known by the relevant domain name or hold any registered right in the appropriate name or trademark. Besides, according to the WhoIs data the relevant disputed domain name was created on 3 August 2023 and it is doubtful that the relevant Respondent could have become commonly known in such a relatively short time.

(iii) There is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name

The current use of the disputed domain name <marcjacobs.moscow> being in fact Internet online store cannot be qualified as non-commercial since it is clear that the website under the disputed domain name is created and is used to obtain a commercial benefit from selling the goods. The nature and overall appearance of the website under the disputed domain name <marcjacobs.moscow> made closely similar to the original website as well as an intensive use of ‘MARC JACOBS’ trademarks throughout the website under the disputed domain name giving an impression that it is an official brand’s store or is somehow affiliated with the relevant brand surely allows to conclude that the Respondent does not make a legitimate and fair use of the relevant domain name but is using it with a sole intent to misleadingly divert consumers for a commercial gain or to tarnish the relevant trademark.

Summarizing the above the Panel believes that in view of lack of contradicting evidence it must be concluded that the Respondent does not have rights or legitimate interests in respect of the disputed domain name for the purposes of Paragraph 4(a)(ii)) UDRP. Consequently, the second UDRP element is fully met.

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

UDRP Paragraph 4(b) provides several non-exclusive scenarios constituting evidence of a respondent’s bad faith, including inter alia the scenarios proving that the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line 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.

The Complainant and its trademarks are widely known throughout the word as a luxury fashion brand. Furthermore, the World Wide Web has a plenty of information about the named person and the relevant brand and even simple Internet search would reveal that this is a word-famous brand and a person.

Bearing the above-mentioned world-scale awareness of the Complainant’s trademarks in mind, as well as taking into account that all the disputed domain name was registered substantially later comparing to the Complainant's trademark registrations were made, the Panel considers it is highly unlikely that the Respondent was not aware of the relevant trademarks and chosen the relevant disputed domain name coincidentally and occasionally, without full knowledge and awareness of the relevant brand name and the fact that it is belonging and is being associated with the particular person and the Complainant.

The disputed domain name fully incorporates the Complainant’s trademark without any amendments, which by itself creates a presumption of bad faith.

Furthermore, the way how the disputed domain name is being used, i.e., as an Internet online shop selling bags under ‘MARC JACOBS’ trademark, clearly indicates that the disputed domain name was registered and is being used in bad faith, with a clear awareness on the side of the Respondent of the brand and prior rights and with intention to attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademark.

Bearing in mind the above and the lack of rights and legitimate interest on the side of the Respondent the Panel believes that the disputed domain name was registered and is being used in bad faith in the sense of Paragraph 4(a)(iii) UDRP. Consequently, the third UDRP element is fully met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **marcjacobs.moscow**: Transferred

PANELLISTS

Name	**Ganna Prokhorova**

DATE OF PANEL DECISION 2024-09-23

Publish the Decision