Decision for dispute CAC-UDRP-107074

Case number	CAC-UDRP-107074
Time of filing	2024-11-21 07:57:25
Domain names	marc-jacobs.site, marc-jacobs.shop

Case administrator

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

Complainant

Organization	Marc Jacobs Trademarks, L.L.C.

Complainant representative

Organization	Agency TRIA ROBIT

Respondent

Name	Artem Mirzoaliev

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous international trademark registrations, e.g. word trademark MARC JACOBS (Reg. No. 839406) in Nice class 9, registered since November 12, 2004 (extended in the Russian Federation), word trademark MARC JACOBS (Reg. No. 864147) in Nice classes 14 and 21, registered since September 16, 2005 (extended in the Russian Federation), etc.

FACTUAL BACKGROUND

The Complainant, Marc Jacobs Trademarks LLC is the owner of the famous mark – MARC JACOBS. It was created in 1984 and refers to its creator Mr. Marc Jacobs, a famous award-winning American fashion designer, who was Louis Vuitton's creative director for 16 years (1997-2013). The brand obtained notorious success over the years and the company behind the brand had over 200 retail stores in 80 countries becoming part of the world's largest fashion company LVHM portfolio. Therefore, the Complainant and its trademarks are widely known throughout the world as a luxury fashion brand.

The Complainant is the owner of numerous international trademark registrations, e.g. word trademark MARC JACOBS (Reg. No. 839406) in Nice class 9, registered since November 12, 2004 (extended in the Russian Federation), word trademark MARC JACOBS (Reg. No. 864147) in Nice classes 14 and 21, registered since September 16, 2005 (extended in the Russian Federation), etc.

Complainant's evidence also show that it is the holder or user of the domain name <marcjacobs.com>.

The disputed domain names were both registered on November 23, 2023, and are inactive, just parked.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names 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 names are 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 names (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 names has been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Complainant filed the Complaint in English rather than in Russian (i.e. the language of the registration agreement). Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the parties, or otherwise specified in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. Paragraph 10(b) and (c) of the Rules requires the Panel to ensure that the proceeding takes place with due expedition and that the parties are treated fairly and given a fair opportunity to present their respective cases.

The Complainant filed its Complaint in English and then requested that English be the language of the proceeding.

The Complainant noted the following factors supporting English as the fair language of the proceeding:

(a) it is a well-known fact, requiring no proof, that English is widely understood, particularly on the Internet (including in Russia), therefore, it is highly likely that the Respondent possesses sufficient English language skills to understand the contents of the Complaint and its accompanying documents; (b) the Russian language uses a Cyrillic script while the disputed domain names are registered in Latin letters which suggests that the Respondent is knowledgeable in English language; (c) there are several online tools available to translate communications from the Panel, which will enable the Respondent to understand the essence of the Complaint; (d) the Complainant is a company based in the USA (where the official language is English) and lacks proficiency in the Russian language; if the Complainant were required to use Russian, they would need to hire a translator and this would impose an unreasonable financial burden on the Complainant as well as could lead to unnecessary delays in the proceedings.

The Panel agrees with the factors presented by the Complainant and also admits additional important factors in favour of the Complainant's option of English language for this proceeding: (a) the domain names <.site> and <.shop> are generic top-level domains in the Domain Name System of the Internet, and they are identical to the same e-commerce terms in English language ("site" and "shop"), indicating the Respondent's sufficient understanding of English; (b) the Respondent has been given the opportunity to present its case in this proceeding and to respond formally to the issue of the language of the proceeding; (c) the Respondent has not responded to the Complainant's request for a change of the language from Russian to English; (d) the Complainant would be unduly disadvantaged by having to proceed in Russian (i.e., by having to arrange and pay for the translation of the Complaint and annexes).

Considering the above circumstances, the Panel finds that the choice of English as the language of the present proceeding is fair to both parties and is not prejudicial to either one of the parties in his or her ability to articulate the arguments for this case.

The Panel has also taken into consideration the fact that insisting the Complaint and all supporting documents to be re-filed in Russian would cause an unnecessary burden of cost to the Complainant and would unnecessarily delay the proceeding which would be contrary to Paragraph 10(b) and (c) of the Rules.

Having considered all the above matters, the Panel determines under paragraph 11(a) of the Rules that (i) it will accept the Complaint and all supporting materials as filed in English; and (ii) English will be the language of the proceeding and the decision will be rendered in English.

In view of all of the above, 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 disputed domain names are identical to the Complainant's trademark MARC JACOBS (the hyphen between the words has no any impact in this regard). The Complainant’s trademark is included in the disputed domain names in its entirety. It is well established in the UDRP case law that the addition of a generic Top-Level Domain (gTLD), here <.site> and <.shop> (the gTLDs intended for the e-shops or other information society services providers), is typically disregarded under the first element when considering the confusing similarity between the complainant’s trademark and the disputed domain name.

The Panel acknowledges that the Complainant presented prima facie evidence that the Respondent is not sponsored by or affiliated with Complainant in any way. Furthermore, the Complainant has not licensed, authorized, or permitted Respondent to use Complainant’s trademarks in any manner, including in domain names. The Respondent's name does not resemble the disputed domain names in any manner. Respondent’s use of the disputed domain names does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use. On these bases, the Panel concludes that the Respondent does not have any rights or legitimate interests in regard to the disputed domain names.

As no administratively compliant response has been provided to the Panel and the prima facie evidence was not challenged by the Respondent, the Panel concludes that the Respondent evidently meant Complainant's trademark MARC JACOBS, when he registered the disputed domain names <marc-jacobs.site> and <marc-jacobs.shop> (see WIPO Overview 3.0, para. 3.1.3 and 3.2). Previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Accordingly, the Panel finds that the disputed domain names were registered in bad faith.

The disputed domain names are not used (just parked). From the inception of the UDRP, previous panellists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having regard to the notoriety of the Complainant’s trademark, the failure of the Respondent to submit a response and the implausibility of any good faith use, the Panel concludes that the disputed domain names are being used in bad faith (section 3.3 of WIPO Overview 3.0).

On these bases, the Panel concludes that the Respondent has both registered and used the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **marc-jacobs.site**: Transferred
2. **marc-jacobs.shop**: Transferred

PANELLISTS

Name	**Darius Sauliūnas**

DATE OF PANEL DECISION 2025-01-03

Publish the Decision