

Decision for dispute CAC-UDRP-104695

Case number	CAC-UDRP-104695
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Time of filing	2022-07-08 09:03:31
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Domain names	zadigvoltaire.shop
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Case administrator

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

Organization	Z&V
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Kai Chu
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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 has provided evidence of ownership of the following trademark:

- European trademark ZADIG & VOLTAIRE n°005014171 registered since March 17th, 2006, duly renewed; and
- International trademark ZADIG & VOLTAIRE n°907298 registered on September 15th, 2006, duly renewed.

FACTUAL BACKGROUND

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states that the disputed domain name is confusingly similar to its trademark ZADIG & VOLTAIRE®. Indeed, the disputed domain name incorporates the Complainant's trademark, without the "&". The Complainant contends that it doesn't eliminate the likelihood of confusion with the trademark.

Furthermore, the Complainant contends that the addition of the new gTLD ".SHOP" does not change the overall impression of

the designation as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

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

The Respondent is not commonly known by the disputed domain name. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark ZADIG & VOLTAIRE®, or apply for registration of the disputed domain name.

Lastly, the domain name is used to host the website to impersonate the Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from Complainant. Furthermore, there is no information/disclaimer on the page of the website to identify its owner. Therefore, the Respondent failed at least in one of the elements of the Oki Data test, i.e. the website linked to the disputed domain name does not disclose accurately and prominently the registrant's relationship with the trademark holder.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant states that the disputed domain name is confusingly similar to its trademark ZADIG & VOLTAIRE. The trademark was registered several years before the registration of the disputed domain name. The Complainant is a worldwide and well known fashion company, and the Respondent makes references to the Complainant's products and trademarks in the website. On those facts, given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks. Please see for instance WIPO Case No. D2004-0673, Ferrari S.p.A v. American Entertainment Group Inc.

The Complainant finds that Respondent registered and uses the domain name in bad faith to create confusion with Complainant's trademarks for commercial gain by using the confusingly similar domain name to resolve to website offering counterfeit or unauthorized versions of Complainant's products in direct competition with the Complainant's products. Using a confusingly similar domain name to trade upon the goodwill of a complainant can evince bad faith under Policy paragraph 4(b) (iv).

PARTIES CONTENTIONS

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

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark to succeed.

The Complainant, Z&V, is a French company in the fashion industry established in 1997. The Complainant has provided evidence of ownership of trademarks in the term “ZADIG&VOLTAIRE” for more than 15 years.

The disputed domain name is <zadigvoltaire.shop>.

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the Complainant holds rights. According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), “this test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name”.

Also, according to section 1.7 of the WIPO Overview 3.0, “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing”.

The disputed domain name wholly incorporates the Complainant’s trademark “ZADIG&VOLTAIRE”, but for the ampersand in the mark. This absence does not prevent a finding of confusing similarity with the Complainant’s trademarks as the ampersand character is not allowed in domain names. The fact that a domain name wholly incorporates the Complainant’s trademark is sufficient for this Panel to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks.

It is well accepted by UDRP panels that a generic Top-Level Domain (“gTLD”), such as “.store”, is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark.

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the Respondent’s rights or legitimate interests in the disputed domain name:

- (i) before any notice to it of the dispute, the Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the Respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: “[...] 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

In the absence of rebuttal from the Respondent, the Panel finds that the Respondent is not commonly known by the disputed domain name.

The Complainant has not at any time authorised or licensed the Respondent to use “ZADIG&VOLTAIRE” as a domain name, business or trading name, trade mark or in any other way.

In addition, nothing in the record shows any bona fide offering of goods or services from the disputed domain name on the part of the Respondent before the submission of the Complaint.

The Panel concludes that the Respondent has no right or legitimate interests in the disputed domain name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

(i) circumstances indicating that the holder has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holders documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the holder has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 your website or location or of a product or service on the holder's website or location.

The Panel finds the third and fourth elements of Paragraph 4(b) of the Policy applicable in the present case. The evidence on the record shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant, and that the Respondent, by registering and using the disputed domain name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark.

The use of an active website displaying the Complainant's trademark in connection with the disputed domain name is further evidence of bad faith use on the part of the Respondent.

The Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith, and therefore finds that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ZADIGVOLTAIRE.SHOP**: Transferred

PANELLISTS

Name	Arthur Fouré
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DATE OF PANEL DECISION	2022-08-16
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Publish the Decision