

Decision for dispute CAC-UDRP-104948

Case number	CAC-UDRP-104948
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Time of filing	2022-10-26 11:52:16
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Domain names	sezaneparis.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	BENDA BILI
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	grimm tessa
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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 owns Trademark Registrations for the mark SEZANE including the following:

- International Trademark No. 1170876 registered on June 3, 2013;
- International Trademark No. 1312614 registered on January 21, 2016;
- French Trademark No. 3933287 registered on July 10, 2012.

FACTUAL BACKGROUND

The Complainant sells apparel, footwear, and accessories under its trademark SEZANE. The Respondent uses the disputed domain name to display a website that prominently features the Complainant's trademark and purports to offer for sale goods which are similar in category, though not identical to those offered by the Complainant.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant is a company specialized in ready-to-wear collections and accessories for women and trading under its commercial name and trademark SEZANE. The term “SEZANE” is a contraction of the first name and last name of the Complainant’s founder and President Morgane SEZALORY. The Complainant offers its goods at the website www.sezane.com.

The disputed domain name <sezaneparis.com> was registered on October 19, 2022. The disputed domain name aims to attract consumers to a website displaying the SEZANE trademark and claiming to sell shoes, coats and handbags which compete with the products provided by 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, UDRP-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.”).

A. 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, UDRP-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 has submitted screenshots from the website of the World Intellectual Property Office (WIPO) as evidence that it owns registered rights to its asserted SEZANE trademark in multiple jurisdictions via the Madrid Protocol, including the country of France. The earliest of these reflects a registration date of July 10, 2012. Registration with 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, which was registered on October 19, 2022, adds the geographically descriptive word “Paris” to the SEZANE trademark and this has the effect of increasing the confusing similarity of the

disputed domain name as the Complainant's headquarters office is located in that city. 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*, UDRP-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 distinguishing element 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 geographically descriptive word 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.

B. 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 a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name. *Cephalon, Inc. v. RiskIQ, Inc.*, UDRP-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 "The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name" and that "the Respondent is not affiliated with nor authorized by the Complainant in any way." The Panel notes that the concerned Registrar, in its verification notice, has identified the Respondent's name as "grimm tessa". The Respondent has not participated in this case and so it does not contest the Complainant's assertions and there is no evidence that it is known by any other name. 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 sell women's apparel, footwear, and handbags that do not appear to originate with the Complainant. 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 *Migros-Genossenschafts-Bund v. Anthony Maitama Smith*, UDRP-104873 (CAC November 4, 2022) ("the Respondent was using the disputed domain name to operate a website impersonating an official MIGROS BANK online banking website in order to pass off as the Complainant, deceive internet users and extract sensitive information and money. Such activity is outright criminal in many jurisdictions and certainly cannot establish Complainant's rights or legitimate interest in respect of the disputed domain name."). Here, the Complainant submits screenshots of the Respondent's website and asserts that "the disputed domain name resolves to an online store selling shoes, coats and handbags, which compete with the products provided by the Complainant". The Panel notes that the Respondent's website prominently displays the term SEZANE along with images of various apparel, footwear, and handbag products though these do not appear to originate from the Complainant or to be identical to images of similar products displayed on the Complainant's own website. The bottom of the page displays a telephone number and postal address in the city of Nice, France as well as the footer "Copyright 2022 SEZANEPARIS. All Rights Reserved." The Panel views this use of the Complainant's trademark as being for the purpose of impersonation or infringement and the Respondent has not filed a Response or made any other submission in this case to offer an alternative theory or 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.

C. 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 Respondent’s impersonation activities at its website, including its use of the word “Paris” (the city of the Complainant’s headquarters), and its display of a phone number and postal address in France, indicates a high likelihood that it had prior knowledge of the Complainant’s trademark at the time that 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 impersonates the Complainant while offer for sale competing goods. 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 *Osprey Packs, Inc. v. Web Commerce Communications Limited / Oscar Leal*, UDRP-104871 (CAC November 15, 2022) (where the Respondent is engaged in the “mimicking of Complainant’s website”, such “[u]se of a disputed domain name to pass off as a complainant and offer competing or counterfeit versions of its products may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv)”). The Complainant asserts that the disputed domain name is used for an “online store which compete [sic] with the products offered by the Complainant”. 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 offering for sale apparel, footwear, and handbag products under the SEZANE trademark that are very similar to those offered by the Complainant. 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 seeking commercial gain through confusion with the Complainant’s trademark, per Paragraph 4(b)(iv).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **sezaneparis.com**: Transferred

PANELLISTS

Name	Steven Levy Esq.
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DATE OF PANEL DECISION 2022-11-23

Publish the Decision