

## Decision for dispute CAC-UDRP-104978

Case number **CAC-UDRP-104978**

Time of filing **2022-11-09 09:35:18**

Domain names **jonakoutlet-fr.shop**

### Case administrator

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

### Complainant

Organization **Joseph NAKAM (Joseph NAKAM)**

### Complainant representative

Organization **NAMESHIELD S.A.S.**

### Respondent

Name **Brigitte Bellamy**

#### 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 is, inter alia, proprietor of the European trademark registration 002580223 JONAK, registered on August 7, 2003 for goods in classes 18 and 25. The mark is in effect.

#### FACTUAL BACKGROUND

The Complainant is the CEO of the company KARINE, operating under the trade name "JONAK". JONAK specializes in women's footwear.

The disputed domain name <jonakoutlet-fr.shop> was registered on November 2nd, 2022. It redirects to the website displaying the Complainant's trademark and logo JONAK in the upper left corner, and allegedly selling the Complainant's products. The website does not indicate any relation to the Complainant or KARINE and does not contain any indication of an address of the operator of the website.

#### PARTIES CONTENTIONS

The Complainant states that the disputed domain name is confusingly similar to its trademark JONAK®. The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. The Respondent is not known by the Complainant. The Complainant contends that Respondent is not affiliated with nor authorized by the Complainant in any way.

The Complainant claims that the disputed domain name redirects to the website displaying the Complainant's trademark and logo JONAK, and allegedly selling the Complainant's products. The Complainant asserts that the domain name is used to host a website in order to impersonate Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from the Complainant.

No administratively compliant Response has been filed.

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#### 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).

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#### 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).

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#### 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

In order to succeed in its claim, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) The 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 with respect to the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

#### **A. Identical or Confusingly Similar**

The Complainant has established the fact that it has valid trademark rights for JONAK in classes 18 and 25 in several countries.

The disputed domain name is confusingly similar to the JONAK mark of the Complainant since the elements "outlet" and the geographical identifier „fr“ being descriptive and non-distinctive words cannot be considered as relevant to influence the overall impression of the domain name.

The Panel therefore considers the disputed domain name to be confusingly similar to the trademark JONAK in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

#### **B. Rights or Legitimate Interests**

The Respondent has no rights in the disputed domain name since the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to the Respondent to use its trademarks. Furthermore, the Respondent has no legitimate interest in the domain name since there is no indication that the Respondent is commonly known by the name "JONAK" or „Jonak-outlet-fr.shop“ nor that the Respondent is using the domain name in connection with a *bona fide* offering of related goods or services.

The latter could be discussed since Respondent seems to offer products from the Complainant. However, the majority opinion of panelists follows in cases where a legitimate interest of resellers of original goods to use a trademark in the domain name is in question, the test of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), <okidataparts.com> after which such use might be legitimate if the use comprise the actual offering of goods, only the trademarked goods are sold on the site, and the site is accurately and prominently disclosing the registrant's relationship with the trademark holder.

Although this Panel follows even the argumentation that any reseller is not allowed to use the trademark, unless otherwise authorized, in a manner which goes beyond the scope of informing the customer about the core of its business activities (see also *Ferrero S.p.A. v. Fistagi S.r.l.*, WIPO Case No. D2001-0262; *Raymond Weil SA v. Watchesplanet (M) Sdn Bhd*, WIPO Case No. D2001-0601; dissenting opinion in *DaimlerChrysler A.G. v. Donald Drummonds*, WIPO Case No. D2001-0160) and unless it is not clear for the customer that the retailer is not an authorized partner of the Trademark owner, the present case does not meet even the less strong criteria of the test after *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, <okidataparts.com>, since the website under the disputed domain name creates the impression of being authorized by the Complainant or the company KARINE.

The Panel therefore finds that the respondent does not have rights or legitimate interests in the disputed domain name.

### C. Registered and Used in Bad Faith

Due to the use of the logo and the alleged sale of JONAK's products, the Respondent must have been well aware of the Complainant and its trademarks when registering the domain name (see also CAC Case No. 104653, *Joseph NAKAM v. Amanda Gorman*: „Trademark rights well-established“). The Complainant had not authorised the Respondent to make use of its mark. This Panel does not see any conceivable legitimate use that could be made by the Respondent of this particular domain name without the Complainant's authorization.

The circumstances of this case furthermore indicate that the Respondent registered and uses the domain name primarily with the intention of attempting to attract, for commercial gain, Internet users to a potential website or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such potential website or location, or of a product or service on such website or location.

The Panel therefore considers the disputed domain name to have been registered and used in bad faith in accordance with paragraph 4(a)(iii) of the Policy.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **jonakoutlet-fr.shop**: Transferred

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### PANELLISTS

Name	<b>Dietrich Beier</b>
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DATE OF PANEL DECISION	<b>2022-12-13</b>
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Publish the Decision

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