

Decision for dispute CAC-UDRP-105502

Case number	CAC-UDRP-105502
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Time of filing	2023-06-07 09:20:49
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Domain names	zadigetvoltaire.online
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Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	ZV HOLDING
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Maroc boutique
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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 the following Trademark Registrations:

International trademark ZADIG & VOLTAIRE Number 907298 registered on September 15, 2006.

European trademark ZADIG & VOLTAIRE Number 005014171 registered since March 17, 2006.

FACTUAL BACKGROUND

THE COMPLAINANT'S CONTENTIONS

The Complainant, established in 1997, produces and sells ready to-wear fashion, accessories and perfumes under the trademark ZADIG & VOLTAIRE. Since 2002, the Complainant's main operating website has been located at www.zadig-et-voltaire.com and the ZADIG & VOLTAIRE name is the subject of International and European trademark registrations as of 2006. The Complainant's trademark is well known and enjoys a global reputation.

The disputed domain name <zadigetvoltaire.online> was registered on May 23, 2023 and redirects to a website purporting to be an online store selling the Complainant's ZADIG & VOLTAIRE products at discounted prices. The disputed domain name copies the trademarks and the graphic charter of the Complainant and there is no information or disclaimer on the page of the website to identify its owner.

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

1. 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*, 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 websites of the World Intellectual Property Organization ("WIPO") and European Union Intellectual Property Office ("EUIPO") as evidence that it owns registered rights to its asserted ZADIG & VOLTAIRE trademark in multiple jurisdictions. The earliest of these reflects a registration date of March 17, 2006. Registration with such intellectual property 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 May 23, 2023, differs from the Complainant's trademark only in its substitution of the word "et" for the ampersand "&". The Complainant asserts that the disputed domain name incorporates the entirety of its ZADIG & VOLTAIRE trademark and the minor change does not avoid a finding of confusing similarity as the term "et" is a word in the French language meaning "and" which is the

same meaning conveyed by the ampersand character “&”. Finally, the Complainant contends that “the addition of the New generic Top-Level Domain suffix ‘.ONLINE’ does not change the overall impression of the designation as being connected to the trademark of the Complainant.” 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 is endorsed by the Complainant.

Prior panels have found confusing similarity under similar fact situations. *Lord & Taylor IP LLC v. zhang qiu mei*, FA 2024642 (FORUM January 25, 2023) (“incorporation of ‘and’ in place of the ampersand” held to not “distinguish the disputed domain name from the Complainant’s trademark”). Also, a gTLD, such as the extension “.online”, typically adds no meaning or distinctiveness to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. *MIGROS-GENOSSENSCHAFTS-BUND v. Zain Chukwuma*, UDRP-105434 (CAC June 21, 2023) (<migrosgh.online> found confusingly similar the MIGROS trademark where “the gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”).

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the substitution of the word “et” in the disputed domain name for the ampersand in the trademark is insufficient to avoid a finding that it is confusingly similar to the Complainant’s trademark. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

2. 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 Respondent is “not commonly known by” the disputed domain name and that the “Respondent is not affiliated with nor authorized by the Complainant in any way.” The Respondent has not participated in this case and so it does not contest these assertions there is also no evidence in the record to contradict them. Furthermore, the Registrar for the disputed domain names identifies the Registrant as “Maroc boutique”. There is no evidence that the Respondent is known otherwise and its use of the Complainant’s trademark in its domain name 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 claims to offer discounted sales of products bearing the Complainant’s trademark. 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 noncommercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy. See *Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund*, FA 1790949 (FORUM July 9, 2018) (finding that the Respondent did not use the disputed domain name to make a bona fide offering of goods or services per Paragraph 4(c)(i) of the Policy or for a legitimate noncommercial or fair use per Paragraph 4(c)(iii) where the website resolving from the disputed domain name featured the Complainant’s mark and various photographs related to the Complainant’s business). Here, the Complainant claims that the Respondent uses the disputed domain name to pass itself off as the Complainant in order to sell products whose authenticity is in question. The Complainant provides screenshots of the Respondent’s resolving website and the Panel notes that the website prominently displays the ZADIG & VOLTAIRE trademark at the top in the identical type-font used by the Complainant. The page also displays a header stating “All Our Zadige [sic] And Voltaire Bags On Discount Today”. Further down the page are displayed photos and the names of many of the Complainant’s products, many of which appear to have been copied from the Complainant’s own website. These products display prices in a grey and strikethrough font followed by lower prices in a black font. At the bottom of the page there is a paragraph describing the offered products and this begins with the statement “Zadig&Voltaire bags epitomize the rock spirit that has always driven the House. As chic as they are versatile, our bags are designed to be the accessory that transcends a look and can be worn as easily during the day as in the evening.” This appears, to the Panel, to be an online sales page but there is no indication that it does not originate with the Complainant or that the Respondent has no relationship with the Complainant. To the contrary, the use of phrases “Our Zadige [sic] And Voltaire Bags...” and “our bags are designed...” reinforces the impression that the Respondent’s page originates with the Complainant. *Oki Data Americas Inc v ASD Inc*, D2001-0903 (WIPO Nov. 6, 2001).

As the Complainant has made out a prima facie case of impersonation for commercial gain 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 noncommercial or fair use of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

3. 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 Complainant claims that "given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark." However, apart from evidence of its two trademark registrations and a single screenshot of its www.zadig-et-voltaire.com website captured on May 31, 2023, the Complainant has not submitted any documentary evidence to support its claims of brand reputation or scope such as advertising and promotion, social media pages, news articles mentioning the trademark, and the like. Nevertheless, based on the Respondent's use of the ZADIG & VOLTAIRE mark to sell questionable products and its apparent copying of product images from the Complainant's own website, the Panel concludes that the Respondent did have actual knowledge of the complainant's rights in its asserted 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 passes itself off as the Complainant to directly compete with it and to disrupt its business. 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 Instant Brands LLC v. Yan Hu, UDRP-105468 75 (CAC June 29, 2023) ("the Disputed Domain Names resolve to active websites impersonating the Complainant by offering or appearing to offer counterfeits of Complainant's products."). The Complainant asserts that the Respondent's use of the disputed domain name disrupts its business by directly competing with it and that this supports a claim of bad faith under Paragraph 4(b)(iii) of the Policy. 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 promoting the sale of products bearing the Complainant's trademark. 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 disrupting the Complainant's business, per Paragraph 4(b)(iii) of the Policy. Although not asserted by the Complainant, the Panel also finds bad faith registration and use by the Respondent's using the disputed domain name to intentionally attempted to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the Complainant's mark, per Paragraph 4(b)(iv) of the Policy.

Finally, the Complainant asserts that the Respondent's use of misleading Whois information, in the form of a privacy service, further suggests bad faith. Prior decisions have noted that using a privacy service may demonstrate a bad faith attempt to hide one's identity and hinder a trademark owner from attempting to assert its rights. See Microsoft Corporation v. Arif Khan, FA 1907105 (FORUM Aug. 31, 2020) ("in the context of this case Respondent's use of a WHOIS privacy service further supports a finding of bad faith under Policy paragraph 4(a)(iii)."). The Complainant submits a screenshot of the public Whois record for the disputed domain name indicating that the Respondent Organization is "Privacy Protect, LLC". Against the backdrop of the use to which the disputed domain name has been put, the Panel finds that Respondent's use of a privacy service further demonstrates its bad faith in this case under Policy paragraph 4(a)(iii).

[1] The Panel presumes that Complainant's Representative meant to say "the trademark ZADIG & VOLTAIRE®" but that it mistakenly mentioned a trademark used in its complaint template from another client.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

1. **zadigetvoltaire.online**: Transferred

PANELLISTS

Name **Steven Levy Esq.**

DATE OF PANEL DECISION **2023-07-03**

Publish the Decision