Panel Decision for dispute CAC-ADREU-006877

Case number	CAC-ADREU-006877
Time of filing	2015-03-12 13:49:24
Domain names	isabelmarant-outlet.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	IM PRODUCTION

Respondent

Name	HEINRICH GROOTHUIZEN

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings, either pending or decided, that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant in this ADR Proceeding is IM PRODUCTION, a company incorporated under the French law and registered in France. The Complainant is a French fashion company creating, manufacturing and selling garments and fashion accessories which are distributed all over the world and notably in Europe, USA and China. Ms Isabel MARANT is the Manager of the Complainant.

The Respondent is Groothuizen Heinrich, with address in Klagerstuin 48, Zwaag, 1689 JT, Netherlands. The Respondent has not demonstrated what comprises his economic activity, if any.

The disputed domain name (isabelmarant-outlet.eu) was registered by the Respondent on 26 December 2013.

The Complaint was received on 21 November 2014. The Czech Arbitration Court acknowledged receipt of the Complaint on 25 November 2014 and issued a Request for EURid Verification for the disputed domain name on the same date. On 28 November 2014, EURid replied in a Non-standard communication confirming that the disputed domain name isabelmarant-outlet.eu was registered with the Registrar EuroDNS S.A., that the current registrant of the domain name was the Respondent, that the domain name would remain locked during the pending ADR Proceeding and that the specific language of the registration agreement as used by the Registrant for the disputed domain name was English. It also provided the full details from the WHOIS database for the domain name registrant and its technical contacts.

On 28 November 2014 the Czech Arbitration Court provided a Notification of Deficiencies in Complaint to the Complainant regarding the absence of Annex No. 1 which was not attached to the Complaint. On the same date the Complainant corrected the above-mentioned deficiencies by submitting a Non-standard communication form accompanied by Annex No. 1. The formal date of the commencement of the ADR Proceeding was therefore 01 December 2014. As the Respondent has not confirmed receiving the e-mail notice of the ADR Proceeding by accessing the online platform within 5 days of its sending, the same was sent by post on 09 December 2014. On 02 January 2015 the written notice of the ADR Proceeding addressed to the Respondent was returned undelivered to the Czech Arbitration Court. In accordance with Paragraph A2 (e) (3) of the .eu Alternative Dispute Resolution Rules ('ADR Rules') the written notice is considered to be delivered on 22 December 2014. On 26 January 2015 a Non-standard communication was sent to the Respondent reminding that the term for submitting a Response was to expire on 05 February 2015. The Respondent did not file any response.

Following an invitation to serve on the Panel in this dispute, the Panel accepted the mandate and submitted the Declaration of Impartiality and Independence in due time. On 17 February 2015 the Czech Arbitration Court duly notified the parties of the identity of the

Panel appointed in accordance with paragraph B4 (e) of the ADR Rules and the date by which the Panel shall forward its decision on the Complaint to the Czech Arbitration Court, which date was specified as 12 March 2015.

In the absence of a challenge to the Panel's appointment by either Party according to Paragraph B5 (c) of the ADR Rules, the Czech Arbitration Court transmitted the case file to the Panel on 20 February 2015.

A. COMPLAINANT

The Complainant claims that it is an owner of a lot of trademarks all over the world and particularly of the following Community Trademark registrations (CTM):

• CTM No. 001035534 - 'ISABEL MARANT' (word) filed on 23 December 1998 in classes 03, 14 and 25, and
• CTM No. 003010048 - 'ISABEL MARANT' (word) filed on 8 January 2003 in classes 09, 18, 21 and 24.

Excerpts of the registration of the CTM No. 001035534 - 'ISABEL MARANT' (word) and the CTM No. 003010048 - 'ISABEL MARANT' (word) were provided as Annex No. 2 to the Complaint.

According to the Complainant's allegations, which have not been opposed by the Respondent, the Complainant is also an owner of a lot of domain names and notably the following domain names:
• isabelmarant.com,
• isabel-marant.com,
• isabelmarant.tm.fr,
• isabelmarant.fr, and
• isabel-marant.fr.

Furthermore, the Complainant contends that the trademark ISABEL MARANT is the name of Designer who is also the President (Manager) of the Complainant. An extract from the French Trade Register with its English translation was provided as Annex No. 3 to the Complaint. An article in THE INDEPENDENT dated October 21, 1991 evidencing the approximate time when the Manager of the Claimant initiated her business was submitted as Annex No. 1 to the Complaint.

The Complainant considers that the registration of the disputed domain name is detrimental to its rights in that:
- the disputed domain name is confusingly similar to the Complainant's prior rights;
- the Respondent has no right or legitimate interest in respect of the domain name;
- the Respondent uses the domain name in bad faith as the disputed domain name is directed to the web site http://uk.isabelmarant-outlet.eu used for selling Isabel Marant's products that the Complainant has identified as counterfeit. By creating confusion with the Complainant's mark knowing that is not an authorized retailer and has no relationship with the Complainant, the Respondent deliberately registered and used the disputed domain name to attract Internet users to its website for financial gain. Screen Captures of the web site http://uk.isabelmarant-outlet.eu were provided as Annex No. 4 to the Complaint.

The Complainant requests the Panel appointed in the ADR Proceeding that the litigious domain name isabelmarant-outlet.eu is transferred to the Complainant.

B. RESPONDENT

The Respondent has failed to submit a Response to the Complaint; the Respondent, having been regularly notified, is, therefore, in default.

DISCUSSION AND FINDINGS

This Complaint is brought under the auspices of Regulation 874/2004 and the ADR Rules. Article 22(1)(a) of Regulation 874/2004 allows any party to initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21 of Regulation 874/2004.

Article 21(1) of Regulation 874/2004 stipulates that a registered domain name shall be subject to revocation where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1) of Regulation 874/2004, and where it:
(a) has been registered by its holder without rights or legitimate interest in the name; or
(b) has been registered or is being used in bad faith.

Article 21(2) of Regulation 874/2004 provides examples whereby the Respondent's legitimate interest may be demonstrated (echoed in Paragraph B11(e) of the ADR Rules), while Article 21(3) of Regulation 874/2004 provides examples whereby bad faith may be demonstrated (similarly echoed in Paragraph B11(f) of the ADR Rules).

Article 10(1) of Regulation 874/2004 stipulates that prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

Article 22(11) of Regulation 874/2004 states that in the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21 of Regulation 874/2004. Furthermore, the domain name is to be transferred to the complainant if the complainant applies for it and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation 733/2002.

Paragraph B11(d)(1) of the ADR Rules provides as follows:

The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves (1) in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that
(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law and; either
(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or
(iii) The domain name has been registered or is being used in bad faith.

Therefore, the Panel finds as follows:

1. Identity or confusing similarity

It is clear from the applicable provisions that the burden of proving that a .eu domain name registration is speculative or abusive lies with the Complainant.

Documentary evidence was provided demonstrating that the Complainant has, for several years, been the proprietor of multiple registrations of the trademark 'ISABEL MARANT' in the European Union, namely CTM Registration No. 001035534 - 'ISABEL MARANT' (word) filed on 23 December 1998 in classes 03, 14 and 25 and CTM Registration No. 003010048 - 'ISABEL MARANT' (word) filed on 8 January 2003 in classes 09, 18, 21 and 24.

The Complainant also brought to the attention of the Panel its domain name registrations, all of which was reviewed by the Panel and it was verified that IM PRODUCTION owned the following domain names at the time of registration of the disputed domain name:
• isabelmarant.com,
• isabel-marant.com,
• isabelmarant.tm.fr,
• isabelmarant.fr, and
• isabel-marant.fr.

The name of the Complainant's Manager and Designer is ISABEL MARANT, as evident from the extract from the Record Office of Commercial Court of Paris, presented as Annex No. 3 to the Complaint. However, since Ms Isabel MARANT is not the Complainant in this ADR Proceeding, her right to the name cannot serve as a valid prior right of the Complainant within the meaning of Article 21(1) and Article 10(1) of Regulation 874/2004. Nevertheless, this circumstance is of importance with regard to the question of registration or use of the disputed domain name in bad faith (see p. 3 below).

Therefore, the Panel finds that Complainant has provided sufficient evidence to prove valid prior rights regarding the disputed domain name registration, as follows:
• The Complainant provided evidence of CTM registrations filed on 23 December 1998, respectively 08 January 2003, where the registrations was duly published on 13 June 2000, respectively on 21 February 2005, while the disputed domain name was registered by the Respondent on 26 December 2013;
• The Complainant is holder of a number of domains, which have been registered before 1 August 2006, namely isabelmarant.com (20 April 2002), isabel-marant.com (20 November 2002), isabelmarant.tm.fr (19 June 2001), isabelmarant.fr (03 June 2004), and isabel-

marant.fr (03 June 2004).

The disputed domain name isabelmarant-outlet.eu differs from the Complainant's registered trademarks in the following way: the words ‘isabel’ and ‘marant’ are written together and the word ‘outlet’ is added to them. The word ‘outlet’ which has become popular with the meaning of ‘a shop that sells goods made by a particular manufacturer at discounted prices’ (see Oxford Dictionaries at http://www.oxforddictionaries.com/definition/english/outlet) does not sufficiently alter the trademark to avoid the confusingly similar aspects of the Respondent’s domain name. The Panel refers to ADR Case No. 05546 - alkostore.eu: ‘Adding a generic and non-distinctive element to a protected name does not remove or indeed even lessen the confusing similarity between the disputed domain name and the Complainant’s registered rights, but rather informs the internet user that the website where the disputed domain name points is a place where the products […] are for sale’.

Aside from the suffixes .eu, .fr, .com, etc., the domain names of the Complainant are confusingly similar with the disputed domain name. However, the suffixes indicating TLD are irrelevant when comparing trademarks and domain names.

To this end, given the highly related nature between the goods offered on the disputed domain name and the goods offered by the Complainant through its trademarks and on its own websites, the Panel finds that the domain name isabelmarant-outlet.eu is both confusingly similar to the registered trademarks in which the Complainant has rights and confusingly similar to the domain names registered by the Complainant.

In addition, the registered trademarks and domain names invoked by the Complainant are much earlier than the domain name isabelmarant-outlet.eu registered by the Respondent.

The Panel considers that the disputed domain name may well cause association with the Complainant’s trademarks because of the identity of the words ‘ISABEL’ and ‘MARANT’, although put together in the domain name. The disputed domain name is thus, in the Panel's view, confusingly similar to the trademarks and domains in which the Complainant holds registered rights, and in this respect the first requirement of Article 21(1) of Regulation 874/2004 is satisfied.

Under such circumstances, it is the Panel’s opinion that registration of the domain name isabelmarant-outlet.eu by an unauthorized third party, requires justification based on established rights or other legitimate interests on the part of the Respondent. If there is no such justification, the domain name must be considered speculative or abusive, pursuant to Article 21(1)(a) of Regulation 874/2004.

2. Respondent’s rights or legitimate interest in the disputed domain name

The Panel then turns to the question of whether the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name.

Article 21(2) of Regulation 874/2004 and paragraph B11(e) of the ADR Rules provide non-exhaustive examples of how a Respondent might demonstrate a legitimate interest. These may be summarized as where (a) prior to any notice of the dispute, the Respondent has used (or made demonstrable preparations to use) the domain name in connection with the offering of goods and services; (b) the Respondent has been commonly known by the domain name; or (c) the Respondent is making a legitimate and non-commercial or fair use of the domain name without intent to mislead consumers or harm the reputation of a name in which a right is recognised or established by national law and/or Community law.

There is no evidence on the record which indicates that Respondent might be able to satisfy any of these requirements. The arguments of the Complainant should be substantiated by the Panel.

In this specific case, the Respondent does not indicate his economic activity, or if indeed he has any economic activity. More importantly, the Respondent does not invoke any prior rights or other legitimate interest which could justify the requested registration in his favour of the domain name isabelmarant-outlet.eu.

Firstly, the Respondent did not provide any evidence that it had trademark rights nor license to use the Complainant’s trademarks.

Secondly, the Respondent did not present any proofs that being a natural person it had ever been commonly known by the name ‘Isabel Marant’.

On the next place, there is no evidence that the Respondent was authorized by the Complainant, to register a domain name similar to the Complainant’s trademarks or the patronymic name ISABEL MARANT. On the contrary, according to the Complainant’s allegations, the

Respondent has been granted no license or other rights to use the Complainant's trademarks as part of any domain name or for any other purpose.

On the surface, it appears that the Respondent has used the domain names in dispute in connection with an offering of goods or services prior to any notice of the current ADR Proceeding. However, Complainant avers that Respondent's use of the domain names at dispute cannot give rise to legitimate interests as the Respondent is clearly attempting to pass itself off as Complainant in order to increase the sales of its counterfeit goods. The Panel finds that the Respondent is not making a legitimate non-commercial or fair use of the domain name at issue. As a matter of fact, the Respondent does not use the domain name in connection with a bona fide offering of goods or services. The Complainant states that considering their low price these goods are counterfeit and not genuine products, and these allegations have not been contested by the Respondent.

Further, the Respondent did not prove to have conducted legitimate offline business under the name isabelmarant-outlet.eu. The Respondent is not making a legitimate and non-commercial or fair use of the disputed domain name.

Finally, there is no evidence for non-commercial or fair use of the domain name by the Respondent without the intention to mislead consumers or to harm the reputation of the Complainant.

As it is impossible for the Complainant to prove negative facts because some required information is only within the knowledge of the Respondent, the Complainant is only able to make a prima facie case that the Respondent lacks rights and legitimate interest in the disputed domain name. The burden of proof shifts to the Respondent then and if the latter fails to show evidence of rights or legitimate interest it is deemed to have none. Considering that the Respondent has failed to submit a Response to the Complaint in due course, it has failed to rebut that demonstration, raising none of the issues referred to in paragraph B11(e) of the ADR Rules, and putting forward no other reasons substantial enough to convince the Panel of its rights or legitimate interest in the disputed domain name.

Thus the Panel cannot conceive of any potential explanation that might confer a right or legitimate interest upon the Respondent in the disputed domain names, whether in terms of the non-exhaustive examples in Article 21(2) of Regulation 874/2004 and paragraph B11(e) of the ADR Rules or otherwise. Consequently, the Panel finds that the Respondent registered the disputed domain name without rights or legitimate interest.

3. Registered or used in bad faith

In this case the Panel has found that the Respondent has no rights or legitimate interest in the disputed domain name under paragraph B11(d)(1)(ii) of the ADR Rules, thus satisfying the conditions to issue a decision granting the remedy requested. However the Panel will go on to consider the question of registration or use of the disputed domain name in bad faith for the sake of completeness. This is expressed in Article 21(1)(b) of Regulation 874/2004 and paragraph B11(d)(iii) of the ADR Rules as a further alternative to a lack of rights or legitimate interest which may be proved by the Complainant. Article 21(3)(a) to (e) of Regulation 874/2004 and the corresponding paragraph B11(f)(1) to (5) of the ADR Rules provide non-exhaustive examples which may be evidence of bad faith registration or use.

The Complainant states that the domain name isabelmarant-outlet.eu is directed to the web site http://uk.isabelmarant-outlet.eu used for selling Isabel Marant's products that the Complainant has identified as counterfeit. In Complainant's view the Respondent offers counterfeit goods with a very low (discount) price whereas some of these goods correspond to the collections 2012, 2013 and 2014 and are sold by the Complainant and/or its distributors at a retail price which is much higher. According to the Complainant such offers demonstrate that the goods offered on the litigious web site are not genuine products.

The Complainant also contends that the Respondent used the domain name to encourage consumers to believe him to be connected to the official web site of the Complainant whereas only goods infringing Complainant's trademarks are sold. In Complainant's view the above shows that the Respondent deliberately registered and used the disputed domain name to attract Internet users to its website for financial gain, by creating confusion with the Complainant's mark knowing that is not an authorized retailer and has no relationship with the Complainant.

In the Panel's view, the use of a domain name consisting of the combination of a distinctive trademark in fashion with the term 'outlet' clearly demonstrates that the Respondent is using the domain name to attract Internet users for commercial gain to the Respondent's website by creating a likelihood of confusion with the Complainant's mark. The use of the domain name can only lead to confusion, divert customers, and dilute the Complainant's goodwill in the trademark ISABEL MARANT. The way the goods are displayed and offered for sale on the website corresponding to the disputed domain name, the fact that these goods are sold for very low prices compared to their current value, the fact that some of these goods are qualified by the Complainant as being counterfeit (which allegations have not

been contested by the Respondent), are such as to dilute the value and goodwill of the Complainant's trademarks (see also ADR Case No. 100419 - alaiashoes.com, and Case No. 100331 - eccoshoesoutlet.org, which established that the Respondent used the domain name for offering counterfeited fashion products is evidence of its bad faith). The very fact that the websites were designed to mislead consumers and Internet users alike is indicative of Respondent's bad faith.

In addition, the Panel checked the list with domains registered by the Complainant and it was verified that the company owned the following domain names at the time of registration of the disputed domain name:
• isabelmarant.com,
• isabel-marant.com,
• isabelmarant.tm.fr,
• isabelmarant.fr, and
• isabel-marant.fr.

All visitors of the aforementioned domains are redirected to the site isabelmarant.com and this fact could have been easily established by the Respondent at the time of the registration.

From the evidence made available to the Panel and in the absence of any Response from the Respondent the Panel is further convinced that Respondent has registered the domain name in bad faith. Given the distinctive character of Complainant's 'ISABEL MARANT' trademarks, as well as the Complainant's use of a number of identical domain names, including the most popular gTLD - .com, .fr, etc., it is practically impossible that Respondent coincidentally chose the domain name 'isabelmarant-outlet' without reference to Complainant's marks and domains. In addition, the name of the Complainant's Manager and Designer has been recognized by the fashion industry for more than 20 years, as evident from the article in THE INDEPENDENT dated October 21, 1991, submitted as Annex No. 1 to the Complaint. The Respondent must have been necessarily aware of the adverse impact to the distinctive trademarks and domain names of the Complainant at the time of registration of the domain name. The choice of the domain name by the Respondent cannot be a matter of chance. This is of course confirmed by the screen shots offered by the Complainant that appear to show that the domain name was linked to a website pretending to sell Isabel Marant's merchandise without any proved legitimate right to do so.

The Respondent has not rebutted the substantiated allegations put forward by the Complainant. The Panel finds that it is unlikely that the contested domain names have been registered without prior knowledge of Complainant's rights and further finds that the registration of the domain name is obviously made for financial gain, by creating confusion with the Complainant's marks.

Therefore, the Panel finds bad faith proven on the grounds that, on the balance of probabilities, in the terms of paragraph B11(f)(4) of the ADR Rules, the circumstances indicate that the domain name was registered primarily for the purpose of attracting customers to the website uk.isabelmarant-outlet.eu for Respondent's own commercial gain.

4. Eligibility of the Complainant for transfer of the disputed domain name

The Complainant has requested the transfer of the disputed domain name. According to Article 22(11) of Regulation 874/2004, the Panel shall, in the case of a procedure against a domain name holder, decide that the domain name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21) of Regulation 874/2004. Furthermore, the domain name shall be transferred to the Complainant if the Complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation 733/2002.

To satisfy those general eligibility criteria the Complainant must be one of the following:
- an undertaking having its registered office, central administration or principal place of business within the European Community; or
- an organisation established within the European Community without prejudice to the application of national law; or
- a natural person resident within the European Community.

The Complainant is an undertaking having its principal place of business in Paris, France, as shown in Annex No. 3 to the Complaint, it is owner of trademark registrations over the disputed sign, therefore, it is entitled to claim transfer of the domain name 'isabelmarant-outlet.eu'.

In view of the above the Panel considers that the requirements for the requested transfer of the domain name to the Complainant are satisfied.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name

ISABELMARANT-OUTLET be transferred to the Complainant.

PANELISTS

Name	**Dimitrov, Petrov & Co., Prof. Dr. George Dimitrov**

DATE OF PANEL DECISION 2015-03-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: ISABELMARANT-OUTLET

II. Country of the Complainant: France, country of the Respondent: The Netherlands

III. Date of registration of the domain name: 26 December 2013

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. Word CTM reg. No. 001035534, for the term ISABEL MARANT, filed on 23 December 1998, registered on 13 June 2000 in respect of goods and services in classes 03, 14 and 25
2. Word CTM reg. No. 003010048, for the term ISABEL MARANT, filed on 08 January 2003, registered on 21 February 2005 in respect of goods and services in classes 09, 18, 21 and 24

V. Response submitted: No

VI. Domain name is confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: the Respondent is not generally known by the disputed domain name, nor has acquired any trademark rights in the ISABEL MARANT mark; the Respondent is using without authorization a domain name consisting of the combination of the word ‘outlet’ and a trademark for similar / identical goods some of which are qualified by the Complainant as counterfeit. Thus, the Respondent is not making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: the Respondent knew or should have known the existence of prior trademark rights belonging to third parties at the time of the registration of the domain name. The Respondent is using the domain name to attract Internet users for commercial gain, to the Respondent's website by creating a likelihood of confusion with the Complainant's marks.

IX. Other substantial facts the Panel considers relevant: No

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: No

XII. Is Complainant eligible? Yes