Panel Decision for dispute CAC-ADREU-007325

Case number	CAC-ADREU-007325
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Domain names	isabel-marant-fr.eu

Case administrator

	Aneta Jelenová (Case admin)

Complainant

Organization	IM PRODUCTION

Respondent

Name	SEEOR KAROLIN

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 pending or decided legal proceedings relating to the Disputed domain name.

FACTUAL BACKGROUND

The Complainant, IM PRODUCTION, is a French company that owns and uses the trade mark ISABEL MARANT for shoes, garments, and jewelry. The trade mark ISABEL MARANT has been used since 1991 for the creation, manufacturing and sale of garments and fashion accessories. Isabel Marant is also the name of the designer who manages indirectly the company IM PRODUCTION.
Currently, products bearing the trade mark ISABEL MARANT are distributed all over the world and notably in Europe, USA, and China.

The Complainant's trade mark ISABEL MARANT has been registered, among others, as EU trade mark n° 001 035 534 on 3 May 2000, designating, among others, class 25 of the Nice classification. The relevant trade mark application was filed on 23 December 1998, having as date of priority the 25 June 1998.

The Complainant is also owner of several domain names, notably the domain names isabelmarant.com, isabel-marant.com, isabelmarant.tm.fr, isabelmarant.fr, and isabel-marant.fr.

In CAC case No 06877, as well as in a significant number of WIPO UDRP cases, the trade mark ISABEL MARANT was involved (see, for example, WIPO UDRP cases D2016-2097, D2016-1542, D2016-1133, D2016-0770, D2015-1817, D2015-0753, D2015-0143, D2015-0141, D2014-1582, and D2014-1574).

The Disputed domain name was registered by the Respondent on 13 July 2016 and it is used for a website which shows the ISABEL MARANT trade mark and the offer for sale of what appears to be ISABEL MARANT footwear at discounted prices.

A. COMPLAINANT

The Complainant contends that the Disputed domain name is confusingly similar to its prior rights, notably its trade marks, its domain names and to Ms Marant's first name and patronymic name.

The Complainant alleges that the Disputed domain name <isabel-marant-fr.eu> combines the words ISABEL and MARANT, protected by the above-mentioned prior rights, with the word FR, which is internationally known as the country code for France, which is country where the Complainant is based. Consequently, the general public would associate the Disputed domain name with the genuine products sold under the trade mark ISABEL MARANT.

The Complainant submits that the Disputed domain name was registered by the Respondent without any rights or legitimate interests in

the name.

The Complainant points out that the Respondent was never authorized by the Complainant to register a domain name phonetically identical and confusingly similar to the trade mark and to the first name and patronymic name ISABEL MARANT. The Complainant adds that the Respondent is not commonly known by the Disputed domain name and that, as far as the Complainant knows, the Respondent has never conducted legitimate offline businesses under the name <isabel-marant-fr.eu>. Furthermore, the Complainant notes that the Respondent registered the Disputed domain name well after the Complainant had established its above-mentioned rights.

The Complainant underlines that the Respondent has been granted no licence or other rights to use its trade marks as part of any domain name or for any other purpose. The Complainant points out that it is in no way associated or affiliated with the Respondent.

The Complainant takes the view that the Respondent is not making a legitimate non-commercial or fair use of the Disputed domain name. The Complainant observes that the Respondent is using the Disputed domain name and the related website for misleadingly attracting customers for its own commercial gain. In particular, on that website the Respondent sells at very low prices ISABEL MARANT products that the Complainant has identified as counterfeited articles.

In light of the above, the Complainant requests the Panel to order the transfer in its favour of the Disputed domain name.

B. RESPONDENT

The Respondent did not file a response.

DISCUSSION AND FINDINGS

In accordance with Article 21 (1) of the Commission Regulation (EC) No 874/2004 (as well as, in substance, paragraph B11 of the ADR Rules), the Complainant, in order to succeed, is required to prove that the Disputed domain name:

(a) 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); and

(b) has been registered by its holder without rights or legitimate interest in the name; or

(c) has been registered or is being used in bad faith.

With reference to the terms “Community law” used at point (a) above, it is worth mentioning that, as a consequence of the fact that the European Union replaced and succeeded the European Community at the entry into force of the Lisbon Treaty on 1st December 2009, the reference to Community law should be regarded as reference to European Union law. Moreover, it should be borne in mind that the community trade marks mentioned in Article 10(1) of the Commission Regulation (EC) No 874/2004, as well as, indirectly, by Article 21(1)(a) of Commission Regulation No 874/2004, have been replaced by the European Union trade marks (see Article 1 of Regulation No 2424/2015 of the European Parliament and of the Council).

The Panel finds that the Disputed domain name <isabel-marant-fr.eu> is confusingly similar to the trade mark ISABEL MARANT, from which it differs only in the addition of the word FR, which is the country code for France (i.e. the country where the Complainant is based). Adding a country code to the domain name does not prevent it from being confusingly similar to the above-mentioned trade mark (see CAC case No. 06643).

It is well established that the TLD “.eu” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar pursuant to Article 21 (1) of Commission Regulation No 874/2004 (see, among others, CAC cases No. 00227, 00387, 00596, 06303, and 6452).

Moreover, the fact that the words are separated by hyphens is not relevant (see, among others, CAC cases No. 4928 and 6901).

In the light of the above considerations, the Panel finds that the Complainant has a right established by the European Union law in the name ISABEL MARANT, registered as European Union trade mark n° 001 035 534.

Consequently, the condition in Article 21(1)(a) of the Commission Regulation No 874/2004 is satisfied. Therefore, it is not necessary to examine the other prior rights invoked by the Complainant.

The Complainant alleges that the Disputed domain name has been registered without any legitimate interest in the name since the Respondent has no affiliation to the Complainant nor any business with the ISABEL MARANT name.

No response or other communication was received from the Respondent in respect of the complaint.

The Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed domain name because there is no evidence of bona fide use of an equivalent mark by the Respondent and the Complainant has never authorised the use of, or licensed the use of, the Disputed domain name, by or to the Respondent.

The Panel accepts the arguments of the Complainant with respect of missing rights and legitimate interests of the Respondent in the Disputed domain name. According to article 22 (10) of the Commission Regulation No 874/2004 and paragraph B 10 of ADR Rules, the Panel bases its decision on this prima facie case.

The Complainant alleges that the Disputed domain name has been registered and used in bad faith, with the aim of attracting Internet users to the Respondent's website for financial gain, by creating a confusion with the Complainant’s trade mark.

The Panel is satisfied that the Disputed domain name has been registered and used in bad faith.

The Disputed domain name was clearly registered with the Complainant very much in mind. Not only it contains the Complainant's trade mark together with the country code of the country of its establishment, but it also has been used for a website which plainly has been set out to impersonate the Complainant and to divert traffic to a website where products identified by the Complainant as counterfeit are sold.

Accordingly, the Disputed domain name has been intentionally registered and used to create a likelihood of confusion in accordance with Article 21(3)(d) of Commission Regulation No 874/2004.

The Complainant has requested the transfer of the Disputed domain name and has satisfied the eligibility criteria in Article 4(2)(b) of Regulation No 733/2002 since it is an undertaking having its registered office within the European Union. It is therefore appropriate to order the transfer of the Disputed domain name to the Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraph B12 (b) of the Rules, the Panel orders that

the Disputed domain name <ISABEL-MARANT-FR.EU> be transferred to the Complainant.

This decision shall be implemented by the Registry within thirty days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a mutual jurisdiction.

PANELISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2017-01-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <isabel-marant-fr.eu>

II. Country of the Complainant: France, country of the Respondent: Germany

III. Date of registration of the domain name: 13 July 2016

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision: word European Union trade mark, reg. No. 001 035 534, for the terms ISABEL MARANT, filed on 23 December 1998, registered on 3 May 2000 in respect of goods and services in classes 3, 14 and 25

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right of the Complainant: Yes

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: The Complaint has made a prima facie case that the Respondent has no rights or legitimate interest in the Disputed domain name and the Respondent, by not submitting a Response, has failed to rebut the Complainant’s contentions.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The Disputed domain name has been intentionally registered and used to attract Internet users for commercial gain to the Respondent's website by creating a likelihood of confusion with the Complainant's trade mark ISABEL MARANT as to the source, sponsorship, affiliation or endorsement of the website (Art. 21(3)(d) of Regulation No 874/2004).

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Transfer of the Disputed domain name

XI. Procedural factors the Panel considers relevant: None

XII. Is Complainant eligible? Yes