

## **ADMINISTRATIVE PANEL DECISION**

**AMI PARIS v. Privacy service provided by Withheld for Privacy ehf / name one, namexone; name lxx; name shop; GLOBAL DIRECT, GLOBAL DIRECT SERVICES PTE. LTD.**

**Case No. D2022-2936**

### **1. The Parties**

The Complainant is AMI PARIS, France, represented by IP Twins, France.

The Respondents are Privacy service provided by Withheld for Privacy ehf, Iceland / name one, namexone, United States of America (“United States”); name lxx, United States; name shop, United States; GLOBAL DIRECT, GLOBAL DIRECT SERVICES PTE. LTD, Singapore.

### **2. The Domain Names and Registrar**

The disputed domain names <amiltd.store>, <amishirts.store>, <amishirt.store>, <amistreetwear.store>, <amisweatshirts.store>, <amitee.store>, and <amiweb.store> are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 9, 2022. On August 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amended Complaint and consolidation arguments. The Complainant filed an amended Complaint on August 16, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents of the Complaint, and the proceedings commenced on August 18, 2022. In accordance with the Rules, paragraph

5, the due date for Response was September 7, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on September 9, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on September 14, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

The Panel has not received any requests from the Complainant or the Respondents regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to the Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a response from the Respondents.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

The Complainant is AMI PARIS, a French company created by the fashion designer Alexandre Mattiussi, operating in the fashion field and owning several trademark registrations for AMI, among which:

- International Trademark Registration No. 1418777 for AMI ALEXANDRE MATTIUSSI and design, registered on May 31, 2018;

- International Trademark Registration No. 1507316 for AMI PARIS, registered on October 4, 2019.

The Complainant operates on the Internet with several domain names including the trademark AMI, among which <ami-paris.com>, <amiparis.com>, <amialexandremattiussi.com>, <ami-alexandremattiussi.fr>.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain names were registered on the following dates: <amiltd.store> and <amiweb.store> on May 19, 2022; <amishirts.store>, <amishirt.store>, <amistreetwear.store>, <amisweatshirts.store> and <amitee.store> on May 30, 2022. When the Complaint was filed, the disputed domain names were all resolving to identical websites in which the Complainant's trademark was reproduced and the Complainant's products were offered for sale, while presently they all redirect to inactive websites.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain names are confusingly similar to its trademark AMI, as the disputed domain names fully incorporate the Complainant's trademark, with the addition of the generic terms "ltd", "shirt", "shirts", "streetwear", "sweatshirts", "tee", and "web".

Further to section 6.1 below, the Complainant argues that the disputed domain names are under common control and thus addresses the Respondents in the singular. The Complainant asserts that the Respondent

has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names, it is not commonly known by the disputed domain names, and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names: the disputed domain names are all resolving to the same website in which the Complainant's trademark is reproduced and the Complainant's products are offered for sale.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant's trademark AMI is distinctive and well-known in the fashion field. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names with the purpose to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark, qualifies as bad faith registration and use.

## **B. Respondent**

The Respondents have made no reply to the Complainant's contentions and are in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn (see, e.g., *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. [D2000-0441](#); *Microsoft Corporation v. Freak Films Oy*, WIPO Case No. [D2003-0109](#); *SSL International PLC v. Mark Freeman*, WIPO Case No. [D2000-1080](#); *Altavista Company v. Grandtotal Finances Limited et. al.*, WIPO Case No. [D2000-0848](#); and *Confédération Nationale du Crédit Mutuel, Caisse Fédérale du Crédit Mutuel Nord Europe v. Marketing Total S.A.*, WIPO Case No. [D2007-0288](#)).

## **6. Discussion and Findings**

### **6.1 Consolidation of Multiple Respondents**

The Complainant has requested consolidation of multiple respondents and stated that the disputed domain names belong to the same person or organization. No objection to this request was made by the Respondents.

Pursuant to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") section 4.11.2, "[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario". The Panel may consider a range of factors to determine whether consolidation is appropriate, such as examining relevant registrant contact information, and any naming patterns in the disputed domain names, or other evidence of respondent affiliation that indicate common control of the disputed domain names.

The Panel notes that the disputed domain names follow the same naming pattern, are all registered with the same Registrar, and were all resolving to identical websites, in which the Complainant's trademark was reproduced and the Complainant's products were offered for sale. Moreover, the use of the disputed domain names remains seemingly coordinated, seeing as the disputed domain names no longer resolve to active websites. The Panel finds that there is evidence that the disputed domain names are subject to common control, and that it would be procedurally efficient, fair and equitable to all Parties to accept the Complainant's consolidation request. The Panel further notes that the Respondents did not object to the consolidation request. The Panel therefore accepts the Complainant's consolidation request. Hereinafter, the Panel will refer to the Respondents in the singular, *i.e.*, "the Respondent".

## 6.2 Substantive Issues

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark AMI and that the disputed domain names are confusingly similar to the trademark AMI.

Regarding the addition of the terms “ltd”, “shirt”, “shirts”, “streetwear”, “sweatshirts”, “tee”, and “web”, the Panel notes that it is now well established that the addition of terms or letters to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark (see, e.g., *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. [D2005-0037](#); *Red Bull GmbH v. Chai Larbthanasub*, WIPO Case No. [D2003-0709](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)). The addition of the terms “ltd”, “shirt”, “shirts”, “streetwear”, “sweatshirts”, “tee”, and “web” does not therefore prevent the disputed domain names from being confusingly similar to the Complainant’s trademark. See [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic Top-Level Domain (“gTLD”), in this case “.store”, is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant’s trademark, pursuant to the Policy, paragraph 4(a)(i).

### B. Rights or Legitimate Interests

The Respondent has failed to file a response in accordance with the Rules, paragraph 5.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not using the disputed domain names for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services, but instead the disputed domain names resolve to the same website, in which the Complainant’s trademark is reproduced and the Complainant’s products are offered for sale.

According to the [WIPO Overview 3.0](#), section 2.13:

“2.13.1 Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent [...].”

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain names. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain names, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

Should the Complainant's products sold on the website to which the disputed domain names are directing Internet users be genuine products, legitimately acquired by the Respondent, the question that would arise is whether the Respondent would therefore have a legitimate interest in using the disputed domain names that are confusingly similar to the Complainant's trademark in circumstances that are likely to give rise to confusion.

According to the current state of UDRP decisions in relation to the issue of resellers as summarized in the [WIPO Overview 3.0](#), section 2.8.1:

"[...] resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark."

This summary is based on the UDRP decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Even if the products sold by the Respondent were the Complainant's genuine products, from inspection of the Respondent's website, the Panel finds that the use of the Complainant's trademark and the lack of any disclaimer would not make, under the Oki Data principles (see above), a *bona fide* offering of goods and services and thus a legitimate interest of the Respondent in the disputed domain names.

The Panel therefore concludes that the disputed domain names are not being used in connection with a *bona fide* offering of goods or services.

Moreover, the Panel finds that the composition of the disputed domain names carries a risk of implied affiliation as they effectively impersonate or suggest sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Based on the facts of this case, the Panel finds that paragraph 4(a)(ii) of the Policy has been satisfied.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that "for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) that [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) that [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location".

Regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademark AMI in the fashion field is clearly established and, given the composition of the disputed domain names and their use in the relevant identical website, the Panel finds that the Respondent obviously knew of the Complainant and deliberately registered the disputed domain names.

The Panel further notes that the disputed domain names are also being used in bad faith since the Respondent is trying to attract Internet users to its website by creating likelihood of confusion with the Complainant's trademark in order to allegedly sell the same products as the Complainant's, an activity clearly detrimental to the Complainant's business.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain names in order both to disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

Furthermore, the Panel considers that the nature of the disputed domain names, which are almost identical to the Complainant's trademark with the mere addition of the terms "ltd", "shirt", "shirts", "streetwear", "sweatshirts", "tee", "web", and the gTLD ".store" further supports a finding of bad faith and intent to confuse users about a non-existent affiliation trading off of the Complainant's reputation and goodwill. See [WIPO Overview 3.0](#), section 3.2.1.

Given the totality of the circumstances, the current passive holding of the disputed domain names does not prevent a finding of bad faith. See section 3.3. of the [WIPO Overview 3.0](#).

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <amiltd.store>, <amishirts.store>, <amishirt.store>, <amistreetwear.store>, <amisweatshirts.store>, <amitee.store>, and <amiweb.store> be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: September 16, 2022