

ADMINISTRATIVE PANEL DECISION

Joseph Nakam and Karine v. Brigitte Bellamy
Case No. D2023-0672

1. The Parties

The Complainants are Joseph Nakam, France, and Karine, France, represented by Shanghai Da Wo Law Firm, China.

The Respondent is Brigitte Bellamy, France.

2. The Domain Name and Registrar

The Disputed Domain Name <jonakmode-fr.shop> is registered with Dynadot Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2023. On February 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 16, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainants on February 20, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on February 21, 2023.

On February 27, 2023, the representative of the Complainants requested the remedy in the Complaint to be changed to the transfer of the Disputed Domain Name to the Complainants.

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 Respondent of the Complaint, and the proceedings commenced on February 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 20, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on March 24, 2023. 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.

4. Factual Background

The Complainants are a French incorporated footwear company and its CEO and founder. The company is selling footwear products online using the trademarks owned by its CEO.

The CEO is the owner of two trademarks consisting of the word “jonak” (hereinafter the “JONAK Trademarks”):

- the French Trademark JONAK No. 1389329 registered on January 15, 1987, for products and services in classes 18 and 25;
- the United States Trademark JONAK No. 5466684, registered on May 15, 2018, for products and services in classes 18 and 25.

The Disputed Domain Name was registered on September 2, 2022, and at the time of the Complaint used to resolve to an e-commerce website selling footwear products. At the time of the Decision, the Disputed Domain Name is inactive.

5. Parties' Contentions

A. Complainants

First of all, the Complainants assert that the Disputed Domain Name is confusingly similar to their earlier JONAK Trademarks, since it incorporates them wholly.

Secondly, the Complainants submit that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, since the Respondent has registered the Disputed Domain Name without authorization. The Complainants contend that the Respondent is using the Disputed Domain Name to sell counterfeit footwear products and that the website linked to the Disputed Domain Name uses pictures of the Complainants' official website. The Complainants stand that the Disputed Domain Name, and the website it resolves to, are infringing on its copyrights and trick consumers into thinking that the Respondent is associated with the JONAK Trademarks and the Complainants.

Finally, the Complainants contend that the Disputed Domain Name was registered in bad faith since it incorporates the whole JONAK Trademarks and resolves to a website selling footwear products. The Complainants stand that this is likely to mislead the public to believe that the products sold on the website linked to the Disputed Domain Name originate from the Complainants or that the Respondent is connected with the Complainants. The Complainants finally state that the Disputed Domain Name was registered in order to gain improper commercial gain.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainants shall prove the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (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

According to the Policy, paragraph 4(a)(i), the Complainants shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights.

First of all, the Panel finds that the Complainants has provided evidence that Joseph Nakam, one of the Complainants, has rights in the JONAK Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Regarding the Disputed Domain Name, the Panel finds that it is composed of:

- the JONAK Trademarks;
- the word "mode" which means fashion in English;
- a hyphen;
- the two letters "fr" for France;
- the generic Top-Level Domain ("gTLD") ".shop".

The gTLD in a domain name is viewed as a standard registration requirement and as such is usually disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

According to prior UDRP panel decisions, it is sufficient that the disputed domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of descriptive or geographical terms to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

Regarding the Disputed Domain Name, the Panel finds that it incorporates the JONAK Trademarks in their entirety and considers that the insertion of the word "mode", a hyphen, and the two letters "fr" after the JONAK Trademarks does not prevent a finding of confusing similarity. Therefore, the Panel finds that these elements do not prevent the JONAK Trademarks to be recognizable in the Disputed Domain Name.

Therefore, the Panel holds that the Disputed Domain Name is confusingly similar to the Complainants' trademark and that the Complainants have established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainants shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute to the respondent, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceeding is on the complainant, previous UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* that a respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainants have shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Indeed, it appears that the Respondent has not received any authorization to use the JONAK Trademarks in any manner, including in domain names.

Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. On the contrary, at the time of the Complaint, the Disputed Domain Name resolved to an e-commerce website trying to pass off as the Complainants by repeatedly using the JONAK Trademarks or hinting at an association with the Complainants by selling footwear products similar to those of the Complainants.

In any case, the Respondent did not reply to the Complainants' contentions, and consequently, did not rebut the Complainants' *prima facie* case.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainants have established that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainants shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) 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) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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.

According to prior UDRP decisions, particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion), (ii) the chosen top-level domain (e.g., particularly where corresponding to the complainant's area of business activity or natural zone of expansion), (iii) the content of any website to which the domain name directs, including any changes in such content and the timing thereof [...], (vii) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant (see section 3.2.1 of the [WIPO Overview 3.0](#)).

First of all, the Panel finds that it is established that the Complainants' JONAK Trademarks were registered and used before the registration of the Disputed Domain Name. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name given that it reproduces the Complainants' JONAK Trademarks entirely.

Moreover, the Panel points out that the Disputed Domain Name revolved to an e-commerce website, trying to pass off as the Complainants and selling footwear similar to those of the latter.

Accordingly, the Panel finds that the Complainants have provided evidence that the Disputed Domain Name was registered and used by the Respondent in an attempt to pass off as the Complainants or someone affiliated to the Complainants, for commercial gain.

Finally, the Respondent has not provided any formal response to the Complainants' contentions.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

The current non-use of the Disputed Domain Name does not change the Panel's finding of the Respondent's bad faith.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

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 Name <jonakmode-fr.shop> be transferred to the Complainants.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: April 7, 2023