

ADMINISTRATIVE PANEL DECISION

Les Editions Jalou v. Australian Venture International Traders Pty. Ltd
Case No. DAU2022-0038

1. The Parties

The Complainant is Les Editions Jalou, France, represented by Clifford Chance, LLP, China.

The Respondent is Australian Venture International Traders Pty. Ltd, Australia.

2. The Domain Name and Registrar

The disputed domain name <lofficiel.com.au> (the “Disputed Domain Name”) is registered with Tucows (Australia) Pty Ltd trading as OpenSRS (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2022. On December 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same day, 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 and contact information in the Complaint. The Center sent a further clarification request to the Registrar. On December 12, 2022, the Registrar sent a further clarification correcting the underlying registrant information. The Center sent email communications to the Complainant on December 9, 15, and 19, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed three amended Complaints respectively on December 14, 16, and 19, 2022.

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

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 19, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was January 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 10, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on January 13, 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 Complainant is a corporation incorporated in 1984 under the laws of the France that operates a fashion and lifestyle publication business involving a magazine first published in Paris in 1921, and available in a number of foreign editions. The Complainant holds registrations for the trademark L'OFFICIEL and variations of it in numerous countries, including the United States Reg. No. 1238267, for the trademark L'OFFICIEL DE LA COUTURE ET DE LA MODE DE PARIS registered on May 17, 1983, featuring the word "L'OFFICIEL" in significantly larger font than the words "DE LA COUTURE ET DE LA MODE DE PARIS". The English translation of the French words "l'officiel de la couture et de la mode de Paris" appearing in the trademark is "the official gazette of Paris couture and fashion". The Complainant holds the European Union Reg. No. 018453442, for the trademark L'OFFICIEL registered on August 26, 2021, covering goods and services that include magazines and the publication of magazines.

The Complainant is also the owner of the domain name <lofficiel.com>, which resolves to its main website.

The Complainant has provided the evidence that the Disputed Domain Name resolves to a website containing artwork of magazines that resemble those published by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations of the trademark L'OFFICIEL in various countries, including the European Union and United States, as *prima facie* evidence of ownership.

The Complainant submits that the mark L'OFFICIEL is distinctive and that its rights in that mark predate the registration of the Disputed Domain Name <lofficiel.com.au>. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the L'OFFICIEL trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the Respondent has no trademark rights in, or license to use, the L'OFFICIEL mark, and is no longer a registered legal entity that can hold any rights or legitimate interests. The Complainant contends that "[t]here are no legitimate reasons for the Respondent to have chosen the same letter composition with identical pronunciation for the [Disputed] Domain Name, and to use the 'L'Officiel' mark and logo on the website and the Respondent's Magazine hosted on the [Disputed] Domain Name in identical form and style as the Complainant's 'L'Officiel' marks and logos".

The Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith. On the issue of registration, the Complainant contends that "it is implausible that the Respondent (which either is the operator of the website hosted thereon or the publisher of the Respondent's Magazine or otherwise have allowed the same) have not heard or come across the Magazine and the Complainant's 'L'Officiel' name and mark, especially as the Respondent's Website and the Respondent's Magazine are of the same nature and target the same sector of consumers".

On the issue of use, the Complainant claims that the Respondent operates a website that “By adopting the [Disputed] Domain Name that is identical or closely similar to that of the Complainant’s registered mark, it is clear that the Respondent had sought to deceive consumers into believing that it is associated with a 100-year-old iconic French fashion and lifestyle magazine”.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

A. Identical or Confusingly Similar

The Complainant must first establish is that the Disputed Domain Name is identical with, or confusingly similar to, the Complainant’s name, trademark or service mark by demonstrating that it has rights in a trademark at the date the Complaint was filed and, if that is the case, the Disputed Domain Name must also be identical or confusingly similar to the trademark.

This Panel finds that the Complainant has rights in the L’OFFICIEL trademark acquired through use since 1921, and subsequent registration.

The Panel also finds that the Disputed Domain Name, which contains the L’OFFICIEL in its entirety, is identical to the L’OFFICIEL trademark.

In considering the element of paragraph 4(a)(i) of the Policy, the contents of a website are typically not relevant, albeit relevant for the assessment of the second and third elements. In *The Crown in Right of the State of Tasmania trading as “Tourism Tasmania” v. Gordon James Craven*, WIPO Case No. [DAU2003-0001](#), the panel held that: “the test of confusing similarity under the Policy is confined to a comparison of the disputed domain name and the name or trademark alone, independent of the other marketing and use factors usually considered in trademark infringement or unfair competition cases.”

Accordingly, the Panel finds that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Disputed Domain Name. Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the Disputed Domain Name:

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

The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the L'OFFICIEL trademark.

The Panel finds on the record that there is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name, and the burden is thus on the Respondent to produce evidence to rebut this presumption, see: *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

The Respondent has failed to submit a Response and so has not shown that it has acquired any trademark rights in respect of the Disputed Domain Name or that the Disputed Domain Name is used in connection with a *bona fide* offering of goods or services. To the contrary, this Panel accepts the Complainant's uncontested submission, supported by evidence, that the Respondent's "use [of] the 'L'Officiel' mark and logo on the website and the Respondent's Magazine hosted on the [Disputed] Domain Name in identical form and style as the Complainant's 'L'Officiel' marks and logos" does not amount to a *bona fide* offering of goods or services under the Policy.

There has been no evidence adduced to show that the Respondent has been commonly known by the Disputed Domain Name, nor does any of the evidence demonstrate that the Respondent is making legitimate noncommercial or fair use of the Disputed Domain Name.

The Panel therefore finds that the Complaint fulfils the second condition in paragraph 4(a)(ii) of the Policy.

C. Registered or Subsequently Used in Bad Faith

The third element of the Policy that the Complainant must also demonstrate is that the Disputed Domain Name has been registered or subsequently used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both.

The evidence that the Respondent registered and has used the Disputed Domain Name in bad faith is overwhelming. The *onus* is on the Respondent to make the appropriate enquiries. Paragraph 2 of the Policy states: "It is your [domain-name holder's] responsibility to determine whether your domain name registration infringes or violates someone else's rights." The Disputed Domain Name registered by the Respondent, the unlikelihood that registering such Disputed Domain Name identical to the Complainant's word trademark attributable to pure coincidence and the apparent lack of any good faith attempt to ascertain whether or not the Respondent was registering and using someone else's trademarks, such as by conducting trademark searches or search engine searches, supports a finding of bad faith.

The Panel finds that the Respondent must have been aware of the relevant trademark. The Panel finds that the Respondent has taken the Complainant's trademark and incorporated it into the Disputed Domain Name without the Complainant's consent or authorization, for the very purpose of capitalizing on the reputation of the trademarks by diverting Internet users to, what is ostensibly, a website promoting a publication designed to appear as though it was authorized or published by the Complainant. This Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship,

affiliation, or endorsement of that website or of a product or service on that website contrary to paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

For all 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, <lofficiel.com.au>, be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: January 23, 2023