

ADMINISTRATIVE PANEL DECISION

Hachette Filipacchi Presse v. Super Privacy Service LTD
c/o Dynadot / James Don
Case No. D2022-0254

1. The Parties

The Complainant is Hachette Filipacchi Presse, France, represented by Novagraaf France, France.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States of America / James Don, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <elletaiwan.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 26, 2022. On January 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 25, 2022, 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 an email communication to the Complainant on January 27, 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 an amended Complaint on January 27, 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 Respondent of the Complaint, and the proceedings commenced on February 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 21, 2022. The Respondent did not submit any formal response. The Center received various communications from the Respondent’s email address as confirmed by the Registrar on February 7, 2022, and February 22, 2022, of which the Center acknowledged receipt.

Accordingly, the Center notified the Commencement of Panel Appointment to the Parties on February 22, 2022.

The Center appointed Steven A. Maier as the sole panelist in this matter on February 24, 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.

4. Preliminary Considerations (Transfer by Consent)

In its email to the Center dated February 7, 2022, the correspondent from the Respondent's email address stated:

"Hi I will remove the website content and will not renew for this domain."

In the email dated February 22, 2022, the correspondent stated:

"Hi I have replied in 7 February that I have removed all of the content from the website and stop the domain renewal."

It is generally accepted in proceedings under the UDRP that where a respondent gives its consent on the record to the remedy sought by the complainant the panel may order that remedy by consent (see *e.g.* section 4.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

While it appears to the Panel that the Respondent has by the above emails indicated an intention not to contest this administrative proceeding, the Panel is not of the view that the emails amount to the Respondent's unequivocal consent to the remedy requested by the Complainant, namely the transfer of the disputed domain name. The Panel will proceed accordingly to a reasoned Decision.

5. Factual Background

The Complainant is a joint-stock company registered in France. It is the publisher of a fashion magazine named ELLE.

The Complainant is the owner of various registrations for the trademark ELLE, including for example the following:

- International trademark registration number 546813 for a figurative mark ELLE, registered on July 10, 1989 for goods and services in numerous International Classes;
- European Union Trade Mark registration number 003475365 for a figurative mark ELLE, registered on October 11, 2005, for goods and services in numerous International Classes; and
- Taiwanese trademark registration number 00835737 for the word only mark ELLE, registered on January 16, 1999, for goods in International Class 16.

The disputed domain name was registered on April 13, 2021.

The Complainant has submitted evidence that on January 24, 2022, the disputed domain name resolved to a website at "www.elletaiwan.com" which was headed "ELLE Taiwan Gambling Blog" and which offered gambling-related advertising.

6. Parties' Contentions

A. Complainant

The Complainant states that the magazine ELLE was created in France in 1945 and has been published under that name since that date. The Complainant states that the magazine is now published in 45 different editions around the world, including a Taiwanese edition. It also provides evidence that the ELLE mark has been used in connection with products including handbags, luggage and socks. The Complainant claims a readership of its Taiwanese edition of 266,000 persons per month (in 2019) with a Facebook following in connection with that edition of 1,6 million and an Instagram following of over 409,000. The Complainant states that it has used the domain name <elle.com> since 1996, and that its Taiwanese website at "www.elle.com.tw" had more than 4.4 million unique visitors by September 2020.

The Complainant submits that the disputed domain name is confusingly similar to a trademark in which it has rights. It states that the disputed domain name wholly incorporates its ELLE trademark together with the term "taiwan".

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has no connection with the Respondent and has never authorized it to use its ELLE trademark. It further provides evidence of a worldwide trademark search that produced no results for "ELLE" or "ELLE TAIWAN" in the name of the Respondent.

The Complainant submits that the disputed domain name was registered and has been used in bad faith. It contends that the Respondent was obviously aware of the Complainant's well-known trademark at the date it registered the disputed domain name and that such registration would inevitably infringe the Complainant's trademark rights. The Complainant submits that the disputed domain name is clearly being used to attract Internet users to the Respondent's gambling website upon the mistaken assumption that it is owned or operated by the Complainant. The Complainant contends that such use capitalizes on the Complainant's reputation for financial gain and also damages the reputation of the Complainant's trademark. The Complainant also provides evidence of a "cease and desist" letter dated October 12, 2021, with a reminder dated November 2, 2021, to which no response was received.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

7. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has 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

The Complainant has established that it has registered trademark rights for the name and mark ELLE. The disputed domain name wholly incorporates that trademark together with the term "taiwan". The addition

of that term does not prevent the Complainant's trademark from being recognizable within the disputed domain name and the Panel therefore finds that the first element under paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainant's submissions set out above give rise to a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. However, the Respondent has not replied to the Complainant's contentions and has not submitted any explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise. The Panel finds that the disputed domain name has been used to resolve to a website offering gambling services and which reveals no apparent connection with the disputed domain name. Such use by the Respondent does not give rise to rights or legitimate interests in respect of the disputed domain name and the Panel therefore finds that the second element under paragraph 4(a) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The Panel finds the Complainant's ELLE trademark to be distinctive and to be widely known worldwide in connection with the Complainant's fashion magazine. In the absence of any explanation from the Respondent for its choice of the disputed domain name, the Panel infers in the circumstances that the Respondent registered the disputed domain name in the knowledge of the Complainant's trademark and with the intention of taking unfair advantage of the Complainant's reputation and goodwill attaching to that trademark.

The Panel further finds the disputed domain name is inherently misleading and will inevitably suggest to Internet users that it resolves to an official or authorized website legitimately connected with the Complainant and its Taiwanese magazine. The disputed domain name has in fact resolved to a website offering gambling services and the Panel infers that the Respondent intends to derive revenue from Internet users so misdirected to that website and the advertising which it includes. The Panel therefore finds that, by using the disputed domain name, 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 mark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel therefore finds that the third element under paragraph 4(a) of the Policy is satisfied.

8. 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 <elletaiwan.com> be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: March 7, 2022