

## **ADMINISTRATIVE PANEL DECISION**

**Damart v. Privacy Service Provided by Withheld for Privacy ehf / Wallace Keynes, Hildegarde, and Melinda Ulbrecht**  
Case No. D2022-0468

### **1. The Parties**

The Complainant is Damart, France, represented by SafeBrands, France.

The Respondents are Privacy Service Provided by Withheld for Privacy ehf, Iceland / Wallace Keynes, Hildegarde, United States of America ("United States), and Melinda Ulbrecht, United States.

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

The disputed domain names <damartfr.online> and <damartsale.shop> are registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 10, 2022. On February 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 11, 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 February 16, 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 February 21, 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 February 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondent's default on March 21, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on March 25, 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 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 formal 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 Damart, a French company operating in the fashion retail field and owning several trademark registrations for DAMART, among which:

- International Trademark Registration No. 269524 for DAMART, registered on May 17, 1963;
- European Union Trademark Registration No. 004047288 for DAMART, registered on January 9, 2006.

The Complainant operates on the Internet at the main websites "www.damart.fr" and "www.damart.com", as well as with many other generic Top-Level Domains ("gTLDs") and country code Top-Level Domains ("ccTLDs") including the trademark DAMART.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name <damartfr.online> was registered on January 12, 2022, and the disputed domain name <damartsale.shop> was registered on January 17, 2022. They both resolved to websites where the Complainant's trademark and logo were reproduced and purported Complainant's products were offered for sale. According to the Complainant, these products were likely to be counterfeits.

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

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

The Complainant states that the disputed domain names <damartfr.online> and <damartsale.shop> are confusingly similar to its trademark DAMART, as the disputed domain names wholly incorporate the Complainant's trademark with the addition of the terms "fr" and "sale".

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 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 were resolving to websites where the Complainant's trademark and logo were reproduced and supposedly counterfeit products bearing the Complainant's trademark were offered for sale.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant's trademark DAMART is distinctive and 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 of selling supposedly counterfeit goods bearing the Complainant's trademark, by creating a likelihood of confusion with the Complainant's trademark as to the disputed domain names' source, sponsorship, affiliation or endorsement, 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 both 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 both the disputed domain names were resolving to similar if not identical websites and are registered with the same Registrar, with the same privacy provider, and using the same DNS. The Panel finds that there is sufficient 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 names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

## A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark DAMART both by registration and acquired reputation and that the disputed domain names <damartfr.online> and <damartsale.shop> are confusingly similar to the trademark DAMART.

Regarding the addition of the terms “fr” and “sale”, 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 “fr” and “sale” 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 gTLD, in this case “.online” and “.shop”, is ignored when assessing the similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are identical or 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, was 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 in the websites at the disputed domain names supposedly counterfeit goods bearing the Complainant’s trademark were offered for sale.

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.

Should the Complainant’s products sold on the website to which the disputed domain names were redirecting 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.

On the other hand, should the products offered for sale on the websites to which the disputed domain names were redirecting Internet users be counterfeit products, as suspected by the Complainant that would be clear evidence that the Respondent does not have any rights or legitimate interests in the disputed domain names.

In the present case, the Panel is reluctant to accept the allegation of counterfeiting suggested by the Complainant as based only on mere conclusory statements.

According to the UDRP panel decisions in relation to the issue of a respondent default and a complainant’s unsupported allegations as summarized in the [WIPO Overview 3.0](#), paragraph 4.3:

“Noting the burden of proof on the complainant, a respondent’s default (*i.e.*, failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true. In cases involving wholly unsupported and conclusory allegations advanced by the complainant, or where a good faith defense is apparent (*e.g.*, from the content of the website to which a disputed domain name resolves), panels may find that – despite a respondent’s default – a complainant has failed to prove its case.”

The Panel notes the Complainant’s circumstantial claim that the products are offered disproportionately below market-value, a claim that is supported by the evidenced captures of the websites that include the original and discounted prices as well as banners on each website reading “60%” or “70%” off. However, taking into account section 2.13.2 of the [WIPO Overview 3.0](#), the Panel considers that the Complainant’s suspect that the goods sold on the website to which the disputed domain names were redirecting Internet users were counterfeited is not adequately supported.

Nevertheless, even if the products sold by the Respondent were the Complainant’s genuine products, from inspection of the Respondent’s websites, the Panel finds that the use of the Complainant’s trademark and logo and the lack of any disclaimer would falsely suggest to the Internet users, under the *Oki Data* principles (see above), that the websites to which the disputed domain names resolved are owned by the Complainant or at least affiliated to the Complainant.

The Panel therefore concludes that the disputed domain names were 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.

The Panel therefore 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 DAMART in the fashion field is clearly established and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the disputed domain names, especially because the disputed domain names resolved to websites consisting of advertising for the sale of various purported Complainant products, in which the Complainant's trademark and logo were reproduced.

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

The above suggests to the Panel that the Respondent intentionally registered and was 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 websites 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 "fr" and "sale", further supports a finding of bad faith. See, [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and was using the disputed domain names in bad faith.

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 <damartfr.online> and <damartsale.shop> be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: April 1, 2022