

ADMINISTRATIVE PANEL DECISION

Deloitte Société d'Avocats v. Domain Admin, Whoisprotection.cc / Dirk Eichmann

Case No. D2022-0818

1. The Parties

Complainant is Deloitte Société d'Avocats, France, represented by PROMARK, France.

Respondent is Domain Admin, Whoisprotection.cc, Malaysia / Dirk Eichmann, Germany.

2. The Domain Name and Registrar

The disputed domain name <taj-avocat.com> is registered with Web Commerce Communications Limited dba WebNic.cc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 8, 2022. On March 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 10, 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 Complainant on March 18, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 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 Respondent of the Complaint, and the proceedings commenced on March 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2022. Respondent did not submit any response. Accordingly, the Center notified the Parties of Respondent's default on April 29, 2022.

The Center appointed Ingrida Kariņa-Bērziņa as the sole panelist in this matter on May 5, 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. Factual Background

Complainant is a French law firm specialized in tax and legal strategies. Until February 2022, it was known as TAJ and has registered a number of trademarks for its TAJ and TAJ-AVOCATS marks, including the following:

- French trademark No. 3272150 for TAJ-AVOCATS (word mark), registered on February 6, 2004, for services in classes 36, 42 and 45;
- European Union Trade mark No. 003891678 for TAJ (word mark), registered on October 19, 2005, for goods and services in classes 9, 16, 35, 41 and 42.

Complainant has registered several domain names reflecting its marks, such as: <taj-avocats.fr>, <taj-avocats.com> and <taj.fr>.

The disputed domain name was registered on May 10, 2021. It resolves to a French-language website offering fashion clothing for sale. The website header identifies that it is operated by “BALENCIAGA Taj-avocat”.

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that, from 2003 to 2022, it intensively used its TAJ and TAJ-AVOCATS marks for law firm services in France. The law firm is specialized in fiscal and in tax and legal strategies and has 50,000 tax and legal professionals in 150 countries. It has significant revenues and has earned numerous awards for expertise in tax law. Complainant's marks are widely used and known by the public, and the disputed domain name integrates almost entirely Complainant's TAJ-AVOCATS mark, differing only by the lack of the letter “s”.

Under the second element, Complainant states that Respondent has no connection to Complainant and is not permitted to use Complainant's marks. Respondent has no legitimate claim to the title of lawyer, which is a highly regulated profession. In France, the legal profession is incompatible with any commercial activity. The goods offered for sale on Respondent's website are clearly counterfeit and are therefore not authorized as legal commercial activity in France. The French lawyers' directory does not include anyone with the name of Respondent.

Under the third element, Complainant states that Respondent has no interest in using a law firm's trademark to sell fashion products other than to misuse the bond of trust between a lawyer and his client. Respondent's banner demonstrates that Respondent is attempting to give the appearance of a connection with the company Balenciaga. However, the extremely low prices of the goods offered suggest that they are counterfeit. It is very unpleasant for a law firm to be associated with a counterfeiter. Respondent does not reveal his identity on the website.

Complainant requests transfer of the disputed domain name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

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

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

Complainant has provided evidence establishing that it has trademark rights in the TAJ and TAJ-AVOCATS marks through registrations in several jurisdictions. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.2.

In comparing Complainant’s TAJ mark with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to this mark as the trademark is clearly recognizable within the disputed domain name. The Panel also finds that the disputed domain name is confusingly similar to Complainant’s TAJ-AVOCATS mark as it consists of an obvious misspelling of that mark. It is the consensus view of UDRP panels that, in such cases, a domain name is considered to be confusingly similar to the relevant mark for purposes of the first element because complainant’s mark is sufficiently recognizable within the disputed domain name. See [WIPO Overview 3.0](#), section 1.9.

It is the well-established view of UDRP panels that a generic Top-Level Domain (“gTLD”), such as “.com”, is viewed as a standard registration requirement and as such may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

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

B. Rights or Legitimate Interests

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not authorized by Complainant and has no rights in the TAJ or TAJ-AVOCATS marks. The disputed domain name reflects a deliberate misspelling of Complainant’s TAJ-AVOCATS mark. Such use cannot confer rights or legitimate interests.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent has not provided any rebuttal of Complainant’s *prima facie* case and has therefore not proved rights or legitimate interests in the disputed domain name. There is no evidence that Respondent is commonly known by the disputed domain name, or that there are any circumstances or activities that would establish Respondent’s rights therein. The disputed domain name consists of the Complainant’s TAJ mark plus the term “-avocat”. Even where a domain name consists of a trademark plus an additional term, UDRP

panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. In this case, the Panel finds that the disputed domain name carries a risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

Moreover, the disputed domain name resolves to a website featuring Complainant's mark together with the well-known fashion brand Balenciaga for the purpose of offering fashion clothing for sale. Evidence of Respondent's commercial activity using Complainant's mark indicates a lack of rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.3. Finally, Complainant provides evidence that Respondent is offering goods for sale disproportionately below market value (for example, offering sandals with a retail price of EUR 285 for EUR 40). Respondent has not refuted this evidence. The Panel finds that the circumstances indicate illegal activity, which would preclude a finding of rights or legitimate interests on the part of Respondent. See [WIPO Overview 3.0](#), section 2.13.1.

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

C. Registered and Used in Bad Faith

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain name. Complainant provides uncontroverted evidence that its rights in the TAJ and TAJ-AVOCATS marks predate the registration of the disputed domain by nearly 20 years. The disputed domain name is confusingly similar to Complainant's TAJ mark and a deliberate misspelling of Complainant's TAJ-AVOCATS mark. Under such circumstances, UDRP panels have consistently found that the registration of a domain name that is identical or confusingly similar to a distinctive trademark by an unaffiliated entity can by itself create a presumption of bad faith on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4. Respondent has not provided any information that would rebut this presumption.

The evidence provided by Complainant indicates that the disputed domain name resolves to a website through which Respondent references "Taj-avocat," which is nearly identical to Complainant's well-established TAJ-AVOCATS mark, and offers "Balenciaga" clothing for sale. There is no information that would allow the Panel to conclude that Respondent's intent in registering the disputed domain name was for any purpose other than attracting users to his website for commercial gain. The circumstances indicate that Respondent attempted to lend the website an air of legitimacy by referencing the mark of Complainant, an established law firm, both in the disputed domain name and on the website itself. Consistent with well-established UDRP practice, such circumstances indicate bad faith in registration and use of the disputed domain name. See [WIPO Overview 3.0](#), section 3.1.4. See also, for example, *Swarovski Aktiengesellschaft v. WhoisGuard Protected / Peter D. Person*, WIPO Case No. [D2014-1447](#), *Booking.com BV v. Chen Guo Long*, WIPO Case No. [D2017-0311](#).

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) of the Policy.

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 <taj-avocat.com> be transferred to Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: May 19, 2022