

ADMINISTRATIVE PANEL DECISION

Magellan v. Whois Agent, Domain Protection Services, Inc / Efdt Wfdhgf
Case No. D2022-0839

1. The Parties

The Complainant is Magellan, France, represented by Inlex IP Expertise, France.

The Respondent is Whois Agent, Domain Protection Services, Inc, United States of America / Efdt Wfdhgf, China.

2. The Domain Name and Registrar

The disputed domain name <bonobomode.com> is registered with Name.com, Inc. (Name.com LLC) (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 10, 2022. On March 10, 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 the Complainant on March 11, 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 March 15, 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 March 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 5, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 6, 2022.

The Center appointed Geert Glas as the sole panelist in this matter on April 11, 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

The Complainant, Magellan, is a French company who sells clothing for men and women under the BONOBO brand. It has a web-shop and its clothes are sold in some 400 physical stores, the latter of which are widely spread across France and Belgium.

The Complainant owns the domain name <bonoboplanet.com>, registered in 2006. This domain name gives access to the Complainant's global website, through which it offers its clothing under the BONOBO brand for sale.

The Complainant also owns a wide range of international, European Union and national trademarks that consist of or include the word "bonobo", among which, by way of example, the following:

French word mark BONOBO, registration no. 3127913, registered on October 25, 2001, in class 25;

French word mark BONOBO, registration no. 3437302, registered on June 27, 2006, in classes 3, 14, 16, 18, 24, and 25;

European Union word mark BONOBO, registration no. 005163225, registered on October 14, 2009, in classes 14, 18, and 25; and

International figurative mark BONOBO, registration no. 1088694, registered on April 1, 2011 in classes 3, 9, 14, 16, 18, 24, 25, 35, 41, and 42.



The disputed domain name was registered on February 14, 2022 and leads to a website on which clothes are offered for sale, often at a discounted price. Consumers can create an account and, after having provided their contact details and bank details, they can purchase clothing. The website contains a logo "bonobomode" and contains photographs which are reproduced from the Complainant's website. Moreover, some of the clothes offered for sale are also sold by the Complainant on its website.

5. Parties' Contentions

A. Complainant

The following is a summary of the Complainant's contentions.

The Complainant requests that the disputed domain name be transferred to it on the following grounds:

The Complainant considers that it has prior rights in the BONOBO trademarks. It claims that the disputed domain name is confusingly similar to its trademarks which consist of the word "bonobo", regardless of the addition of the French term "mode" and the generic Top-Level Domain ".com" in the disputed domain name.

Subsequently, the Complainant contends that the Respondent does not have rights or legitimate interests in respect of the disputed domain name. It argues that the Respondent has not been authorized nor licensed by the Complainant to use the BONOBO trademarks. Moreover, it claims that the website to which the disputed domain name leads shows the Respondent's intention of taking unfair advantage of the reputation of the Complainant's trademarks.

Finally, the Complainant argues that the disputed domain name was registered and is being used in bad faith. According to the Complainant, it is obvious that the Respondent is intentionally attempting to take advantage of the Complainant's trademarks to generate profits by misleading consumers with a domain name confusingly similar to its prior trademarks and by using a website which copies the look and feel of its official website.

B. Respondent

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

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the disputed domain name. As the UDRP proceedings are of an administrative nature, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy, that:

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

The Panel will therefore deal with each of these requirements.

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns numerous trademarks consisting of the word "bonobo".

The Panel observes that the disputed domain name comprises the Complainant's BONOBO trademarks in its entirety, with as only two differences the addition of "mode" and ".com".

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that "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 UDRP standing."

Moreover, section 1.8 of the [WIPO Overview 3.0](#) holds that where a trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity. The nature of such additional term(s) may however bear on the assessment of the second and third elements.

Several UDRP panels have already ruled that the addition of the term "mode" to a trademark in a domain name does not prevent a finding of confusing similarity (e.g., *COFRA Holding (C&A) v. Contact Privacy Inc., Customer 0149788187 / Wenyan Hu, zigzagzong*, WIPO Case No. [D2018-2381](#); *Dolce & Gabana S.r.l. v. Yang*, WIPO Case No. [D2013-1763](#)).

Finally, it is a well-established principle that the use of a Top-Level Domain is considered as a standard registration requirement and as such is to be disregarded in the confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)). The addition of the Top-Level Domain “.com” in the disputed domain name does not prevent a finding of confusing similarity with the BONOBO trademarks.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks and that the first element under paragraph 4(a)(i) of the Policy has been established.

B. Rights or Legitimate Interests

Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, the consensus view is that, once the complainant has made a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of proof 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 paragraph 4(a)(ii) of the Policy (section 2.1 of the [WIPO Overview 3.0](#); *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Dow Jones & Company, Inc., (First Complainant) and Dow Jones LP (Second Complainant) v. The Hephzibah Intro-Net Project Limited (Respondent)*, WIPO Case No. [D2000-0704](#)).

Based on the evidence submitted by the Complainant, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Such finding is based on the following observations:

- i. The Respondent has not received any authorisation, license, or permit from the Complainant to use its trademarks in association with the registration of the disputed domain name.
- ii. There is no indication that the Respondent holds trademark rights on the word “bonobo”, nor that the Respondent has been commonly known by the disputed domain name, in particular because the information available about the Respondent’s identity does not suggest any correlation with the word “bonobo” (section 2.3 of the [WIPO Overview 3.0](#)).
- iii. The disputed domain name is almost identical to the BONOBO word trademarks, which carries a high risk of implied affiliation (section 2.5.1 of the [WIPO Overview 3.0](#)).
- iv. The disputed domain name is misleading and is likely to be a pretext for commercial gain (section 2.5.3 of the [WIPO Overview 3.0](#)). It resolves to a website which looks like a copycat of the Complainant’s website, including the reproduction of photographs from the Complainant’s website. Hence, it is very likely that the Respondent registered the disputed domain name knowing that it would attract interest from Internet users who are searching for the Complainant and mislead them into thinking that the website is operated by or affiliated with the Complainant, when in fact it is not. This cannot amount to a *bona fide* offering of goods or services (e.g., *Verisure Sàrl v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Minh Choi*, WIPO Case No. D2021-1363).
- v. The Respondent did not file a response and by doing so failed to provide any evidence of any rights or legitimate interests it would claim to have in the disputed domain name.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the second element under paragraph 4(a)(ii) of the Policy has been established.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) refers to the question of whether the disputed domain name has been registered and is being used in bad faith by the Respondent.

Paragraph 4(b) of the Policy describes some circumstances which, if found to exist, will be evidence of the registration and use of the domain name in bad faith. Among these circumstances is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 website or location or of a product or service on the website or location (paragraph 4(b)(iv) of the Policy).

(a) Registered in bad faith

The Complainant has been benefitting from trademark protection for its BONOBO name from 2001 onwards. The disputed domain name was registered in February 2022. Panels have consistently found that the mere registration of a domain name that is virtually identical to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (section 3.1.4 of the [WIPO Overview 3.0](#)). This is particularly true where the trademark has a distinctive character and has acquired a certain reputation.

A simple search in any search engine would have informed the Respondent of the existence of the Complainant's clothing stores and the corresponding BONOBO trademarks (section 3.2.2 of the [WIPO Overview 3.0](#)). Therefore, not to mention the use to which the disputed domain name has been put, the Respondent cannot reasonably dispute that it knew, or should have known, the Complainant's trademarks when registering the disputed domain name. As the disputed domain name resolves to a copycat website of the Complainant's website, it is even less likely that the disputed domain name was registered in good faith (e.g., *Teva Pharmaceutical Industries Limited v. Miraj Albert*, WIPO Case No. [D2021-1707](#)). This is also illustrated by the fact that the word "mode" (French for "fashion") which the Respondent added to the word "bonobo" to make up the central part of the disputed domain name constitutes a direct reference to the activities of the Complainant. The fact that the Respondent chose to register the disputed domain name anyway and opted not to offer any explanation in response to the Complaint, strongly suggests that the decision to register the disputed domain name was made in bad faith.

In light of the above, the Panel finds that the Respondent registered the disputed domain name in bad faith.

(b) Used in bad faith

The disputed domain name is in use. It resolves to a website on which customers can purchase clothes, often at a discounted price, after they have created an account by providing their contact details and banking details. The website has the appearance of an official web-shop of the Complainant, in particular because it contains the Complainant's BONOBO word trademarks and it reproduces photographs from the Complainant's website. Moreover, it sells clothes which are also sold by the Complainant.

The foregoing makes it very likely that Internet users will assume that there is an association between the disputed domain name and the Complainant. The Panel believes that the addition of the term "mode" in the disputed domain name makes it even more likely that the Respondent wishes to give the impression that the web-shop is affiliated to the Complainant (see e.g., *Dr. Martens International Trading GmbH and Dr. Maertens Marketing GmbH v. Lv Fang*, WIPO Case No. [D2012-1396](#); *Dolce & Gabbana S.r.l. v. Yang*, WIPO Case No. [D2013-1763](#)). This indicates the Respondent's intention to attempt to attract Internet users to its website by creating a likelihood of confusion between the disputed domain name and the BONOBO trademarks.

Consequently, the Panel finds that the Respondent has also been using the disputed domain name in bad faith.

Therefore, the Panel concludes that the disputed domain name was registered and is being used in bad faith by the Respondent and that the third element under paragraph 4(a)(ii) of the Policy has been established.

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 <bonobomode.com> be transferred to the Complainant.

/Geert Glas/

Geert Glas

Sole Panelist

Date: April 25, 2022