

## **ADMINISTRATIVE PANEL DECISION**

Société Anonyme des Galeries Lafayette v. Client Care, Web Commerce Communications Limited  
Case No. D2022-1565

### **1. The Parties**

The Complainant is Société Anonyme des Galeries Lafayette, France, represented by Dreyfus & associés, France.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

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

The disputed domain name <sacgalerieslafayette.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2022. On April 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 6, 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 May 13, 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 May 18, 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 May 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 16, 2022.

The Center appointed Theda König Horowicz as the sole panelist in this matter on June 23, 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 is specialized in city-centre fashion retailing in France and other countries such as Germany, China, and the United Arab Emirates. It is a leader in department stores offering several brands from the affordable to premium and luxury. It has 290 stores worldwide and also operates e-commerce websites.

The Complainant has been active since decades under the corporate name GALERIES LAFAYETTE, operates shops and e-shops under the said brand and holds several trademark registrations worldwide for the said name including the Malaysian trademark GALERIES LAFAYETTE, No 93007797, registered on August 10, 1995, in class 18.

In addition, the Complainant holds many domain names comprising GALERIES LAFAYETTE including <galerieslafayette.com> which was registered on August 8, 1997.

The disputed domain name was registered on March 4, 2022. At the time of the registration, the disputed domain name resolved to an unauthorized “Longchamp Paris” website offering different bags and accessories for online sale.

On March 7, 2022, the Complainant asked the Registrar to block the disputed domain name without success. The same day, the Complainant sent another notification to the hosting company requesting a deactivation of the disputed domain name, without success.

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

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

##### **Confusing similarity**

The Complainant alleges to be the owner of several rights over the well-known name GALERIES LAFAYETTE including trademark rights in Malaysia where the Respondent is based. The disputed domain name reproduces entirely the Complainant's trademark with the addition of the generic word “sac” which means “bag” in French language. This addition does not prevent a likelihood of confusion. On the contrary, the Internet users are likely to believe that this domain name will redirect them to the Complainant's official website. The extension “.com” is not to be taken into consideration.

##### **Rights or Legitimate interests**

The Complainant further states that the Respondent is neither affiliated with the Complainant nor that the Respondent has been authorized by the Complainant to use and register its well-known trademark. The Respondent is not commonly known by the disputed domain name or the name GALERIES LAFAYETTE. The Respondent cannot assert that he is using the disputed domain name in connection with a offering of goods. As a matter of fact, the disputed domain name resolves to a fake website “LONGCHAMP PARIS” offering different bags and accessories for online sale. Moreover, this page requests Internet users' credentials which generates a risk of phishing.

## **Bad Faith Registration and Use**

The Complainant also invokes that the disputed domain name was registered and is used in bad faith. It is indeed implausible that the Respondent was unaware of the Complainant when he registered the disputed domain name because (i) the Complainant is well known throughout the world including in Malaysia where the Respondent is located, (ii) the composition of the disputed domain name which associates both the Complainant's brand and the word "bag" in French language, (iii) the Complainant's rights over GALERIES LAFAYETTE predate the registration of the disputed domain name, and (iv) a quick Internet search on GALERIES LAFAYETTE would have revealed the existence of the Complainant to the Respondent.

The Complainant finally underlines that the Respondent also uses the disputed domain name to direct Internet users to a fake Longchamp website offering bags and different accessories for sale and therefore tries to benefit from the fame of Complainant's trademark rights. Moreover, having regard to the fact that the website linked to the disputed domain name requests Internet users' credentials, there might be a risk that the Respondent is engaged in a phishing scheme.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under the Policy, in order to prevail, a complainant must prove the following three elements for obtaining the transfer of a domain name:

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

### **A. Identical or Confusingly Similar**

The Complainant showed to have trade name and trademark rights in GALERIES LAFAYETTE through several registrations worldwide, including in Malaysia, the location of the Respondent.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. 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.

Furthermore, according to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms, including descriptive terms, does not prevent a finding of confusing similarity.

The disputed domain names contain the GALERIES LAFAYETTE trade name and trademark in entirety. The addition in the disputed domain name of the term "sac" which means "bag" in French language, does not prevent confusing similarity, as the GALERIES LAFAYETTE trademark remains clearly recognizable in the disputed domain names.

Under these circumstances, the Panel concludes that the disputed domain names are confusingly similar to the Complainant's mark.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in the use of a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services;
- (ii) being commonly known by the domain name; or
- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made some submissions in order to demonstrate that the Respondent would have no rights or legitimate interests in the disputed domain name which registration was not approved by the Complainant and which is pointing towards an unauthorized website selling Longchamp bags.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case and the burden of production shifts to the Respondent who has chosen not to reply.

Furthermore, the Panel notes that the case file does not show that the Respondent would be known by the disputed domain name or GALERIES LAFAYETTE.

Given the structure of the disputed domain name, which fully incorporates the Complainant's GALERIES LAFAYETTE trade name and trademark along with the term "sac" which means "bag" in French language, the false impression is given that the Respondent would be operating a legitimate GALERIES LAFAYETTE website. Indeed, it is notorious that the GALERIES LAFAYETTE retail stores and website are selling fashion brands including fashion bag brands such as Longchamp bags which are commercialized on the website linked to the disputed domain name. Such composition of the disputed domain name cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#).

Moreover, the Panel observes that the Internet user who wishes to buy a product on the website which is linked to the disputed domain name must provide information, notably an email address, which generates a risk of phishing which cannot confer rights or legitimate interests to the Respondent in the disputed domain name. See section 2.13.1 of the [WIPO Overview 3.0](#).

Additionally, the Panel notes that considering the strong commercial presence of the Complainant on the Internet and in many countries including in Malaysia where the Respondent is based, it is more than likely that the Respondent was planning to surf on the Complainant's notoriety.

Consequently, the Panel finds that the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

It is undisputed that trade name and the trademark GALERIES LAFAYETTE has been widely used by the Complainant in many countries and on the Internet and that it is a well-established retail business which enjoys a certain notoriety.

There can be no doubt that the Respondent knew about the GALERIES LAFAYETTE business and trademark when registering the disputed domain name. See section 3.2.2 of the [WIPO Overview 3.0](#).

The Panel agrees with the Complainant that the bad faith use of the disputed domain names is supported by several findings, notably:

- the absence of any license or permission from the Complainant to use its trademark and brand,
- the fact that the disputed domain name points to an unauthorized website selling a bag's brand which is also sold by the Complainant and that the said unauthorized website requests Internet users to disclose at least their email address (indicating a potential phishing scheme),
- the absence of response to the Complainant's warning letter and in the present proceedings.

All these circumstances indicate that the Respondent's intent in registering and using the disputed domain name was in fact to profit in some fashion from or otherwise exploit the Complainant's GALERIES LAFAYETTE trademark and brand. See section 3.1.1 of the [WIPO Overview 3.0](#).

In light of the above, the Panel finds that the Respondent has registered and is using the disputed domain names in bad faith and that the Complainant has established its case under paragraph 4(a)(iii) 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 <sacgallerieslafayette.com> be transferred to the Complainant.

*/Theda König Horowicz/*

**Theda König Horowicz**

Sole Panelist

Date: July 8, 2022