

ADMINISTRATIVE PANEL DECISION

Promod v. Host Master, Transure Enterprise Ltd
Case No. D2022-3113

1. The Parties

The Complainant is Promod, France, represented by Dreyfus & associés, France.

The Respondent is Host Master, Transure Enterprise Ltd, United States of America (“the US”).

2. The Domain Name and Registrar

The disputed domain name <promodfr.com> is registered with Above.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 23, 2022. On August 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 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 August 30, 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 August 31, 2022.

The Center verified that the Complaint together with 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 September 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 19, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on October 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. Factual Background

The Complainant is one of France's largest fashion retailers specialized in ready to wear clothing and women's accessories.

The Complainant was founded in 1975 as a French family owned boutique by Francis Charles Pollet. The Complainant aims at offering women accessible and elegant clothing, with a French and feminine allure.

The Complainant is the owner of, *inter alia*, the following PROMOD trademark registrations:

- International trademark registration for PROMOD No. 597138, dated February 8, 1993, duly renewed, designating *inter alia* Austria, China, Cuba, Poland, Viet Nam and covering goods in classes 24, 25 and 26;
- International trademark registration for PROMOD No. 743777, dated October 11, 2000, duly renewed, designating *inter alia* Austria, Benelux, Switzerland, Spain and covering goods in class 25;
- US trademark registration for PROMOD No. 6376084, dated June 8, 2021 and covering goods in class 9;
- US trademark registration for PROMOD No. 6021408, dated March 31, 2020 and covering goods and services in classes 25 and 35;
- French trademark registration for PROMOD No. 3025492, dated May 3, 2000, duly renewed, and covering goods in class 25.

The disputed domain name was registered on April 20, 2022. The Complainant has provided evidence showing that the disputed domain name at different points in time resolved or redirected to various webpages, including the Complainant's own website and pay-per-click ("PPC") landing pages on which it hosted multiple hyperlinks to third-party websites.

5. Parties' Contentions

A. Complainant

The Complainant has acquired considerable goodwill and renown. By 1990, the Complainant had become a major fashion retailer in Europe and expanded its further business in the Middle East. Pioneer in the fashion market, the Complainant launched its first online store in 1999. In 2006, the brand was introduced in Asia and in 2013, in the US and in the United Kingdom. With a turnover of more than 1 billion EUR in 2012, of which 60 per cent was generated through international business, the Complainant has more than 1,066 stores in 52 countries. The group expansion strategy is not just based upon opening stores, but also on the development of online shops in some countries.

The Complainant sent a cease and desist letter to the Respondent requesting the transfer of the disputed domain name free of charge, on June 9, 2022. Despite multiple reminders, the Respondent failed to provide any response to the Complainant's emails.

The disputed domain name is confusingly similar to the Complainant's trademark PROMOD. Indeed, the disputed domain name reproduces the Complainant's trademark PROMOD in its entirety. The incorporation of the letters "fr" does not mitigate any possible confusion, rather contributes to the likelihood that consumers will believe that the disputed domain name is somehow officially related to or associated with the Complainant who is based in France.

The Respondent is neither affiliated with the Complainant in any way nor has he been authorized by the Complainant to use its trademark PROMOD, or to seek registration of any domain name incorporating said mark.

The Respondent had not made demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services.

The Respondent never answered the Complainant's letter despite the reminders. Furthermore, an email server has been configured on the disputed domain name and thus, there might be a risk that the Respondent is engaged in a phishing scheme. So, the disputed domain name is not used in any type of legitimate business or services.

The Respondent is using the disputed domain name to intentionally attract 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 the services offered on the Respondent's website.

The Respondent used the disputed domain name to redirect Internet users to various webpages, including the Complainant's official website, without authorization. The Respondent is voluntarily creating a risk of confusion by suggesting that he is linked to the Complainant.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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. Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the PROMOD trademarks on the basis of its multiple trademark registrations in several countries. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1). It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such finding is confirmed, for example, within section 1.7 of [WIPO Overview 3.0](#).

The Respondent's incorporation of the Complainant's mark in full in the disputed domain name is sufficient to establish that the disputed domain name is confusingly similar to the Complainant's mark. Mere fact of the addition of the geographic acronym "fr" which corresponds to France, the country of origin of most of the commercial activities of the Complainant, to the Complainant's trademark PROMOD does not prevent a finding of confusing similarity with the Complainant's mark. Furthermore, the addition of the generic Top-Level-Domain ".com" does not prevent a finding of confusing similarity either.

The Panel is satisfied that the disputed domain name is identical or confusingly similar to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is often mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth.

The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain name.

The Respondent has no connection or affiliation with the Complainant and has not received any license or authorization to use the Complainant's trademarks PROMOD in a domain name or in any other manner.

The Panel notes that the nature of the disputed domain name carries a risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)), which is, in the Panel's view, further reinforced by addition of the abbreviation "fr", the country code for France, where the Complainant is located and operating its business. Furthermore, the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of a complainant's mark or otherwise mislead Internet users. See [WIPO Overview 3.0](#), section 2.9.

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith:

(i) the respondent has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;

(ii) 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;

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name.

In this case, the commercial recognition of the trademark PROMOD is such that the Respondent, must have had knowledge of the trademark before registering the disputed domain name. The fact that the disputed domain name reproduces in its entirety the Complainant's trademark and, as evidenced by the Complainant, at some point was redirecting to the Complainant's official website reinforces the finding that its registration is not a mere coincidence.

Noting the use of the disputed domain name, the Respondent appears to have chosen the disputed domain name in order 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 the products on its website. Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith.

Furthermore, it is evidenced by the Complainant that the Respondent failed to respond to a cease and desist letter sent by the Complainant's lawyers on June 9, 2022, in which the Complainant requested that the Respondent stops using and transfers the disputed domain name. The Panel follows earlier UDRP decisions and finds that a failure to respond to such a letter and to the present Complaint can be further *prima facie* evidence of bad faith.

The Panel concludes that the disputed domain name was registered and is being used in bad faith within 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, <promodfr.com>, be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: November 4, 2022