

ADMINISTRATIVE PANEL DECISION

Groupe Fiminco v. Malte Bering
Case No. D2022-3250

1. The Parties

The Complainant is Groupe Fiminco, France, represented by Cabinet Bouchara, France.

The Respondent is Malte Bering, Germany, represented by DORNKAMP Rechtsanwälte, Germany.

2. The Domain Name and Registrar

The disputed domain name <yodi.shop> is registered with united-domains AG (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 1, 2022. On September 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 2, 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 September 6, 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 the same day.

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 September 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 4, 2022. The Response was filed with the Center on October 4, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on October 10, 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.

With a Panel Order dated November 8, 2022 the Panel requested that Respondent:

- provides evidence in support that Ms. Yodit Shafi is the partner of the Respondent (for example a sworn declaration from Ms. Shafi); and
- submits additional explanations and respective evidence of the above alleged business project.

4. Procedural Issue: Language of the Proceedings

Paragraph 11(a) of the Rules provides that the language of the proceeding shall be the language of the Registration Agreement unless otherwise specified in that agreement or agreed by the parties. The paragraph also provides that the Panel has the authority to determine otherwise, having regard to the circumstances of the administrative proceeding. The Registrar's Registration Agreement is made available in German. Notwithstanding the Registration Agreement being in German, Complainant requested that English be adopted as the language of the present proceeding. The Panel considers the following assertions of Complainant and Respondent:

Complainant claims that it is not familiar with the German language. Translating the Complaint in German and conducting the proceedings in the German language would incur substantial cost, inconvenience and undue delay.

Respondent did not put forward any objection to the language of the proceedings being English through the submission of pleadings to the Complaint, which were filed in English.

Complainant submits that a reverse Whois search on the basis of the Respondent's first and last names shows that Respondent is the holder of several domain names composed exclusively of terms in English, thus clearly suggesting that he knows the English language well, including:

<automotive-markets.com>, <autoradar-x.com>, <autosuchprogramm.online>, <autosuchsoftware.net>, <deluxeladies.net>, <dietflour.com>, <digital-markets.net>, <humanswiki.com>, <humanswiki.org>, <the-next-beer-is-on-me.com>, <thenextbeerisonme.com>.

Furthermore Complainant submits that the public LinkedIn account of Respondent states that Respondent speaks English with the following level "Professional working proficiency".

The Panel accepts Complainant's request and determines that the language of this proceeding will be English (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.5.1 and 4.5.2, *Laverana GmbH & Co. KG v. Silkewang, Jiangsu Yun Lin Culture Communication Co., Ltd. / xia men yi ming wang luo you xian gong si*, WIPO Case No. [D2016-0721](#); *eBay Inc. v. NicSoft, Antonio Francesco Tedesco*, WIPO Case No. [D2014-0812](#)).

5. Factual Background

Complainant is a holding company of the company YODI which operates in the field of design, manufacture and distribution of perfumes and toiletries worldwide. YODI offers a range of hygiene and beauty products: shampoos, skin and hair care and facial cleansers.

Per Complaint, Complainant's affiliate owns trademark registrations for YODI and YODI YOU DESERVE IT, since as early as April 19, 2018, including:

- the French trademark registration YODI No. 4507211, filed on December 11, 2018, published on January 4, 2019 and duly registered for goods and services in international classes 4, 5, 35 and 42 and
- the International trademark registration YODI No. 1483006, registered on June 7, 2019 with priority from December 11, 2018, designating the European Union and Switzerland, for goods and services in international classes 4, 5, 35 and 42.

The Panel accepts that a trademark owner's affiliate, namely Complainant, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint ([WIPO Overview 3.0](#), section 1.4.1).

Complainant further submitted website printouts all dated 2022 showing the presence of its YODI trademark and goods under it, on the Internet. Complainant offers its products and services under the domain name <yodibeauty.com>.

The Domain Name was registered on January 26, 2019 and resolves to a landing page set up automatically by the registrar indicating that the Domain Name is already registered, while two mail exchange ("MX") records have been activated in connection thereto. The Domain Name was registered a few weeks after the above mentioned French trademark of Complainant No. 4507211 was published in the official bulletin on January 4, 2019.

6. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for the transfer of the Domain Name.

B. Respondent

Respondent asserts that the registration of the Domain Name was not made in bad faith. He claims that he had no knowledge of Complainant's earlier trademarks and that the reason for choosing the Domain Name was because his partner's first name is YODIT, which is the Ethiopian spelling of the name Judith, while YODI is a common nickname for it in that country. Respondent submitted a copy of the passport of a person with the first name YODIT and Ethiopian nationality. Furthermore, following a Panel Order, Respondent submitted a written and signed statement that Ms. Yodit Shafi has been in a relationship with Respondent since late 2018 and that since her childhood, her family and friends call her "Yodi".

Per Respondent, an online shop was to be set up under the Domain Name, which would enable small manufacturers in Ethiopia to sell their products directly to end customers around the world. The project was not realized per Respondent due to the civil war there. Respondent, following the Panel Order, submitted a written and signed statement, with an explanation of the above business idea and confirmed that since war broke out in Tigray, Ethiopia, he has completely stopped all planning.

To this, Complainant remarked, as reply to the documents submitted by Respondent further to the Panel Order, that a) the Tigray war started on November 4, 2020, thus more than a year and a half after the domain name registration, b) the explanation does not amount to a clear contemporaneous evidence of *bona fide* pre-complaint preparations, required by the UDRP, c) that Respondent is the holder of about one hundred domain names which makes him a professional or near-professional domain name registrant who has an obligation to ensure that the registration of a domain name does not infringe on a prior trademark and d) that Respondent did not provide any explanation regarding the two mail exchange ("MX") records activated for the Domain Name.

Respondent further asserts that Complainant's trademark YODI "was still unknown to the public at the time of the domain registration".

7. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements, which Complainant must satisfy with respect to the Domain Name:

(i) the 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 Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Domain Name incorporates Complainant's trademark YODI in its entirety.

The generic Top-Level Domains ("gTLD") ".com" is disregarded, as gTLDs typically do not form part of the comparison as they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Name is identical to the YODI mark of Complainant.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

(i) before any notice to Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Name, even if Respondent has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As per Complainant, Respondent was not authorized to register the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

Respondent submitted a signed statement explaining his business idea, however he did not provide any concrete and credible evidence about any preparatory act to materialize this idea, invoking war in Tigray as the reason for "stopping all further planning". However, as Complainant demonstrates, the war in Tigray started in November 2020 and therefore Respondent had a year and a half within which he took no action, or at least provides no evidence that he took any action, to start up an online shop under the Domain Name as contemplated.

In view of the evidence submitted in the case file, the Panel is not in a position to make a finding on whether the Respondent has rights or legitimate interests in the disputed domain name.

Noting the Panel's finding under the third element of the Policy, it is not necessary for the Panel to make a final determination under the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, are evidence of the registration and use of the Domain Name in bad faith:

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that 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 Respondent has engaged in a pattern of such conduct; or

(iii) that 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, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel notes that no evidence was provided that Complainant's YODI mark had been used at the time of the Domain Name registration by Respondent and would have been found by Respondent in a Google search made at that time. While, the Panel notes that Complainant's French registration mentioned above was just published at the time of the Domain Name registration which casts a doubt on the timing of Respondent's registration, the Panel finds on balance that there is no evidence in the case file to establish that the intention of the Respondent towards the disputed domain name was to take unfair advantage of the Complainant's trademark.

The Panel also notes that Complainant indicates that Respondent owns a number of domain names (see above), that they are all resolving to inactive websites, and that he is professional or near-professional domain name registrant. This provided list by the Complainant is not sufficient to establish a pattern conduct in the circumstances of the present case, as it is not clear from that list whether the intention of the Respondent was to target any third party trademarks.

Under these circumstances and on this record, the Panel finds on balance that Complainant has not established paragraph 4(a)(iii) of the Policy.

However, if new evidence comes to light showing that the Respondent's intent towards the Domain Name was to take unfair advantage of its identity with the Complainant's mark, acceptance of a refiled complaint may be justified.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: November 29, 2022