

ADMINISTRATIVE PANEL DECISION

C F E B Sisley v. Jiafan Yan
Case No. D2023-0292

1. The Parties

The Complainant is C F E B Sisley, France, represented by Fidal, France.

The Respondent is Jiafan Yan, China.

2. The Domain Name and Registrar

The disputed domain name <sisley-paris.org> (the “Disputed Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 23, 2023. On January 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same day, 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 January 30, 2023 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 amendment to the Complaint on February 1, 2023.

The Center verified that the Complaint together with the amendment to the 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 February 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on February 28, 2023. 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 company was incorporated in France in 1972 and operates a business that develops and sells skincare, makeup, fragrance and hair care products in numerous countries. The Complainant holds a number of registrations for the trademark SISLEY and SISLEY-PARIS in various jurisdictions including, for example: International Trademark Registration No. 385946 for SISLEY, registered on February 10, 1972, in class 3 and French Trademark Registration No. 3991140 for the Trademark SISLEY-PARIS, registered on March 19, 2013.

The Complainant has owned the domain name <sisley-paris.com> since August 2000, which hosts its main website as well as more than 350 domain names that include the Trademark SISLEY and 91 domain names that include the Trademark SISLEY-PARIS.

The Respondent registered the Disputed Domain Name <sisley-paris.org> on January 6, 2023. The Disputed Domain Name resolves to a pay-per-click (“PPC”) parking page that also displays an offer to sell the Disputed Domain Name for USD 9,800.

5. Parties’ Contentions

A. Complainant

The Complainant cites its trademark registrations internationally for the marks SISLEY and SISLEY-PARIS as *prima facie* evidence of ownership.

The Complainant submits that its rights in the marks SISLEY and SISLEY-PARIS predate the Respondent’s registration of the Disputed Domain Name. It submits that “[t]he Complainant’s trademark [SISLEY-PARIS] is included in the [D]isputed [D]omain [N]ame in its entirety with no additional elements” and that the identity is not removed by the addition of the generic Top-Level Domain (“gTLD”) “.org”.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that “[t]he Complainant has not authorized licensed, permitted or otherwise consent to the Respondent’s use of the trademark SISLEY in the [D]isputed [D]omain [N]ame and has no relationship with the Respondent.” It also contends that “the Respondent uses the [D]isputed [D]omain [N]ame in connection with a website page offering sponsored links for the sale of goods and services” and that “the [D]isputed [D]omain [N]ame is offered for sale” for USD 9,800.

Finally, the Complainant alleges that the Respondent registered and is using the Disputed Domain Name in bad faith and that “the Complainant’s commencement of its business and its use of the SISLEY trademark since at least 1972, far pre-date the registration date of the [D]isputed [D]omain [N]ame in 2023, it is clear that the Respondent was aware of the Complainant’s rights and deliberately registered the [D]isputed [D]omain [N]ame in bad faith”.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of 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 has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark SISLEY and SISLEY-PARIS in numerous jurisdictions. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the SISLEY-PARIS trademark, the Panel observes that the Disputed Domain Name comprises: (a) the Complainant's trademark SISLEY-PARIS; (b) followed by the gTLD ".org".

It is well established that the gTLD used as technical part of a domain name may be disregarded. The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "sisley-paris" (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In this case, the Disputed Domain Name identically incorporates the entirety of the Complainant's trademark. It is also well-established 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 (see [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because (i) the Disputed Domain Name is inactive; (ii) the Respondent has not acquired or owned any trademark or service mark rights in the name SISLEY-PARIS, and has not been commonly known by the name SISLEY-PARIS; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain.

The Respondent is not using the Disputed Domain Name with legitimate interests in a domain name incorporating the Complainant's mark, and is not commonly known by the Disputed Domain Name. The Panel accepts the Complainant's uncontested submission that use to direct Internet traffic to a PPC webpage is "clearly not a use in connection with a *bona fide* offering of goods or services pursuant to Policy or a legitimate noncommercial or fair use" and that "[u]sing the Complainant's identity [and] [r]eproducing in its entirety without any prior authorization the Complainant's trademark [...] does not amount to legitimate or

bona fide conduct and supports an inference that the Respondent has no rights or legitimate interests in the [D]isputed [D]omain [N]ame”.

The composition of the Disputed Domain Name, which consists of the Complainant’s trademark does, in this Panel’s view, indicate an awareness and targeting of the Complainant with the intention to take unfair advantage of its trademarks, which does not support a finding of any rights or legitimate interests.

The Panel finds for the Complainant on this element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy requires that the Complainant must also demonstrate that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, given the composition of the Disputed Domain Name, the Panel is satisfied that the Respondent targeted the Complainant’s trademarks SISLEY and SISLEY-PARIS when it registered the Disputed Domain Name and the Panel is prepared to infer that the Respondent knew, or should have known, that its registration would be identical or confusingly similar to the Complainant’s trademark (see [WIPO Overview 3.0](#), section 3.2.2).

In addition, the gap of several years between registration of the Complainant’s trademark and the Respondent’s registration of the Disputed Domain Name, along with the composition of the Disputed Domain Name (containing an exact reproduction of the Complainant’s well-known trademark) in the circumstances of this case is a further indicator of bad faith. (See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Complainant’s rights in its trademarks SISLEY and SISLEY-PARIS predate any rights that could possibly flow from the Respondent’s registration of the Disputed Domain Name by approximately 51 years and by approximately 10 years respectively.

On the issue of use, the Complainant’s evidence is that some of the Disputed Domain Names resolved to a PPC landing page displaying links that redirect Internet traffic to third-party competitor websites unaffiliated with the Complainant. This Panel accepts the Complainant’s uncontested evidence as evidence of bad faith use. Targeting of this nature is a common example of bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP decisions (see [WIPO Overview 3.0](#), sections 3.1.4, and 3.2.1).

The Panel also accepts the uncontested evidence that the Disputed Domain Name was listed for sale on the aftermarket for more than USD 9,800, which appears likely to exceed out of pocket costs incurred by the Respondent in registering the Disputed Domain Name. Targeting of this nature is another common example of bad faith.

This Panel also notes that the Respondent’s webpage displays an almost identical version of the Complainant’s ‘favicon’, the name commonly used for the small icon associated with a particular website or web page typically displayed before the URL in the address bar of a browser, in the browser’s tabs or next to the site name in a user’s list of bookmarks. The Panel finds this use of a favicon is use in bad faith, and is analogous to the use of website content targeting the complainant’s trademark that numerous previous panels have determined amounts to evidence of bad faith (see [WIPO Overview 3.0](#), section 3.1.1).

In the absence of responsive evidence to the contrary, this Panel accepts the Complainant’s evidence and finds that the Respondent has registered and used the Complainant’s trademarks SISLEY and SISLEY-PARIS in the Disputed Domain Name, without the Complainant’s consent or authorization, for the likely purpose of capitalizing on the reputation of the trademark to infringe upon the Complainant’s rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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, <sisley-paris.org> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: March 14, 2023