

ADMINISTRATIVE PANEL DECISION

Delsey v. Masoud Charmchi, Lilianmode Tejarat Co., Hamed Saati
Case No. DIR2023-0005

1. The Parties

The Complainant is Delsey, France, represented by Domgate, France.

The Respondents are Masoud Charmchi, Iran (Islamic Republic of), Lilianmode Tejarat Co., Iran (Islamic Republic of), and Hamed Saati, Iran (Islamic Republic of),

2. The Domain Names and Registrar

The disputed domain names <delseyiranian.ir>, <delseyiran.ir>, <delseywarranty.ir>, <irandelsey.ir>, and <mydelsey.ir> are registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2023. On June 6, 2023, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain names. On June 8, 2023, IRNIC transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 11, 2023 providing the registrant and contact information disclosed by IRNIC, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 20, 2023.

The Center verified that the Complaint and the amended Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondents of the Complaint, and the proceedings commenced on July 14, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was August 3, 2023. On August 6, 2023, the Center notified the Respondents’ default.

The Center appointed Edoardo Fano as the sole panelist in this matter on August 10, 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.

The Panel has not received any requests from the Complainant or the Respondents regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), “to employ reasonably available means calculated to achieve actual notice to the Respondent”. Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a response from the Respondents.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Delsey, a French company operating since 1946 in the field of luggage, and owning several trademark registrations worldwide for DELSEY, among which the following ones in Iran, namely the Respondents' country:

- Iranian Trademark Registration No. 59108 for DELSEY and design, registered on October 23, 1984;
- Iranian Trademark Registration No. 238536 for DELSEY PARIS and design, registered on December 19, 2015;
- Iranian Trademark Registration No. 222201 for DELSEY (in Farsi), registered on December 15, 2014;
- International Trademark Registration No. 1201488 for DELSEY, registered on March 6, 2014, also extended to Iran.

The Complainant also operates on the Internet, its main website being “www.delsey.com”.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain names were registered on the following dates: <delseyiranian.ir> on April 10, 2019, <delseyiran.ir> on March 9, 2022, <delseywarranty.ir> on April 15, 2018, <irandelsey.ir> on March 9, 2022, and <mydelsey.ir> on November 13, 2016. The disputed domain names <delseyiranian.ir> and <delseywarranty.ir> are redirecting to the disputed domain name <delseyiran.ir>, while the disputed domain name <delseyiran.ir> is redirecting to the website at the disputed domain name <irandelsey.ir>, in which the Complainant's trademark is reproduced and the Complainant's products are purportedly offered for sale by a self-declared official representative of the Complainant in Iran. The disputed domain name <mydelsey.ir> redirects to a “potential security risk ahead” webpage.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain names are confusingly similar to its trademark DELSEY, as the disputed domain names wholly incorporate the Complainant's trademark.

Further to section 6.1 below, the Complainant argues that the disputed domain names are under common control and thus addresses the Respondents in the singular. The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the

disputed domain names, it is not commonly known by the disputed domain names and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names: four of the disputed domain names resolve or are redirected to the same website in Persian, where the Complainant's products are purportedly offered for sale and the Complainant's trademark is reproduced, with the aim to divert consumers and deceive them into believing that the disputed domain names are associated to the Complainant, while the fifth disputed domain name redirects to a "potential security risk ahead" webpage.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, as four of them resolve or are redirected to a website displaying the Complainant's trademark and fraudulently purporting to offer the Complainant's products, while the fifth disputed domain name redirects to a "potential security risk ahead" webpage. The Complainant contends that the use of the disputed domain names to impersonate the Complainant in order to attract, for commercial gain, Internet users to the Respondent's website, creating a likelihood of confusion with the Complainant's trademark, purportedly offering for sale the Complainant's products and disrupting the Complainant's business, qualifies as bad faith registration and use.

B. Respondent

The Respondent has made no reply to the Complainant's contentions and is in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.¹

6. Discussion and Findings

6.1 Consolidation of Multiple Respondents

The Complainant has requested consolidation of multiple Respondents and stated that all the disputed domain names belong to the same person or organization. No objection to this request was made by the Respondents.

Pursuant to the [WIPO Overview 3.0](#), section 4.11.2, "[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario". The Panel may consider a range of factors to determine whether consolidation is appropriate, such as examining relevant registrant contact information, and any naming patterns in the disputed domain names, or other evidence of respondent affiliation that indicate common control of the disputed domain names.

The Panel notes that the disputed domain names <delseyiran.ir> and <irandelsey.ir> have been registered by the Respondent Masoud Charmchi, and the disputed domain names <delseyiraninan.ir> and <delseyarranty.ir> have been registered by the Respondent Lilianmode Tejarat Co., while the disputed domain name <mydelsey.ir> has been registered by the Respondent Hamed Saati. The Panel also notes that all the disputed domain names redirect to the same IP address, four of them resolving or being redirected to the same website, in which the Complainant's products are purportedly offered for sale and the

¹ In light of the substantive and procedural similarities between the irDRP and the Uniform Domain Name Dispute Resolution Policy ("UDRP"), the Panel has cited decisions under the UDRP and the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where appropriate.

Complainant's trademark is reproduced. The Panel finds that there is plausible evidence that the disputed domain names are subject to common control, and that it would be procedurally efficient, fair, and equitable to all Parties to accept the Complainant's consolidation request. The Panel further notes that the Respondents did not object to the consolidation request. The Panel therefore accepts the Complainant's consolidation request. Hereinafter, the Panel will refer to the Respondents in the singular, *i.e.*, "the Respondent".

6.2 Substantive Issues

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered or are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark DELSEY both by registration and acquired reputation and that the disputed domain names are confusingly similar to the trademark DELSEY.

Regarding the addition of the terms "iranian", "iran", "warranty" and "my", the Panel notes that it is now well established that the addition of other terms (whether descriptive, geographical terms, letters, or otherwise) to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark. The additional terms do not therefore prevent the disputed domain names from being confusingly similar to the Complainant's trademark. See [WIPO Overview 3.0](#), section 1.8.

It is well accepted that a country code Top-Level Domain ("ccTLD") suffix, in this case ".ir", is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain names.

The Respondent may establish rights or legitimate interests in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

"(i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name[s] or a name corresponding to the domain name[s] in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name[s], even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name[s], without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain names according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is generally more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names in order to shift the burden of production to the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain names in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not using the disputed domain names for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services, but instead, on the website at four of the disputed domain names, namely <delseyiranian.ir>, <delseyiran.ir>, <delseywarranty.ir> and <irandelsey.ir>, the Complainant's trademark is reproduced and the Complainant's products are purportedly offered for sale by a self-declared official representative of the Complainant in Iran, while the fifth disputed domain name, namely <mydelsey.ir>, redirects to a "potential security risk ahead" webpage.

According to the [WIPO Overview 3.0](#), section 2.13.1:

"2.13.1 Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent [...]."

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain names. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain names.

The Panel therefore concludes that the disputed domain names are not being used in connection with a *bona fide* offering of goods or services.

Moreover, the Panel finds that the composition of the disputed domain names carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Based on the facts of this case, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered or Used in Bad Faith

While paragraph 4(a)(iii) of the Policy requires a demonstration that a domain name has either been registered or is being used in bad faith, the Complainant has argued that the Respondent has both registered and used the disputed domain names in bad faith. Paragraph 4(b) of the Policy provides that "for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant

who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

(ii) that [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; or

(iii) that [the 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, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location".

Regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademark DELSEY in the field of luggage is clearly established and the Panel finds that the Respondent likely knew of the Complainant, and deliberately registered the disputed domain names in bad faith, especially because, on the website to which four of the disputed domain names are either resolving or being redirected, the Complainant's products are purportedly offered for sale and the Complainant's trademark is reproduced.

The Panel further notes that four of the disputed domain names, namely <delseyiranian.ir>, <delseyiran.ir>, <delseywarranty.ir> and <irandelsey.ir>, are also being used in bad faith since the Respondent is trying to attract Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the disputed domain names' source, sponsorship, affiliation or endorsement, in order to fraudulently try to impersonate the Complainant by passing itself off as the Complainant's official representative in Iran, an activity clearly detrimental to the Complainant's business. See [WIPO Overview 3.0](#), sections 3.1.4

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain names <delseyiranian.ir>, <delseyiran.ir>, <delseywarranty.ir> and <irandelsey.ir> in order both to disrupt the Complainant's business, and to attract, for commercial gain, Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

As regards the use in bad faith of the disputed domain name <mydelsey.ir>, which redirects to a "potential security risk ahead" webpage, the Panel considers that bad faith may exist even in cases of so-called "passive holding", as found in the landmark UDRP decision *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In the circumstances of this case, the Panel finds that such passive holding does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3. In support thereof, the Panel considers as relevant the notoriety of the Complainant's trademark, the use of the other disputed domain names, the Respondent's failure to formally participate, and the Respondent's use of a privacy service to mask its details in the publicly-available WhoIs.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain names, which include the Complainant's trademark in its entirety with the addition of the terms "iranian", "iran", "warranty" and "my", further supports a finding of bad faith. See [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain names in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

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 names <delseyiranian.ir>, <delseyiran.ir>, <delseywarranty.ir>, <irandelsey.ir>, and <mydelsey.ir> be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: August 12, 2023