

ADMINISTRATIVE PANEL DECISION

TRICOTS SAINT-JAMES, SAS v. Zhang Qiang

Case No. D2024-2382

1. The Parties

The Complainant is TRICOTS SAINT-JAMES, SAS, France, represented by Fidal, France.

The Respondent is Zhang Qiang, China.

2. The Domain Name and Registrar

The disputed domain names <saintjamesaustralia.com>, <saintjamesespaña.com>, and <saintjamesnederland.com> are registered with Paknic (Private) Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 31, 2024. On June 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 13, 2024, the Registrar 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 (No information) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 2024, 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 June 14, 2024.

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 June 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 12, 2024.

The Center appointed Selma Ünlü as the sole panelist in this matter on July 19, 2024. 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, established in 1889, is a French company that manufactures and sells clothing and fashion accessories for men, women, and children, specializing in the design of garments under the SAINT JAMES trademark. The Complainant owns trademarks containing SAINT JAMES such as the marks as follows:

- European Union Trademark Registration No. 006625339, registered on December 12, 2008, in class 25;
- European Union Trademark Registration No. 1527542, registered on June 05, 2019, in classes 3, 4, 9, 14, 16, 18, 21, 24, and 25;
- France Trademark No. 4549780, registered on May 9, 2019, in classes 3, 4, 9, 14, 16, 18, 21, 24, and 25;
- France Trademark No.4000393, registered on April 24, 2013, in classes 3, 14, 18, 24, and 25; and
- International Registration No.1178246, registered on May 2, 2013, in classes 3, 14, 18, 24, and 25.

The Complainant is also the owner of several domain names incorporating its SAINT JAMES trademark, such as <saint-james.com>, <saint-james-australia.com.au>, <saint-james.au>, <saint-james.com.au>, <saint-james.es>, <saint-james.eu>, <saint-jamesaustralia.com.au>, <saintjames.es>, <saintjames.eu>, and <saintjamesaustralia.com.au>.

The disputed domain names, <saintjamesnederland.com> created on June 20, 2023, <saintjamesaustralia.com> created on June 20, 2023, and <saintjamesespaña.com> created on June 19, 2023. All three disputed domain names have redirected to the Respondent's online sales websites.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the disputed domain names are under common control, as all associated websites are identical, featuring the same design, photos, tabs, and products. The disputed domain names were registered on June 19 and 20, 2023, through the same Registrar, and by the same Respondent.

According to the Complainant, the disputed domain names <saintjamesnederland.com>, <saintjamesaustralia.com>, and <saintjamesespaña.com> are confusingly similar to the Complainant's trademarks, specifically the SAINT JAMES mark. The Complainant asserts that the disputed domain names incorporate the SAINT JAMES trademark in full at the beginning of each disputed domain name, which highlights the trademark. The Complainant claims that the addition of geographic terms does not diminish the confusing similarity to its trademarks, a position supported by previous UDRP decisions.

The Complainant further contends that the Respondent's use of the disputed domain names replicates the Complainant's website design and content, including the trademarks and product offerings. The Complainant argues that this imitation misleads consumers by creating websites that closely resemble the Complainant's official sites, thereby exploiting the Complainant's reputation and trademarks. The Complainant believes that the disputed domain names were registered in bad faith, as evidenced by the unauthorized use of the Complainant's trademarks, the deliberate mimicry of the Complainant's website, and the potential intent to engage in phishing or fraudulent activities.

In summary, the Complainant alleges that the Respondent's actions constitute identity theft and a deliberate attempt to deceive consumers into believing they are interacting with the Complainant's legitimate sites. The Complainant asserts that the similarities between the disputed domain names and the Complainant's trademarks, combined with the absence of legitimate use or authorization, indicate bad faith registration and use of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

The Complainant must prove that the three elements of paragraph 4(a) of the Policy have been met for each of the disputed domain names, namely:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Since the Respondent did not object to any of the contentions from the Complainant by not submitting a Response, the Panel will decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable and on the basis of the Complaint and supporting Annexes.

A. Identical or Confusingly Similar

In light of the explanations and evidence provided by the Complainant, the Panel is satisfied that the Complainant has valid trademark rights in the SAINT JAMES trademark, which is reproduced in its entirety in the disputed domain names. The Panel is of the opinion that the addition of terms does not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademarks.

Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".com" does not prevent a finding of confusing similarity, since it is merely a technical registration requirement to be disregarded typically.

Consequently, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark and the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists non-exhaustively the relevant circumstances that could show the Respondent's rights or legitimate interests in a domain name, as follows:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [the respondent] of the dispute, [the 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) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trademark or service mark rights; or

(iii) [the 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.”

The Panel notes that the Respondent has not filed a Response, and therefore, neither denied the Complainant’s claims, nor brought any information or evidence to prove any rights or legitimate interests.

The Complainant has made a prima facie showing that the Respondent does not have any rights or legitimate interests in the disputed domain names. In particular, the Complainant asserted that the Respondent has no trademarks with the words “Saint James” and that it did not provide any license or authorization for the Respondent to use its trademark as part of the disputed domain names.

Additionally, the Complainant’s registration and use of the SAINT JAMES trademark predates the registration of the disputed domain names. Since the Complainant made out a prima facie case, the burden of production shifts to the Respondent to establish its rights or legitimate interests in the disputed domain names. The Respondent, however, has not sought to rebut that prima facie case.

Moreover, the Panel finds that the composition of the disputed domain names, consisting of the Complainant’s trademark entirely, carries a risk of implied affiliation. This finding is reinforced given the Complainant’s use of the domain name <saint-james.com>. See section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

In light of the Complainant’s assertions and evidence, the Panel finds that the Complainant has met the requirement under the Policy of prima facie showing that the Respondent does not have any rights or legitimate interests in the disputed domain names. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists certain relevant non-exhaustive circumstances, which can be considered as the registration and use of a domain name in bad faith, namely:

“(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] 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 that complainant, for valuable consideration in excess of [the respondent’s] documented out-of-pocket costs directly related to the domain name; or

(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; or

(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 [the respondent’s] website or other on-line 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.”

The Panel must decide by examining all relevant circumstances of each case in question. It is possible that cumulative conditions lead to the finding of bad faith, such as the Complainant’s trademark being well known, and no response submitted to the Complaint.

The Panel finds that the Respondent has acted in bad faith. The Respondent’s websites reproduce the Complainant’s SAINT JAMES trademarks and website design without authorization, creating a misleading

imitation of the Complainant's official site. This deliberate replication of trademarks, images, and site layout is intended to confuse consumers and exploit the Complainant's established reputation, which the Complainant asserts is well-recognized both nationally and internationally.

Furthermore, the Panel notes that the Respondent's use of the disputed domain names to promote to what appear counterfeit products mirrors the Complainant's offerings, which constitutes impersonation. The timing of the domain name registration, occurring well after the Complainant had established its brand internationally, suggests that the Respondent's actions were opportunistic and in bad faith.

In light of these findings, and considering the Complainant's claim of its mark's significant international recognition, the Panel concludes that the Respondent's actions reflect a clear intent to misuse the Complainant's trademark and reputation for commercial gain, thereby affirming the Respondent's bad faith in the registration and use of the disputed domain names. Paragraph 4(b)(iv) of the Policy.

Consequently, given the explanations in the Complaint and the evidence provided by the Complainant, the Panel decides that the third requirement is also met, and both the registration and the use of the disputed domain names are in bad faith.

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 <saintjamesaustralia.com>, <saintjamesespaña.com>, and <saintjamesnederland.com> be transferred to the Complainant.

/Selma Ünlü/

Selma Ünlü

Sole Panelist

Date: August 5, 2024