

ADMINISTRATIVE PANEL DECISION

Magellan v. sebastian oster, Sebastian Oster
Case No. D2022-4524

1. The Parties

The Complainant is Magellan, France, represented by Inlex IP Expertise, France.

The Respondent is sebastian oster, Sebastian Oster, Germany.

2. The Domain Name and Registrar

The disputed domain name <outletbonobo.com> is registered with Web Commerce Communications Limited dba WebNic.cc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 28, 2022. On November 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 28, 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 (Domain Admin, Whoisprotection.cc) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 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 December 13, 2022.

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 January 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 27, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on January 31, 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 is active in the fashion industry for men and women clothes sold under the trademark BONOBO. The Complainant provides its goods also through its website at “www.bonoboplanet.com”.

The Complainant is the owner of trademark registrations for BONOBO worldwide, including:

- French trademark registration no. 3127913, BONOBO (figurative), registered on October 25, 2001, for goods in international class 25; and
- European Union Trade Mark registration no. 005163225, BONOBO (word), filed on June 27, 2006, and registered on October 14, 2009, for goods in international classes 14, 18, and 25.

The disputed domain name was registered on November 13, 2022, and leads to a website that looks like an e-shop offering clothing.

5. Parties' Contentions

A. Complainant

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is identical or confusingly similar to the BONOBO trademark registration of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

Third, the Complainant submits that the disputed domain name was registered and is being used in bad faith.

With respect to bad faith the Complainant specifically states that the disputed domain name points to a website that looks like an e-shop offering clothing. The Complaint states that this is not a genuine website, as there is only one “clothing” tab on the website, the address provided to the Registrar does not correspond to the address on the website and the address on the website does not correspond to any BONOBO shop. The website is presented as an e-shop where the consumer can create an account and purchase products, namely, the consumer is invited to provide personal details for purchasing products.

The Complainant request the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

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

- (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.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical or confusingly similar to the Complainant's trademark. The Complainant holds several valid trademark registrations for BONOBO.

The disputed domain name <outletbonobo.com> contains the trademarks BONOBO of the Complainant in its entirety with the addition of the term "outlet". Since the trademark BONOBO of the Complainant is included in the disputed domain name, this is sufficient to establish that a domain name is confusingly similar to the Complainant's trademark. The addition of others terms does not prevent a finding of confusing similarity.

The Panel finds the first element of the Policy has therefore been met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

- "(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, 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, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

There is no evidence of the existence of any of those rights or legitimate interests in this case.

The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. The Complainant has prior rights in the trademarks, which precede the Respondent's registration of the disputed domain name.

Moreover, the Complainant has asserted that at the time of filing the Complaint, the disputed domain name resolved to an online shop titled "La Capsule D'evy" allegedly selling and offering clothing.

The Complainant has therefore established a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and thereby shifted the burden to the Respondent to produce evidence to rebut this presumption. The Respondent has failed to rebut the Complainant's *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second requirement of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove both that the disputed domain name was registered and used in bad faith. The Complainant's allegations with regard to the Respondent's registration and use of the disputed domain name in bad faith have been considered by the Panel. The Respondent has not contested these allegations.

There is no doubt that the Respondent was aware of the Complainant's trademark when he registered the disputed domain name given that the disputed domain name reproduces the Complainant's trademark and includes the title "La Capsule D'evy" which corresponds to another competing clothing shop.

With respect to use in bad faith, the Complainant has asserted that at the time of filing the Complaint, the disputed domain name resolved to an online shop allegedly selling and offering clothing. In addition, the Complainant stated that the disputed domain name may be use for fraud purposes. It is the view of the Panel, this is evidence of bad faith.

In light of the evidence, the Panel holds that the Respondent has intentionally attempted to attract for commercial gain Internet users to his website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website and services and products offered on it under paragraph 4(b)(iv) of the Policy, and likely to disrupt the business of the Complainant.

Therefore, the Panel concludes that the Complainant has made out its case that the disputed domain name was registered and is being used in bad faith and has satisfied the third limb of the Policy, under paragraphs 4(a)(iii) and 4(b)(iv).

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 <outletbonobo.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: February 14, 2023