

## **ADMINISTRATIVE PANEL DECISION**

**C F E B SISLEY v. Jiafan Yan**  
Case No. D2023-0290

### **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.net> (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 January 24, 2023, 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.net> on January 6, 2023. The Disputed Domain Name resolves to an inactive webpage with an invitation to potential purchasers of the Disputed Domain Name to make an offer.

#### **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 the Disputed Domain Name "is identical to the Complainant's trademarks in which the Complainant has rights" and that the identity is not removed by the addition of the generic Top-Level Domain ("gTLD") ".net".

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 "It has also been shown that the Respondent is not making any direct use of the [D]isputed [D]omain [N]ame but merely to redirect to a website where the [D]isputed [D]omain [N]ame is offered for sale".

Finally, the Complainant alleges that the Respondent registered and is using the Disputed Domain Name in bad faith and that "the Respondent registered the [D]isputed [D]omain [N]ame in bad faith with the knowledge of the Complainant's trademarks and business and to take advantage due to its value as a trademark owned by the Complainant". It also contends that "the fact that the [D]isputed [D]omain [N]ame redirects to a website offering it for sale appears to signal an intention on the part of the Respondent to derive commercial gain from the resale of the [D]isputed [D]omain [N]ame riding on the reputation of the Complainant's trademarks".

##### **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 ".net".

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 "[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 trademark 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 evidence is that the Disputed Domain Name is inactive and unconnected with any *bona fide* supply of goods or services by the Respondent. Previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the ‘passive holding’ doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put” (see [WIPO Overview 3.0](#), section 3.3). This Panel notes that the evidence is that at least three of these factors are present in this proceeding.

The Respondent’s conduct calls for an explanation, which was not forthcoming. In the absence of any countervailing evidence, 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.net>, be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: March 13, 2023