

ADMINISTRATIVE PANEL DECISION

SIM Licensing Limited v. Amirhossein Ghasemi
Case No. DIR2022-0019

1. The Parties

The Complainant is SIM Licensing Limited, Cyprus, represented Saba & Co. Intellectual Property s.a.l. (Offshore) Head Office, Lebanon.

The Respondent is Amirhossein Ghasemi, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name <eliesaab.ir> is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 14, 2022. On October 17, 2022, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On October 18, 2022, IRNIC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced on October 20, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was November 9, 2022.

On November 9, 2022, the Respondent sent an informal email. On November 17, 2022, the case was suspended and re-instituted on December 19, 2022.

The Center appointed Gareth Dickson as the sole panelist in this matter on January 3, 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.

At the request of the Panel and pursuant to paragraphs 10 and 12 of the irDRP Rules, the Center issued Procedural Order No. 1 on January 25, 2023, inviting the Complainant: to provide copies of the certificates for the trade mark registrations cited in support of the Complaint; and to provide evidence in support of its contentions that the Respondent's activities were "commercial exploitation" and were for "commercial gain", notwithstanding its submission that the Respondent was not linking the disputed domain name to an active website. The Complainant was instructed to limit any response to the requests described above, and responded within the deadline set out in Procedural Order No. 1. The Respondent was invited to make a submission in response to the Complainant's response to Procedural Order No. 1 but did not do so.

4. Factual Background

The Complainant is a fashion company based in Cyrus, specializing in haute couture and founded by the Lebanese designer, Elie Saab. It is the owner of a number of trade mark registrations for ELIE SAAB (the "Mark") around the world, including International trade mark registration number 1031563, registered on November 25, 2009.

The disputed domain name was registered on July 17, 2013. Upon its own investigation, the Panel has determined that it currently directs users to a holding page offering the disputed domain name for sale and containing links to other businesses.

5. Parties' Contentions

A. Complainant

The Complainant argues that it has rights in the Mark by virtue of its ownership of various trade mark registrations for the Mark around the world, and provided evidence to that effect in response to Procedural Order No. 1.

The Complainant contends that the disputed domain name is confusingly similar to the Mark since it incorporates the Mark (which is recognisable within the disputed domain name) in its entirety, under the country-code Top-Level Domain ("ccTLD") ".ir".

The Complainant confirms that the disputed domain name was registered by the Respondent without its permission, that the Respondent has not acquired trade mark rights in the Mark and that the Respondent is not a licensee of nor authorized by the Complainant. It alleges that the Respondent has been using the disputed domain name to create a likelihood of confusion among Internet users and to mislead them into thinking that the disputed domain name, and any associated website, is affiliated with the Complainant.

The Complainant submits that there is no evidence to suggest that the Respondent: has been commonly known by the disputed domain name; is making, or intends to make, a legitimate noncommercial or fair use of it or has ever used or demonstrated preparations to use it in connection with a *bona fide* offering of goods or services.

The Complainant submits that the Respondent must have known of the Mark when it registered the disputed domain name. The Mark, according to the Complainant, is distinctive as it is the name of the founder of the Complainant. The Complainant further alleges that the Mark is well known throughout the world but has provided no evidence with the Complaint to support that contention. The Complainant referred the Panel to a website "for more details about the Complainant" but that website does not appear to have any mention of the Complainant.

Finally, the Complainant argues that the Respondent has used the disputed domain name to attempt to attract Internet users to its website "for commercial gain" through the offering of the disputed domain name for sale and through the use of links to other businesses, having created a likelihood of confusion with the

Mark, contrary to the Policy. Together, the Complainant submits that the disputed domain name has been registered or is being used in bad faith.

B. Respondent

The Respondent did not reply substantively to the Complaint. He did, however, send an email to the Center on November 9, 2022, stating that the disputed domain name had been registered for a customer (the Respondent describing himself as a web designer) and that he would be willing to transfer the disputed domain name to the Complainant. As a result, this case was suspended pending discussions between the Complainant and the Respondent. In an email dated December 12, 2022, the Complainant confirmed that they had received no further contact from the Respondent and asked for the case to be reinstated. The Respondent again emailed the Center on December 12, 2022, asking for details regarding the transfer process. These were provided to the Respondent by the Center in an email dated December 13, 2022. No further correspondence and no substantive reply to the Complaint was received from the Respondent and the case was reinstituted on December 19, 2022.

6. Discussion and Findings

6.1 Procedural Order No. 1.

The Panel issued Procedural Order No. 1 as set out above requesting the Complainant to provide evidence to support a number of its propositions.

In the current proceeding, the Panel has concluded that while it is by no means the Panel's role to do the Complainant's work for it, the most efficient and equitable course of action for all parties and for the administration of the Policy in general, is to issue a Procedural Order requiring further submissions on any missing evidence which is material to the merits of the case.

Accordingly, the Panel has decided that for reasons of: i) procedural economy; and ii) fairness to all parties, the correct course of action in this proceeding was for the Panel to ask the Complainant to support its allegations. Those parts of the Complainant's response which did not relate to the Panel's requests as set out in Procedural Order No. 1 have not been considered in deciding the Complaint.

6.2 Application of the Policy

Under paragraph 4(a) of the Policy, the Complainant bears the burden of proving that:

- a) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- b) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- c) the disputed domain name has been registered or is being used in bad faith.

These criteria are cumulative. The failure of the Complainant to prove any one of these elements means the Complaint must be denied.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant is the owner of, and therefore has rights in, the Mark. Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)") provides that: "[I]n 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".

The Panel therefore finds that the disputed domain name is confusingly similar to the Mark, since the disputed domain name incorporates the Mark in its entirety. The use of the ccTLD “.ir” does not prevent a finding of confusing similarity.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Although a complainant is required to demonstrate that a respondent has no rights or legitimate interests in respect of the domain name, as explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view of previous UDRP panels is that where a complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the current proceeding, the Complainant has established its *prima facie* case. The evidence before the Panel is that the Mark has some degree of inherent distinctiveness that, in all the circumstances of this Complaint, makes a coincidental adoption by the Respondent highly unlikely. The Complainant states that it has not given the Respondent permission to use the Mark, in a domain name or otherwise, and submits that the Respondent has not been commonly known by the disputed domain name.

There is no evidence that the Respondent has acquired any common law rights to use the Mark, is commonly known by the Mark or has chosen to use the Mark in the disputed domain name in any descriptive manner or is making any use of the disputed domain name that would establish rights or legitimate interests as a result of a noncommercial or fair use of it.

By limiting his substantive participation in these proceedings to a simple comment that the disputed domain name was purchased for a third party, the Respondent has failed to refute the Complainant's *prima facie* case that it has met its burden under the second UDRP element.

As clearly stated in section 2.1 of the [WIPO Overview 3.0](#), “a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed”.

Furthermore, the disputed domain name, which is identical to the Complainant's Mark, carries a high risk of implied affiliation.

Having reviewed and weighed the available evidence, the Panel finds that the Complainant has demonstrated that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered or Used in Bad Faith

The Panel notes that the disputed domain name was registered after the Mark was registered and accepts that the disputed domain name was chosen by reference to the Mark.

As a result, and in the absence of evidence from the Respondent that the similarity of the disputed domain name to the Mark is coincidental, the Panel must conclude that the Respondent knew of the Complainant's rights in the Mark when it registered the disputed domain name, regardless of it having been said to have been registered on behalf of a third party.

The Panel therefore finds that the Respondent's registration of the disputed domain name was in bad faith (whether of the Respondent or of those on whose instructions the disputed domain name was registered) since it attempted to appropriate for the Respondent or a related third party, without the consent or authorisation of the Complainant, rights in the Complainant's Mark.

The disputed domain name is also being used in bad faith by seeking commercial gain, either through the sale of the disputed domain name or through the promotion of links to websites appearing on the website to which the disputed domain name directs Internet users. The Panel has not been made aware of, and does not know of, any use of the disputed domain name by the Respondent that would not be illegitimate and therefore there is no basis for the Panel to conclude that the Respondent's use of the disputed domain name is justified.

Therefore, and on the basis of the information available to it, the Panel finds that the Respondent's use of the disputed domain name is without justification and is inconsistent with the Complainant's exclusive rights in the Mark. Consideration of these and other factors militates in favour of a finding of bad faith.

The Panel finds that the Respondent has registered and is using the disputed domain name 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 name <eliesaab.ir> be transferred to the Complainant.

/Gareth Dickson/

Gareth Dickson

Sole Panelist

Date: February 17, 2023