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JACQUEMUS SAS, Paris vs Furst Phillipp, DE
INDRP Case no. 1787
 Arbitrator: Mr. P.K.Agrawal

1 | Page

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PRABODHA KUMAR

AWARD

1. The Parties

The Complainant is JACQUEMUS SAS 69 rue de Monceau – 75008 Paris.

The Respondent is Furst Phillipp, Waldowstr. 24, Oberrot, DE 74420.

2. The Domain Name and Registrar

The disputed domain name is <jacquemusbags.co.in>. The said domain name is registered with the Registrar – NameCheap, Inc. (IANA ID: 1068). The details of registration of the disputed domain name (as per WHOIS details relevant to the Complaint) are as follows:

- a. Domain ROID: CD9A692754CEC446CA5DA304B3CD5B9B7-IN
- b. Date of creation: Sept 21, 2023.
- c. Expiry date: Sept 21, 2024.

3. Procedural History

- (a) A Complaint dated 9.11.2023 by the Complainant has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the domain name at issue. The print outs confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.
- (b) The Exchange appointed the undersigned Mr. P.K.Agrawal, Former Addl. Director General in the Government of India, as the sole Arbitrator in this matter. The Arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.
- (c) In accordance with the Policy and the Rules, the copies of complaint with annexures were sent by the National Internet Exchange of India on 4.12.2023 by email. The Arbitrator served the Notice under Rule 5(C) of INDRP Rules of procedure along-with copies of complaint and annexures to the parties through email on 4.12.2023. The Complainant was advised to serve copies of the domain complaint along with complete set of documents in soft copies as well as in physical via courier or post to the

Respondent Registrant at the address provided in the WHOIS details of the domain. The Respondent was given 14 days' time by the Arbitrator through Notice dated 4.12.2023 for reply. The Notice email was served upon the Respondent email id given in WHOIS details, which was delivered. The Complainant confirmed on 5.12.2023 / 18.12.2023 through emails that the complaint with annexures was communicated to the Respondent through email, and physically sent to the Respondent on 5.12.2023 through International Mail. In view of this, the Complaint and its annexures may be regarded to have been served to the Respondents as per Arbitration and Conciliation Act, 1996 and INDRP rules. The Respondent has not responded to the Notice. Since the Respondent has not responded and presented any grounds in his defence, the present proceedings have to be conducted *ex parte* as per the Arbitration and Conciliation Act, 1996 and the .IN Domain Name Dispute Resolution Policy and the Rules of Procedures framed there under.

4. Factual Background

The Complainant in this arbitration proceedings is JACQUEMUS SAS 69 rue de Monceau – 75008 Paris. The Complainant is a French company which manufactures and markets since 2013 clothing and fashion accessories under the trademark “JACQUEMUS”. According to the Complainant, JACQUEMUS is known worldwide in the fashion industry, notably for the quality and originality of its creations. Its famous designer, Simon PORTE JACQUEMUS, is considered to be one of the most important designers in the fashion industry. JACQUEMUS products are now sold in 50 different countries around the world.

JACQUEMUS is the owner of numerous trademarks in the world (hereinafter, the “Trademarks”) including:

- The French trademark “JACQUEMUS” registered on December 24, 2013 under No. 4057016 in classes 9, 18 and 25;
- The European trademark “JACQUEMUS” registered on June 11, 2019 under No. 18080381 in classes 14, 24 and 28;
- The International trademark “JACQUEMUS” registered on February 5, 2014, under No. 1211398 in classes 9, 18 and 25, designating notably India;
- The International trademark “JACQUEMUS” registered on November 19, 2019 under No. 1513829 in classes 14, 24 and 28, designating notably India.

JACQUEMUS is also the owner of the domain name <jacquemus.com>, registered in 2010.

Respondent's Identity and Activities

The Complainant claims that the Litigious Domain Name leads to a website offering for sale alleged counterfeiting products. Indeed, the prices displayed, the lack of legal information, the reproduction of original pictures from JACQUEMUS' official website and the mention that this website sell original products are indications clearly suggesting that the products sold on the website are infringing JACQUEMUS' rights.

The Complainant sent a cease-and-desist letter on October 5th, 2023 to the registrar, but he did not receive any answer.

The Respondent has neither responded to the Notices served upon him nor submitted any reply to the complaint.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to **element (i)**, the Complainant submits that the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

According to the Complainant, the Complainant is the owner of several Trademarks in the world duly exploited notably for clothing and accessories. The Trademarks are duly exploited and well-known throughout the world, notably in the fashion industry in classes 18, 24 and 25. The Litigious Domain Names www.jacquemusbags.co.in consists of the Trademarks in their entirety followed by the terms "*bags*" and by the generic Top-Level "*.co.in*". These additional elements do not prevent a finding of confusing similarity. On the contrary, the addition of the word "*bags*" will lead the internet user to believe that the Litigious Domain Name is a new website dedicated to the sale JACQUEMUS's bags. In addition, Trademarks are clearly recognizable within the Litigious Domain Names.

The Complainant argues that it is well established by numerous previous UDRP decisions concerning JACQUEMUS 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 Disputed Domain Names, the Disputed Domain Names will normally be considered confusingly similar to that mark for purposes of UDRP standing (WIPO Case regarding the domain name www.jacquemusjewelry.com, No. D2019-3144 ; WIPO Case regarding the domain name www.jacquemusventesprivees.com, No. D2019-2765; WIPO Case

regarding the domain name www.fashionjacquemus.com No. D2020-2073; WIPO Case regarding the domain name www.jacquemus.eu No. DEU2020-0024; WIPO Case regarding <jacquemusbagshop.com> and <jacquemusbagstore.com> No. D2021-3296)

Finally, the generic Top-Level “.co.in” is generally accepted as irrelevant when assessing whether the Litigious Domain Name is identical or confusingly similar to a trade mark as it is a functional element (INDRP/1672 – MakeMyTrip (India) Private Limited against Adesh Kumar)

Therefore, this use of the Trademarks in the Litigious Domain Names leads the public to believe that the Respondent Litigious Domain Names belong to the Complainant.

Accordingly, the Complainant contends that the first condition that Respondent's domain name is identical or confusingly similar to a name, trademark, or service mark in which the Complainant has rights, as per Paragraph 4 (a) of the Policy has been satisfied.

In relation to **element (ii)**, the Complainant contends that the Respondent does not have any right or legitimate interest in <jacquemusbags.co.in>.

The Complainant submits that the NIXI has already stated, regarding the case of Fila Luxembourg SARL v. Phillip Kaestner Case No. INDRP/1487 that the Respondent has no rights or legitimate interests in respect of the domain name if:

“a) The Respondent has never been authorized by the Complainant to register the disputed domain name, which clearly exploits the latter's registered trademarks, name and identity.

b) The Respondent has never been authorized or licensed by the Complainant to sell products under the FILA trademarks.

c) Consumers were given the impression of navigating on an official FILA website dedicated to the distribution of products produced by the Complainant by using the FILA trademark in the domain name and the website. There is a clear commercial interest of the Respondent to use the FILA Trademark and associate its image with the FILA reputation to attract consumers to mislead consumers into believing it to be an official FILA website and consequently, achieve commercial gain.

d) Accordingly, it is sufficient that Complainant shows prima facie evidence in order to shift the burden of production on Respondent.”

Yet; The Complainant has never authorized the Respondent to register and/or use any domain name incorporating the Trademarks. The Complainant has not granted any license, nor any authorization to use the

Trademarks, included as a domain name or for setting up a website selling alleged counterfeit Complainant's products.

Thus, the Respondent has not made a legitimate non-commercial or a fair use of the Litigious Domain Name. Indeed, the Litigious Domain Name pointed out to a website offering for sale alleged counterfeiting products. Therefore, the Respondent's use does not qualify as *bona fide* offer of goods and services.

Based on the above-mentioned arguments, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, as per Paragraph 4 (b) of the Policy.

Regarding the **element (iii)**, the Complainant contends that the Domain Name has been registered and used in bad faith for the following reasons:

(i) Bad faith because of the fame of JACQUEMUS Trademarks

The Arbitration and Mediation Centre has already stated, regarding *The Gap, Inc. v. Deng Youqian* case that: (WIPO Arbitration and Mediation Centre no. D2009-0113, *The Gap v. Deng Youqian*).

"Complainant's first contention of bad faith is based on the argument that at the time of registration of the disputed domain names Respondent knew, or at least should have known, the existence of Complainant's trademarks, and that registration of a domain name containing well-known trademarks constitutes bad faith per se. The Panel finds that, in addition to GAP and OLD NAVY, the BANANA REPUBLIC trademark has also acquired extensive and worldwide reputation and is to be regarded as a well-known trademark. As one panel held before, "the Complainant's worldwide reputation, and presence on the Internet, indicates that Respondent was or should have been aware of the marks prior to registering the disputed Domain Name". Caesar World, Inc. v. Forum LLC, WIPO Case No. D2005-0517. In light of the reputation of the GAP, BANANA REPUBLIC and OLD NAVY trademarks, it is clear that Respondent in all likelihood knew of the existence of Complainant's trademarks. In addition, the Panel concurs with previous WIPO UDRP decisions holding that registration of a well-known trademark as a domain name is a clear indication of bad faith in itself, even without considering other elements. See Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., WIPO Case No. D2000-0163; PepsiCo, Inc. v. "null", aka Alexander Zhavoronkov, WIPO Case No. D2002-0562; Pepsico, Inc. v. Domain Admin, WIPO Case No. D2006-0435."

The Complainant contends that it is unquestionable that the Complainant's Trademarks registrations pre-date the registration of the

Litigious Domain Name. The Trademarks have acquired extensive and worldwide reputation and should thus be considered as well-known. Indeed, the Arbitration and Mediation Centre has already recognized the reputation of the Trademarks in previous decisions regarding domain names using Jacquemus's trademark (WIPO Case regarding the domain name www.jacquemusjewelry.com, No. D2019-3144 ; WIPO Case regarding the domain name www.jacquemusventesprivees.com, No. D2019-2765; WIPO Case regarding the domain name www.fashionjacquemus.com No. D2020-2073; WIPO Case regarding the domain name www.jacquemus.eu No. DEU2020-0024; WIPO Case regarding [<jacquemusbagshop.com>](http://jacquemusbagshop.com) and [<jacquemusbagstore.com>](http://jacquemusbagstore.com) No. D2021-3296). Consequently, the choice of the Litigious Domain Name does not seem to be a mere coincidence, but on the contrary seems to have been done on purpose to generate a likelihood of confusion with the Domain Name and the Trademarks.

The Trademarks are well-known, so in application with the Panel's previous decision, it shall be deemed that the registration of the Litigious domain name has been done per se in bad faith.

(ii) Bad faith because of the litigious website's content

The Complainant submits that the website linked to the Litigious Domain Name is a website offering for sale alleged JACQUEMUS's products and using original pictures from its official website which constitute bad faith. (HBI Branded Apparel Enterprises, LLC v. Xu Gueijuan; Rueitao Xiao; Gueijuan Xu, Case No. D2018-2542). Therefore, it appears that the Litigious Domain Name has been used to take advantage of the reputation of the Trademarks to intentionally attempted to attract, for commercial gain, Internet users to the litigious website.

In this context, there is no doubt that the registration of the Litigious domain name has been done in bad faith.

iii) Bad faith because of the will of the Respondent to hide its identity

The Complainant further submits that the WHOIS of the Litigious Domain Name is anonymous, indeed the Registrant is using a "whois protection service". Moreover, there is no address and no legal information regarding the company operating the website. In this matter, the NIXI has already stated that "*The Fact that the Respondent registered the Disputed Domain Name using incomplete Whois contact information also indicate bad faith at the time of the registration*" (INDRP CASE no. 1642 / Meta c/ Mika Khan, February 6th, 2023.).

The Complainant argues that the information about the registrant seems fake. Indeed, Philipp Fürst is the name of a famous German gymnast who competed in the Olympics in the 60's. Furthermore, it appears that Oberrot does not have a street called Waldstraße.

In view of the aforesaid, the Complainant submits that the disputed domain name has been registered and is being used in bad faith, and that paragraph 4(c) of the INDRP is satisfied.

B. Respondent

The Respondent has neither responded to the Notice nor submitted his reply.

6. Discussion and Findings

The Rules instruct this arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

- (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant's has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant's domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name <jacquemusbags.co.in> was registered by the Respondent on Sept 21, 2023.

The Complainant is an owner of the registered trademark JACQUEMUS for the last many years. The Complainant is also the owner of the similar domains as referred to in the Complaint. These domain names and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. In the present case the disputed domain name is <jacquemusbags.co.in>. Thus, the disputed domain name is very much similar to the name, activities and the trademark of the Complainant.

The Hon'ble Supreme Court of India has held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for

JACQUEMUS products would mistake the disputed domain name as of the Complainant.

In the case of *Wal Mart Stores, Inc. v. Richard MacLeod*, (WIPO Case No. D2000-0662) it has been held that "When the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" it is identical or confusingly similar for purposes of the Policy.

Therefore, I hold that the domain name <jacquemusbags.co.in> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant'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 Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant is making a legitimate non-commercial 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.

In Case No. INDRP/776, *Amundi v. GaoGou*, the arbitration panel found that the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4 (II) of the INDRP Policy.

There is no evidence to suggest that the Respondent has been known by the disputed domain name anywhere in the world. The name of the Registrant / Respondent is not JACQUEMUS as per WHOIS details. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed, or otherwise permitted the Respondent to use its name or trademark JACQUEMUS or to apply for or use the domain name incorporating said trademark. The domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

As has been contended by the Complainant, the Respondent is not making a legitimate, fair or bona fide use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name <jacquemusbags.co.in> under INDRP Policy, Para-4(ii).

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant 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 Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's

website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

In WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe - "Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use."

The circumstances as evident from the foregoing paragraphs lead to the conclusion that the domain name in dispute was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the domain name was registered in bad faith and is being used in bad faith, it is clear beyond doubt that the Respondent has violated the provisions of Rule-3 of the Policy. Therefore, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <jacquemusbags.co.in> be transferred to the Complainant.

No order to the costs.



Prabodha K. Agrawal

Sole Arbitrator

Dated: 19th Dec, 2023