

## **ADMINISTRATIVE PANEL DECISION**

Jacob Cohën Company SpA v. Sion Capper, Sion  
Case No. D2022-2110

### **1. The Parties**

The Complainant is Jacob Cohën Company SpA, Italy, represented by Dr. Modiano & Associati S.p.A., Italy.

The Respondent is Sion Capper, Sion, United States of America (“USA”).

### **2. The Domain Name and Registrar**

The disputed domain name <jacobcohan.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 10, 2022. On June 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 11, 2022, the Registrar 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 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 sent notification to the Respondent of the Complaint, and the proceedings commenced on June 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 5, 2022. The Respondent did not submit any response. Accordingly, the Center sent notification of the Respondent’s default on July 12, 2022.

The Center appointed Petra Pecar as the sole panelist in this matter on July 15, 2022. 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 Jacob Cohën Company SpA is a joint stock company, incorporated under Italian law with its principal place of business in Milan, producing luxury denim since 1985. The brand closed the financial year 2018 with sales of approximately EUR 80 million. In addition to the stores directly owned and managed by the Complainant, the brand is sold through around 1,400 selected multiband stores, including 16 monoband stores and 30 corners and shop-in-shops.

The Complainant is the owner of national and international registered trademarks for the marks that consist of an imprint depicting the wording JACOB COHËN. Some of the trademark owned by the Complainant are:

- Italian national figurative trademark  Reg. No. 0001594786, registered on May 19, 2014;
- International figurative trademark  Reg. No. 1398399 registered on September 8, 2017, designating, *inter alia*, the USA and
- International figurative trademark  Reg. No. 844885A registered on August 13, 2004, designating, *inter alia*, the USA.

The Complainant provided proof that it holds, among others, the domain names <jacobcohen.com> registered on January 24, 2000, <jacob-cohen.com> registered on February 24, 2004, <jacob-cohen.net> registered on December 13, 2019, <jacobcohen.net> registered on July 15, 2005, <jacob-cohen.biz> registered on December 13, 2019, <jacobcohen.biz> registered on December 13, 2019, <jacob-cohen.info> registered on December 13, 2019, <jacobcohen.fr> registered on September 4, 2013, <jacob-cohen.us> registered on January 30, 2020 and <jacobcohen.us> registered on September 4, 2013.

Based on the Whois information, as confirmed by the Registrar, the Respondent is an individual based in the USA.

The disputed domain name was registered on April 4, 2022, and does not resolve to an active website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant states that it holds trademark registrations for the mark JACOB COHEN, which has been extensively used by the Complainant since 1985 and which are also valid in the USA. This use has continually grown the goodwill and reputation of the trademark, which is therefore a valuable and important asset of the company.

The Complainant contends that the disputed domain name is confusingly similar or almost identical to the trademark JACOB COHEN and domain names <jacobcohen.com>, <jacobcohen.net>, <jacobcohen.us>, and <jacobcohen.biz>. The disputed domain name differs from the Complainant's trademark in the replacement of the letter "ë" with the letter "a" in the name COHEN which is not sufficient to avoid confusion and to prevent a finding of confusing similarity with the Complainant's JACOB COHEN trademark.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The disputed domain is used in an email scheme to mislead the Complainant's clients in order to induce them to make payments for orders made to a bank account not affiliated with the

Complainant. The Respondent used the disputed domain for email addresses that reproduce almost identically those of the Complainant, with the purpose of misleading the Complainant's clients into believing that the contents of emails are genuine. The Respondent has never been known under the JACOB COHEN and/or similar names.

The Complainant contends that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. The Complainant's trademark and logo have become internationally well-known marks through massive advertising and through the high level of quality of the products and/or services offered, making it evident that the Respondent could not have been unaware of the Complainant's trademarks. Therefore, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Even if the Respondent did not file a Response to the Complainant's contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant. "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (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 by the Respondent in bad faith.

### **A. Identical or Confusingly Similar**

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must, firstly, establish rights in a trademark or service mark and, secondly, establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

A trademark registration provides a clear indication that the rights in the trademark belongs to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.2.1). The Panel finds that the Complainant has provided evidence of ownership of registrations for the JACOB COHĚN trademark, demonstrating that it has rights in the JACOB COHĚN trademark, through a number of registrations and use.

The Panel finds that the disputed domain name incorporates the Complainant's trademark JACOB COHĚN, with a single letter difference in the word COHĚN, where the letter "a" is placed instead of the letter "ě" (COHĚN/ COHAN). In accordance with section 1.9 of [WIPO Overview 3.0](#), a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark JACOB COHĚN, since the trademark remains recognizable.

The disputed domain name also includes the generic Top-Level Domain (“gTLD”) “.com”. It is well accepted practice by UDRP panels that a gTLD, such as “.com”, is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In accordance with the above, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its JACOB COHĚN mark.

## **B. Rights or Legitimate Interests**

Under the second element of the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also [WIPO Overview 3.0](#), section 2.1).

Moreover, the Policy provides guidance to respondents on how to demonstrate rights or legitimate interests in a domain name. In particular, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name, including: (i) use of the domain name “in connection with a *bona fide* offering of goods or services”; or (ii) demonstration that the Respondent has been “commonly known by the domain name”; or (iii) “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 thus did not deny the Complainant’s assessment, nor brought any information or evidence demonstrating any rights or legitimate interests in respect of the disputed domain name. Therefore, the Complainant has made a *prima facie* case showing that the Respondent does not have any rights or legitimate interests in the disputed domain name, particularly by asserting that the Respondent is not connected with the Complainant, nor affiliated with it in any way, and that it never authorized, licensed, or permitted the Respondent to use its trademark as part of the disputed domain name. The Respondent is not commonly known under the disputed domain name, does not own any rights in the JACOB COHĚN mark, and does not make any *bona fide* use – either commercial or noncommercial, of the same.

Furthermore, the disputed domain name has been used as part of a phishing scheme to mislead Internet users, most likely for illicit purposes, with the Respondent not disputing the Complainant’s contentions or responding to this matter in any way. “UDRP panels have categorically held that the use of a domain name for illegal activity (*e.g.*, the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent” (see [WIPO Overview 3.0](#), section 2.13.1). Given the phishing scheme that the Respondent operated by impersonating the Complainant’s staff, such use of the disputed domain name cannot confer rights or legitimate interests on the Respondent.

The Panel therefore finds that the Complainant has made a *prima facie* demonstration of the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent, and that the Complainant has accordingly established the second element of the Policy in accordance with paragraph 4(a)(ii).

## **C. Registered and Used in Bad Faith**

The third element of paragraph 4(a) of the Policy requires the Complainant to demonstrate that the Respondent registered and is using the disputed domain name in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a Respondent’s bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other

online location by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

The Complainant has substantiated that its trademark JACOB COHĚN was registered in 2004, 18 years before the registration of the disputed domain name, and was also used for registering domain names before the registration of the disputed domain name. Regarding the prior registration of the Complainant's trademarks, as well as its reputation, it seems unlikely and implausible that the Respondent was unaware of the activities of the Complainant and of the existence of its trademarks JACOB COHĚN at the time of registration of the disputed domain name.

The disputed domain name consists of an obvious typosquatting variant of the Complainant's distinctive trademark. It does not resolve to an active webpage and was most likely intended for illicit purposes, since the Complainant provided evidence of use of the disputed domain name to send emails originating from email addresses almost identical to existing email addresses of the Complainant's staff.

Moreover, panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. [...] Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers. (see [WIPO Overview 3.0](#), section 3.4). The sending of fraudulent emails and perpetrating a phishing scheme to solicit payment of fraudulent invoices is precisely what occurred here and such behavior of the Respondent can be observed as a clear evidence of use of the disputed domain name in bad faith.

Further, UDRP panels have found that email-based phishing schemes that use a complainant's trademark in a domain name are evidence of bad faith (see, e.g., *DeLaval Holding AB v. Registration Private, Domains By Proxy LLL / Craig Kennedy*, WIPO Case No. [D2015-2135](#)).

Furthermore, by registering the disputed domain name as an obvious typosquatting variant of the Complainant's trademark, the Respondent has engaged in typosquatting, since the disputed domain name differs minimally from the Complainant's JACOB COHĚN trademark, by changing only a letter "ě" to a letter "a". In conjunction with other evidence, use of typosquatting domain name appears to be a part of thoroughly prepared Internet fraud scheme used with the clear aim of monetary gain on the Respondent's side.

Given these circumstances and the fact that the Respondent failed to submit a response or to provide any evidence of actual possible good-faith use (which are very unlikely to exist, given the evidence of online fraud provided by the Complainant), the Panel concludes that the Respondent's registration and use of the disputed domain name is in bad faith. Accordingly, the Complainant has satisfied 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 <jacobcohan.com> be transferred to the Complainant.

*/Petra Pecar/*

**Petra Pecar**

Sole Panelist

Date: July 29, 2022