

ADMINISTRATIVE PANEL DECISION

S.T. DUPONT v. Minesh Bhindi

Case No. D2023-1401

1. The Parties

The Complainant is S.T. DUPONT, France, represented by Cabinet IPSILON, France.

The Respondent is Minesh Bhindi, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <stdupont.com> (the “Disputed Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 31, 2023. On March 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 31, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 4, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On April 5, 2023, the Respondent sent an email to the Center simply mentioning “What is this?”, referring to the Center’s Notice of Registrant Information. The Center replied on April 6, 2023, by explaining that it was verifying the Complaint and that the Respondent would be notified if an administrative proceeding is commenced pursuant to the UDRP.

The Complainant filed an amended Complaint on April 6, 2023. On April 7, 2023, the Respondent replied by asking the Complainant if it would like to discuss a sale of the Disputed Domain Name. Following an invitation by the Center to suspend the proceedings if the parties wished to explore settlement options, the Complainant indicated on April 12, 2023, that it did not wish to discuss neither to suspend the proceedings.

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 April 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2023. On May 5, 2023, the Center informed the Parties that it would proceed to Panel Appointment.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on May 16, 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, S.T. Dupont, is a French manufacturing company based in Paris, which has been making luxury goods since its founding in 1872. Products commercialised include lighters, collectible pens, cigarettes, handbags, perfumes *etc.*

The Complainant holds numerous registered trademarks consisting of or including S.T. DUPONT, including the following:

-  , international mark registered under No. 276547 on November 22, 1963, for products in class 34 covering “lighters, gas lighters and all articles for smokers”;
-  , UK mark registered under No. UK00000928099 on July 16, 1968, for products in class 34.

The Complainant also owns various domain names such as <st-dupont.com>, which resolves to its official website.

The Disputed Domain Name was registered on March 25, 1997 and appears to resolve to a website offering products similar to the Complainant’s products.

5. Parties’ Contentions

A. Complainant

In summary, the Complainant considers the Disputed Domain Name to be identical to trademarks in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant:

- the Respondent has not been licensed, contracted or otherwise permitted by the Complainant in any way to use the S.T. DUPONT marks or to register for any domain name incorporating the S.T. DUPONT marks, nor has the Complainant acquiesced in any way to such use or registration of the S.T. DUPONT marks by the Respondent;
- the Respondent is also not engaged in any *bona fide* activity that could give rise to rights or legitimate interests in the Disputed Domain Name, but rather attempts to exploit the reputation of the Complainant’s S.T. DUPONT trademarks for its own commercial gain by misleading and diverting Internet users from the Complainant to its own website.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. In the Complainant's view, it is inconceivable that the Respondent ignored the Complainant or its earlier rights on the term S.T. DUPONT given the reputation of the Complainant's trademarks and the identity between these and the Disputed Domain Name. The Complainant claims that by using the Disputed Domain Name, the Respondent intentionally tried to attract Internet users by creating a likelihood of confusion with the Complainant's marks. The traffic generated on the Disputed Domain Name through the confusion caused in the consumers' minds by the use of S.T. DUPONT by the Respondent, generated income for the Respondent and disrupts the Complainant's business.

B. Respondent

The Respondent did not reply to the Complainant's contentions. In its communication of April 7, 2023, the Respondent indicated that it bought the Disputed Domain Name "fair and square when it became available on GoDaddy.com" and asked whether the Complainant wanted to discuss a sale. The Respondent also added the following:

"Clearly, someone in your client's team needs to be fired for leaving it available to purchase via GoDaddy.com for so long."

6. Discussion and Findings

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, 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.

The Panel will therefore deal with each of these requirements.

A. Identical or Confusingly Similar

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are trademarks in which it has rights. The Complainant's S.T. DUPONT trademarks have been registered and used in connection to the Complainant's luxury products including lighters and other articles for smokers.

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether

the mark is recognizable within the disputed domain name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))).

It is well established that generic Top-Level Domains (“gTLDs”), here “.com”, may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

The Disputed Domain Name matches all textual elements of the Complainant’s S.T. DUPONT trademarks except for the removal of the two dots and the space. The Panel therefore finds that the Disputed Domain Name is identical to the Complainant’s mark as the omitted characters cannot be included in domain names due to technical restrictions.

In light of the above, the Panel considers the Disputed Domain Name to be identical to the Complainant’s S.T. DUPONT mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make out a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel notes that the Respondent has not apparently been commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is “Minesh Bhindi” from the organisation “Gold And Silver For Life LLC”. The Respondent’s use and registration of the Disputed Domain Name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent exists or existed.

Fundamentally, a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant’s mark is often central to this inquiry. Where a domain name is identical to a complainant’s trademark, UDRP panels have largely held that it carries a high risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name incorporates the Complainant’s S.T. DUPONT mark in its entirety, simply leaving out the two dots and the space. Therefore, the Panel finds that the Disputed Domain Name cannot constitute *bona fide* or even fair use.

Beyond looking at the composition of the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Panel observes that the Disputed Domain Name refers to a website offering products similar to the Complainant’s products. In the Panel’s view, this does not amount to a legitimate noncommercial or fair use of the Disputed Domain Name.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In the present case, the Panel finds that the Respondent must have been aware of the Complainant and its trademark rights when it registered the Disputed Domain Name:

- some of the Complainant's marks predate the registration of the Disputed Domain Name by more than two decades or even more, including in the United Kingdom where the Respondent appears to be located;
- the Disputed Domain Name is identical to the Complainant's trademark;
- the website linked to the Disputed Domain Name appears to offer products directly competing with the Complainant's products; and
- in its communication of April 7, 2023, the Respondent stated the following: "Clearly, someone in your client's team needs to be fired for leaving [the Disputed Domain Name] available to purchase via GoDaddy.com for so long." In the Panel's view, such statement may be considered as an acknowledgement of the Complainant's rights in the circumstances of this case.

In the Panel's view, the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#)).

The Respondent uses the Disputed Domain Name to resolve to a website which appears to offer products which directly compete with the Complainant's products. Even though these products are offered under a brand different from the Complainant's mark, the Panel finds that the use of a domain name identical to the Complainant's mark indicates that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

By failing to provide a substantive response to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is established that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last element 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 <stdupont.com> be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: May 31, 2023