

## **ADMINISTRATIVE PANEL DECISION**

Im Production v. COMPANY MINDED PTY LTD

Case No. DAU2023-0021

### **1. The Parties**

The Complainant is Im Production, France, represented by Nameshield, France.

The Respondent is COMPANY MINDED PTY LTD, Australia.

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

The disputed domain name <isabelmarantsale.com.au> is registered with Web Address Registration Pty Ltd.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 21, 2023. On April 21, 2023, the Center transmitted by email to Web Address Registration Pty Ltd a request for registrar verification in connection with the disputed domain name. On April 24, 2023, Web Address Registration Pty Ltd 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 .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au 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 April 26, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was May 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 17, 2023.

The Center appointed Staniforth Ricketson as the sole panelist in this matter on May 22, 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 is a French fashion house founded in 1995 that specialises in the manufacturing and making of ready-to-wear clothing, shoes handbags and jewellery. The Complainant markets these products under the brand "ISABEL MARANT", and has stores in France and in a number of other countries around the world (see Complaint, Annex 3).

The Complainant owns a large portfolio of trade marks that include the words "ISABEL MARANT". These include the following registrations (Complaint, Annex 4):

- Australian trade mark ISABEL MARANT n° 979681 registered since October 6, 2003 in class 25 (clothing);
- International trade mark ISABEL MARANT n° 1284453, registered since November 16 2015;
- International trade mark MARANT n° 1627354, registered since June 21, 2021.

The Complainant also owns multiple domain names containing the wording "ISABEL MARANT". These include <isabelmarant.com> registered on April 20, 2002 and <isabelmarant.com.au> registered on July 20, 2017 (Complaint, Annex 5).

The disputed domain name <isabelmarantsale.com.au> resolves to an online store that looks very similar to the Complainant's online website (Complaint, Annexes 6 and 7). It is unclear whether the clothing and other items advertised there are genuine articles manufactured by the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that the disputed domain name is identical or confusingly similar to its registered trade marks and domain names within the meaning of paragraph 4(a)(i) of the the Policy. It has provided evidence that it is registered as the owner of several Australian and international trade marks comprising the words ISABEL MARANT and therefore has rights in these marks as required for the purposes of paragraph 4(a)(i) of the Policy. It argues further that the suffix "sale" in the disputed domain name is insufficient to avoid the possibility of confusion, and that the ccTLD ".com.au" is also to be ignored in making the necessary comparison. It therefore asserts that the disputed domain name is confusingly similar to its registered trade marks (and also its own registered domain names).

The Complainant asserts further that the Respondent has no rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy, noting in particular that the Respondent is not known by the disputed domain name but rather is identified in the Whois database as "Company Minded Pty Ltd". The Respondent is not known to the Complainant and has no authorisation from the Complainant to use the disputed domain name in its business. The Complainant alleges further that the disputed domain name resolves to a website on which goods purportedly made by the Complainant appear, meaning that the Respondent is asserting a connection or association with the Complainant that does not exist. Overall, the Complainant asserts that none of this demonstrates or points to any rights or legitimate interests in the disputed domain name on the part of the Respondent.

The Complainant alleges finally that the registration and subsequent use of the disputed domain name by the Respondent has been in bad faith within the meaning of paragraph 4(a)(iii) of the Policy. In this regard, the Complainant argues that it is reasonable to suppose that the registration was effected with full knowledge of the Complainant's marks, and that the Respondent's use of the disputed domain name to directly compete with the Complainant is further evidence of bad faith registration and use.

## B. Respondent

The Respondent has not submitted any response to the Complaint.

## 6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark 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 or subsequently used in bad faith.

When a respondent has defaulted and in the absence of exceptional circumstances, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint. Paragraph 15(a) of the Rules then requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

### A. Identical or Confusingly Similar

There are two parts to the inquiry required under paragraph 4(a)(i) of the Policy: the Complainant must demonstrate that it has rights in a trade mark and, if so, the disputed domain name must be identical or confusingly similar to the trade mark.

The Complainant has provided evidence that it owns the registered Australian and International trade marks ISABEL MARANT. The Panel therefore finds that the Complainant has shown that it has rights in the cited marks and meets the first requirement of paragraph 4(a)(i).

As to the issue of identity or confusing similarity, this requires a comparison and assessment of the disputed domain name itself with the Complainant's trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

The disputed domain name differs from the Complainant's Australian and International trade marks ISABEL MARANT only by reason of the addition of the word "sale" and the ccTLD ".com.au". In making the comparison required under paragraph 4(a)(i), however, the presence of the ccTLD ".com.au", may be disregarded as a functional requirement of the domain name system: *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

As for the addition of the word "sale", previous panels have held consistently that domain names are identical or confusingly similar to a trade mark for the purposes of the Policy "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). See also *Bayerische Motoren Werke AG ("BMW") v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs*, WIPO Case No. [D2017-0156](#). The only difference between the Complainant's trade mark and the disputed domain name in the present case is the addition in the disputed domain name of the word "sale", which is apt to describe a website providing sales of products bearing the trade mark ISABEL MARANT.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trade mark and that paragraph 4(a)(i) of the Policy is satisfied.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a 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.

This is an illustrative list only of the situations in which a respondent can show rights or legitimate interests in a domain name.

The Complainant bears the onus of proving this requirement of the Policy, as is the case for each of the other elements listed in paragraph 4(a) of the Policy. Panels have consistently recognized the difficulties that arise where a party has to prove a negative, particularly in situations where much of the relevant information is in, or likely to be in, the possession of the respondent, rather than the complainant. In general, then, it is usually enough for a complainant to state a *prima facie* case against the respondent under this head, with the evidential burden then shifting to the respondent to rebut that case. See e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#); *Wal-Mart Stores, Inc. v. WalMart Careers, Inc.*, WIPO Case No. [D2012-0285](#); *AW Faber-Castell (Aust) Pty Ltd. v. Pen City Pty Ltd. / Atf Diblasi Jones Unit Trust*, WIPO Case No. [DAU2013-0018](#); *OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. [D2015-1149](#).

In the present case, the Complainant states that neither it nor its parent has authorized the Respondent to register or use the disputed domain name or any domain name containing the ISABEL MARANT trade marks. Apart from the Respondent's sale of possibly genuine ISABEL MARANT products on the website to which the disputed domain name resolves, there is no association between the Complainant and the Respondent. In addition, the disputed domain name is not the name of the Respondent nor is it derived from any name by which the Respondent appears to be known. Likewise, it is not reflected in the registration details of the disputed domain name ("Ashley Sadler" and "Company Minded Pty Ltd": see Complaint, Annex 1). In the absence of a response, there has been no indication from the Respondent of any basis on which it might otherwise claim rights or legitimate interests in the disputed domain name.

In these circumstances, the Panel finds that the Complainant has established a clear *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and finds that the requirements of paragraph 4(a)(ii) of the Policy are satisfied.

## C. Registered or Subsequently Used in Bad Faith

In contrast to the Uniform Domain Dispute Resolution Policy (UDRP), under paragraph 4(a)(iii) of the Policy the Complainant must establish that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent (these are disjunctive requirements). Paragraph 4(b) of the Policy then provides the following, non-limiting, list of circumstances which, if present, will be evidence of such registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

- (ii) you have registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location; or
- (v) if any of your representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

In the present Complaint, there is no evidence before the Panel that falls within the circumstance referred to in sub-paragraph (i). In the absence of any response from the Respondent, however, the Panel finds that a *prima facie* case arises of the existence of circumstances falling within the following sub-paragraphs of paragraph 4(b):

1. The registration of the disputed domain name in the “.au.com” space will present difficulties for the Complainant in registering domain names containing the words “Isabel Marant” in that space. Given that the Respondent's registration of the disputed domain name took place on April 16, 2023 and given also that the Complainant's own trade mark and domain name registrations predate this considerably (as far back as 2004 in the case of the Australian registered trade mark and 2002 in the case of <isabelmarant.com>), the clear inference arises that the registration of the disputed domain name was made with the intention referred to in sub-paragraph 4(b)(ii). In the absence of any Response, the Panel concludes that this intention was present. See *e.g. Miltenyi Biotec GmbH v. Rachel A. Liu-Williams*, WIPO Case No. [DAU2015-0033](#); *R S Capital Partners Pty Ltd t/a My SMSF v. Adviser IT Ltd*, WIPO Case No. [DAU2019-0007](#)
2. The use of the disputed domain name, which is confusingly similar to the Complainant's trade marks and domain names, to resolve to a website selling clothing products that may be those of the Complainant (it is unclear whether these were genuine products or not) gives rise to the likelihood that consumers will be confused as whether or not the Complainant is affiliated to, or has sponsored, that website. This is obviously not the case, and, in the absence of any response, the Panel concludes that the circumstances outlined in sub-paragraphs 4(b)(iii) and (iv) by the Complainant also exist. See, *e.g. Entrust Corporation (formerly Entrust Datacard Corporation) v. Unicard Systems Pty Ltd*, WIPO Case No. [DAU2021-0003](#).
3. In view of the world wide operations of the Complainant, it is difficult to escape the more general conclusion that the disputed domain name was not registered with full knowledge of the Complainant's marks and domain names, and that the circumstances outlined in sub-paragraph 4(b)(ii) arise.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is established and that the disputed domain name was registered and is being used in bad faith.

## 7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <isabelmarantsale.com.au> be transferred to the Complainant.

/Staniforth Ricketson/  
**Staniforth Ricketson**  
Sole Panelist  
Date: May 26, 2023