

ADMINISTRATIVE PANEL DECISION

Jung S.A.S. v. Sakshi Taneja, Souvenir..Pty
Case No. DAU2022-0011

1. The Parties

The Complainant is Jung S.A.S., France, represented by AB INITIO, France.

The Respondent is Sakshi Taneja, Souvenir..Pty, Australia.

2. The Domain Name and Registrar

The disputed domain name <backmarket.com.au> 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 May 30, 2022. On the following day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 6, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 2022, providing contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 15, 2022.

The Center verified that the Complaint together with the amended 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 June 17, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was July 7, 2022. The Respondent did not submit any response by the due date. Accordingly, the Center notified the Respondent’s default on July 11, 2022.

The Center appointed Matthew Kennedy as the sole panelist in this matter on July 20, 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.

On July 21, 2022, the Center received an email communication from a third party named Jannan Pavan. Later the same day, in response to a request from the Center, the Respondent asked that all communication be directed to Jannan Pavan's email address, which it confirmed was its correspondence email.

On July 26, 2022, the Panel issued Administrative Panel Procedural Order No. 1, in which it noted that the information for the disputed domain name from the Registrar's Whois database as notified to the Complainant on June 14, 2022 had omitted the disclosed registrant. Accordingly, the Center notified to the Complainant the complete information disclosed by the Registrar and requested that the Complainant amend the Complaint to reflect the verified registrant name by July 29, 2022. The Respondent was given five calendar days to comment and the decision due date was extended to August 9, 2022. The Complainant filed a further amended Complaint on July 28, 2022. The Respondent did not comment.

4. Factual Background

The Complainant provides an online marketplace named "Back Market" for refurbished electronic and electrical products, which it launched in 2014. The Complainant holds multiple trademark registrations in multiple jurisdictions, including the following:

- French trademark registration number 4135314 for BACK MARKET, registered on March 13, 2015, and specifying services in classes 35, 38, and 41;
- International trademark registration number 1415150 for BACK MARKET, registered on January 17, 2018, designating multiple jurisdictions, including Australia, where the mark was protected on December 21, 2020, and specifying goods and services in classes 9, 35, and 37; and
- International trademark registration number 1514729 for a semi-figurative mark featuring the words BACK MARKET, registered on November 19, 2019, designating multiple jurisdictions, including Australia, where the mark was protected on December 21, 2020, and specifying goods and services in classes 9, 35 and 37.

The above trademark registrations remain current. The Complainant has also registered multiple domain names including <backmarket.fr> (registered in 2014), <backmarket.co.uk> (registered in 2015), and <backmarket.com> (acquired no later than January 2018¹), that it uses in connection with websites where it offers refurbished technology products for sale. Its websites receive over 11 million "sessions" per month.

The Respondent is identified in the Registrar's Whois database as "Souvenir..Pty" and the registrant contact name is "Sakshi Taneja".

The disputed domain name was created on December 13, 2019. It resolves to a landing page provided by the Registrar that displays Pay-Per-Click ("PPC") links for online shopping, among other things.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical to the Complainant's BACK MARKET trademarks, domain names, trade name, and brand name.

¹ The Panel notes its general powers articulated *inter alia* in paragraphs 10 and 12 of the Rules and has searched for archived Web pages in the Internet Archive ("www.archive.org"), which is a matter of public record, to verify the Complainant's website associated with this domain name was live at relevant times. The Panel considers this process of verification useful to assessing the case merits and reaching a decision. See [WIPO Overview 3.0](#), section 4.8.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is neither affiliated with the Complainant nor has been authorized to register and use the Complainant's BACK MARKET signs. As the term BACK MARKET is distinctive and arbitrary, the registration of the disputed domain name could not have been a coincidence.

The disputed domain name was registered and is being used in bad faith. Given the reputation of the Complainant and its BACK MARKET signs, the distinctiveness of its trademarks, the fact that the disputed domain name is identical to the Complainant's trademarks, and the lack of any substantiated credible explanation from the Respondent to date, in all the circumstances the passive holding of the disputed domain name does not prevent a finding of bad faith.

B. Respondent

In the informal Response, it is submitted that the disputed domain name is currently being used to do market analysis on Australia's property market. The Respondent has no affiliation with the Complainant or the business associated with it in the European Union. No trademarks of the Complainant are being used or have been used. In Australia, trademark registration does not tie in with domain names; the claim that there is trademark infringement is false; also, this is not a domain-squatting exercise. There is no evidence to support any of the claims; "backmarket" is a generic term and is not associated with a brand.

6. Discussion and Findings

6.1. Procedural Issue: Late Filing of an Informal Response

The Center received an informal communication from a third party, Jannan Pavan, responding to the Complainant's contentions after the due date for the Response. In response to a request from the Center for clarification of Jannan Pavan's relationship to the Respondent, the Respondent confirmed that this party's email address is its address for communication. Acceptance of this communication as the Response does not cause unfairness to either Party and will not delay this proceeding. Accordingly, the Panel exercises its discretion to accept the communication submitted by Jannan Pavan on behalf of the Respondent as the informal Response.

6.2. Substantive Issues

Paragraph 4(a) of the auDRP provides that a complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;
- (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.

The burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

Based on the evidence submitted, the Panel finds that the Complainant holds registered rights in the BACK MARKET trademark, among others. Although the Complaint also refers to rights in domain names and a trade name registered overseas, these other rights do not satisfy the first element of paragraph 4(a), including Note 1, of the auDRP.

The disputed domain name incorporates the BACK MARKET trademark, omitting only the space between the words for technical reasons. The disputed domain name also includes the open 2LD suffix ".com.au" but

this element is generally disregarded in an assessment of identity or confusing similarity between a domain name and a trademark for the purposes of the auDRP.

Therefore, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the auDRP.

B. Rights or Legitimate Interests

Paragraph 4(c) of the auDRP sets out circumstances which, without limitation, if found by the Panel to be proven based on its evaluation of all evidence presented, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the auDRP:

- (i) before any notice to [the respondent] of the subject matter of the dispute, [the respondent's] *bona fide* use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with an offering of goods or services (not being the offering of domain names that [the respondent has] acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first and third circumstances set out above, the disputed domain name resolves to a landing page that displays PPC links for online shopping, among other things. The disputed domain name incorporates the Complainant's BACK MARKET trademark, adding only a 2LD suffix, which *prima facie* carries a high risk of implied affiliation with the Complainant. However, the Complainant submits that the Respondent is neither affiliated with it nor has been authorized to register and use its BACK MARKET mark. The use of the disputed domain name is for the commercial gain of the Respondent, if it is paid to generate traffic to the linked websites, or for the commercial gain of the operators of the linked websites, or both. These circumstances indicate that the Respondent is not making a *bona fide* use of the disputed domain name in connection with an offering of goods or services within the terms of paragraph 4(c)(i) of the auDRP nor making a legitimate noncommercial or fair use of the disputed domain name within the terms of paragraph 4(c)(iii) of the auDRP.

As regards the second circumstance set out above, the Respondent is identified in the Registrar's Whois database as "Souvenir..Pty" and the contact person is named "Sakshi Taneja". Nothing indicates that the Respondent has been commonly known by the disputed domain name within the terms of paragraph 4(c)(ii) of the auDRP.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Turning to the Respondent's arguments, it asserts that the disputed domain name is currently being used to do market analysis on Australia's property market. However, it does not explain how the disputed domain name is being used for that purpose, it provides no evidence to substantiate its assertion, and it does not address the evidence showing that the disputed domain name is actually being used to resolve to a landing page displaying PPC links.

The Respondent argues that "backmarket" is a generic term. However, it provides no evidence in support of that argument and it provides no evidence that it is using the disputed domain name in connection with any such generic meaning. The Panel notes that "back" and "market" are two English words but they do not form a dictionary term or common phrase unlike, say, "black market". As far as the Panel is aware, the combination of "back" and "market" is arbitrary and only refers to the Complainant (indeed, a Google search

shows no “generic” uses of the term, but only links to or about the Complainant). Accordingly, the Panel finds that the Respondent has not rebutted the Complainant’s *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the auDRP.

C. Registered or Subsequently Used in Bad Faith

Paragraph 4(b) of the auDRP provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, although it is not an exhaustive list of such circumstances. The fourth circumstance is as follows:

(iv) by using the domain name, [the respondent has] 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.

With respect to registration, the disputed domain name was created on December 13, 2019, years after the earliest registration of the Complainant’s BACK MARKET trademark in France and years after the establishment of the Complainant’s global and national websites associated with the domain names <backmarket.com>, <backmarket.fr>, and <backmarket.co.uk>, among others. Although the disputed domain name was registered before the BACK MARKET trademark was protected in Australia, where the Respondent is established, by that time the BACK MARKET mark had already acquired a considerable reputation online through use in connection with the Complainant’s websites. BACK MARKET is not a dictionary term or common phrase and the disputed domain name is identical to it. The Respondent does not substantiate what appears to be its explanation for registration of the disputed domain name (*i.e.*, to use in connection with property market analysis). Accordingly, the Panel finds that, on balance, the most plausible explanation for the registration of the disputed domain name is that the Respondent had the Complainant’s trademark in mind.

With respect to use, the disputed domain name resolves to a landing page displaying PPC links to sites for online shopping, among other things. Internet users seeking an Australian website for the Complainant may be diverted to that landing page. The landing page operates for the commercial gain of the Respondent or the operators of the linked websites, or both. The Respondent confirms that it has no affiliation with the Complainant or its business. While the Respondent submits that no trademarks of the Complainant are being used, this overlooks the fact that the disputed domain name itself incorporates the BACK MARKET mark. The Respondent also denies that this is a case of cybersquatting but, for the reasons set out above, the Panel does not agree. In view of these circumstances, the Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the landing page associated with the disputed domain name, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of that landing page or of a service on that landing page, within the terms of paragraph 4(b)(iv) of the auDRP.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) of the auDRP.

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 disputed domain name <backmarket.com.au> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: August 9, 2022