

## **ADMINISTRATIVE PANEL DECISION**

**FNAC Darty Participations et Services v. Privacy Service Provided by Withheld for Privacy ehf/yh dai**  
Case No. D2022-2469

### **1. The Parties**

The Complainant is FNAC Darty Participations et Services, France, represented by IP Twins, France.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland/ yh dai, China.

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

The disputed domain name < fnac-shop.com > is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 7, 2022. On July 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 8, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 8, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 13, 2022.

The Center verified that the Complaint together with the amended 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 July 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 4, 2022.

The Center appointed William R. Towns as the sole panelist in this matter on August 11, 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 is the owner of a multinational company headquartered in France, offering a myriad of products and services such as electronics and electronic equipment, office and home computers, and other products and services related to education, music, and entertainment. The Complainant since as early as 1990 has operated under its FNAC name and logo, and has secured a number of trademark registrations for the Complainant's FNAC mark, including among the following:

- International Trademark registration no. 555526, applied for and registered on February 28 1990;
- International Trademark registration no. 808821, applied for and registered on April 10, 2003;
- European Union Trademark ("EUTM") registration no. 180885, applied for April 1, 1996; and registered on November 24, 1998.

The Complainant holds extensive trademark registrations for several hundred of its FNAC marks, which the Complainant maintains enjoys a wide-spread and continuous reputation in a number of countries. The FNAC mark also has been reported by the Complainant to be a well-known mark in numerous other countries. The Complainant also has registered a number of domain names resembling or reflecting the Complainant's FNAC mark.

The disputed domain name <fnac-shop.com> was registered by the Respondent on April 17, 2022, according to the concerned Registrar's Whois record. It appears from the record that the Respondent has used the disputed domain name to create website appropriating the Complainant's distinctive FNAC mark – a mark that consistently has been identified by the public. See, e.g., *FNAC Darty Participations et Services v. Renato Cardoso, Texto Sentido, CCCP SU Lda.*, WIPO Case No. [D2017-1347](#). See also *FNAC SA v. Laticinios Itaruma Ind. e Com. Ltda*, WIPO [D2015-2038](#).

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

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

The Complainant submits that the disputed domain name is identical or confusingly similar to the Complainant's FNAC mark. The Complainant maintains it has established substantial rights in its well-known FNAC mark, acquired as a result of the Complainant's extensive registration and use of the mark. The Complainant emphasizes it is a multinational company listed on the Paris Stock Exchange, operating worldwide with more than 957 stores and over 25,000 employees. The Complainant articulates that the Respondent's insertion in the disputed domain name of the generic term "shop" does not preclude a finding of confusing similarity when assessing likelihood of confusion as to the Complainant's FNAC mark.

The Complainant maintains that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant submits there is no evidence that the Respondent has been commonly known by the disputed domain name, emphasizing that the Respondent has neither acquired rights in the Complainant's FNAC mark nor been licensed or otherwise authorized to use the Complainant's mark.

The Complainant observes that the Respondent has used the disputed domain name with a website offering various products for sale. According to the Complainant, however, whether or not any products were sold on the Respondent's website, either genuine or counterfeit, the website creates a false impression of ownership and affiliation with the Complainant. Accordingly, the Complainant submits that the Respondent has neither used nor made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

The Complainant submits that the Respondent registered and is using the disputed domain name in bad faith. The Complainant reiterates that its FNAC mark is widely known, and considers it inconceivable for the Respondent to have ignored the Complainant or any of its earlier rights. The Complainant finds it highly likely that the Respondent chose the disputed domain name because of its identify or similarity to the Complainant's FNAC mark.

The Complainant considers that the Respondent's registration of the disputed domain name was driven by the fame of the Complainant's well-known FNAC mark, and further observes that UDRP panels consistently have found that the mere registration of a domain name identical or confusingly similar to a well-known or famous mark can create a presumption of bad faith. The Complainant remarks that the Respondent by registering the disputed domain name is preventing the Complainant from reflecting the FNAC mark in a corresponding domain name.

The Complainant further maintains that the Respondent has used disputed domain name to create a website prominently displaying the Complainant's FNAC mark and logo, using lower-case letters with yellow colors for the sole intention of imitating the Complainant's FNAC distinctive mark and logo. The Complainant submits this constitutes unequivocal bad faith use of the disputed domain name by the Respondent. The Complainant further observes that the disputed domain name appears to be linked to an email service.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Scope of the Policy**

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the First WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169 -177. The term "cybersquatting" is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.* at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules, and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests with respect to the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Cancellation or transfer of the domain name is the sole remedy provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets out four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations. Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the view is that the burden of production shifts to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See WIPO Overview of WIPO Panel Views On Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.1. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

## **B. Identical or Confusingly Similar**

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s FNAC trademark, a well-known mark in which the Complainant has demonstrated rights through registration and extensive use. In considering confusing similarity, the first element of the Policy serves essentially as a standing requirement,<sup>1</sup> involving a relatively straightforward comparison between the complainant’s trademark and the disputed domain name.

The Complainant’s FNAC mark is clearly recognizable in the disputed domain name.<sup>2</sup> The first element test typically entails a side-by-side comparison of the domain name and the textual components of the relevant trademark in order to assess whether the mark is recognizable within the disputed domain name.<sup>3</sup> Applying this comparison, the Complainant’s mark is recognizable.<sup>4</sup> When as here the relevant trademark is recognizable in the disputed domain name, the inclusion of an additional term in the disputed domain name such as “shop” does not preclude a finding of confusing similarity under paragraph 4(a)(i) of the Policy.<sup>5</sup>

Top-Level Domains (“TLDs”), in this case “.com”, generally are disregarded in determining identity or confusing similarity under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.<sup>6</sup>

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

## **C. Rights or Legitimate Interests**

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, the burden of production shifts to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) of the Policy has been made. It is undisputed that the Respondent has not been authorized to register or use the Complainant’s FNAC mark. Regardless, the Respondent intentionally has registered the disputed domain name, misappropriating the Complainant’s well known FNAC mark, and

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<sup>1</sup> See [WIPO Overview 3.0](#), section 1.7.

<sup>2</sup> *Id.* When the relevant trademark is recognizable in the disputed domain name, the domain name normally will be considered confusingly similar to the mark for purposes of paragraph 4(a)(i) of the Policy.

<sup>3</sup> *Id.*

<sup>4</sup> See [WIPO Overview 3.0](#), section 1.8 and cases cited therein.

<sup>5</sup> *Id.* See also [WIPO Overview 3.0](#), section 1.8 and cases cited therein. The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy.

<sup>6</sup> See [WIPO Overview 3.0](#), section 1.11 and cases cited therein.

creating a website prominently displaying the Complainant's FNAC mark and logo, using lower-case letters with yellow colors to imitate the Complainant's FNAC mark and logo. As previously noted, the Complainant continuously has operated under the FNAC name and logo since as early as the year 1990.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent has been commonly known by the disputed domain name, even if it 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.

The Respondent has not submitted any response to the Complainant, in the absence of which the Panel may accept all reasonable inferences and allegations in the Complaint as true. See *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#). Regardless, the Panel has carefully reviewed the record in this case, and has found nothing therein that would bring the Respondent's registration and use of the disputed domain name within any of the "safe harbors" of paragraph 4(c) of the Policy.

It is apparent to the Panel that the Respondent knew of and had the Complainant's well-known FNAC mark in mind when registering the disputed domain name, which as previously noted is confusingly similar if not virtually identical to the Complainant's well known mark. To the extent the Respondent might claim even remotely to be making a fair use of the disputed domain name, the Panel considers that any reliance by the Respondent on decisions such as *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (hereinafter "*Oki Data*") would be solely misplaced.

UDPR panels generally have held that a domain name identical or confusingly similar to a complainant's trademark carries a high risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1. Further, UDRP panels have consistently held that the mere registration of a domain name confusingly similar to a widely-recognized trademark, even by an unaffiliated entity, may create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Having regard to the relevant circumstances in this case, and absent any explanation by the Respondent, the Panel finds the Respondent has neither used nor made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services within the contemplation of paragraph 4(c)(i) of the Policy. See *Autodesk, Inc. v. Brian Byrne, meshIP, LLC*, WIPO Case No. [D2017-0191](#). Further, and to the extent discussed above, the Panel finds the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name. The Panel has found no indication in the record that the Respondent has been commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy, and nothing in the record before the Panel supports any claim by the Respondent to hold rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the Respondents' documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent 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 respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For the reasons discussed under this and the preceding heading, the Panel concludes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of paragraph 4(b)(iv) of the Policy. The record is convincing that the Respondent knew of and had the Complainant's distinctive and well-known FNAC mark and logo firmly in mind when registering the disputed domain name. The Respondent's misappropriation and calculated abuse of the Complainant's FNAC mark clearly is demonstrative of bad faith.

The Panel thus finds that the Complainant has satisfied the requirements of 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 <fnac-shop.com> be transferred to the Complainant.

*/William R. Towns/*

**William R. Towns**

Sole Panelist

Date: August 25, 2022