

ADMINISTRATIVE PANEL DECISION

New Yorker S.H.K. Jeans GmbH & Co KG v. Yann Tassy, FSBN
Case No. D2022-2898

1. The Parties

The Complainant is New Yorker S.H.K. Jeans GmbH & Co KG, Germany, represented by Cabinet Beau de Lomenie, France.

The Respondent is Yann Tassy, FSBN, France.

2. The Domain Name and Registrar

The disputed domain name <fsbn-fbsister.com> is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint in French was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 15, 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 August 16, 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 in English on August 17, 2022.

On August 16, 2022, the Center sent an email communicating in both English and French regarding the language of the proceeding. The Complainant replied on August 17, 2022, providing a translation of the amended Complaint into English. The Respondent did not comment on the language of the proceeding.

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 August 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 8, 2022.

The Center appointed Emre Kerim Yardimci as the sole panelist in this matter on September 14, 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, New Yorker S.H.K. Jeans GmbH & Co KG, is the owner of the trademarks FSNB and FBSISTER in connection with clothing and apparel.

The Complainant has been using the trademarks FSNB and FBSISTER prior to the registration of the disputed domain name and holds the following International Trademark Registrations designating the European Union ("EU"):

- the International Registration with no. 1385362 for FSNB trademark registered on September 21, 2017, for the goods in class 25;
- the International Registration with no. 1384461 for FBSISTER trademark registered on September 21, 2017, for the goods in class 25.

The Respondent has registered the disputed domain name with the Registrar on May 3, 2022.

At the time of the Complaint, the disputed domain name did not resolve to an active website and remains inactive at the time of this decision. The Complainant has also submitted the evidence that the disputed domain name previously resolved to a website displaying its FSNB and FBSISTER trademarks and purportedly offering for sale its products.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the disputed domain name is confusingly similar to the Complainant's trademarks, as it literally repeats the trademarks FSNB and FBSISTER that are only separated by a dash "-".

The Complainant considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name, mainly because the Complainant has neither licensed nor otherwise authorized the Respondent to use its marks or to apply for or use any domain name incorporating the trademarks of the Complainant and the Respondent does not appear to be known by the disputed domain name.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant claims that the Respondent is using the disputed domain name with the aim to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademarks and for the purpose of disrupting the Complainant's business and targeting the Complainant's trademarks by incorporating two trademarks of the Complainant within the disputed domain name.

B. Respondent

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

6. Discussions and Findings

6.1. Effect of the Default

Paragraph 14(b) of the Rules provides that, in the absence of exceptional circumstances, a panel shall draw such inferences as it considers appropriate from a failure of a party to comply with a provision or requirement of the Rules.

As there are no exceptional circumstances for the failure of the Respondent to submit a formal Response, the Panel infers that the Respondent does not deny the facts asserted and contentions made by the Complainant. Therefore, asserted facts that are not unreasonable will be taken as true and the Respondent will be subject to the inferences that flow naturally from the information provided by the Complainant (*Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. [D2000-0441](#)).

6.2. Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement. The Registrar has confirmed that the Registration Agreement is in English in this case.

The Complaint was filed in French, in which the Complainant had requested French to be the language of the proceeding. In responding to the Center's language of the proceeding email, the amended Complaint was then submitted in English, which had also included the Complainant's original language request. The Respondent has not objected to the Complainant's request on language of the proceeding and did not submit its Response.

The Panel is familiar with both French and English. Having assessed the Complainant's communications in both French and English, the Panel however decided, in accordance with paragraph 11(a) of the Rules, that the language of the proceeding as English in accordance with the language of the Registration Agreement as confirmed by the Registrar.

6.3. Substantive Issues

Pursuant to paragraph 4(a) of the Policy, the Complainant is required to prove the presence of each of the following three elements to obtain the remedy it has requested:

- (i) the disputed 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 in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner.

In this respect the Panel notes that the disputed domain name does not only integrate the Complainant's two trademarks at the same time, but it is also formed through the exact combination of the Complainant's

registered trademarks which is an important point that will be taken into consideration during the analysis of the third element.

Therefore, in the Panel's view, the disputed domain name is confusingly similar to two trademarks of the Complainant for purposes of standing to proceed with its claim.

As regards the generic Top-Level Domain ("gTLD") ".com", it is typically disregarded under the confusing similarity test.

Consequently, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The onus is on the Complainant to make out at least a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and it is then for the Respondent to rebut this case. See section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel accepts the Complainant's submissions that the Respondent does not appear to be commonly known by the disputed domain name, has not used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, is not making a legitimate noncommercial or fair use of the disputed domain name, and has no consent from the Complainant to use its trademarks.

The Respondent has not filed a Response.

The Complainant has made out its *prima facie* case under this element of the Policy and the Respondent has failed to rebut it. Accordingly and in view of the Panel's discussion below, the Panel finds that the Complainant succeeds in relation to the second element of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent has registered and used the disputed domain name to intentionally attempt to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's two trademarks at the same time.

As a matter of fact, considering:

- the use of the Complainant's two trademarks within the disputed domain name at the same time,
- the striking similarity of the previous website content under the disputed domain name with the Complainant's own website,
- the use of the Complainant's trademarks on the previous website under the disputed domain name, and
- the use of the Complainant's copyrighted videos and photos on the previous website under the disputed domain name,

it is clear that the Respondent has targeted the Complainant and its FSBN and FBSISTER trademarks to further its own commercial activities.

The Respondent's registration of the disputed domain name composed of the Complainant's marks for a website impersonating the Complainant's website clearly constitutes bad faith use and registration.

Therefore, the only reason for the registration of the disputed domain name by the Respondent must have been with bad faith intent to use it to exploit, for commercial gain, the reputation of the Complainant and its trademarks. The Respondent has used the disputed domain name for precisely that purpose.

Although the disputed domain name did not resolve to an active website at the time of the Complaint and remains inactive, the Panel finds that such change does not prevent a finding of bad faith under the doctrine of passive holding (section 3.3 of the [WIPO Overview 3.0](#)).

Therefore, in view of cumulative circumstances, the Panel finds that the requirement of registration and use in bad faith is satisfied, according to the third 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 <fsbn-fbsister.com> be transferred to the Complainant.

/Emre Kerim Yardimci/

Emre Kerim Yardimci

Sole Panelist

Date: October 5, 2022