

ADMINISTRATIVE PANEL DECISION

Petit Bateau v. Chao Yu
Case No. D2022-3531

1. The Parties

The Complainant is Petit Bateau, France, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Chao Yu, China.

2. The Domain Name and Registrar

The disputed domain name <thepetitbateau.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 23, 2022. On September 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 26, 2022, the Registrar 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 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 September 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 20, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on October 27, 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 a children's clothing and underwear manufacturer based in France, which was founded in 1920.

The Complainant obtained registrations for the PETIT BATEAU trademark in China (Registration Number 1281084, registered on June 7, 1999); in the European Union (Registration No. 001923820, registered on January 18, 2002); and in the United States of America (Registration No. 1156475, registered on June 2, 1981).

The Complainant is also the owner of other domain names comprising the PETIT BATEAU trademark, including its official website at <petit-bateau.com>, registered in 2000.

The Respondent registered the disputed domain name on May 14, 2022.

The Panel accessed the disputed domain name on November 10, 2022, when it was not linked to any active website. However, the Complainant brought evidence that the disputed domain name was recently linked to a website reproducing the Complainant's trademark and logo, as well as parts of the Complainant's official website. This circumstance was also confirmed by the Center after the Complaint was filed.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. By virtue of its trademark and service mark registrations, the Complainant is the owner of PETIT BATEAU trademarks. It is standard practice when comparing a disputed domain name to complainant's trademarks, to not take the extension into account. The mere addition of the generic prefix "the" to the Complainant's trademark does not negate the confusing similarity between the disputed domain name and the Complainant's trademark under Policy 4(a)(i).

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not sponsored by or affiliated with the Complainant in any way. Nor has the Complainant given the Respondent permission to use the Complainant's trademarks in any manner, including in domain names. The Respondent is not commonly known by the disputed domain name, which evidences a lack of rights or legitimate interests. The pertinent Whois information identifies the registrant as "Chao Yu", which does not resemble the disputed domain name in any manner. The disputed domain name resolves to a website that copies and attempts to duplicate the Complainant's official website by displaying the Complainant's copyrighted logo and offering for sale PETIT BATEAU branded products. The Respondent is attempting to pass off the disputed domain name as being affiliated with the Complainant, and in fact as being the Complainant. The Respondent registered the disputed domain name significantly after the Complainant's registration of the PETIT BATEAU trademark and also significantly after the Complainant's registration of its primary domain name <petit-bateau.com> in 2000. By the time the Respondent registered the disputed domain name, the Complainant already had a worldwide reputation in its trademark which is fully adopted in the disputed domain name. Therefore, it is evident that the disputed domain name carries a high risk of implied affiliation with the Complainant which cannot be considered a fair use of the disputed domain name.

- The disputed domain name was registered and is being used in bad faith. The Complainant and its PETIT BATEAU trademark are known internationally, with trademark registrations across numerous countries, including in China where the Respondent is located. The Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business, as evidenced by the use of the Complainant's

copyrighted logo and PETIT BATEAU branded items on the website linked to the disputed domain name. It is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brands at the time the disputed domain name was registered. The PETIT BATEAU trademark is so closely linked and associated with the Complainant that the Respondent's use of this trademark, or any minor variation of it, strongly implies bad faith. The Respondent's actions create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the disputed domain name, and the Respondent is thus using the fame of the Complainant's trademarks to improperly increase traffic to the website listed at the disputed domain name for the Respondent's own commercial gain. The Respondent has ignored the Complainant's attempts to resolve this dispute outside of this administrative proceeding. Past UDRP panels have held that failure to respond to a cease-and-desist letter may properly be considered a factor in finding bad faith registration and use of a domain name. In addition to the disputed domain name, the Respondent currently holds registrations for several other domain names that misappropriate the trademarks of well-known brands and businesses. This fact demonstrates that the Respondent is engaging in a pattern of cybersquatting/typosquatting, which is evidence of bad faith registration and use of the disputed domain name. Finally, on balance of the facts set forth above, it is more likely than not that the Respondent knew of and targeted the Complainant's trademark, and the Respondent should be found to have registered and used the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (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.

A. Identical or Confusingly Similar

The Panel has no doubt that "PETIT BATEAU" is a term directly connected with the Complainant's trademarks.

Annex 1 to the Complaint shows trademark registrations for PETIT BATEAU that date as early as in 1981.

The trademark PETIT BATEAU is wholly encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark PETIT BATEAU merely by the inclusion of the prefix "the" and of the generic Top-Level Domain ("gTLD") extension ".com".

Previous UDRP decisions have found that the mere addition of descriptive terms (such as the English definite article "the") to a trademark in a domain name do not avoid a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a gTLD such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

(i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name; or

(iii) the respondent is 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 at issue.

Based on the Respondent’s default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

Indeed, the Complainant showed that the disputed domain name was linked to a website unauthorizedly reproducing the Complainant’s trademark and logo, as well as parts of its official website, offering products for sale by impersonating the Complainant.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

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

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or

(ii) 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) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2022) the trademark PETIT BATEAU was already directly connected to the Complainant's products for decades.

Also, as already referred above, the disputed domain name was recently pointing to a commercial website that unauthorizedly reproduces the PETIT BATEAU trademark and logo.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's trademark, as well as that the adoption of the expression “thepetitbateau” together with the gTLD extension “.com” could be a mere coincidence.

In fact, the inclusion of the definite article “the” even enhances the likelihood of confusion concerning the source of the products offered on a website linked to the disputed domain name, suggesting it is “the” PETIT BATEAU website.

Furthermore, by associating the disputed domain name with a website targeting the PETIT BATEAU brand, the Respondent potentially obtains revenue and deprives the Complainant from selling products to prospective clients who are clearly looking for the Complainant.

In the Panel's view, such circumstances, including the Respondent not providing justifications for the registration of a domain name containing a third-party famous trademark, as well as the lack of any plausible good faith reason for the adoption of the term “thepetitbateau” by the Respondent, are enough to characterize bad faith registration and use of the disputed domain name in the present case.

Also, the Respondent's non-collaborative posture – not answering the Complainant's cease-and-desist letter, nor the present procedure – and his pattern of conduct of registering domain names incorporating third parties' trademarks are additional indications of bad faith use of the disputed domain name.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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 <thepetitbateau.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: November 11, 2022