

## **ADMINISTRATIVE PANEL DECISION**

ETAM SAS v. Xiaohong Liu

Case No. D2022-3563

### **1. The Parties**

The Complainant is ETAM SAS, France, represented by Domgate, France.

The Respondent is Xiaohong Liu, China.

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

The disputed domain name <etam-store.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 27, 2022. On September 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 27, 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 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 21, 2022.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on October 28, 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 presents itself as one of the world's most popular international lingerie brands. It currently operates nearly 1,429 stores in 55 countries. The first ETAM store opens in 1916 in Germany and in 1928 in France.

The Complaint is based, amongst others, on International Registration ETAM (verbal) no. 744378, with priority of April 22, 1997 registered for goods in classes 3, 9, 18, and 25, and designating many jurisdictions, including China where the Respondent is located.

The disputed domain name has been registered on May 12, 2022.

It results from the undisputed evidence provided by the Complainant that the disputed domain name resolves to a web shop which is a copy of the Complainant's official online shop and allegedly selling and offering the Complainant's lingerie. This web shop prominently features at its head the Complainant's "ETAM PARIS" logo without the Complainant's authorization.

In June 2022, the Complainant's representative tried to contact the Respondent through the Registrar online contact form. Several reminders were sent but the Respondent never replied.

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

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

Firstly, the Complainant contends that the disputed domain name is confusingly similar to its earlier trademark. In fact, it reproduces the ETAM trademark and combines it with the term "store". The mere addition of the term "store" does not eliminate the similarity between the Complainant's marks and the disputed domain name, since it merely refers to a point of sale. Consequently, the addition of the English generic term "store" separated by a hyphen adds to confusion by suggesting that the website belongs to the Complainant and is the online store selling the Complainant's products.

Secondly, the Complainant contends that the Respondent lacks any rights or legitimate interests in the disputed domain name. In particular, the Respondent knew the ETAM trademarks and was not authorized to use these marks. There is no doubt that the Respondent registered the disputed domain name without any right or legitimate interest but with the *mala fide* intention to gain money from it. Indeed, the Respondent is making an illegitimate commercial use of the disputed domain name to divert consumers to its online shop which is a copy of the Complainant's official online shop.

Thirdly, the Respondent's registration and use of the disputed domain name constitutes – in the Complainant's view – bad faith. In particular, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. In the Complainant's view, the Respondent clearly registered the disputed domain name for the purpose of making business benefits from the confusion and attracting consumers to its commercial counterfeiting website.

##### **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

(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.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

### A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of various trademark registrations in several jurisdictions consisting of the term ETAM. Reference is made in particular to International Registration ETAM (verbal) no 744378, registered with priority of April 22, 1997 registered for goods in classes 3, 9, 18 and 25.

Many UDRP panels have found that a domain name is confusingly similar to a complainant’s trademark for purposes of the first element where the relevant trademark is recognizable within the domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). This Panel shares the same view and notes that the disputed domain name contains the Complainant’s registered trademark ETAM, which is placed at the beginning of the disputed domain name. The addition of the term “store” does not prevent a finding of confusing similarity between the Complainant’s trademark and the disputed domain name. The Panel is of the opinion that the trademark ETAM remains recognizable within the disputed domain name.

Finally, the generic Top-Level-Domain (“gTLD”) “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests to the disputed domain name. In the Panel’s view, based on the undisputed allegations stated above, the Complainant has made a *prima*

*facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First, the Complainant's uncontested evidence demonstrates that the disputed domain name resolves to a web shop which is a copy of the Complainant's official online shop and allegedly selling and offering the Complainant's lingerie. This web shop prominently features at its head the Complainant's "ETAM PARIS" logo without the Complainant's authorization, and the website shop does not contain a disclaimer about the lack of relationship with the Complainant. Furthermore, the disputed domain name identically contains the ETAM trademark separated by a hyphen of the term "store". In the Panel's view, noting the nature of the disputed domain name, such use cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since the disputed domain name rather capitalizes on the reputation and goodwill of the Complainant's trademark and is therefore likely to mislead Internet users (*cf.* [WIPO Overview 3.0](#) at section 2.5). In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain name. In particular, it results from the Complainant's uncontested allegations that it has not authorized the Respondent's use of the ETAM trademark for registering the disputed domain name and using it for a web shop pretending to be the Complainant's web shop.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, the Panel notes that there is no evidence in the record either showing that the Respondent might be making a 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 pursuant to paragraph 4(c)(iii) of the Policy. In fact, the disputed domain name is used for a commercial website, so that a noncommercial use is excluded from the outset. In addition, the Panel is satisfied that the disputed domain name was registered to take unfair advantage of its similarity with the Complainant's ETAM trademark so that it is unlikely that the Respondent wanted to fairly use the disputed domain name.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith.

The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of a domain name's registration and use in bad faith. One of these circumstances is that the respondent by using the domain name, 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 (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand:

It results from the Complainant's uncontested evidence demonstrates that the disputed domain name resolves to a web shop which is a copy of the Complainant's official online shop and allegedly selling and offering the Complainant's lingerie. This web shop prominently features at its head the Complainant's "ETAM PARIS" logo without the Complainant's authorization. Furthermore, the disputed domain name

identically contains the ETAM trademark. The web shop and the disputed domain name therefore create the wrong impression that they originate from the Complainant. However, the Complainant has not given any authorisation for such use and is neither linked to the Respondent or this website. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent positively knew the Complainant's trademark when it registered the disputed domain name.

The finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- (i) the nature of the disputed domain name, exactly containing the Complainant's trademark ETAM combining it with a term "store" which is related to the Complainant's business;
- (ii) the content of the website to which the disputed domain name directs, which creates the wrong impression that the Complainant is responsible for this content;
- (iii) website content on the disputed domain name is using and targeting the Complainant's trademark ETAM;
- (iv) the clear absence of any rights or legitimate interests in the disputed domain name;
- (v) the Respondent's failure to submit a response with a credible evidence-backed rationale for registering the disputed domain name;
- (vi) the Respondent's failure to reply to the Complainant's pre-UDRP correspondence;
- (vii) the Respondent's failure to provide any evidence of actual or contemplated good-faith use; and
- (viii) the implausibility of any good faith use to which the disputed domain name may be put.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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 <etam-store.com> be transferred to the Complainant.

*/Tobias Malte Müller/*

**Tobias Malte Müller**

Sole Panelist

Date: November 11, 2022