

ADMINISTRATIVE PANEL DECISION

Jacquemus SAS v. Jeanine Wash
Case No. D2022-4713

1. The Parties

The Complainant is Jacquemus SAS, France, represented by DBK Law Firm, France.

The Respondent is Jeanine Wash, United States of America.

2. The Domain Name and Registrar

The disputed domain name <jacquemusonline.shop> (the “Disputed Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 8, 2022. On December 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 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 (PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 9, 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 December 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 December 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 6, 2023.

The Center appointed Haig Oghigian as the sole panelist in this matter on January 16, 2023. 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 French fashion label and design company, active since 2013 in the field of luxury clothing and fashion accessories, including jewelry, shoes and handbags. Products sold by the Complainant have been extensively featured in numerous fashion and lifestyle publications throughout the world, including Vogue, ELLE, and InStyle.

The Complainant owns numerous trademark registrations worldwide for JACQUEMUS (thereafter, the "JACQUEMUS Trademark"). In support of this submission, the Complainant referred the Panel to the following sample, for which it provided copies of the registration information available online:

- JACQUEMUS, European Union Registration No. 018080381, registered on October 18, 2019 for goods in classes 14, 24 and 28 related to jewelry, textiles and games.
- JACQUEMUS, International Registration No. 1211398, registered on February 5, 2014 for goods in classes 9, 18, 25 related to clothing items and fashion accessories.
- JACQUEMUS, International Registration No. 1513829, registered on November 19, 2019 for goods in classes 14, 24 and 28 related to jewelry, textiles and games.

The Disputed Domain Name was registered on November 6, 2022.

At the time the Complaint was filed, and to this day, the Disputed Domain Name resolves to an active website which hosts an ecommerce platform selling alleged JACQUEMUS-branded handbags.

5. Parties' Contentions

A. Complainant

The Complainant's submissions are summarized as follows.

First, the Complainant submits that the Disputed Domain Name is confusingly similar to the Complainant's JACQUEMUS trademark. The Complainant submits that the Disputed Domain Name consists of the trademark JACQUEMUS followed by the word "online" and the generic Top-Level Domain ("gTLD") ".shop." The Complainant submits that the presence of the word "online" does not prevent a finding of confusing similarity with the JACQUEMUS trademark, because it will certainly be understood by internet users as a website being dedicated to purchasing online the Complainant's products and that the JACQUEMUS trademark is clearly recognizable from the Disputed Domain Names. The Complainant submits that in a case where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the disputed domain name, the disputed domain name will normally be considered confusingly similar to that trademark.

The Complainant also submits that the Respondent has no rights or legitimate interests in the Disputed Domain Name because (1) the Complainant has not authorized the Respondent to register and/or use any domain name incorporating the JACQUEMUS trademark, (2) the Complainant has not granted any license nor any authorization to use the JACQUEMUS trademark as part of a domain name, and (3) it sells counterfeit products infringing the Complainant's rights for which there can be no legitimate interests.

Finally, the Complainant submits that the Disputed Domain Name was registered and is being used in bad faith. First, it submits that the JACQUEMUS trademark became known and acquired an extensive reputation worldwide and should be considered as well known, and thus, that the Respondent had prior knowledge of the existence of the Complainant's trademark at the time of registering the Disputed Domain Name constituted bad faith *per se*. Second, the Complainant submits that the Respondent is using the Disputed Domain Name to offer for sale counterfeit products of the Complainant and is also infringing on the Complainant's copyrights by reproducing pictures from the Complainant's official website, all of this by creating a likelihood of confusion with the Complainant's trademark as the source, sponsorship, affiliation, or endorsement of its website. Third, the Complainant submits that the Respondent's use of "Whols Protective Service" (PrivacyGuardian.org LLC, as indicated at Annex 2 of the Complaint) to remain anonymous is evidence of the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

Even in the absence of a substantive response from the Respondent, and in accordance with paragraph 4(a) of the Policy, the Complainant bears the burden to prove to the Panel, *prima facie*, each of the following elements:

- 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.

The Panel will successively rule on each of these elements.

A. Identical or Confusingly Similar

The Complainant satisfactorily established its rights in the JACQUEMUS trademark and that the Disputed Domain name is confusingly similar to the JACQUEMUS trademark.

The Complainant has shown its rights in the JACQUEMUS trademark through the above-cited valid registration in the European Union as well as the two International Registrations. Evidence of such registrations was sufficient to *prima facie* satisfy the threshold requirement of having trademark rights in the JACQUEMUS trademark, according to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

As stated in section 1.7 of the [WIPO Overview 3.0](#), a domain name which incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name will normally be considered confusingly similar to that trademark. The test for identity or confusing similarity typically involves a side-by-side comparison of the domain name, to assess whether the trademark is recognizable within the domain name.

In this case, the Disputed Domain Name is composed of two elements: (1) the word "jacquemus" and (2) the word "online." The Panel is permitted to ignore the gTLD ".shop", in accordance with section 1.11.1 of the [WIPO Overview 3.0](#). The first element is identical to the JACQUEMUS trademark of the Complainant and the second element is the word "online". The JACQUEMUS trademark of the Complainant remains clearly recognizable within the Disputed Domain Name, despite the word "online", which is consistent with section 1.8 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Disputed Domain Name is confusingly similar to the JACQUEMUS trademark and thus the Complainant has discharged its burden under subparagraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Respondent has no rights or legitimate interests in the Disputed Domain Name.

Following section 2.1 of the [WIPO Overview 3.0](#), the Complainant must demonstrate, *prima facie*, that the Respondent has no rights to or legitimate interests in the Disputed Domain Name. If the Complainant succeeds, and in order to avoid the Complainant having to prove that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, which may result in the often-impossible task of “proving a negative,” the burden of production of this second element under subparagraph 4(a)(ii) of the Policy shifts to the Respondent. Here, the Respondent must now produce relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. Such a legitimate interest is defined, non-exhaustively at paragraph 4(c) of the Policy, as either use of the domain name in connection with a *bona fide* offering of goods or services, the respondent being commonly known by the disputed domain name, or a legitimate noncommercial fair use of the disputed domain name, without misleading the consumers or tarnishing the trademark at issue.

In the present case, the Respondent did not file a response and thus provided no evidence that it holds any such rights or legitimate interests in the Disputed Domain Name, namely that it has used or made preparation to use the Disputed Domain Name in connection with a *bona fide* offering of goods and services.

There is a clear presence of the JACQUEMUS trademark in the Disputed Domain Name, and in the absence of evidence from the Respondent to the contrary, this is sufficient for the Panel to agree with the Complainant’s submissions that the Complainant did not authorize the Respondent to register or use the Disputed Domain Name, that there is no connection between the Complainant and the Respondent and thus, no conceivable basis upon which the Respondent could possibly claim to have any rights or legitimate interests in respect of the Disputed Domain Name.

Moreover, the presence of the well-known JACQUEMUS trademark along with a descriptive term of services, such services which are also provided by the Complainant through its “www.jacquemus.com” website, carries a risk of implied affiliation since it effectively impersonates or suggests sponsorship or endorsement by the Complainant of the Respondent’s activities and website, according to section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Respondent does not hold any rights or legitimate interests in the Disputed Domain Name and that the Complainant has discharged its burden under subparagraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent has registered and is using the Disputed Domain Name in bad faith.

Subparagraph 4(a)(iii) of the Policy states this double requirement. According to section 3.1 of the [WIPO Overview 3.0](#), bad faith occurs if the Respondent takes unfair advantage of or otherwise abuses the Complainant’s trademark. The same subsection lists non-exhaustive scenarios which could constitute evidence of bad faith.

The Complainant submits three motives evidencing the Respondent’s bad faith. This Panel agrees with the first one, partially agrees with the second, and ignores the third.

With regards to the first motive, the Panel agrees that the Respondent knew, or at least should have known, the existence of the Complainant’s JACQUEMUS trademark. There is no doubt that the Complainant enjoys a worldwide reputation and presence in the marketplace, as it is eloquent from the appearance of the

Complainant's products and trademarks in numerous prestigious publications, and as such, the JACQUEMUS trademark must be considered as a well-known trademark. Several previous UDRP decisions found that it was indeed a well-known trademark. Furthermore, the nature of the Respondent's activities that is selling unauthorized JACQUEMUS-branded goods through the website of the Disputed Domain Name makes it obvious that the Respondent was indeed aware of the existence of the JACQUEMUS trademark, well prior the registration of the Disputed Domain Name. In that sense, the Panel agrees with the ruling in *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#), cited by the Complainant in support of its submission. There is no doubt in the Panel's view that the Respondent is trading off the Complainant's reputation, and therefore has registered and is using the Disputed Domain Name in bad faith.

With regards to the second motive, the Panel partially agrees with the Complainant's submissions. The Complainant submits that the Respondent is commercializing counterfeit versions of the Complainant's products, but the Complainant did not adduce any conclusive evidence that the products sold by the Respondent were indeed counterfeit goods. The mere fact that the products are sold at a lower price than those sold by the Complainant and that these products have not been destocked by the Complainant is no conclusive evidence that they are counterfeit. The Complainant also submits that the Respondent infringes on its copyrights by reproducing pictures taken from the Complainant's website, but did not provide actual evidence of the Complainant's ownership of the images used by the Respondent – Annex 7 to the Complaint falls short of supporting that position.

That being said, the Panel agrees with the Complainant that the Respondent is using without authorization, the Complainant's trademark. As stated above, the Complainant established that the Respondent had no legitimate connection to the Complainant, namely that the Complainant never authorized or licensed the use of its JACQUEMUS trademark to the Respondent to register and use the Disputed Domain Name. Even in the absence of evidence of counterfeiting, this Panel concluded above that there were no conceivable grounds upon which the Respondent could claim a legitimate interest in the Disputed Domain Name. Given the extensive notoriety of the JACQUEMUS trademark and the nature of the Respondent's activities, the Panel is of the view that the Respondent was necessarily aware of the JACQUEMUS trademark and its reputation, and that such use and registration by the Respondent create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation and endorsement of the Disputed Domain Name and website, which is an evidence of bad faith.

Finally, with regards to the third motive, the Panel ignores it. The Complainant submits that the Respondent registered the Disputed Domain Name anonymously, is hiding its identify, and wishes to remain anonymous. It is not uncommon for owners of domain names to file for registration anonymously through proxies, as the Respondent seems to have done.

Therefore, the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith and that the Complainant has established the third element under subparagraph 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 <jacquemusonline.shop> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: January 30, 2023