

ADMINISTRATIVE PANEL DECISION

Jacquemus SAS v. Oirdi Boulghobra
Case No. D2022-4759

1. The Parties

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

The Respondent is Oirdi Boulghobra, France.

2. The Domain Name and Registrar

The Disputed Domain Name <cafecitronparis.com> (the “Disputed Domain Name”) is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 12, 2022. On December 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 14, 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.

On December 15, 2022 and December 20, 2022, the Respondent sent informal email communications. On December 20, 2022, the Complainant informed the Center that it did not wish to explore settlement options.

The Center sent an email communication to the Complainant on December 15, 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 21, 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 22, 2022. In accordance with the Rules,


paragraph 5, the due date for Response was January 11, 2023. The Response was filed with the Center on January 9, 2023.

The Center appointed Christiane Féral-Schuhl 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 company which manufactures and markets clothing and fashion accessories under the trademark JACQUEMUS. This trademark is named after the Complainant's famous designer who has acquired a world-wide renown and reputation.

The Complainant has designed and decorated a restaurant in Paris named "Café citron" in 2019. The Disputed Domain Name was registered by the Complainant on April 9, 2019 and used to resolve to a website dedicated to the presentation of this restaurant.

The Complainant has also registered on July 4, 2020, the French semi figurative trademark  (the "CITRON Trademark") No. 45649992 for products and services in class 41.

The Disputed Domain Name was not renewed by the Complainant and the Respondent bought it at an auction through a drop catching service on May 15, 2022.

At the time of the Complaint, the Disputed Domain Name used to resolve to an information and news blog on various subjects edited by the Respondent with the first article dedicated to the Complainant's restaurant "Café citron" – for which the Disputed Domain Name is named after, and another article dedicated to the presentation of the Complainant's star designer.

At the time of the decision, the Disputed Domain Name redirects to another domain name owned by the Respondent: <vira.fr> with the same initial content except for the two front-page articles on the Complainant and its restaurant. The Respondent has also added a disclaimer stating that it is not affiliated with the Complainant or its restaurant.

5. Parties' Contentions

A. Complainant

First, the Complainant states that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant points out that it is the owner of the CITRON Trademark and that the Disputed Domain Name is composed of this trademark in its entirety and of the additional terms "café" and "paris". For the Complainant, the addition of these two terms does not prevent a finding of confusing similarity since they are both generic and descriptive of the services offered by the Complainant under the CITRON Trademark. The Complainant explains that the Disputed Domain Name will certainly be considered by the Internet users as an official website dedicated to the restaurant opened by the Complainant.

Then, the Complainant explains that it has never authorized the Respondent to register and/or use any domain name incorporating the CITRON Trademark. The Complainant then explains that the fact that the Respondent is anonymous is evidence that it has not made a legitimate noncommercial or a fair use of the Disputed Domain Name. Moreover, the Complainant states that the Respondent has used a picture of its designer in order to lead Internet users into thinking that the website to which the Disputed Domain Name resolves is affiliated to the Complainant.

Then the Complainant stands that the Disputed Domain Name was registered and is being used in bad faith. The Complainant explains that the CITRON Trademark registration pre-dates the registration of the Disputed Domain Name by the Respondent. The Complainant highlights its worldwide fame and reputation and the ones of its designer. For the Complainant, the choice of the Disputed Domain Name by the Respondent does not seem to be a mere coincidence, but on the contrary seems to have been done on purpose to generate a likelihood of confusion between the Disputed Domain Name and the CITRON Trademark.

The Complainant also underlines the fact that the content of the website linked to the Disputed Domain Name is another evidence of bad faith registration and use. The Complainant states that the Disputed Domain Name resolves to a website promoting the Respondent's blog and recipes by using the Complainant's notoriety. The Complainant also states that the fact that the Respondent chose to hide its identify when registering the Disputed Domain Name is also evidence of bad faith. The Complainant also finds out a sign of bad faith in the way the Disputed Domain Name was registered. For the Complainant, the fact that the Disputed Domain Name was registered through a drop catching service demonstrates that the Respondent clearly knew that the Disputed Domain Name had been previously owned and used by the Complainant and that a simple search would have easily revealed the Complainant's rights in the Disputed Domain Name.

Finally, the Complainant stated that the behavior of the Respondent following the Complaint also demonstrated the latter's bad faith. The Complainant explains that the Respondent offered to remove the litigious content or to resell the Disputed Domain Name.

B. Respondent

First, the Respondent states that it has bought the Disputed Domain Name at an auction after the Complainant gave it up. The Respondent explains that it has chosen to hide its identity in order to avoid spam and that this is a very common registration practice.

The Respondent states that the Complainant's CITRON Trademark and the Respondent's logo (composed of a cup of coffee with a slice of lemon) do not look alike since the Respondent's logo does not include any visual element of the Complainant's semi-figurative CITRON Trademark.

The Respondent explains that the Complainant's restaurant CAFÉ CITRON is now closed and has a low notoriety. The Respondent also explains that the original website linked to the Disputed Domain Name did not have a lot of traffic. The Respondent states that it did not took advantage of the Complainant's CITRON Trademark's notoriety.

The Respondent adds that is not only a restaurant or food blog, but an information and news blog on various subjects.

The Respondent highlights that it has removed all the litigious content from the Disputed Domain Name upon notification of the Complaint which is evidence of its good faith.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the 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;
- (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

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the CITRON Trademark.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the Disputed Domain Name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Panel finds that the Disputed Domain Name is composed of:

- the CITRON Trademark;
- the terms "café" and "paris"
- the generic Top-Level Domain ("gTLD") ".com".

According to prior UDRP panel decisions, it is sufficient that the domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of a word to a mark does not prevent a finding of confusing similarity.

The Panel considers that, in this case, the mere addition of the terms "café" and "paris" to the CITRON Trademark does not prevent a finding of confusing similarity between the latter and the CITRON Trademark.

Furthermore, the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Finally, the Panel holds that the Disputed Domain Name is confusingly similar to the CITRON Trademark and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

- 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 or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* that a respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Indeed, it appears that the Complainant has not given any license or authorization of any kind to the Respondent to use the CITRON Trademark and to register the Disputed Domain Name.

Furthermore, there is no evidence that the Respondent is commonly known by the Disputed Domain Name. Indeed, according to prior UDRP panel decisions, for this condition to apply, the respondent must be “commonly known” (as opposed to merely incidentally being known) by the relevant moniker (e.g., a personal name, nickname, corporate identifier), apart from the domain name. Panels will carefully consider whether a respondent’s claim to be commonly known by the domain name – independent of the domain name – is legitimate. Mere assertions that a respondent is commonly known by the domain name will not suffice; respondents are expected to produce concrete credible evidence (see section 2.3 of the [WIPO Overview 3.0](#)).

In this case, the Respondent is known as “Oirdi Boulghobra”, and while the Panel notes that the Respondent was using a logo “Café citron” composed of a cup of coffee with a slice of lemon to present its services, the Respondent’s website was also posting articles dedicated to the Complainant’s restaurant “Café citron” and a presentation of the Complainant’s star designer.

Furthermore, at the time of the decision, the Disputed Domain Name redirects to another website owned by the Respondent containing the word “vira” which is now the name of the logo on the Respondent’s website. The Panel considers that this change of name is further evidence that the Respondent is not commonly known under the Disputed Domain Name.

Finally, the Respondent did not demonstrate that it is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers.

Indeed, in order to assess whether a respondent is making a legitimate noncommercial or fair use of the disputed domain name, Panels take in consideration a wide variety of element such as (i) the nature of the domain name, or (ii) whether the domain name has been registered and is being used for legitimate purposes and not as a pretext for commercial gain or other such purposes inhering to the respondent’s benefit, (iii) whether it is clear to Internet users visiting the respondent’s website that it is not operated by the complainant, (iv) whether there is an actual connection between the complainant’s trademark in the disputed domain name and the corresponding website content, and not to a competitor, or an entire industry, group, or individual, and (viii) whether the domain name registration and use by the respondent is consistent with a pattern of *bona fide* activity (whether online or offline) (see section 2.5.2 of the [WIPO Overview 3.0](#)).

According to the Panel, there is not sufficient evidence provided by the Respondent to demonstrate that it has made a noncommercial or fair use of the Disputed Domain Name.

Indeed, the Respondent only affirms that the website to which the Disputed Domain Name resolves is a blog of information and news on different areas (cooking, fashion, lifestyle, slimming, travel ...). However, as stated above, after acquiring the Disputed Domain Name, the Respondent dedicated two front page articles to the Complainant's restaurant and designer and the website of the Respondent did not include any disclaimer to deny any affiliation with the Complainant before the Complaint was filed. Therefore, the Panel considers that the content of the website at the time the Complaint was filed tended to mislead Internet users into thinking there was an affiliation between the Complainant and the Respondent, which cannot be considered as a fair use of the Disputed Domain Name.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers on balance that Complainant has demonstrated that the Respondent does not have rights to or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's 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 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent's website or location or of a product or service on the respondent's website or location.

Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the complainant's (or a competitor's) website, and (vi) absence of any conceivable good faith use (see section 3.1.4 of the [WIPO Overview 3.0](#)).

First, the Panel considers that it is established of the Complainant's CITRON Trademark was registered and used before the Disputed Domain Name was bought by the Respondent.

The Panel points out that the Disputed Domain Name used to resolve to a website reproducing the name of the Complainant's restaurant for which the CITRON Trademark was registered and containing two front-page articles dedicated to the restaurant and the Complainant's famous designer.

The Panel also highlights that the Disputed Domain Name at the time of the decision redirects to another domain name and website owned by the Respondent and the latter underwent a change of name from "CAFÉ CITRON" to "VIRA".

Furthermore, the combination of the words "citron" and "café" is the exact same name of the Complainant's restaurant, and the word "café" is descriptive of the Complainant's activities with regards to the CITRON Trademark. Moreover, the addition of the word "paris" refers to the capital of France where the Complainant's restaurant was located.

Therefore, the Panel finds that there is a risk of confusion and/or association between the Complainant's CITRON Trademark and the Disputed Domain Name, even more since the Disputed Domain Name used to be owned by the Complainant.

The Panel considers that there is evidence that the Respondent knew of the Complainant's prior rights on the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith.

Regarding the use of the Disputed Domain Name, the Panel highlights that:

- the Disputed Domain Name used to resolve to a website reproducing the name of the Complainant's restaurant for which the CITRON Trademark was registered and containing two front-page articles dedicated to the restaurant and the Complainant's famous designer;
- the Respondent indicates that this website allows it to make links for its other websites or those of its partners;
- at the time of the decision, the Disputed Domain Name redirects to another website owned by the Respondent containing the word "vira" which is now the name of the logo on the Respondent's website. The Panel considers that the fact that the Respondent changed the content of the Disputed Domain Name further to the filing of the Complaint is a further indication of the Respondent's bad faith.

There is also sufficient evidence that the Respondent has intended to benefit from the Complainant's reputation to attract Internet users to its website or other websites, by creating a likelihood of confusion with the Complainant's CITRON Trademark as to the source, sponsorship, or affiliation.

Finally, it is important to note that where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. In such cases, UDRP panels may consider the respondent's use of a disclaimer as an admission by the respondent that users may be confused (See section 3.7 of the [WIPO Overview 3.0](#)). In any event, the disclaimer was added on the Respondent's website was after receiving notice of the UDRP Complaint.

In view of all the circumstances of this case, the Panel holds on balance, that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

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 <cafecitronparis.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: January 30, 2023