

ADMINISTRATIVE PANEL DECISION

Bonpoint v. chao du; dong yin; and hui zhang
Case No. D2022-4914

1. The Parties

The Complainant is Bonpoint, France, represented by Cabinet Germain & Maureau, France.

The Respondents are chao du; dong yin; and hui zhang, China.

2. The Domain Names and Registrars

The disputed domain names <bonpoints.com> and <bonpointshop.com> are registered with Name.com, Inc. (the “Registrar”).

The disputed domain name <bonpointpep.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

The above disputed domain names are hereinafter collectively referred to as the “Disputed Domain Names”.

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 21, 2022. On December 21, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the Disputed Domain Names. On December 22, 2022, the Registrars transmitted by email to the Center their verification responses disclosing registrants and contact information for the Disputed Domain Names which differed from the named Respondents and contact information in the Complaint. The Center sent an email communication to the Complainant on December 27, 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 December 29, 2022.

On December 27, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On December 29, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondents 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 Respondents of the Complaint in both Chinese and English, and the proceedings commenced on January 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 26, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on January 27, 2023.

The Center appointed Peter J. Dernbach as the sole panelist in this matter on February 14, 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 simplified joint-stock company registered at the Paris RGS (Registre du commerce et des sociétés). In 1975, the Complainant established its first shop in Paris, France. The Complainant now operates 120 stores in 30 countries, including 25 stores in China, primarily selling children’s clothing.

The Complainant holds trademark rights for BONPOINT in several jurisdictions, including:

- the French trademark No. 1379283, registered on November 12, 1986;
- the European Union trademark No. 003837218, registered on February 12, 2007;
- the European Union trademark No. 018179633, registered on May 22, 2020;
- International trademark No. 1516504, registered on January 9, 2020;
- International trademark No. 1064862, registered on December 28, 2010; and
- the Chinese trademark No. 19959908A, registered on August 14, 2017.

In addition, the Complainant owns and operates several domain names, including:

- <bonpoint.com> reserved on November 3, 1998;
- <bonpoint.eu> reserved on June 18, 2006;
- <bonpoint.cn> reserved on February 23, 2006; and
- <bonpoint.fr> reserved on July 8, 1999.

The Disputed Domain Names <bonpoints.com>, <bonpointpep.com>, and <bonpointshop.com> were registered on September 21, 2022, November 10, 2022, and November 12, 2022, respectively. The Disputed Domain Names resolve to websites that offer competing goods for sale, some of which are identical to the Complainant’s products. Some of these products incorporate the cherry logo for which the Complainant is known.

5. Parties’ Contentions

A. Complainant

The Complainant’s submissions may be summarized as follows:

- (i) The Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has registered the BONPOINT trademark in many jurisdictions and registered domain names containing the BONPOINT trademark, including those noted above. The aforementioned trademarks and domain names were all registered before the Disputed Domain Names and are used in connection with clothing for children and infants.

Established in 1975, the Complainant has built a considerable reputation for itself in children's clothing, cosmetics, and perfumes. It is a popular brand in France and globally and has used its trademarks extensively around the world. It enjoys a strong reputation in Asia and in China.

The Disputed Domain Names make use of the Complainant's trademark in part or in full. The Disputed Domain Name <bonpointpep.com> reproduces the Complainant's trademark in full, with the word "pep", which is hardly perceptible, as the sole addition. The Disputed Domain Name <bonpointshop.com> also reproduces the Complainant's trademark, adding only the descriptive word "shop". Lastly, the Disputed Domain Name <bonpoints.com> fully reproduces the term "bonpoint" and only differs from the Complainant's trademark in the substitution of the letter "t" with the letter "s". However, the letter "t" is typically not pronounced in the word "bonpoint".

As BONPOINT is a distinctive and well-known trademark, these minor changes to the word "bonpoint" do not sufficiently distinguish the Disputed Domain Names from the Complainant's trademark. For example, the addition of the word "shop" to "bonpoint" in <bonpointshop.com> will merely lead Internet users to mistakenly believe that the website of the Disputed Domain Name hosts the Complainant's online shop. Internet users will also unwittingly associate the other Disputed Domain Names with the Complainant. Therefore, the Complainant contends that the Disputed Domain Names are identical or confusingly similar to the Complainant's trademarks and domain names.

(ii) The Respondents have no rights or legitimate interests in respect of the Disputed Domain Names.

There is no business affiliation between the Complainant and the Respondents. The Complainant has not given permission or license to the Respondents to use the Complainant's trademarks in any way.

The Complainant has prior rights in the trademark and domain names, dating back prior to the Respondents' registration of the Disputed Domain Names, leading to a likelihood that consumers will mistakenly believe that the Disputed Domain Names and the websites to which they direct belong to the Complainant or companies affiliated with the Complainant.

(iii) The Disputed Domain Names were registered and are being used in bad faith.

The Respondents do not make any legitimate use of the Disputed Domain Names. Instead, they registered and use the Disputed Domain Names for the sale of counterfeit goods, some of which are identical to the Complainant's goods and are sold at a steep discount. Some of these goods replicate the Complainant's trademark and/or its well-known cherry logo, which is an iconic symbol of the Complainant's brand.

The websites to which the Disputed Domain Names resolve also include false addresses in the "Contact Us" section. The Complainant has verified that some of these addresses are not real and that others have nothing to do with their actual use (*e.g.*, one address is that of a zoo in Knoxville, Tennessee). These false addresses are identical to the addresses used in domain name registrations in which fraudulent websites infringed upon the Complainant's rights and for which a consolidated UDRP complaint was filed in June 2022 (with a decision favourable to the Complainant).

These false addresses, along with the existence of registration forms through which Internet users may input their security or personal details, show bad faith on the Respondents' part. The Respondents are likely using these websites for phishing attacks or for commercial benefit through the sale of counterfeit goods. The websites to which the Disputed Domain Names resolve also contain the Bonpoint name as well as false legal information referring to the Complainant. Therefore, the Complainant contends that the Disputed Domain Names have been registered and used in bad faith.

B. Respondents

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

6. Discussion and Findings

6.1 Language of the Proceeding

Paragraph 11(a) of the Rules provides that “[u]nless 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, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

Paragraphs 10(b) and (c) of the Rules provides that “[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case; [t]he Panel shall ensure that the administrative proceeding takes place with due expedition [...]” It is customary practice to heed the aims of paragraphs 10(b) and (c) of the Rules in the determination of the language of the proceeding, that is, to ensure that this and other proceedings remain part of an accessible and expeditious avenue for domain name dispute resolution. (*Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. ltd.*, WIPO Case No. [D2008-0293](#)).

For the following reasons, the Panel finds that the English shall be language of the proceeding and that the decision shall be rendered in English:

1. the Disputed Domain Names resolve to websites with content in English and items offered for sale in USD;
2. the Respondents were given an opportunity to express their opinion regarding the language of proceeding and failed to do so; and
3. requiring the Complainant to translate the Complaint into Chinese would involve unnecessary delay to the proceeding.

6.2 Consolidation - Multiple Respondents

The consensus view of UDRP panels on the consolidation of multiple respondents is summarized in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), whereby: “[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.”

The Panel acknowledges that the technical evidence suggests that the Disputed Domain Names are under common control and that consolidation would be appropriate. Such evidence includes that the Respondents' email addresses are based on a personal service through two different domains: “[...]@yucenter.live” and “[...]@macenter.live”. Both of these domains were registered on the same day, within 13 seconds of each other, by the same “declared” registrant. Also, both domain names are based on the same email server hosted by the German company Contabo GmbH. The websites to which the Disputed Domain Names resolve contain similar goods for sale. Therefore, the Panel finds that the Disputed Domain Names are under common control.

The Respondents did not reply to the consolidation request. There is no evidence showing that the Complainant's request for consolidation would affect the Respondents' rights in responding to the Complaint. Therefore, the Panel accepts the Complainant's request and finds it appropriate to consolidate three Respondents in one administrative proceeding.

The three Respondents are hereinafter collectively referred to as the “Respondent”.

6.3 Substantive Issues

The Complainant must prove, by evidence, each of the following UDRP elements:

- the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- the Disputed Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.”

The Complainant has established that it is the owner of the BONPOINT trademarks.

Two of the three Disputed Domain Names, <bonpointshop.com> and <bonpointpep.com> replicate the trademark BONPOINT in full. These Disputed Domain Names merely affix the words “shop” and “pep”, respectively, to the identical “bonpoint” element. The other Disputed Domain Name <bonpoin.com> replicates the “bonpoin” part of the trademark BONPOINT differing only in its elimination of the letter “t” and replacing it with the letter “s”. In each of the foregoing cases, the Disputed Domain Names feature minor change(s) to BONPOINT. The addition of the Top-Level Domain “.com” is merely a technical requirement for domain name registration. These minor changes, or the additional words like “shop” or “pep”, do not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant’s trademark.

For these reasons, the Panel finds that the Disputed Domain Names are confusingly similar to the Complainant’s trademark, and the condition of paragraph 4(a)(i) of the Policy has been met.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that [...] (ii) [the respondent has] no rights or legitimate interests in respect of the domain name”.

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, the Disputed Domain Names, for the purposes of paragraph 4(a)(ii) of the Policy:

“(i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [Disputed Domain Name] or a name corresponding to the [Disputed Domain Name] in connection with a *bona fide* offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed Domain Name], even if [the Respondent has] acquired no trademark or service mark rights; or

(iii) [the Respondent is] making a legitimate 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.”

Based on paragraphs 4(a)(ii) and 4(c) of the Policy, the Complainant is first required to make a *prima facie*

case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. The burden of production then shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Disputed Domain Names.

Based on the evidence submitted, it appears that the Complainant's BONPOINT trademark was distinctive and well-known long before the Respondent registered the Disputed Domain Names. The Complainant has asserted that there is no business affiliation between the Complainant and the Respondent, and that the Complainant has not authorized, licensed, or otherwise granted the Respondent's use of BONPOINT in any manner, including as part of any domain name.

Based on the evidence submitted, it appears that the Respondent is using the Disputed Domain Names to attract Internet users to a website where it sells competing goods to the Complainant's BONPOINT branded clothing. The Panel need not ascertain whether the goods sold on the Respondent's websites are genuine, given that the Respondent cannot claim rights or legitimate interests in the Disputed Domain Names when it has not accurately and prominently disclosed its relationship to the trademark owner, leading to user confusion. (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)).

Based on the information provided by the Registrars, it appears that the Respondent's names have no relation to the Disputed Domain Names, so there is nothing in the file to suggest that the Respondents are commonly known by the Disputed Domain Names.

The Panel finds that the Complainant has made out a *prima facie* argument that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. Hence, the burden of production shifts to the Respondent to come forth with appropriate allegations or evidence of rights or legitimate interests in the Disputed Domain Names. The Respondent has not done so. Further, nothing in the evidence submitted suggests that the Respondent has rights or legitimate interests in the Disputed Domain Names.

Having considered the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that "[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that [...] (iii) [the respondent's] domain name has been registered and is being used in bad faith".

Paragraph 4(b) of the Policy sets out the following four circumstances as evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the Respondent] has registered or acquired the [Disputed Domain Name] primarily for the purpose of selling, renting, or otherwise transferring the [Disputed Domain Name] registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the Disputed Domain Name; or
- (ii) [the Respondent] has registered the [Disputed 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 [Disputed Domain Name] primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the [Disputed Domain Name], [the Respondent] has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's 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.

Registered in Bad Faith

The BONPOINT trademarks and the Complainant's domain names were all registered years before the Disputed Domain Names were registered. The Complainant also made wide use of the BONPOINT trademark, including in China, where the Respondent is located, well before the registration of the Disputed Domain Names. It is reasonable to expect that the Respondent knew or should have known about the existence of the BONPOINT trademarks at the time of the Respondent's registration of the Disputed Domain Names. Any search of the term "bonpoint" on Google generates numerous results on the Complainant on just the first page. The same search done on Baidu, the search engine with the largest market share in China, similarly yields many results on the Complainant on its first page. Thus, the Panel finds that the Disputed Domain Names were registered in bad faith.

Used in Bad Faith

In addition, the Disputed Domain Names resolve to websites where goods directly competing with the Complainant's BONPOINT branded clothing are offered for sale. Some of the clothing offered for sale at the websites appear to be replicas of the Complainant's products, bearing the Complainant's cherry logo and its BONPOINT trademark. This is clearly commercial use to attract Internet users for commercial gain.

Together, these facts persuade the Panel that the Respondent is using the Disputed Domain Names in bad faith, and thus the condition of paragraph 4(a)(iii) of the Policy has been met.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that all the Disputed Domain Names, <bonpoin.com>, <bonpointshop.com>, and <bonpointpep.com>, be transferred to the Complainant.

/Peter J. Dernbach/

Peter J. Dernbach

Sole Panelist

Date: February 24, 2023