

## **ADMINISTRATIVE PANEL DECISION**

Big Bang v. Mhnfh Undei

Case No. D2023-1179

### **1. The Parties**

The Complainant is Big Bang, France, represented by Cabinet Hoffman, France.

The Respondent is Mhnfh Undei, Hong Kong, China.

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

The disputed domain name <shoppetzl.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”) in respect of the disputed domain name and other domain names on March 7, 2023. On March 15, 2023, the Complainant filed a separate Complaint in respect of the disputed domain name. On March 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 20, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and its 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 March 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 21, 2023.

The Center appointed Taras Kyslyy as the sole panelist in this matter on May 4, 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 that has been specializing for almost 50 years in the development of mountain and safety equipment for both sporting and professional activities. The Complainant operates under the trademark PETZL which has been the subject of numerous trademark registrations in many jurisdictions around the world, including for instance International Trademark Registration No. 439777 (figurative), registered on July 28, 1978.

The Complainant markets its products under the trademark through numerous retailers, both online and through physical outlets, all over the world. The Complainant's products are available in more than 55 countries worldwide.

The disputed domain name was registered on May 17, 2022, and resolves to a website prominently featuring the Complainant's trademark, containing the graphic elements of the Complainant's original website and offering for sale goods under the Complainant's trademark.

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

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

The disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name is composed of two terms: a generic term "shop" evoking a store and the Complainant's trademark. The Complainant received several complaints from customers who mistakenly believed that they were browsing the Complainant's official website and who in some cases placed orders for products that were never delivered. The content of the website at the disputed domain name is intended to mislead the consumer into believing that this is official Complainant's website and that the products presented and offered for sale therein are therefore genuine Complainant's products.

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has no connection whatsoever with the Complainant, or its trademark. The Respondent is furthermore not recognized by the public through the disputed domain name. The Complainant did not grant any license or distribution rights to the Respondent. The Respondent has never requested or obtained permission from the Complainant to use the disputed domain name incorporating the Complainant's trademark. The Respondent is seeking to create confusion among the public not only by reproducing the Complainant's trademark without any authorization (i) within the disputed domain name, (ii) on all the pages of the website linked to the disputed domain name, (iii) on products that are identical (and infringing) to those of the Complainant in order to make people believe that the products are original, but also by using the Complainant's graphic elements and homepages in order to persuade the consumer that he or she is on an official Complainant's website. This illegitimate and unfair approach tarnishes the Complainant's trademark because of the registration of the disputed domain name, insofar as the latter is used to market counterfeit products of poor quality, which may not comply with the particular standards applicable to this type of product and may therefore be dangerous in terms of safety.

The disputed domain name was registered and is being used in bad faith. By using the disputed domain name the Respondent is attempting to attract, for profit, Internet users to website on which infringing goods, identical to those developed by the Complainant, are marketed under the Complainant's trademark without any authorization. The Respondent creates a likelihood of confusion in the mind of the average consumer by including in the disputed domain name the Complainant's trademark with generic term and by marketing identical products via the website, in order to falsely imply the authentic and authorized nature of the products sold. The Respondent is attempting to entice consumers to buy goods on the website linked to the disputed domain name, in order to unduly and unlawfully profit from the counterfeit goods that are marketed there. The Respondent uses the graphic elements of the Complainant's official website, or even elements identical to those on the home pages of the official website. This approach reinforces the confusion sought to be created by leading consumers and users to believe that the disputed domain name is official.

## B. Respondent

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the applicable generic Top-Level Domain ("gTLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#) in cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case the disputed domain name incorporates the entirety of the Complainant's trademark.

According to section 1.8 of the [WIPO Overview 3.0](#) where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The Panel finds that in the present case the addition of the word "shop" to the disputed domain name does not prevent a finding that it is confusingly similar to the Complainant's trademark.

Considering the above, the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademark by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

According to section 2.8.1 of the [WIPO Overview 3.0](#) resellers, distributors using a domain name containing complainant's trademark to undertake sales related to the complainant's goods may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the "Oki Data Test"), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods at issue;
- (ii) the respondent must use the site to sell only the trademarked goods;

- (iii) the site must accurately and prominently disclose the registrant's relationship with trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names reflecting trademark.

The Panel finds that the Respondent failed to satisfy at least the third above requirement and did not in any way disclose its actual relationship with the Complainant, and thus failed to pass the *Oki Data* Test. The Respondent's use of the disputed domain name misleads consumers into thinking that the website is operated by or affiliated with the Complainant. As such, the Respondent's use of the disputed domain name cannot be considered *bona fide*.

The disputed domain name incorporates the PETZL trademark of the Complainant in its entirety and it is its distinctive element. Since PETZL is a well-known trademark, and the disputed domain name is associated with the website offering PETZL products, the Panel finds that the Respondent must have been aware of the PETZL trademark when it registered the disputed domain name, and that it chose to target the PETZL trademark because of the likelihood that it will attract traffic to the Respondent's website. In the Panel's view, such conduct cannot be regarded as giving rise to rights or legitimate interests on the part of the Respondent to register and use the disputed domain name (see, e.g., *LEGO Juris A/S v. Andrei Novakovich*, WIPO Case No. [D2016-1513](#)).

According to section 2.13.1 of the [WIPO Overview 3.0](#), panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. According to section 2.13.2 of the [WIPO Overview 3.0](#), panels are generally not prepared however to accept merely conclusory or wholly unsupported allegations of illegal activity, including counterfeiting, even when the respondent is in default. On the other hand, panels have found that circumstantial evidence can support a complainant's otherwise credible claim of illegal respondent activity. In the present case the Panel finds that the provided customer's complaint addressed to the Complainant due to fraudulent activities at the disputed domain name proves it was used for illegal activity and thus cannot confer rights or legitimate interests on the Respondent.

Considering the above, the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

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

The Respondent's use of the disputed domain name to purport to sell the Complainant's products shows that at the time of the registration of the disputed domain name the Respondent clearly knew and targeted the Complainant's prior registered and famous trademark, which confirms the bad faith (see, e.g., *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

According to paragraph 4(b)(iv) of the Policy the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location. In this case, the disputed domain name is resolving to a website featuring the Complainant's trademark and falsely pretending to be official Complainant's website to intentionally attract Internet users by creating likelihood of confusion with the Complainant's trademark as to the source of the website and its products. The Panel finds the above confirms the disputed domain name was registered and used in bad faith.

Considering the above, the Panel finds the disputed domain name was registered and is being used in bad faith. Therefore, the Complainant has established its case under 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, <shoppetzl.com>, be transferred to the Complainant.

*/Taras Kyslyy/*

**Taras Kyslyy**

Sole Panelist

Date: May 17, 2023