

ADMINISTRATIVE PANEL DECISION

Les Editions Jalou v. Sidharth Saigal and Chalk Media FZE Case No. D2023-1430

1. The Parties

The Complainant is Les Editions Jalou, France, represented by Clifford Chance, LLP, Hong Kong, China.

The Respondents are Sidharth Saigal, India, and Chalk Media FZE, United Arab Emirates, represented by Scriboard Advocates & Legal Consultants, India.

2. The Domain Name and Registrar

The disputed domain name <lofficialarabia.com> is registered with Google LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 3, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 4, 2023, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 2023, 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 April 16, 2023.

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 registrar-disclosed Respondent of the Complaint, and the proceedings commenced on April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. On May 3, 2023, the Respondents requested for a two-day extension to submit the Response. The due date for Response was accordingly extended through May 10, 2023. The Response was filed with the Center on May 9, 2023.

On May 30, 2023, and June 9, 2023, the Complainant submitted unsolicited supplemental filings. On June 5, 2023, and June 12, 2023, the Respondents submitted unsolicited supplemental filings.

The Center appointed Steven A. Maier, Nicholas Weston, and John Swinson as panelists in this matter on June 15, 2023. The Panel finds that it was properly constituted. Each member of 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. Identity of Respondents

The registrar-disclosed Respondent in this proceeding is Sidharth Saigal. Mr. Saigal has provided evidence that he is the owner and authorized representative of a company registered in the United Arab Emirates named Chalk Media FZE, which was a licensee of the Complainant with Mr. Saigal as guarantor and which used the disputed domain name. The Panel finds on balance that Mr. Saigal registered the disputed domain name on behalf of Chalk Media FZE and that both Mr. Saigal and Chalk Media FZE are proper Respondents in this proceeding. The term Respondent is used in the remainder of this Decision to refer interchangeably to Mr. Saigal and Chalk Media FZE.

5. Parties' Unsolicited Supplemental Filings

As discussed in section 4.6 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"):

"Paragraph 10 of the UDRP Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition. [...]

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. [...]"

In all such cases, panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some "exceptional" circumstance)."

In this proceeding, the Panel determines that it shall admit the Complainant's first supplemental filing dated May 30, 2023, and the Respondent's first supplemental filing dated June 5, 2023, to the limited extent that they contain the submissions and evidence expressly referred to below. The Panel declines to admit the Parties' additional supplemental filings and observes that the contents of those additional supplemental filings would not in any event have affected the outcome of the case.

6. Factual Background

The Complainant is a limited company incorporated in France. It is a publisher and distributor of fashion magazines, including a French fashion and lifestyle magazine named L'Officiel, which was first published in Paris in 1921.

The Complainant is the owner of numerous trademark registrations which comprise or include the mark L'OFFICIEL. Those registrations include:

- Bahrain trademark, registration number 1/046099, registered on June 3, 2008, for a mark combining the term L'OFFICIEL in large type with the words DE LA COUTURE ET DE LA MODE DE PARIS in smaller type. The Complainant contends that it has similar trademarks in Saudi Arabia, Oman, Qatar and Kuwait, although it does not provide full evidence of these additional registrations or their dates;

- European Union Trade Mark registration number 006728695 for a word mark L'OFFICIEL HOMMES, registered on February 6, 2009; and
- European Union Trade Mark registration number 018453442 for a word mark L'OFFICIEL, registered on August 26, 2021.

The Complainant, Chalk Media FZE and Mr. Saigal are the parties to a licence agreement dated June 2018 relating to the distribution of the Complainant's magazine L'Officiel in the states of the Gulf Cooperation Council, namely the United Arab Emirates, Qatar, Bahrain, Kuwait, Oman, and Saudi Arabia (the "Licence Agreement"). The Complainant submits that it duly terminated the Licence Agreement by notice dated February 11, 2021, which the Respondent disputes.

The disputed domain name was registered on April 10, 2018. The Respondent has used the disputed domain name for the purpose of publishing content from, and expressly associated with, the Complainant's publication L'Officiel.

7. Parties' Contentions

A. The Complaint

The Complainant contends that, during the currency of the Licence Agreement, the Respondent was entitled to publish the Complainant's magazine in the Middle East and to use its L'OFFICIEL trademarks for that purpose. It states in particular that "The L'Officiel Middle East website was operated on the Disputed Domain Name during the terms of the Licence agreement".

The Complainant submits that it duly terminated the Licence Agreement by notice dated February 11, 2021, and that the Licence Agreement concluded accordingly, with effect from either February 26, 2021 or on or about November 23, 2022. The Complainant contends that, following that termination, the Respondent no longer had the right to use the Complainant's L'OFFICIEL trademark and was obliged to cease operating its relevant website, and other related online media, in the Middle East territory. The Complainant relies on the terms of the Licence Agreement for the proposition that the Respondent had no right to use the disputed domain name following the termination of the Licence Agreement. The Complainant claims that the Respondent's continued use of the disputed domain name to publish its magazine post such termination represents an infringement of its intellectual property rights.

The Complainant contends that the disputed domain name is confusingly similar to its trademark L'OFFICIEL. It submits that its mark is neither generic or descriptive and that the disputed domain name incorporates it in full. It contends that the additional term "arabia" is merely descriptive of a geographical area and is typical of the manner in which the Complainant uses domain names to designate local editions of its magazine, e.g. <lofficielusa.com>.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It repeats that any rights of the Respondent to use the L'OFFICIEL trademark ended in conjunction with the termination of the Licence Agreement. It states that the Respondent's combination of the Complainant's trademark L'OFFICIEL with the country designation "arabia" seeks to take advantage of the Complainant's goodwill in its trademark and that the Respondent's website continues misleadingly to represent itself as being legitimately associated with the Complainant.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It states that the Respondent was obviously aware of the Complainant's trademark and its extensive international reputation and that there was no justification for it to register or use a domain name which incorporated its L'OFFICIEL trademark. It contends that the Respondent is using the disputed domain name to free-ride on the Complainant's goodwill by seeking to deceive Internet users into believing that it continues to be legitimately associated with a 100-year-old iconic French magazine.

The Complainant makes further submissions concerning an additional domain name operated by the Respondent, and otherwise, in support of its contentions that the disputed domain name was registered and is being used in bad faith. The Panel does not find those further submissions to be material to this Decision for reasons which will become apparent from the analysis below.

The Complainant requests the transfer of the disputed domain name.

B. The Response

The Respondent contends that it continues to have the right to publish L'Officiel magazine in the relevant Middle Eastern countries by virtue of the Licence Agreement. It states that the Licence Agreement was for a term of eight years from 2018 and that it has made a significant investment in promoting the relevant business. It exhibits what it states to be a copy of the Licence Agreement.

The Respondent submits that it has disputed the Complainant's notice of termination, which was based on the alleged non-payment of monies due, for several reasons. These included a factual dispute over the amount of the monies claimed, as well as the existence of a *force majeure* clause in the Licence Agreement, which was itself subject to French law. The Respondent further alleges that, notwithstanding its service of a notice of termination, the Complainant continued for a period of nine months to conduct regular day-to-day business communications with the Respondent. The Respondent adds that, in its response to the Complainant's notice of termination, it made clear that it relied on an arbitration clause contained in the Licence Agreement. The Respondent exhibits copies of the relevant correspondence.

The Respondent contends that the dispute between the parties is, accordingly, of a civil and commercial nature, based on the past relationship of the parties, and is beyond the scope of the UDRP. It relies on a number of previous decisions under the UDRP in support of this position, e.g. *Pret A Manger (Europe) Limited v. Pretto LLC*, WIPO Case No. [D2018-0782](#). The Respondent submits that the disputed domain name is inseparable from the larger commercial dispute between the parties. It further submits that its registration and use of the disputed domain name cannot be viewed as "cybersquatting" as contemplated by the Policy.

The Respondent acknowledges that the disputed domain name is identical [*sic*] to the Complainant's L'OFFICIEL trademark. It maintains that it is duly authorized to use that trademark by virtue of the Licence Agreement.

The Respondent contends that it has rights or legitimate interests in respect of the disputed domain name by virtue of being the Complainant's authorized licensee. It adds that it is the owner of a United Arab Emirates trademark for the mark L'OFFICEL ARABIA, for which it applied on December 7, 2020, and therefore before the date of the Complainant's termination notice (although the Panel observes that the Respondent's evidence exhibited in connection with this trademark is without a translation and unclear). The Respondent submits that it is therefore using the disputed domain name for a *bona fide* offering of goods or services under the Licence Agreement and has rights or legitimate interests in the disputed domain name.

The Respondent denies that the disputed domain name was registered or has been used in bad faith. It submits that the Complainant must establish both registration in bad faith and use in bad faith and that, in the circumstances set out above, it clearly unable to demonstrate the former. It alleges in particular that the Complainant was aware of its United Arab Emirates trademark application but made no objection to it.

C. The Complainant's Supplemental Filing

The Complainant denies that the dispute between the parties is complex or outside the scope of the UDRP. It states that the Respondent can deny neither the Complainant's rights in the L'OFFICEL mark or that the disputed domain name is identical [*sic*] to that mark.

The Complainant further disputes that it acquiesced in the registration of the Respondent's United Arab Emirates trademark. It states that the registration constituted a breach of the Licence Agreement which prohibits the registration of any such trademark without the Complainant's consent. It contends that the Respondent was obliged to inform it of its trademark application and that the Complainant is not able continually to monitor all trademark filings.

The Complainant submits that the Respondent cannot have rights or legitimate interests in respect of the disputed domain name as it must have realized the potential for confusion that would arise from the registration of both the disputed domain name and the Respondent's United Arab Emirates trademark. It claims that the Respondent does not have rights or legitimate interests in circumstances where it using the disputed domain name for "fraudulent activities".

Concerning registration and use in bad faith, the Complainant states as follows:

"The Complainant acknowledges that at the time when the [disputed domain name] was registered, it was registered with the knowledge of the Complainant and subject to it being used in accordance with the terms of the Licence Agreement..."

The Complainant submits that the Respondent's website is no longer operated under the quality control of the Complainant and that the disputed domain name is accordingly "[...] no longer registered with the consent of the Complainant."

The Complainant further submits that the Respondent has attempted to deceive the Panel by its exhibit which it claims to be a copy of the Licence Agreement. The Complainant states that the Respondent deliberately omitted a number of pages from this copy, which contained relevant clauses. The Complainant sets out those clause, including clause 7.5 which states that both during and after the termination of the Licence Agreement [...] the Licensee undertakes not to file [...] any of the Trademarks [...] [or] any Internet Domain Name". It also refers to clause 7.7, under which the Licensee undertakes to inform the Licensor of any infringement of the Complainant's trademark rights.

The Complainant seeks to rely on the Respondent's omission of the relevant clauses as further evidence of bad faith on its part.

D. The Respondent's Supplemental Filing

The Respondent denies having exhibited an incomplete copy of the Licence Agreement with any intention of deceiving the Panel. It states that it exercised its discretion as to what parts of the Licence Agreement to include [...] in providing a concise and targeted Response to specifically address the relevant issues raised by the Complainant."

The Respondent submits that the Complainant was demonstrably aware of, and acquiesced in, its registration of the disputed domain name. It exhibits various email exchanges dated September 2018 with an individual who is identified as the Complainant's Head of Digital Product. Those emails relate to the Respondent's website content and in particular the question of picture alignment. They include an email from the relevant individual, dated September 27, 2018, stating that "the DNS switch is completed" and that the Respondent should from now on "forget about the old temporary domain [...] and use the real domain [...] Frontend: [sic] "https://www.lofficielarabia.com".

8. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (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

The Complainant has established registered trademark rights going back to at least 2008 for marks including the term “L’Officiel” together with other elements, and a European Union Trade Mark dated August 26, 2021, for a word mark L’OFFICIEL. The disputed domain name incorporates the whole of that trademark (disregarding the apostrophe) together with the term “arabia” which does not prevent the trademark from being recognizable within the disputed domain name. The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In the view of the Panel, the question of whether or not the Respondent has rights in the disputed domain name is inextricably tied to the question of whether or not the Licence Agreement was validly terminated by the Complainant. That matter is disputed between the parties and is not a question which the Panel finds to be suitable for determination within the confines of the UDRP.

As observed in section 4.14.6 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)):

“Depending on the facts and circumstances of a particular case, and irrespective of whether the parties may also be engaged in court litigation, in some instances (e.g., complex business or contractual disputes) panels have tended to deny the case not on the UDRP merits but on the narrow grounds that the dispute between the parties exceeds the relatively limited “cybersquatting” scope of the UDRP, and would be more appropriately addressed by a court of competent jurisdiction.”

In this case, any determination of the contractual dispute between the Parties implicates a number of factors. First, there is a dispute concerning the factual matrix. Secondly, the Licence Agreement is stated to be governed and construed in accordance with the laws of France: the Panel is not versed in French law and may only determine this proceeding under the terms of the Policy in any event. Thirdly, the Respondent relies on a *force majeure* clause within the Licence Agreement, which would require not only a factual examination, but also a determination of what constitutes *force majeure* for the purposes of French law. Fourthly, the Licence Agreement expressly states that:

“All disputes between the Parties arising out of or in connection with the present Agreement, whether regarding its interpretation, its fulfilment and/or its termination, shall be settled through arbitration entrusted to three (3) arbitrators appointed in compliance with the rules of the [French Arbitration Body].”

Since the Panel is not in a position to decide the applicability or otherwise of the arbitration clause to the dispute between the Parties, or any of the other matters set out above, the Panel finds that determination of these issues clearly falls outside the scope of the UDRP and that it is unable, therefore, to determine whether or not the Respondent has rights or legitimate interests in respect of the disputed domain name. In these circumstances, it is impossible for the Complainant to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name and the Complaint must necessarily fail.

C. Registered and Used in Bad Faith

While the Panel's determination under the second element of paragraph 4(a) of the Policy is sufficient to dispose of the proceeding, the Panel also considers it appropriate to record its observations on the issue of registration of the disputed domain name in bad faith.

As the Respondent correctly observes, the third element of paragraph 4(a) of the Policy involves the conjunctive requirement that a complainant must demonstrate first, that the disputed domain name was registered in bad faith and secondly, that it is being used in bad faith. Therefore, even if a complainant can establish that the respondent's current use of the domain name is in bad faith, it will inevitably fail in its complaint unless it can also show that the registration or acquisition of the domain name (by that respondent) was in bad faith.

In this case, notwithstanding the language of clause 7.5 of the Licence Agreement, the Complainant freely admits that the disputed domain name was registered with its knowledge and that it acquiesced in its registration and use during the currency of the Licence Agreement.

The Panel also finds on the evidence that that the Complainant assisted the Respondent with its website, including the reconfiguration of that website upon the disputed domain name, in or around September 2018.

While the Complainant submits that it only consented to the Respondent using the disputed domain name for the duration of the Licence Agreement, which it contends has now terminated, such termination, even if valid, cannot convert a good faith registration into a bad faith registration retroactively. There is no evidence that the Respondent registered the disputed domain name with the intention of infringing any rights of the Complainant or any other party, and on the contrary, the Panel finds that it registered the disputed domain name with the legitimate intention of using it in connection with its licensed publication of the Complainant's magazine. Regardless of its submissions concerning subsequent breach and termination, the Complainant cannot therefore demonstrate that the Respondent registered the disputed domain name in bad faith and the Complaint must necessarily fail for that reason also.

9. Decision

For the foregoing reasons, the Complaint is denied.

/Steven A. Maier/
Steven A. Maier
Presiding Panelist

/Nicholas Weston/
Nicholas Weston
Panelist

/John Swinson/
John Swinson
Panelist
Date: June 29, 2023