

## **ADMINISTRATIVE PANEL DECISION**

Jacquemus SAS v. CAROLYN SMITH

Case No. D2023-1893

### **1. The Parties**

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

The Respondent is CAROLYN SMITH, United States of America.

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

The disputed domain name <jacquemusfashion.com> (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 April 27, 2023. On April 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 27, 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 (REDACTED FOR PRIVACY, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 5, 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 May 5, 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 Respondent of the Complaint, and the proceedings commenced on May 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 16, 2023.

The Center appointed Michael D. Cover as the sole panelist in this matter on June 22, 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 has manufactured and marketed clothing and fashion accessories under the trademark JACQUEMUS. Those products are known worldwide in the fashion industry, including for the quality and originality of its creations; and Simon Porte Jacquemus, its designer, is considered to be one of the most important designers in the fashion industry. JACQUEMUS products are sold in 50 different countries around the world.

The Complainant is the proprietor of many registered trademarks around the world, including international trademark No. 1211398 JACQUEMUS registered on February 5, 2014, in Classes 9,18, and 25, international trademark No. 1513829 JACQUEMUS registered on November 19, 2019, and European Union trademark No. 018080381 JACQUEMUS registered on October 18, 2019, and copies of the registration certificates for these trademarks are provided at Annex 5 to the Complaint.

The Complainant is the proprietor of the domain name <jacquemus.com>, registered in 2010.

The Disputed Domain Name was registered on December 14, 2022. The Disputed Domain Name has been pointed at a website which is very similar to the Complainant's official website, with no disclaimer as to the lack of affiliation with the Complainant.

The Complainant sent a cease and desist letter before the filing of this Complaint and this is set out at Annex 8 to the Complaint.

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

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

##### **Identical or Confusingly Similar**

The Complainant notes that it is the owner of several trademarks in the world, duly exploited, notably for clothing in Classes 24 and 25. The Complainant submits that its JACQUEMUS trademarks are well-known throughout the world, notably in the clothing industry.

The Complainant also notes that its trademarks are wholly reproduced in the Disputed Domain Name and submits that the addition of the word "fashion" in the Disputed Domain Name does not exclude a likelihood of confusion and in fact, as the word directly refers to the Complainant's activity, contributes to confusing similarity. The Complainant notes that previous UDRP decisions have stated that the addition of such a descriptive term does not avoid confusing similarity. The Complainant also submits that the addition of the generic Top-Level Domain("gTLD"), ".com", should not be taken into account to assess the likelihood of confusion, not least as this is a technical requirement of registration.

The Complainant concludes that the use of its trademarks in the Disputed Domain Name leads the public to believe that the Disputed Domain Name belongs to the Complainant.

##### **Rights or Legitimate Interests**

The Complainant states that it has never authorized the Respondent to register or use any domain name incorporating JACQUEMUS trademarks and that the Complainant has not granted a license or any authorization to use those trademarks, including as a domain name.

The Complainant continues by submitting that the Respondent has not made a legitimate non-commercial or fair use of the Disputed Domain Name. Indeed, the Complainant notes that the Disputed Domain Name pointed to a website which the Complainant describes as a “copycat” of the Complainant’s official website, with no disclaimer as to the lack of affiliation with the Complainant. The Complainant notes that previous panels have already stated that the fact that a respondent is benefitting either directly or indirectly from wrongly associating itself with a complainant establishes that the relevant respondent lacks rights or legitimate interests in a disputed domain name and cites the decision in *Teva Pharmaceutical Industries Limited v. Miraj Albert*, WIPO Case No. [D2021-1707](#) in support.

The Complainant concludes that such use does not qualify as *bona fide* offering of goods and services.

### **Registered and used in Bad Faith**

The Complainant submits that JACQUEMUS trademark is well known and goes on to submit that previous panels have held that the registration of well known trademark as a domain name by an unaffiliated entity is a clear indication of bad faith, even without considering other elements.

The Complainant states that its JACQUEMUS trademarks have acquired an extensive and worldwide reputation and should thus be recognized as well known and cites the decisions of previous Panels, which have recognized the reputation of those trademarks. The Complainant goes on to submit that the choice of the Disputed Domain Name 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 with the Complainant’s trademarks and domain name.

The Complainant concludes that the JACQUEMUS trademarks are well known and that, in application with the previous decisions of panels, it should be deemed that the registration of the Disputed Domain Name has been done per se in bad faith.

### **Remedy requested by the Complainant**

The Complainant requests that the Panel order that the Disputed Domain Name be transferred to the Complainant.

### **B. Respondent**

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

## **6. Discussion and Findings**

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and that the Disputed Domain Name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant has established registered rights in its trademark JACQUEMUS.

The Complainant has also established that the Disputed Domain Name is confusingly similar to its JACQUEMUS trademark, in which it has rights. The Disputed Domain Name contains the Complainant’s trademark JACQUEMUS in its entirety. It is well established that the addition of items, such as “fashion” in this case, does not prevent a finding of confusing similarity. It is also well established that the addition of gTLD, such as “.com” in this case, is to be disregarded in assessing confusing similarity, not least as this is a technical requirement of registration of domain name.

The Panel therefore decides that the Disputed Domain Name is confusingly similar to a trademark, in which the Complainant has rights.

### **B. Rights or Legitimate Interests**

The Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and that the provisions of paragraph 4(a)(ii) of the Policy have been met.

The Panel accepts that the Respondent has not been authorized, licensed, or otherwise permitted by the Complainant to register or use the Complainant's JACQUEMUS trademark as part of the Disputed Domain Name or otherwise.

The Complainant has established a *prime facie* case, to which no response has been filed, that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not, before any notice to the Respondent of the dispute, made use or demonstrable preparations to use the Disputed Domain Name or a name corresponding to it in connection with a *bona fide* offering of goods or services nor has the Respondent been commonly known by the Disputed Domain Name nor has the Respondent made a legitimate, noncommercial, or fair use of the Disputed Domain Name; it has used the same to misleadingly divert consumers based on the trademark at issue. Such use involves the Disputed Domain Name resolving to a website, which resembles the official website of the Complainant. This does not constitute a *bona fide* offering of goods or services.

The Panel therefore decides that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

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

The Panel finds that the Disputed Domain Name has been registered and is being used in bad faith. It is a reasonable inference that the Respondent knew of the Complainant and its well-known JACQUEMUS trademark at the time when the Respondent registered the Disputed Domain Name and that the Respondent can have had no reason to register the Disputed Domain Name other than for the significance of the JACQUEMUS element, which is the dominant part of the Disputed Domain Name.

With regard to the use of the Disputed Domain Name, this has been used to resolve to the website which resembles that of the Complainant. In addition, the Respondent has failed to use the opportunity to file a Response to the cease and desist letter or the Complaint and, in particular, to file any evidence of good faith use and had sought to conceal the identity of the Respondent.

The Panel accordingly finds that the Respondent has registered and is using the Disputed Domain Name in bad faith and that the provision of the Policy, paragraph 4(a)(iii) 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 the Disputed Domain Name, <jacquemusfashion.com>, be transferred to the Complainant.

*/Michael D. Cover/*

**Michael D. Cover**

Sole Panelist

Date: July 13, 2023