

ADMINISTRATIVE PANEL DECISION

Delsey v. Lenna Wehner
Case No. D2023-4648

1. The Parties

The Complainant is Delsey, France, represented by Domgate, France.

The Respondent is Lenna Wehner, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <delseystore.com> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 9, 2023. On November 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 9, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 15, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Centre received a communication on November 16, 2023, from the Complainant, requesting the suspension of the above-referenced administrative proceeding and the Center suspended proceedings until December 16, 2023, for the purposes of settlement discussions concerning the disputed domain name. On November 21, 2023, the Complainant requested that the proceedings be reinstated whiling submitting an amended Complaint and the proceeding was reinstated on November 22, 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 November 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 19, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on January 3, 2024. 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 manufacturer of luggage based in France which sells its collections online and in more than 6,500 points of sale in over 110 countries, including in department stores such as Galeries Lafayette, Printemps, Harrods, Selfridges, Karstadt, La Rinascente, El Corte Inglés, Dubai Mall, Macy's, Bloomingdales, and Mitsukoshi, as well as in multi-brand boutiques and exclusive Delsey stores. It commenced its presence in the United States and Canada in 2000, more than 20 years ago.

In 2022, the Complainant employed over 4,000 people worldwide, and has generated net global sales of EUR 207 million. Through its international website at "www.delsey.com", the Complainant sells to customers on five continents and in 2022, it ran a global branding campaign across 16 countries. The Complainant also has an established presence and following on social media sites such as Facebook, Instagram, and Pinterest.

The Complainant owns registered trade marks in numerous jurisdictions for or incorporating its DELSEY mark including the French trade mark registration DELSEY No. 1211815, registered on August 25, 1982; the French trade mark registration DELSEY PARIS No. 4576396, registered on December 13, 2019 and the United States trade mark registration DELSEY No. 4650555, registered on December 2, 2014.

The disputed domain name was registered on September 4, 2023. The disputed domain name resolves to a website which features the Complainant's DELSEY PARIS mark, various information concerning the history of the DELSEY brand, appears to offer the Complainant's products at discount prices and otherwise seems to masquerade as belonging to or as being authorised by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name incorporates its DELSEY trade mark in its entirety and is therefore confusingly similar to its registered trade mark. It submits that the mere addition of the common English word "store" does not eliminate the similarity between the Complainant's trade mark and the disputed domain name.

The Complainant submits that its DELSEY mark is not a generic term but is the distinctive combination of the names of its founders Delahaye and Seynhaeve. The Complainant submits that the Respondent is not known under the DELSEY name or mark, and a simple Internet search confirms this fact and provides results pertaining to the Complainant and not to the Respondent. The Complainant submits that to its knowledge the Respondent does not own any DELSEY trade mark and has never licensed or otherwise authorised the Respondent to use the DELSEY trade mark as a domain name and particularly for giving access to a commercial website. The Complainant says that the disputed domain name resolves to an online shop and therefore, the use of the disputed domain name is commercial and cannot be considered as a legitimate noncommercial or fair use of the disputed domain name. The Complainant further notes that the Respondent did not reply to its cease and desist letter which it says further confirms the Respondent's lack of rights or legitimate interests in the disputed domain name.

As far as bad faith is concerned, the Complainant submits that the Respondent clearly knew of the Complainant's mark at the time of registration because the DELSEY mark is used in its entirety in the disputed domain name and the website to which it resolves is in the French language and features the Complainant's logo and DELSEY PARIS trade mark, and overall looks like the Complainant's official website. The Complainant also notes that the website to which the disputed domain name resolves also includes some pages about the history of the DELSEY brand which reinforces the impression that the website is an official site of the Complainant. However, the Complainant says that the contact information indicated on the website is an address in Viet Nam, while the currencies accepted are EUR, GBP, or USD, none of which is consistent with the website being in the French language.

The Complainant submits that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website at the disputed domain name by creating a likelihood of confusion with the Complainant's mark as to the source of the website and the products on it. It also asserts that the Respondent has registered or acquired the disputed domain name primarily for the purpose of attracting Internet users to its counterfeiting website. The Complainant says there is no doubt that the Respondent registered and is using the disputed domain name in order to make money or to disrupt the Complainant's business.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the word "store" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 a *prima facie* case that the 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Complainant has submitted that its DELSEY mark is not a dictionary term but is the distinctive combination of the names of its founders Delahaye and Seynhaeve. The Complainant has asserted that the Respondent is not known under the DELSEY name or mark, and a simple Internet search confirms this fact and provides results pertaining to the Complainant and not to the Respondent. The Complainant has also submitted that to its knowledge the Respondent does not own any DELSEY trade mark and has never licensed or otherwise authorised the Respondent to use the DELSEY trade mark as a domain name or use it to give access to a commercial website.

The disputed domain name resolves to an online shop at a website that also uses the DELSEY PARIS logo mark and which is presented as if it belongs to or is affiliated with the Complainant when according to the Complainant this is not the case. The Complainant has asserted that such use is commercial and cannot be considered as a legitimate noncommercial or fair use of the disputed domain name. The Complainant has further noted that the Respondent did not reply to its cease-and-desist letter which it says is also indicative of the Respondent's lack of rights or legitimate interests in the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the website to which the disputed domain name resolves appears to masquerade as if it belongs to the Complainant or is authorised by the Complainant. It features the Complainant's DELSEY PARIS logo together with a considerable amount of information about the DELSEY brand. It is therefore more than likely that the Respondent was well aware of the Complainant's long established and distinctive DELSEY trade mark and business when the Respondent registered the disputed domain name in 2023 many years after the registration of the Complainant's trade marks.

Under paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of the disputed domain name in bad faith where a respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's trade marks as to the source, sponsorship, affiliation, or endorsement of the website.

In this case, the Respondent has used the disputed domain name to intentionally attract Internet users for commercial gain, to its website by creating a likelihood of confusion with the Complainant's DELSEY mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. The website masquerades Internet users as if it belongs to or is authorised by the Complainant and for the purposes of offering heavily discounted products that are being marketed as DELSEY products. The Complainant has asserted that it has not authorised the Respondent to use its marks or to sell its products and that these products are counterfeit goods. This assertion has not been challenged by the Respondent, and although there is otherwise no evidence on the record as to whether the goods offered from the website are fake or genuine products, the Panel finds that the Respondent's conduct amounts to conduct in terms of paragraph

4(b)(iv) of the Policy which is evidence of registration and use of each of the disputed domain names in bad faith. The Panel's view in this regard is only reinforced by the Respondent's failure to respond to the Complainant's cease-and-desist letter and/or to the Complaint.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <delseystore.com> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: January 17, 2024