

ADMINISTRATIVE PANEL DECISION

Jacquemus SAS v. Client Care, Web Commerce Communications Limited Case No. D2023-4751

1. The Parties

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

Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names, <jacquemusar.com>, <jacquemusau.com>, <jacquemusbelgie.com>, <jacquemusbogota.com>, <jacquemusca.com>, <jacquemuscl.com>, <jacquemusdenmark.com>, <jacquemus-dubai.com>, <jacquemusegypt.com>, <jacquemus.com>, <jacquemushr.com>, <jacquemusie.com>, <jacquemusit.com>, <jacquemusjp.com>, <jacquemus-malaysia.com>, <jacquemusnl.com>, <jacquemusnorgeno.com>, <jacquemusnzshop.com>, <jacquemusosterreich.com>, <jacquemusoutletgreece.com>, <jacquemusoutletsuomi.com>, <jacquemusph.com>, <jacquemuspt.com>, <jacquemusro.com>, <jacquemusrs.com>, <jacquemussa.com>, <jacquemusse.com>, <jacquemus-singapore.com>, <jacquemussk.com>, <jacquemus-turkiye.com>, <jacquemusukshoip.com>, <jacquemusukshop.com>, <jacquemusus.com>, and <jacquemusza.com>, are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2023. On November 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 20, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registrant not identified) and contact information in the Complaint. The Center sent an email communication to Complainant on November 23, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 23, 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 Respondent of the Complaint, and the proceedings commenced on November 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2023. Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 18, 2023.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on December 21, 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

Complainant is a French company that since 2013 has manufactured, marketed, and sold clothing and fashion accessories. Complainant's products are designed and promoted for the high fashion segment of the market. The trademark JACQUEMUS under which Complainant's clothing and accessory products are marketed and sold is the surname of its founding designer Simon Port JACQUEMUS. Complainant has long operated a commercial website, including at the domain names <jacquemus.com> and <jacquemus.fr>. Complainant's products are sold in a substantial number of countries.

Complainant is owner of registrations for the word trademark JACQUEMUS, including on the register of the French Patent and Trademark Office (INPI), registration number 4057016, registration dated January 17, 2014, in international classes (ICs) 9, 18, and 25, covering, *inter alia*, eyeglasses, leather accessories, clothing, and footwear; on the register of the European Union Intellectual Property Office (EUIPO), registration number 018080381, registration dated October 18, 2019, in ICs 14, 24, and 28; registration as an International Trademark under the Madrid System, registration number 1211398, registration dated February 5, 2014, in ICs 9, 18, and 25, designating a substantial number of countries, and: registration on the register of the Intellectual Property Office of Malaysia (MyIPO), registration number TM2020023742, registration dated October 14, 2020, in ICs 18 and 25.

According to the Registrar's verification, Respondent is the owner of registration for each of the 35 disputed domain names at issue in this proceeding. The disputed domain names were registered on September 21, 2023.

Respondent has directed 16 of the disputed domain names to websites that are designed to appear as operated by Complainant, including with prominent display of Complainant's JACQUEMUS trademark. These websites display photographs of models wearing clothing products purporting to originate with Complainant, and they display photographs of accessories with Complainant's branding. Ordering and pricing information is displayed (with prices indicated in the local currency of the websites using geographic identifiers that are incorporated in the respective disputed domain names). Complainant states that it is unaware of the source of the products displayed on Respondent's websites. It presumes they are counterfeit products. No information has been provided as to whether Respondent actually ships products displayed on its websites to Internet users, whether or not those products are counterfeit. Complainant states that it has been unable to make contact with Respondent through the contact portals that are part of Respondent's websites.

19 of the disputed domain names appear not to have been associated with active websites.

Respondent has been the subject of numerous previous adverse UDRP determinations involving allegations of selling counterfeit products using domain names incorporating well-known brands. See, e.g., *Valentino S.p.A. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-2868](#).

5. Parties' Contentions

A. Complainant

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

Notably, Complainant contends that it owns rights in the trademark JACQUEMUS and that each of the disputed domain names is identical or confusingly similar to that trademark.

Complainant argues that Respondent lacks rights or legitimate interests in the disputed domain names because: (1) Complainant has not authorized Respondent to make use of its trademark whether in the disputed domain names or otherwise; (2) Respondent has not made legitimate noncommercial or fair use of the disputed domain names, and; (3) the disputed domain names either have been used in connection with the offering and sale of counterfeit goods, or have not been associated with active websites, in each case not constituting a *bona fide* offering of goods.

Complainant contends that Respondent registered and is using the disputed domain names in bad faith because: (1) Respondent knew or should have known of Complainant's trademark rights when it registered the disputed domain names; (2) Respondent's registration of Complainant's well-known trademark without more constitutes bad faith; (3) Respondent's passive holding of multiple disputed domain names under circumstances such as those present in this case evidence's bad faith; (4) Respondent has taken steps to disguise its identity; (5) Respondent has been the subject of numerous previous adverse UDRP decisions, including a number involving the alleged sale of counterfeit products.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent has notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical address provided in its record of registration. Courier delivery of the Written Notice to Respondent was successfully completed. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. Each of the 35 disputed domain names at issue in this proceeding are registered by the same domain name holder.

This proceeding involves a substantial number of disputed domain names (i.e., 35) in two groups. The first group is disputed domain names that have been associated with active websites. The second group is disputed domain names that have not been associated with active websites. Respondent's conduct within each group is substantially identical. Given that substantial identity, there is no need for the Panel to address each of the disputed domain names separately. Rather the disputed domain names can be addressed by their respective groups as appropriate.

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 Complainant's trademark 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 Complainant has shown rights in respect of a trademark 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 each of the disputed domain names (in both groups). Accordingly, each of the disputed domain names is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Furthermore, the Panel finds the mark is recognizable within each of the disputed domain names. Accordingly, each of the disputed domain names (in each group) is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms such as geographical identifiers may in principle – although not in this case – bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names (in both groups) 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 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 Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain names. Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

While evidence is lacking as regards the genuine nature of the goods offered at the first group of disputed domain names, the Panel need not come to any conclusion thereon in view of the failure of these disputed domain names to satisfy the so-called "Oki Data test" enshrined in section 2.8 of the [WIPO Overview 3.0](#). Rather, in view of the use of the Complainant's trademark in both the disputed domain names' construction and content, and the lack of any disclaimer, it is clear that the Respondent sought to impersonate the Complainant, or create the impression of being an authorized distributor in the geographical area corresponding to the relevant disputed domain name, for its presumed financial gain. Panels have held that the use of a domain name for illegal activity, here impersonation and alleged sale of counterfeit goods as to the first group of disputed domain names (i.e., associated with active websites), can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

With respect to the second group of disputed domain names (i.e., not associated with active websites), Respondent has done nothing to establish rights or legitimate interests.

Furthermore, the Panel notes that the composition of all the disputed domain names, wholly incorporating Complainant's JACQUEMUS trademark, carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

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 Respondent has engaged in a pattern of bad faith conduct contrary to paragraph 4(b)(ii) of the Policy, having been the subject of numerous adverse UDRP panel determinations involving abusive registration and use of well-known trademarks. This is sufficient to establish bad faith with respect to each of the disputed domain names constituting the subject matter of this proceeding.

Respondent's registration and use of multiple iterations of Complainant's distinctive trademark in disputed domain names in connection with websites advertising and offering for sale clothing and accessories falsely purporting to originate with Complainant indicates a clear targeting of Complainant's goodwill in its trademark. Respondent could not plausibly have been unaware of Complainant's trademark rights. With respect to the first group of disputed domain names (i.e., associated with active websites), Complainant intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant's mark, contrary to paragraph 4(b)(iv) of the Policy.

Moreover, panels have held that the use of a domain name for illegal activity, here as impersonation and alleged sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent's registration and use of the first group of disputed domain names (i.e., associated with active websites) constitutes bad faith under the Policy.

With respect to the second group of disputed domain names (i.e., not associated with active websites), Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the second group of disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have

been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the second group of disputed domain names does not prevent a finding of bad faith under the Policy. Lastly, the Respondent's pattern of bad faith registrations targeting the Complainant in this instance appears to reinforce the Respondent's reputation as a serial cyber-squatter and ultimately the Panel's bad faith finding. See, for example, *Aime Leon Dore LLC and Aime Leon Dore Holdings, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-4628](#), and *Prada S.A. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-4002](#).

Based on the available record, the Panel finds that Complainant has established the third element of the Policy with respect to each of the disputed domain names.

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 names, <jacquemusar.com>, <jacquemusau.com>, <jacquemusbelgie.com>, <jacquemusbogota.com>, <jacquemusca.com>, <jacquemuscl.com>, <jacquemusdenmark.com>, <jacquemus-dubai.com>, <jacquemusegypt.com>, <jacquemusesh.com>, <jacquemushr.com>, <jacquemusie.com>, <jacquemusit.com>, <jacquemusjp.com>, <jacquemus-malaysia.com>, <jacquemusnl.com>, <jacquemusnorgeno.com>, <jacquemusnzshop.com>, <jacquemusosterreich.com>, <jacquemusoutletgreece.com>, <jacquemusoutletsuomi.com>, <jacquemusph.com>, <jacquemuspt.com>, <jacquemusro.com>, <jacquemusrs.com>, <jacquemussa.com>, <jacquemusse.com>, <jacquemus-singapore.com>, <jacquemussk.com>, <jacquemus-turkiye.com>, <jacquemusukshoip.com>, <jacquemusukshop.com>, <jacquemusus.com>, and <jacquemusza.com>, be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: January 4, 2024