

ADMINISTRATIVE PANEL DECISION

Joseph NAKAM v. Mecara Untech

Case No. D2023-4944

1. The Parties

The Complainant is Joseph NAKAM, France, represented by Nameshield, France.

The Respondent is Mecara Untech, United States of America.

2. The Domain Names and Registrars

The disputed domain names <jonakfrance.com> and <jonak-promo.com> are registered with NameCheap, Inc. Hosting Concepts B.V. d/b/a Registrar.eu. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 28, 2023. On November 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 28, 2023, the Registrar, NameCheap, Inc., transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <jonakfrance.com> which differed from the named Respondent (Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. On November 29, 2023, the Registrar, Hosting Concepts B.V. d/b/a Registrar.eu., transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <jonak-promo.com> which differed from the named Respondent (Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 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 December 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 December 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 16, 2024.

The Center appointed Delia-Mihaela Belciu as the sole panelist in this matter on January 19, 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 French company specialized in women's footwear.

The Complainant owns of several trademarks consisting of "JONAK", including the following:

- International Trademark Registration No. 625324 for JONAK, registered on October 14, 1994, for goods in classes 18 and 25;
- European Union Trademark Registration No. 002580223 for JONAK, registered on August 7, 2003, for goods in classes 18 and 25.

Moreover, the Complainant owns several domain names containing its trademark JONAK, such as the domain name <jonak.fr> registered since January 31, 1999 which is used for its official website.

The disputed domain name <jonakfrance.com> was registered on September 6, 2023 while the disputed domain name <jonak-promo.com> was registered on November 21, 2023. According to the evidence filed by the Complainant, at the time of filing the Complaint, both disputed domain names resolved to websites having the same layout and content, dedicated both to an online store selling shoes and accessories at discounted prices under the brand JONAK. Furthermore, also according to the evidence filed by the Complainant, the Legal Terms of Sale of both websites impersonate 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 names.

Notably, the Complainant contends that:

(i) the disputed domain names are confusingly similar to the Complainant's JONAK mark as it incorporates the JONAK trademark in its entirety, and the addition of the terms "france", respectively "promo" is not sufficient to prevent the finding that the disputed domain names are confusingly similar to the JONAK trademark. The addition of the generic Top-Level Domain ("gTLD") ".com" does not change the overall impression of the designation as being connected to the Complainant's trademark;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names for a number of reasons, among which that, (1) the Respondent is not identified in the WhoIs database at the disputed domain names, (2) the Respondent is not affiliated with nor authorized by the Complainant in any way, (3) the Complainant does not carry out any activity for, nor has any business with the Respondent, (4) no license nor authorization has been granted to the Respondent to make any use of the Complainant's JONAK trademark, or apply for registration of the disputed domain names, and (5) the Respondent used the disputed domain names to disrupt the Complainant's business and to attract users by impersonating the Complainant, as the Respondent identified itself as "JONAK";

(iii) the disputed domain names were registered and are being used in bad faith for a number of reasons, among which that, (1) the disputed domain names comprise the distinctive JONAK trademark, which has

existed for many years and has no generic or descriptive meaning, (2) a Google search on the term “jonak” provides several results, all of them being related to the Complainant, (3) the Respondent has registered and used the disputed domain names with full knowledge of the Complainant’s trademark, (4) the disputed domain names direct to an online store which competed with the products offered by the Complainant, and (5) by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the Respondent’s website or location or of a product or service on the respondent’s website or location.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to succeed, such must prove, according to paragraph 4(a) of the Policy, that:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

In case all three element above have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. Thus, the Panel will deal with each of the requirements in turn.

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 trademark and the disputed domain names. 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 trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the JONAK mark is recognizable within the disputed domain names. The entirety of the mark is reproduced within both disputed domain names followed by the addition of the geographical term “france” in the disputed domain name <jonakfrance.com>, respectively a dash and the descriptive term “promo” in the disputed domain name <jonak-promo.com>, which does not prevent a finding of confusing similarity. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms “france” in the disputed domain name <jonakfrance.com>, and the term “promo” in the disputed domain name <jonak-promo.com> may 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 and the mark for the purposes of the Policy, as the JONAK trademark is recognizable within the disputed domain names. [WIPO Overview 3.0](#), section 1.8.

In what concerns the addition of the gTLD “.com” in relation to both disputed domain names, this is not to be taken into consideration when examining the confusing similarity between the Complainant’s trademarks and the disputed domain names, as such is viewed as a standard registration requirement, and such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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 names. 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 names such as those enumerated in the Policy or otherwise.

Thus, based on the available evidence, the Respondent does not appear to be known by “JONAK”, and is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. No license nor authorization has been granted to the Respondent to make any use of the Complainant’s JONAK trademark or apply for registration of the disputed domain names.

Both disputed domain names comprise the Complainant’s JONAK mark in its entirety in combination with the geographical term “france” in the disputed domain name <jonakfrance.com>, and the descriptive term “promo” in the disputed domain name <jonak-promo.com>, conveying to Internet users that this is a French shop for JONAK products, respectively a shop for JONAK products with discounts/promotions, leading thus to confusion and misleading Internet users into believing that the websites associated to the disputed domain names are operated by the Complainant or by an affiliated entity with the Complainant’s consent. Generally speaking, UDRP panels have found that domain names confusingly similar to a complainant’s trademark carry a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Moreover, at the time when the Complaint was filed, both disputed domain name resolved to active websites having the same content and layout which incorporated the Complainant’s trademark, and imagery with no disclaimers as to the lack of any relationship with the Complainant, which suggests that the Respondent intended to attract Internet users to false websites looking like an official website of the Complainant. Furthermore, according to the evidence filed by the Complainant, the Legal Terms of Sale of both websites impersonate the Complainant, as the Respondent identified itself as JONAK.

Panels have held that the use of a domain name for illegal activity, like impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

All the above do not amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain names.

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 Complainant's rights to the JONAK trademark predate the registration date of both disputed domain names. Based on the available record, a Google search on the terms "jonak" provides several results, all of them being related to the Complainant.

In light of the above, the Panel agrees with the Complainant that it is not conceivable that the Respondent registered the disputed domain names without knowledge of the Complainant's JONAK mark, which supports a finding of bad faith registration. [WIPO Overview 3.0](#), section 3.2.2.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark.

The Respondent's incorporation into both disputed domain names of the Complainant's JONAK mark in its entirety, followed by the addition of the term "france" in the disputed domain name <jonakfrance.com>, and the descriptive term "promo" in the disputed domain name <jonak-promo.com>, conveying to Internet users that this is a French shop for JONAK products, respectively a shop for JONAK products with discounts/promotions, the use of both disputed domain names at the time when the Complaint was filed, in relation to an active websites which incorporated the Complainant's trademark, and imagery with no disclaimers as to the lack of any relationship with the Complainant, while the Legal Terms of Sale of both websites impersonated the Complainant, as the Respondent identified itself as "JONAK", suggest that the Respondent intended to attract Internet users to false websites looking like an official website of the Complainant by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website and the goods offered and promoted through said website, support a finding of bad faith registration and use according to paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), sections 3.1.4.

Moreover, UDRP panels have held that the use of a domain name for illegal activity like impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

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 names <jonakfrance.com> and <jonak-promo.com> be transferred to the Complainant.

/Delia-Mihaela Belciu/

Delia-Mihaela Belciu

Sole Panelist

Date: February 2, 2024