

ADMINISTRATIVE PANEL DECISION

Joseph NAKAM v. Web Commerce Communications Limited
Case No. D2023-5112

1. The Parties

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

The Respondent is Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <jonakoutletparis.com> is 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 December 7, 2023. On December 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 8, 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 (Anonymous) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 8, 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 amended Complaint on December 11, 2023.

The Center verified that 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 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 12, 2024.

The Center appointed Oleksiy Stolyarenko as the sole panelist in this matter on January 17, 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 actively engaged in the women's footwear industry. Over the years, the Complainant has established a significant presence in this sector, primarily through the development and promotion of the JONAK brand. This brand is not only a testament to the Complainant's innovative design and quality but also to his entrepreneurial spirit and commitment to customer satisfaction.

The Complainant owns several registered trademarks for the JONAK mark, including:

- International trademark registration number 625324 for JONAK, registered on October 14, 1994.
- European Union trademark registration number 002580223 for JONAK, registered on August 7, 2003.

These trademarks cover a wide array of goods and services related to the footwear industry and are used in connection with women's footwear.

The Complainant has secured several domain names incorporating the JONAK trademark. Among these, <jonak.fr> stands out as the primary domain name, registered on January 31, 1999, and serving as the official online storefront for the JONAK brand. This domain name, along with others, forms the digital foundation of the Complainant's business, offering customers worldwide access to its products and services.

The Respondent is identified as Web Commerce Communications Limited, Malaysia.

The disputed domain name, <jonakoutletparis.com>, was registered on October 20, 2023. According to the evidence submitted by the Complainant the website associated with the disputed domain name was linked to an online store selling JONAK-branded shoes and accessories at discounted prices. At the time of decision when the Panel tried to access this website, it was informed that the access to the website was blocked by the Cloudflare as a part of defending the website from attacks. Therefore, the Panel was unable to assess the content of the website.

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 Complainant's JONAK marks are registered internationally and in the European Union, signaling their established legal protection and recognition far predating registration of the disputed domain name. These registrations, which include the international trademark No. 625324 registered on October 14, 1994, and the European trademark No. 002580223 registered on February 15, 2002, support the Complainant's claim to the JONAK mark.

The Complainant argues that the addition of the terms "outlet" and "paris" to the JONAK mark in the disputed domain name does not mitigate the confusing similarity. Instead, it could potentially lead consumers to mistakenly associate the domain name with the Complainant's official business and products.

The website associated with the disputed domain name purports to offer JONAK-branded products, which directly competes with the Complainant's legitimate business offerings, and is alleged to be unauthorized and misleading to consumers.

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name. There is no evidence suggesting that the Respondent has been known by the name "JONAK," nor any indication of authorization or licensing by the Complainant for the Respondent to use the trademark.

The Complainant asserts that the disputed domain name was registered with knowledge of the Complainant's rights in the JONAK trademarks and is being used in bad faith. The lack of legitimate business activity, offerings, or fair use by the Respondent and the potential for consumer deception are cited as evidence of bad faith.

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 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.

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 Complainant has established unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3.

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.

The Panel finds the mark is recognizable 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 other terms here, "outlet" and "paris" 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 name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

According to the Complainant, the Respondent is not an authorized or licensed to use the JONAK trademark in the disputed domain name.

There is also no evidence suggesting that the Respondent has been known by the name "JONAK".

Given that the disputed domain name includes the Complainant's trademark in its entirety with added terms "outlet" and "paris", which is a clear reference to the Complainant's home market and type of business, the Panel struggles to conceive any legitimate interests of the Respondent in the disputed domain name because the disputed domain name effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#). Under such circumstances, any use of the disputed domain name by the Respondent only increases the possibility of the Internet users' to falsely attribute the disputed domain name to the activities of the Complainant.

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.

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.

Panels have held that the use of a domain name for illegal activity here, 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 name constitutes bad faith under the Policy.

In the present case, the Panel established above, the Complainant's JONAK trademark was used in commerce well before the registration of the disputed domain name on October 20, 2023. The Complainant's JONAK trademark predates registration of the disputed domain name for decades. Therefore, there is a presumption of bad faith registration of the disputed domain name given that it reproduces the Complainant's JONAK Trademarks entirely.

The Respondent also supplemented the disputed domain name with terms "outlet" and "paris", which is a clear reference to the Complainant's home market and type of business. Thus, the Respondent's aim on targeting the Complainant, its reputation and customers is clear to the Panel.

The Panel points out that the disputed domain name revolved to an e-commerce website, trying to pass off as the Complainant or someone affiliated to the Complainant, for commercial gain.

Furthermore, the Responded failed to submit a response to disprove allegations of illegal activity or provide any evidence of a good-faith use or to show rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent's intent for registering the disputed domain name, which reproduces the Complainant's trademark entirely has always been to capitalize on the goodwill of the Complainant's trademark.

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 <jonakoutletparis.com> be transferred to the Complainant.

/Oleksiy Stolyarenko/

Oleksiy Stolyarenko

Sole Panelist

Date: February 5, 2024