

## **ADMINISTRATIVE PANEL DECISION**

Jacquemus SAS v. Daniel Fm mallet, Streetwinter  
Case No. D2024-0074

### **1. The Parties**

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

The Respondent is Daniel Fm mallet, Streetwinter, France.

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

The disputed domain name <jacquemusfactory.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 9, 2024. On January 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 10, 2024, 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 (Contact Privacy Inc. Customer 0169237076) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 12, 2024, 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 January 12, 2024.

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 January 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 5, 2024.

The Center appointed Alexandre Nappey as the sole panelist in this matter on February 12, 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 the French company Jacquemus SAS which manufactures and markets since 2013 clothing and fashion accessories under the trademark JACQUEMUS.

The Complainant is known worldwide in the fashion industry.

JACQUEMUS products are sold in 50 different countries around the world.

The Complainant is the owner of numerous trademarks in the world, notably:

- International trademark JACQUEMUS registered on February 5, 2014, under no. 1211398 in classes 9, 18, and 25;
- International trademark JACQUEMUS registered on November 19, 2019, under no. 1513829 in classes 14, 24, and 28;
- European Union trademark JACQUEMUS registered on October 18, 2019, under no. 018080381 in classes 14, 24, and 28;
- French trademark JACQUEMUS registered on April 18, 2014, under No. 4057016 in classes 9, 18, and 25.

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

The disputed domain name was registered on November 8, 2023.

According to the Complainant's evidence, the disputed domain name used to point to a website displaying the Complainant's JACQUEMUS trademark and selling alleged the Complainant's goods at heavily discounted prices.

At the time of the Decision, the disputed domain name is not active.

#### **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.

First, the Complainant claims that the disputed domain name is highly similar to the Complainant's trademark JACQUEMUS, as it incorporates it in its entirety. The JACQUEMUS trademarks are well known throughout the world, notably in the fashion industry. The JACQUEMUS trademarks are wholly reproduced in the disputed domain name and the addition of the word "factory" does not exclude the likelihood of confusion. On the contrary, the disputed domain name will probably be understood by Internet users as an outlet website.

Then, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has never authorized the Respondent to register and/or use any domain name incorporating the JACQUEMUS Trademarks. The Complainant has not granted any license, nor any authorization to the Respondent to use its trademarks, including as a domain name. Moreover, the

Respondent has not made a legitimate noncommercial or a fair use of the disputed domain name. Indeed, the disputed domain name pointed out to a website which was offering for sale alleged counterfeit goods. The Respondent's such use does not qualify as a bona fide offering of goods and services.

Third, the Complainant asserts that the disputed domain name was registered and is being used in bad faith. The Complainant's trademarks have acquired extensive and worldwide reputation and should thus be considered as well known. Indeed, UDRP panels have already recognized the reputation of the Complainant's trademarks in previous decisions regarding domain names using the JACQUEMUS trademark. Consequently, the choice of the disputed domain name does not seem to be a mere coincidence, but on the contrary, it seems to have been done on purpose to generate a likelihood of confusion with the Complainant's domain name and its trademarks. The Complainant's trademarks are well known, so in application with UDRP panels' previous decisions, it shall be deemed that the registration of the disputed domain name has been done per se in bad faith. Moreover, the website operated under the disputed domain name is selling infringing goods and reproducing the Complainant's official website which constitutes bad faith. Therefore, it appears that the disputed domain name has been used to take advantage of the reputation of the Complainant's trademarks to sell products which origin and authenticity are questionable.

## **B. Respondent**

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

## **6. Discussion and Findings**

Notwithstanding the default of the Respondent, the Complainant has the burden of proof to make its case in accordance with paragraph 4(a) of the Policy, and to demonstrate that:

- (i) the disputed domain name is 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 in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

However, under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Having considered the Parties' submissions, the Policy, the Rules, the Supplemental Rules and applicable law, the Panel's findings on each of the above-mentioned elements are the following:

### **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 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 other term, here “factory”, 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.

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.

Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 Respondent had necessarily the Complainant’s trademark in mind when it registered the disputed domain name, considering that the Complainant has established goodwill and reputation in the JACQUEMUS trademark, and that the disputed domain name incorporates that trademark in its entirety.

Indeed, the Respondent knew or should have known of the Complainant’s trademarks and deliberately registered the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2. Such finding is reinforced by the fact that the Complainant submitted printouts showing that the disputed domain name resolves to a website displaying the Complainant’s trademark and purportedly offering for sale the Complainant’s products at heavily discounted prices.

It appears therefore that the Respondent, by referring to the JACQUEMUS trademark in the disputed domain name, is trying to create a likelihood of confusion to attract, for commercial gain, Internet users to its own website. Accordingly, the Panel finds that the Respondent registered the disputed domain name with the Complainant in mind and with the intention of capitalizing on the reputation of the Complainant’s trademarks within the meaning of paragraph 4(b)(iv) of the Policy.

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, claimed sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Further, the current non-use of the disputed domain name does not change the Panel's finding of the Respondent's bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name 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 name <jacquemusfactory.com> be transferred to the Complainant.

*/Alexandre Nappey/*

**Alexandre Nappey**

Sole Panelist

Date: February 26, 2024