

ADMINISTRATIVE PANEL DECISION

**ROSET USA CORPORATION, and ROSET S.A. v. Rajendran Anand, and
West 22 f/k/a AB Modern
Case No. D2024-0538**

1. The Parties

The Complainants are ROSET USA CORPORATION, United States of America (“United States”), and ROSET S.A., France, represented by Shwal & Platt, United States.

The Respondents are Rajendran Anand, India, and West 22 f/k/a AB Modern, United States.

2. The Domain Name and Registrar

The disputed domain name <lignerosethouston.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 6, 2024. On February 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 7, 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 (Gname.com Pte. Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainants on February 7, 2024 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on February 10, 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 February 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 7, 2024.

The Center appointed Steven A. Maier as the sole panelist in this matter on March 15, 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.

On March 28, 2024, the Panel issued the Administrative Panel Procedural Order No.1 instructing the Center to forward the Notification of Complaint, along with the Complaint and its Annexes, to West 22 f/k/a AB Modern (defined below), inviting the latter to indicate by the end of April 2, 2024 whether it intends to participate in the proceeding, and extending the Decision due date to April 8, 2024. As of April 2, 2024, no response was received.

4. Consolidation of Proceedings

The Complaint is brought by two named Complainants. As discussed in section 4.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), proceedings of this nature may be consolidated in circumstances where "(i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation." The Complaint and its Annex 12 indicate that ROSET USA CORPORATION is ROSET S.A.'s American affiliate. The Panel being satisfied that the two named Complainants are in common ownership, and that the above criteria are met, the Panel directs that the proceedings be consolidated. The two named Complainants shall henceforth be referred to as "the Complainant" accordingly.

5. Identity of Respondent

Neither Party has provided any information concerning the Registrar-disclosed Respondent in this proceeding or any connection between that party and the use of the disputed domain name.

The Complainant submits that it is not familiar with the Registrar-disclosed registrant, but believes the true owner of the disputed domain name to be a former authorized reseller of its products, AB Modern Houston, LLC ("AB Modern"), which has now changed its name to West 22 LLC ("West 22"). The Complainant submits evidence that the disputed domain name has resolved to a website which prominently displays the LIGNE ROSET trademark (together with the symbol ®) and appears to provide information about the Complainant and its products. The relevant web pages provide a street address and telephone number in Houston, Texas, United States and references to AB Modern as the owner of the business operated under the disputed domain name. The Complainant states that the address and telephone number correspond with its former authorized reseller.

In these circumstances, the Panel determines on balance that West 22 f/k/a AB Modern is the beneficial holder of the disputed domain name and a proper respondent in the proceeding. Such finding is supported by the Respondent's website content, which the Panel notes includes a copyright notice dated 2024. While the Panel infers that the Registrar-disclosed registrant may be a representative or agent of the beneficial holder, the Panel sees no basis upon which to release the Registrar-disclosed registrant as a respondent in the proceeding. Therefore, the Panel determines that both the Registrar-disclosed registrant and West 22 f/k/a AB Modern are proper Respondents in the case and refers to them together as "the Respondent" in the remainder of this Decision.

6. Factual Background

The Complainant ROSET S.A. was founded in France in 1860. It is a supplier of modern furniture.

The Complainant is the owner of various registered trademarks, including United States trademark registration number 2433155 for the word mark LIGNE ROSET, registered on March 6, 2001 in International Classes 11, 20, 21 and 27.

The disputed domain name was registered on November 30, 2011.

As stated above, the Complainant submits evidence that the disputed domain name has resolved to a website which prominently displays the LIGNE ROSET trademark (together with the symbol ®) and appears to provide information about the Complainant and its products.

7. Parties' Contentions

A. Complainant

The Complainant exhibits a letter agreement between itself, ROSET USA CORPORATION ("Roset"), and AB Modern dated November 16, 2011 (the "Letter Agreement"). The Letter Agreement appoints AB Modern as an authorized reseller of certain of the Complainant's products. It provides by clause 10 as follows:

"Trademarks.

(a) Except as provided below, you will not use nor authorize anyone else to use Roset's name or trademarks. Any use which you make of Roset's name or trademarks will inure to Roset's sole benefit, and you will accrue no rights in such name or trademarks. Under no circumstances shall you use any of Roset's names or trademarks in your corporate or business name, or as an assumed name.

(b) Except as provided below, Roset hereby grants you the non-exclusive, nontransferable, royalty-free right to use Roset's trademark LIGNEROSSET® and all related logos, designs and presentations (altogether constituting the "Trademark") in the Territory in connection with your sale of Products under this Letter Agreement. You will display the symbol "®" adjacent to Roset's trademarks at all times.

(c) Except as may expressly be permitted by Roset in a writing signed on its behalf by its authorized representative, you will not make any use or mention (whether human-readable or machine-readable) of the Trademark, or any part of the Trademark, on the Internet, on the World-Wide Web, or on any other publicly accessible or searchable computer network, node, or site. In addition, you will refrain from using any technique designed to ensure or enhance the likelihood that any search engine (such as ALTA VISTA, AOL NETFIND, ASK, BING, EXCITE, GOOGLE, HOTBOT, INFOSEEK, LYCOS, WEBCRAWLER, or YAHOO) will index, describe, or categorize your site as a LIGNE ROSET site or as a site at which goods of such brand are available for purchase, whether by means of "meta tags," "keywords," or otherwise."

The Complainant submits evidence of a letter from it to AB Modern dated August 12, 2021 referring to the discontinuation of the business relationship between the Parties. It submits subsequent correspondences dated April 21, 2022 by email and by courier demanding that West 22 f/k/a AB Modern cease and desist from using the LIGNE ROSET trademark, and asserting that the use of that trademark online was in any event a breach of clause 10(c) of the Letter Agreement. On January 12, 2024, the Complainant sent another letter by courier demanding that West 22 f/k/a AB Modern transfer the disputed domain name to the Complainant. In these correspondences, the Complainant asserts that "[n]o written agreement was ever entered into that would have permitted [the Respondent] to make any online use of LIGNE ROSET or any other [Complainant's] mark."

The Complainant submits that the disputed domain name is confusingly similar to its LIGNE ROSET trademark because it incorporates that trademark in full.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has not licensed the Respondent to use its LIGNE ROSET trademark, that the Respondent is not an authorized reseller of the Complainant's products, and that the Complainant does not believe it has access to commercial quantities of the Complainant's authentic furniture: indeed, it alleges (although without supporting evidence) that the Respondent uses the disputed domain name principally for the purpose of selling "knock off" goods. The Complainant disputes that the Respondent has any independent rights in respect of the disputed domain name and submits that the Respondent is making neither bona fide commercial use, nor legitimate noncommercial or fair use, of the disputed domain name.

The Complainant submits that the Respondent registered and is using the disputed domain name in bad faith. It contends in particular that, by using the disputed domain name, the Respondent is intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website or of products on that website.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

8. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those 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.

A. Identical or Confusingly Similar

The Complainant has established that it has registered trademark rights in respect of the mark LIGNE ROSET. The disputed domain name wholly incorporates that mark together with the additional term "houston", which does not prevent the trademark from being recognizable within the disputed domain name. The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainant's submissions set out above give rise to a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. However, the Respondent has failed to file a Response in this proceeding and has not submitted any explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise.

While the Panel finds that the Respondent was a former authorized distributor of the Complainant's products, it also accepts the Complainant's evidence that the Respondent has no continuing authority to use the Complainant's LIGNE ROSET trademark, and that even while it remained an authorized reseller, it was not entitled to use that trademark in connection with any online activity. Furthermore, even if (which is far from

clear) the Respondent is now an independent, unauthorized reseller of the Complainant's genuine products, the Respondent does not satisfy the conditions discussed in section 2.8.1 of WIPO 3.0 for the "nominative fair use" of a complainant's trademark within a domain name. In particular, the Respondent's website fails to make clear that it has no official relationship with the Complainant, and indeed implies the contrary.

The Panel finds in the circumstances that the Respondent has no rights or legitimate interest in respect of the disputed domain name.

C. Registered and Used in Bad Faith

Since the Policy includes the conjunctive requirement that the disputed domain name must have been both registered and used in bad faith, this can result in a difficulty for complainants under the UDRP who have terminated a business relationship with a formerly authorized distributor: in particular, if a distributor was authorized to register a particular domain name referencing the complainant's trademark at the date of such registration, then that domain name will not have been registered in bad faith, and any subsequent withdrawal of authorization by the complainant, e.g. upon the termination of the business relationship, cannot be sufficient to satisfy the third element under the Policy.

The Panel does not, however, find this to be such a case. Based on the Complainant's evidence of the Letter Agreement, the Panel finds that the Respondent was not at any time entitled to use the Complainant's LIGNE ROSET trademark for the purpose of an Internet domain name or otherwise in connection with promotional activities online. The Panel finds in these circumstances that the disputed domain name was registered in bad faith, i.e. with the intention of referring to the Complainant's trademark, but knowingly without the right to do so.

The Panel finds further that the disputed domain name has been used in bad faith. Based on the evidence available to the Panel, the Respondent is not now an authorized distributor of the Complainant's products, but both the disputed domain name and the respondent's website content imply that it has a continuing relationship with the Complainant and is authorized to offer its products. The Panel finds in particular that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel finds in the circumstances that the disputed domain name has been registered and is being used in bad faith.

9. 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 <lignerosethouston.com> be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: April 4, 2024