

ADMINISTRATIVE PANEL DECISION

Tricots Saint-James v. Alice Kelly
Case No. D2024-3536

1. The Parties

Complainant is Tricots Saint-James, France, represented by Fidal, France.

Respondent is Alice Kelly, Italy.

2. The Domain Name and Registrar

The disputed domain name <saintjamesdenmark.com> (the “Domain Name”) is registered with Paknic (Private) Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 4, 2024. On September 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 5, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Whois Agent, Web Domains By Proxy) and contact information in the Complaint. The Center sent an email communication to Complainant on September 11, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on September 11, 2024.

The Center verified that the Complaint together with the amendment to the 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 September 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 4, 2024.

The Center appointed Dinant T. L. Oosterbaan as the sole panelist in this matter on October 8, 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

Complainant manufactures and sells since 1889 clothing and fashion accessories for men, women, and children, specializing in the design of clothing under the SAINT JAMES label. Complainant has more than 173 points of sale in France and Europe, and it sells 40 percent of its products outside of France, especially throughout Europe.

Complainant owns multiple trademarks for SAINT JAMES, including:

- European Union wordmark SAINT JAMES, registration number 1178246 and registration date May 2, 2013, and
- International Trademark (figurative) SAINT JAMES with registration number 1527542 and registration date June 5, 2019, also applicable in Denmark.

In addition, Complainant runs multiple websites using the domain name <saint-james.com>.

The Domain Name was registered on June 20, 2023.

The Domain Name resolves to a website that copies Complainant's figurative SAINT JAMES trademark and the look and feel of Complainant's website.

The trademark registrations of Complainant were issued prior to the registration of the Domain Name.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

Notably, Complainant contends that the Domain Name is highly similar to its SAINT JAMES trademark because the Domain Name combines Complainant's trademark in its entirety with an additional term "denmark" which is a mere addition of a geographical indicator.

According to Complainant, Respondent has no rights or legitimate interests in the Domain Name. Complainant submits that Respondent is not commonly known under the Domain Name nor is the Respondent offering a bona fide offer of product or services. Moreover, to Complainant's best knowledge, Respondent does not make any use of a business name which includes the sign SAINT JAMES and Respondent has no right on any trademark composed of this sign. Complainant has not authorized, licensed, permitted or otherwise consented to Respondent's use of the trademark SAINT JAMES in the Domain Name and has no relationship with Respondent. Finally, Respondent has sought to confuse Internet users who are looking to buy "Saint James" products and who think they are on the official Complainant's website or on an affiliated one.

Complainant submits that Respondent registered and is using the Domain Name in bad faith. According to Complainant, supported by evidence, the website under the Domain Name copies without any authorization Complainant's figurative SAINT JAMES trademark and website architecture and look. Respondent has built a very confusing imitation of Complainant's corporate website. Respondent uses the Domain Name for a

website that promotes the same products as those offered by Complainant. Respondent therefore uses Complainant's trademark for the same activities, which is ready-to-wear clothing for men, women and children. In addition, Complainant asserts that Respondent's website under the Domain Name is selling counterfeit goods. Considering Respondent's reproduction of Complainant's trademark on its website promoting identical activities, it is apparent that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating confusion with Complainant's trademark.

According to Complainant Respondent has registered and used and is still using fraudulently and in bad faith the Domain Name by reproducing Complainant's prior trademark rights with intent to take advantage of Complainant's reputation and give credibility to its scams and phishing operation.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires that a complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (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.

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.

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 SAINT JAMES mark is reproduced within the Domain Name. Accordingly, the Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds that the addition of the geographical term "denmark" in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The generic Top-Level Domain ".com" is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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 the 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 Domain Name. 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 Domain Name such as those enumerated in the Policy or otherwise.

Complainant has stated it has not licensed or otherwise permitted Respondent to make any use of its SAINT JAMES trademark and that it has no relationship with Respondent. Based on the undisputed submission and evidence provided by Complainant, the Domain Name resolves to a website which uses Complainant’s distinctive figurative trademark, copies without authorization the look and feel of Complainant’s website and appears to sell counterfeit goods. Panels have held that the use of a domain name for illegal activity such as impersonation/passing off and the sale of counterfeit goods can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, the composition of the Domain Name together with the construction of the website under the Domain Name are misleading and carry the risk of implied affiliation, which does not provide any indication as to how Respondent could possibly be seen as making a bona fide use of the Domain Name. Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert Internet users or to tarnish the trademark of Complainant. The Panel does not consider such use a bona fide offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Name. Respondent is also not commonly known by the Domain Name nor has it acquired any trademark or service mark rights.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of a domain name in bad faith in the event Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service offered on Respondent’s website or location.

The Panel finds that the Domain Name has been registered and is being used in bad faith. Noting the status of the SAINT JAMES mark and the overall circumstances of this case, the Panel finds it more likely than not that Respondent knew or should have known Complainant’s SAINT JAMES mark. The registration of the Domain Name in awareness of the SAINT JAMES trademark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

The Panel notes that the Domain Name resolves to a website which incorporates Complainant’s trademark in its entirety, which copies without authorization the distinctive figurative trademark of Complainant and the

look and feel of Complainant's website, which indicates, in the circumstances of this case, that Respondent registered and used the Domain Name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy. In addition, the Panel takes into account that previous panels have held that the use of a domain name for illegal activity such as impersonation/passing off and the 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 Domain Name constitutes bad faith under the Policy.

The Panel finds that 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 Domain Name, < saintjamesdenmark.com >, be transferred to Complainant.

/Dinant T. L. Oosterbaan/

Dinant T. L. Oosterbaan

Sole Panelist

Date: October 15, 2024