

ADMINISTRATIVE PANEL DECISION

PUIG FRANCE S.A.S v. ernesto castaneda, Mi tienda
Case No. D2024-3798

1. The Parties

The Complainant is PUIG FRANCE S.A.S, France, represented by Zacco Sweden AB, Sweden.

The Respondent is ernesto castaneda, Mi tienda, Mexico.

2. The Domain Name and Registrar

The disputed domain name <jeanpaulgoultier.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 September 18, 2024. On September 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 18, 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 0171774862) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 19, 2024, the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on September 19, 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 the Respondent of the Complaint, and the proceedings commenced on September 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 15, 2024.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on October 21, 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 part of the company group Antonio Puig S.A. which was founded in 1914 and operates within the clothing, fashion, fragrances and skincare sector. The group employs more than 11.000 people across the globe, selling its products in more than 150 countries. The Complainant's portfolio includes brands such as Jean Paul Gaultier, Carolina Herrera, Paco Rabanne, Dries Van Noten, Nina Ricci, and Byredo, among others. The designer Jean Paul Gaultier has been creating fashion since 1976 and founded his brand JEAN PAUL GAULTIER in 1982. In 1993 the brand launched its first fragrance.

The Complainant is the owner of several trademarks for JEAN PAUL GAULTIER ("JEAN PAUL GAULTIER trademark"), including:

- European Union Trademark Registration JEAN PAUL GAULTIER No. 018741366, registered on December 14, 2022,
- United States Trademark Registration JEAN PAUL GAULTIER No. 3036215, registered on December 27, 2005, and
- International Trademark Registration JEAN PAUL GAULTIER No. 457343, registered on December 17, 1980, inter alia designated for Germany, Indonesia and the Russian Federation.

The Complainant is also owner of domain names including the JEAN PAUL GAULTIER trademark, such as the domain name <jeanpaulgaultier.com>, registered on December 13, 1996.

The disputed domain name was registered on July 16, 2024. The Complainant has provided evidence showing that the disputed domain name resolved to an active website which prominently displayed the JEAN PAUL GAULTIER trademark as well as product images and content from the Complainant's website. At the time of the decision, the disputed domain name resolves to an error webpage.

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.

On the first element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to the JEAN PAUL GAULTIER trademark. The disputed domain name consists of the term "jeanpaulgaultier", which is an obvious and intentional misspelling of the JEAN PAUL GAULTIER trademark, and confusingly similar with the same trademark. The addition of the generic Top-Level Domain ("gTLD") ".com" does not have any impact on the overall impression of the dominant portion of the disputed domain name and is therefore irrelevant when determining the confusing similarity between the trademark and the disputed domain name. There is a considerable risk that the trade public will perceive the disputed domain name as either a domain name owned by the Complainant or that there is some commercial relationship with the Complainant. By using the Complainant's trademark in the disputed domain name, the Respondent exploits the goodwill and the image of the Complainant's trademark, which may result in dilution and other damage to it.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. To the Complainant's knowledge, no license or authorization of any other kind has been given by the Complainant to the Respondent to use the JEAN PAUL GAULTIER trademark, and the Complainant has found no information indicating that the Respondent is somehow trading under a name corresponding to the disputed domain name. Furthermore, the Respondent is not, based on the available information, an authorized representative of the Complainant's products or services and has never had a business relationship with the Complainant. No evidence has been found indicating that the Respondent is using JEAN PAUL GAULTIER as a company name or that it has any other legal rights to the name. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services. Instead, the disputed domain name is hosting a website that is infringing upon the Complainant's business, name, and trademark, and where the Respondent falsely claims to be, or at the very least represent, the Complainant and the Complainant's trademark. The Respondent uses images and content from the Complainant's website, and uses phrases such as "ABOUT JEAN PAUL GAULTIER" and "JOIN PUIG" in the footer, which further supports that the Respondent is falsely claiming to be, or at the very least represent, the Complainant, and the Complainant's trademarks. In light of this, the Complainant can also only presume that the goods offered for sale on the website under the disputed domain name are inferior counterfeits, especially given that all products are being offered with a discount and free shipping. Furthermore, the use of a domain name as described above can never amount to legitimate use. Panels have categorically held that the use of a disputed domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. Particularly in the case of counterfeits and pharmaceuticals, this is true irrespective of any disclosure on the related website that such infringing goods are "replicas" or "reproductions" or indeed the use of such term in the domain name itself. It is also clear that the disputed domain name is being used for a commercial purpose, which will risk diluting and damaging the JEAN PAUL GAULTIER trademark, and that the Respondent, for financial gain, is attempting to unfairly capitalize on the reputation and goodwill of the Complainant and the Complainant's trademark.

On the third element of the Policy, the Complainant asserts that the Respondent has registered and used the disputed domain name in bad faith. The Complainant holds numerous registrations for the JEAN PAUL GAULTIER trademark, both nationally in e.g. Canada, China, France, Mexico and the United States, but also in the entire European Union. The Complainant's seniority for the JEAN PAUL GAULTIER trademark dates back to e.g. 1980 in France, to 1985 in the United States, to 1992 in Mexico, to 1995 in Canada, to 2001 in China, and to 2003 in the European Union. The Respondent registered the disputed domain name on July 16, 2024. This date is subsequent to when the Complainant obtained registered trademark rights for the trademark in Canada, China, the European Union, France, Mexico, and the United States, and also elsewhere, by several decades. The fact that the disputed domain name resolves to a fraudulent website which infringes upon the JEAN PAUL GAULTIER trademark, shows that the Respondent cannot possibly have conducted the registration of disputed domain name in good faith. In contrary, the sum of all arguments and facts makes it very likely, in the Complainant's opinion, that it is the fame and value of the Complainant's company and trademark that has motivated the Respondent to register and use the disputed domain name. Furthermore, the mere registration of a disputed domain name that is identical or confusingly similar to a famous or widely known trademark, by an unaffiliated entity, can by itself create a presumption of bad faith. In light of all the above, the Complainant, on September 4, 2024, issued a notice letter to the Respondent, demanding a complete stop of all infringing activities and a transfer of the disputed domain name to the Complainant. The Complainant did not receive any reply to this notice letter, and as a result, a fully-fledged cease and desist letter was sent to the Respondent, again requesting that the disputed domain name be transferred to the Complainant, but again the Respondent choose to not respond to the cease and desist letter within the time frame. At the time of filing the Complaint, the Complainant is yet to receive any response from the Respondent. Accordingly, it seems clear to the Complainant that the Respondent must have noticed the Complainant's concerns with the Respondent's registration and use of the disputed domain name, but has in effect chosen to ignore, or at least respond, to the attempts of contacts made. As previously mentioned, the disputed domain name currently resolves to a website that infringes upon the Complainant's trademark, and where the Respondent, in the Complainant's opinion, claims to be, or at the very least represent, the Complainant, by using the Complainant's logotype, name and trademark. The

Complainant can only presume that the Respondent is intentionally attempting to create the mistaken impression that it is affiliated with, or endorsed by, the Complainant, for illicit and fraudulent purposes.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

It has been a consensus view in previous UDRP decisions that a respondent's default (i.e., failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely 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.

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 3.0](#), section 1.7.

A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9.

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, with the only difference of the letter "o" instead of "a". The Panel finds the mark is recognizable within the disputed domain name. Further, it is obvious that the disputed domain name is an intentional misspelling of the JEAN PAUL GAULTIER trademark. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7 and 1.9.

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.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

In this case, the Respondent did not reply to the Complainant’s contentions. Further the Complainant’s lawyers sent notice letters to the Respondent, demanding a stop of all infringing activities and a transfer of the disputed domain name to the Complainant, but did not receive any reply. According to the Complaint, the Complainant has not authorized the Respondent to use the JEAN PAUL GAULTIER trademark, the Respondent is not commonly known by the disputed domain name, and the Respondent has not used the disputed domain name for a legitimate noncommercial or fair use, nor used it in connection with a bona fide offering of goods or services. Further, the Respondent has not attempted to justify why the disputed domain name was registered.

The Complainant asserts that the Respondent sells counterfeit products but omits to provide evidence showing why the products sold by the Respondent are counterfeit. While some circumstantial evidence, such as the unusual discount prices for products offered on the website, tends to suggest the Respondent is offering counterfeit products, the Panel need not come to a final determination on this matter. In any event, the website at the disputed domain name fails to disclose the lack of relationship between the Parties and the Panel finds that the composition of the disputed domain name, reproducing the JEAN PAUL GAULTIER trademark, with the only difference of the letter “o” instead of “a”, coupled with the use of the disputed domain name resolving to a website displaying the JEAN PAUL GAULTIER trademark as well as product images and content from the Complainant’s website, affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and the Complainant, as to the origin or affiliation of the website at the disputed domain name.

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 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.

Considering the public presence of the Complainant, it is unlikely that the Respondent had no knowledge of the JEAN PAUL GAULTIER trademark. The incorporation of the JEAN PAUL GAULTIER trademark within the disputed domain name, with the only difference of the letter "o" instead of "a", as well as the fact that the disputed domain name resolves to a website displaying the JEAN PAUL GAULTIER trademark as well as product images and content from the Complainant's website, demonstrates the Respondent's actual awareness of and intent to target the Complainant. In light of the lack of any rights to or legitimate interests in the disputed domain name by the Respondent and in the absence of any conceivable good faith use, the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract Internet users to its website or affect the commercial activities of the Complainant by creating a likelihood of confusion with 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 <jeanpaulgaultier.com> be transferred to the Complainant.

/Christian Gassauer-Fleissner/
Christian Gassauer-Fleissner
Sole Panelist
Date: November 4, 2024