

ADMINISTRATIVE PANEL DECISION

SOFRANE, Société civile v. Name Redacted

Case No. D2024-4044

1. The Parties

The Complainant is SOFRANE, Société civile, France, represented by Cabinet Bouchara, France.

The Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <paulandjoe.shop> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 2, 2024. On October 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 2, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 3, 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 October 4, 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”).

¹The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 29, 2024. On October 15 and 18, 2024 and on November 14 and 15, 2024, the Center received emails from a third party. On November 5, 2024, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Mihaela Maravela as the sole panelist in this matter on November 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

According to information in the Complaint, the Complainant specializes mainly in clothing, fashion accessories, cosmetics, and accessories of all kinds (high-tech, office, travel, etc.), which are distributed in many countries worldwide. It launched in 1995 its PAUL & JOE brand.

The Complainant is the exclusive owner of a number of registered trademarks consisting of PAUL & JOE including the French trademark PAUL & JOE No. 95580220, registered on July 12, 1995, for goods in Class 25, the European Union Trademark PAUL & JOE No. 001329127, registered on January 9, 2002, for goods in classes 3, 4, 18 and 25, and the United States of America Trademark PAUL & JOE No. 2289813, registered on November 2, 1999, for goods in Class 25. The Complainant is also the holder of the domain name <paulandjoe.com>, registered since 2000 which it uses as its main website.

The disputed domain name was registered on June 22, 2024, and it resolves to a website displaying the Complainant's trademark and promoting for sale competing products.

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 Respondent reproduces identically and integrates, in the same order and rank, in the disputed domain name, the principal distinctive and distinguishing elements "PAUL"- "JOE" of the Complainant's PAUL & JOE trademarks, as the ampersand in the trademarks and the "and" in the disputed domain name have the same meaning. Further, the generic Top-Level Domain ("gTLD") suffix ".shop" shall be disregarded as a standard registration requirement when assessing the similarity between the trademark and the disputed domain name. Therefore, the disputed domain name is confusingly similar to the Complainant's prior trademarks.

As regards to the second element, the Complainant argues that the Respondent is not related in any way to the Complainant's business. The web page linked to by the disputed domain name is a website selling perfume and clothing, to capitalize on the Complainant's investments and notoriety, notably by prominently displaying the Complainant's trademarks. This shows the Respondent's intention to divert consumers to the disputed domain name for commercial gain, by taking unfair advantage of the goodwill and reputation of the Complainant's trademarks PAUL & JOE.

With respect to the third element, the Complainant argues that the disputed domain name was registered in 2024, almost twenty-nine years after the Complainant's earliest trademarks, therefore the Respondent could not possibly have been unaware of the Complainant's activities and the Complainant's trademarks. As regards the use, the Respondent is free riding on the reputation of the Complainant and the Complainant's

trademarks in order to attract Internet users to the website at the disputed domain name by creating a likelihood of confusion with the Complainant's trademarks, and therefore falls within the example given in the paragraph 4(b)(iv) of the Policy. Furthermore, it is unclear whether the Respondent is authorized to sell perfumes under the different third-party trademarks displayed on the website at the disputed domain name. Such activity could seriously damage the Complainant's reputation.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. A third party apparently in receipt of the Center's written notice of the proceeding sent informal email communications to the Center on October 15 and 18, 2024 and November 14 and 15, 2024.

6. Discussion and Findings

No formal response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.2.

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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

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.

The Complainant has shown rights in respect of the trademark PAUL & JOE for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name consists of the PAUL & JOE trademark of the Complainant, except for the replacement of the ampersand with "and", the ampersand not being a valid character in domain name registrations.

Therefore, 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.

It is the settled view of panels applying the Policy that the TLD (here ".shop") should be disregarded under the first element test.

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 evidence submitted by the Complainant, the disputed domain name is used to resolve to a website promoting various fashion and beauty products, displaying both the Complainant’s trademark and trademarks of other brand owners. The products advertised on the website compete with those offered by the Complainant under its PAUL & JOE trademark. Also, the Panel found no evidence of any visible disclaimer as to the lack of any relationship with the Complainant. In the Panel’s view, the Respondent’s use of the disputed domain name in the above circumstances is not in connection with a bona fide offering of goods or services as contemplated by the first circumstance of paragraph 4(c) of the Policy and fails the applicable safeguards found in “Ok! Data”². [WIPO Overview 3.0](#), section 2.8.

Also, the Respondent did not claim, and there is no evidence showing that the Respondent holds any right for PAUL & JOE trademarks. The Panel also notes that there is no evidence showing that the Respondent is authorized or licensed to use the PAUL & JOE trademark, nor has the Respondent claimed it would hold such authorization or license. Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

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.

According to the assertions of the Complainant, its reputed PAUL & JOE trademarks were registered and widely used in commerce well before the registration of the disputed domain name. The Respondent did not contest these assertions. The disputed domain name is confusingly similar to the Complainant’s trademarks. The website to which the disputed domain name resolves, displays the Complainant’s PAUL & JOE trademark along with various other third-party trademarks in the fashion and beauty industry. The Respondent’s intention when registering the disputed domain name confusingly similar to the Complainant’s trademark for purposes of promoting competing products, is prima facie bad faith insofar as it reflects the Respondent’s mala fide intent with respect the Complainant’s trademark.

² *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)

As regards to the use of the disputed domain name, from the evidence on file it results that the disputed domain name resolves to a website displaying the Complainant's PAUL & JOE trademark without authorization from the Complainant, to promote competing goods. Such use creates a false impression of an association with the Complainant. As the Respondent is not authorised by the Complainant to use the Complainant's trademarks and is not associated with the Complainant in any way, such use is in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. Accordingly, the Panel finds that the Respondent has registered and used the disputed domain name with the intention of taking advantage of the fame and reputation of the Complainant's trademark for the commercial benefit of the Respondent.

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 <paulandjoe.shop> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: December 5, 2024