

ADMINISTRATIVE PANEL DECISION

Thalia Bücher GmbH v. Kamal El Haid

Case No. D2023-2014

1. The Parties

Complainant is Thalia Bücher GmbH, Germany, represented by Taylor Wessing LLP, Germany.

Respondent is Kamal El Haid, Morocco.

2. The Domain Name and Registrar

The disputed domain name <thalia-online.shop> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2023. On May 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 5, 2023, 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 (Unknown/REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to Complainant on May 8, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 8, 2023.

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 May 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 4, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 28, 2023.

The Center appointed John C. McElwaine as the sole panelist in this matter on July 10, 2023. 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 is an online and brick and mortar retail bookstore based in Germany. Relevant to this proceeding, Complainant or its affiliate, Thalia Holding GmbH, own eight (8) trademark registrations for THALIA in the European Union and in Germany, including German Registration No. DE30244383 registered on August 20, 2003, in Classes 9, 16, and 41 (the “THALIA Mark”).

Respondent registered the Domain Name with the Registrar on March 25, 2023. At the time of the drafting of the Complaint the Domain Name resolved to an active website purporting to be “Thalia Online Shop.” The Domain Name does not currently resolve to an active website.

5. Parties’ Contentions

A. Complainant

By way of background, Complainant contends that its house mark THALIA enjoys a high degree of market recognition in German-speaking countries due to this trademark being used in commerce for more than 100 years. Complainant operates both an online retail bookstore at <thalia.de> and more than 340 bookshops in Germany and Austria. Complainant asserts that it is a market leader in the retail bookstore field with around 6,000 employees and an annual turnover of approximately EUR 1.3 billion. In addition to books, Complainant alleges that it offers for a sale a wide-range of goods including, e-books, audio books, toys, stationery, entertainment, technology, and gifts.

Complainant contends that the Domain Name resolved to a website in the English language that displayed Complainant’s THALIA Mark and its logo, which was a scam/phishing website. Complainant points out that the website prominently displayed the THALIA Mark in the top line of the website and gave viewers the false impression that the website was Complainant’s website or online store. Complainant further asserts that it filed a complaint with the Registrar and the website which resolved from the Domain Name was taken offline.

With respect to the first element of the Policy, Complainant contends that its THALIA Mark is protected throughout the European Union covering retail services for a variety of consumer goods, including eBooks, audio books, eBook readers. Complainant alleges that the Domain Name is confusingly similar to its THALIA Mark because it incorporates the distinctive THALIA Mark in its entirety.

With respect to the second element of the Policy, Complainant asserts that Respondent intentionally registered the Domain Name without authorization and with full awareness of Complainant’s well-known THALIA Mark. As such, Complainant asserts that Respondent’s infringing use of the Domain Name cannot provide it rights or legitimate interests.

With respect to the third element of the Policy, Complainant asserts that paragraph 4(b)(iv) of the Policy is relevant to the fact of the present case. In particular, Complainant alleges that Respondent registered the Domain Name which is nearly identical to the well-known THALIA Mark. Further, Complainant contends that the Domain Name was registered with the intent of misleading Internet users as to the commercial origin of the website. Complainant re-asserts that its well-known THALIA Mark was used in a conspicuous manner without indicating that the mark is owned by Complainant. Complainant points out that even the general terms and conditions on the website state that the contractual partner is Complainant, *i.e.*, Thalia Bücher GmbH. In sum, Complainant alleges that Respondent is deliberately misleading consumers by intentionally creating the impression that the website that resolves from the Domain Name is affiliated with Complainant.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Although Respondent defaulted, to succeed in this UDRP proceeding, paragraph 4 of the Policy requires Complainant to prove its assertions with evidence demonstrating:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires Complainant show that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights. Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2. On this point, Complainant has provided evidence that it is the owner of a German trademark registration for the THALIA Mark.

The Domain Name contains Complainant's THALIA Mark in its entirety as the dominant element with the addition of the word, "-online". The addition of other such terms to a trademark in a domain name does not avoid a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8 ("Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."); *Mastercard International Incorporated v. Dolancer Outsourcing Inc.*, WIPO Case No. [D2012-0619](#); *Air France v. Kitchkulture*, WIPO Case No. [D2002-0158](#); *DHL Operations B.V., and DHL International GmbH v. Diversified Home Loans*, WIPO Case No. [D2010-0097](#). Here, the THALIA Mark is clearly recognizable in the Domain Name.

Accordingly, the Panel finds that the Domain Name is confusingly similar to Complainant's THALIA Mark in which Complainant has valid trademark rights. Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in the Domain Name. Complainant needs to make a *prima facie* showing on this element, at which point the burden of production shifts to Respondent to present evidence that it has some rights or legitimate interests in the Domain Name. If Respondent has failed to do so, Complainant may be deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

Complainant contends it has not provided authorization for Respondent to use or register the Domain Name, which contains Respondent's THALIA Mark. Although Respondent has been properly notified of the Complaint by the Center, Respondent failed to submit any response on this point. The silence of a respondent may support a finding that it has no rights or legitimate interests in respect of the domain name. See *Alcoholics Anonymous World Services, Inc., v. Lauren Raymond*, WIPO Case No. [D2000-0007](#); *Ronson Plc v. Unimetal Sanayi ve Tic.A.S.*, WIPO Case No. [D2000-0011](#). Additionally, previous UDRP panels have found that when respondents have not availed themselves of their rights to respond to complainant, it can be assumed in appropriate circumstances that respondents have no rights or legitimate interests in the domain name at issue. See *AREVA v. St. James Robyn Limoges*, WIPO Case No. [D2010-1017](#); *Nordstrom, Inc. and NIHC, Inc. v. Inkyu Kim*, WIPO Case No. [D2003-0269](#).

Under paragraph 4(c) of the Policy, a respondent's rights or legitimate interests to a domain name may be established by demonstrating any of the following three conditions: (i) before any notice to respondent of the dispute, respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or (ii) respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if respondent has acquired no trademark or service mark rights; or (iii) respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. The Panel finds that Respondent has failed to show rights or legitimate interests under any of the three conditions.

As an initial matter, Respondent cannot satisfy paragraph 4(c)(ii) of the Policy. There is no evidence in the record that Respondent is commonly known by the name "Thalia Online".

Complainant asserts that the Domain Name resolves to a website that imitates Complainant's website and that this website is being operated to further possible scam or phishing scheme. Respondent has not submitted any response to rebut these allegations. The Panel finds that the use of the Domain Name to divert Internet traffic to a scam or a phishing scheme is not a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy. See *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#) (finding that the respondent had no rights or legitimate interests in the disputed domain name holding, "such phishing scam cannot be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name") Moreover, even if the mark was not being used to perpetrate an overt fraud, but instead being used in a commercial manner, the Panel finds that the website displayed at the Domain Name was deliberately designed to give the false impression that it is affiliated to or sponsored by Complainant, which is not the case. Prior panels deciding under the UDRP have held that such use of a domain name cannot be a "*bona fide* offering of goods or services" and is not "fair use of the domain name." See *Microsoft Corporation v. Microsof.com aka Tarek Ahmed*, WIPO Case No. [D2000-0548](#) ("by using a domain name and establishing a website deliberately designed to confuse Internet users and consumers regarding the identity of the seller of the goods and services, Respondent has not undertaken a *bona fide* or good faith offering of the goods and services."); see *Hulu, LLC v. Helecops, Vinod Madushanka*, WIPO Case No. [D2016-0365](#) (finding that an infringing website operating under the name "HuluMovies" does not entail a *bona fide* offering of services in the sense of paragraph 4(c)(i) of the Policy, nor a legitimate noncommercial or fair use under Policy paragraph 4(c)(iii), without intent for commercial gain to misleadingly divert consumers or to tarnish the HULU mark). The Panel notes that the contentions by Complainant about the website at the Domain Name have not been rebutted by Respondent in this proceeding.

Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interests and Respondent has failed to come forward to rebut that showing. As provided for by paragraph 14 of the Rules, the Panel may draw such inference from Respondent's default as it considers appropriate. For all these reasons, the Panel is entitled to accept that the second element of the Policy is established by Complainant, and Respondent has no rights or legitimate interests in respect of the Domain Name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can be found where a respondent “knew or should have known” of a complainant’s trademark rights and nevertheless registered a domain name in which it had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). As detailed above, Respondent registered the Domain Name, which is confusingly similar to the THALIA Mark. The content of the website establishes familiarity with Complainant as Complainant’s logo was copied and the screenshot of Respondent’s alleged website demonstrates books being offered for sale. There is no explanation for Respondent to have chosen to register the Domain Name other than to intentionally trade off the goodwill and reputation of Complainant’s trademark or otherwise create a false association with Complainant. With no response from Respondent, such a claim of bad faith registration is undisputed.

Also as discussed herein, Respondent registered the Domain Name and linked it to a website using Complainant’s THALIA Mark in the header and a copy of Complainant’s logo. This amounts to bad faith use of the Domain Name by Respondent. See *Identigene, Inc. v. Genetest Labs*, WIPO Case No. [D2000-1100](#) (finding bad faith where the respondent’s use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site); *MathForum.com, LLC v. Weiguang Huang*, WIPO Case No. [D2000-0743](#) (finding bad faith under paragraph 4(b)(iv) of the Policy where the respondent registered a domain name confusingly similar to the complainant’s mark and the domain name was used to host a commercial website that offered similar services offered by the complainant under its mark).

As detailed above, the Panel finds on the record before it that Respondent’s intention in registering the Domain Name was to attract, for commercial gain, Internet users to Respondent’s website by creating a likelihood of confusion with the THALIA Mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. Thus, the Panel holds that Complainant has met its burden of providing sufficient evidence that Respondent registered and is using the Domain Name in bad faith under paragraph 4(b)(iv) of the Policy.

For these reasons, the Panel holds that Complainant has met its burden of showing that Respondent registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) 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, <thalia-online.shop>, be transferred to Complainant.

/John C McElwaine/
John C McElwaine
Sole Panelist
Date: July 24, 2023