

## **ADMINISTRATIVE PANEL DECISION**

Benda Bili v. 何容 (Rong He)

Case No. D2023-2647

### **1. The Parties**

The Complainant is Benda Bili, France, represented by Nameshield, France.

The Respondent is 何容 (Rong He), China.

### **2. The Domain Name and Registrar**

The disputed domain name <sezane-fr.shop> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 20, 2023. On June 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 21, 2023, 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 (Not Identified) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 22, 2023 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 in English on June 22, 2023.

On June 22, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On June 22, 2023, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on July 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 30, 2023. The Respondent did not submit any

response. Accordingly, the Center notified the Respondent's default on August 8, 2023.

The Center appointed Rachel Tan as the sole panelist in this matter on August 17, 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**

The Complainant is a company specialized in ready-to-wear collections and accessories for women and trading under its commercial name and trade mark SEZANE or SÉZANE. The term "sezane" is a contraction of the first name and last name of the Complainant's founder and President Morgane Sezalory. The SEZANE branded clothing and accessories are sold through brick-and-mortar stores and its online shop.

The Complainant is the owner of the SEZANE mark, including the International Trade Mark Registration No. 1170876, SÉZANE, registered on June 3, 2013, in classes 14, 18, and 25, and the French Trade Mark Registration No. 4308523, SEZANE, registered from October 19, 2016, in classes 11 and 20, collectively "the SEZANE mark".

The Complainant is the registrant of several domain names incorporating the SEZANE mark, for example <sezane.com> registered on April 3, 2003.

The Respondent is 何容 (Rong He), China.

The disputed domain name was registered on June 9, 2023. At the date of this Decision, the disputed domain name does not resolve to any active websites. At the time of filing of the Complaint, the disputed domain name resolved to a website in French, which displayed the Complainant's SEZANE mark, and allegedly sold clothes and accessories at heavily discounted prices.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark and domain names. The disputed domain name includes in its entirety the Complainant's mark. The addition of the term "fr" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the SEZANE mark. Further, the addition of the new generic Top-Level Domain ("gTLD") ".shop" does not change the overall impression of the designations as being connected to the Complainant's mark.

The Complainant further alleges that the Respondent is not commonly known by the disputed domain name. The Respondent is not affiliated with nor authorized by the Complainant in any way. The Respondent has no rights or legitimate interests in respect of the disputed domain name. Further, the Respondent uses the disputed domain name to redirect the consumers to a competitor's website, and such use may not qualify as a *bona fide* offering of goods or services nor as a legitimate noncommercial or fair use under the Policy.

The Complainant finally asserts that the Respondent has registered and is using the disputed domain name in bad faith. The Respondent registered the disputed domain name with actual knowledge of the Complainant's SEZANE mark. The Respondent has used the disputed domain name to attract Internet users and offer possibly fraudulent services while impersonating the Complainant or, at a minimum, disrupt the Complainant's business by offering services in direct competition with the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Language of the Proceeding**

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The panel may choose to write a decision in either language, or request translation of either party's submissions.

In this case, the Registrar has confirmed to the Center that the language of the Registration Agreement as used by the registrant for the disputed domain name is Chinese. However, the Complainant has requested that English be adopted as the language of the proceeding for the reasons summarised below:

- (a) the English language is the language most widely used in international relations and is one of the working languages of the Center;
- (b) the disputed domain name is formed by words in Roman characters and not in Chinese script; and
- (c) the Complainant would have had to retain specialized translation services at a cost very likely to be higher than the overall costs of the proceedings in order to proceed in Chinese. The use of Chinese in this case would therefore impose a burden on the Complainant which must be deemed significant in view of the low cost of these proceedings.

It is established practice to take paragraphs 10(b) and 10(c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Panel having considered the circumstances finds that English shall be the language of this proceeding. The reasons are set out below:

- (a) the Complainant is based in France. Requiring the Complainant to translate the Complaint in Chinese would lead to delay and cause the Complainant to incur translation expenses;
- (b) the Respondent's choice of Roman letters for the disputed domain name indicates that the Respondent is familiar with the English language;
- (c) even if the Respondent does not possess a sufficient command of English to understand the Complaint, there were ample opportunities for the Respondent to raise an objection. The Center notified the Parties in English and Chinese of the language of the proceeding, the Complainant requested English to be the language of the proceeding, but the Respondent did not object to this request;
- (d) the Respondent has failed to participate in the proceeding even though the Center sent the notification of the Complaint in English and Chinese, and indicated that the Response may be submitted in Chinese or English; and

- (e) the Complaint has been submitted in English. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

Accordingly, the Panel will proceed with issuing this Decision in English.

## 6.2 Substantive Issues

### A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has adduced evidence to demonstrate its established rights in the SEZANE mark.

The Panel notes that the SEZANE mark is wholly encompassed within the disputed domain name. The SEZANE mark is instantly recognizable in the disputed domain name. In cases where a domain name incorporates the entirety of a trade mark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is accepted by previous UDRP panels that the addition to the complainant's trade mark of other words or terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity between the domain name and the complainant's trade mark under the first element of the Policy. See section 1.8 of the [WIPO Overview 3.0](#). As such, the Panel finds the additional symbol "-" and term "fr", the country code for France, do not preclude a finding of confusing similarity between the SEZANE mark and the disputed domain name.

Lastly, it is permissible for the Panel to disregard the TLD in the disputed domain name, *i.e.*, ".shop". It is accepted by UDRP panels that the practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to "new gTLDs") and the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment to the first element. See sections 1.11.1 and 1.11.2 of the [WIPO Overview 3.0](#).

Accordingly, the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

In circumstances where the Complainant possesses rights to the SEZANE mark, whereas the Respondent seems to have no trade mark rights, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the burden of production shifts to the Respondent to show that he or she has rights or legitimate interests in the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain name or reasons to justify his or her choice of the term "sezane" in the disputed domain name. There is no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. Moreover, the Complainant has not granted the Respondent any license or authorization to use the Complainant's marks or register the disputed domain name.

The Panel notes that the disputed domain name previously resolved to a website in French, which allegedly offered the products similar to those of the Complainant for sale at heavily discounted prices. The website noticeably displayed the Complainant's SEZANE mark and attempted to impersonate the Complainant. The website did not accurately and prominently disclose a lack of a relationship between the Complainant and the Respondent. Therefore, the facts do not support a claim of a *bona fide* offering of goods or services under the "Oki Data test". See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied the second element under paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

The Complainant's SEZANE mark was registered well before the registration of the disputed domain name. Through use and advertising, the Complainant's SEZANE mark is known throughout the world, including in China. Search results using the term "sezane" on the Internet search engines direct Internet users to the Complainant and its products, which indicates that an exclusive connection between the SEZANE mark and the Complainant has been established. As such, the Respondent should have known of the Complainant's SEZANE mark when registering the disputed domain name. This fact has been reinforced by the Respondent's use of the SEZANE mark on the website at the disputed domain name.

The Panel notes that the disputed domain name previously resolved to a website allegedly offering for sale the products similar to those of the Complainant at heavily discounted prices. The lack of a disclaimer that the Respondent is not affiliated with the Complainant is noticeably absent. The Panel is satisfied that the Respondent intends to take advantage of the reputation of the Complainant's trade marks to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's marks as to source, sponsorship, affiliation, or endorsement of the website. This demonstrates bad faith registration and use of the disputed domain name, as provided in paragraph 4(b)(iv) of the Policy.

The Panel notes that the disputed domain name currently does not resolve to any active website. The current inactive use of the disputed domain name in this case would not prevent a finding of bad faith under the doctrine of passive holding. In its determination, the Panel considers the degree of reputation of the Complainant's SEZANE mark, the Respondent's failure to respond in the face of the Complainant's allegations of bad faith, as well as the implausibility of any good faith use that the disputed domain name may be put. See section 3.3 of the [WIPO Overview 3.0](#).

Given all the circumstances of the case, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain name, and considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain name as discussed above as well as continuing to hold the disputed domain name, the Panel is led to conclude that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the third element under paragraph 4(a) 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 <sezane-fr.shop> be transferred to the Complainant.

*/Rachel Tan/*

**Rachel Tan**

Sole Panelist

Date: August 30, 2023