

ADMINISTRATIVE PANEL DECISION

Alain Afflelou Franchiseur v. Nikoloz Javakhia

Case No. DGE2021-0003

1. The Parties

The Complainant is Alain Afflelou Franchiseur, France, represented by Novagraaf France, France.

The Respondent is Nikoloz Javakhia, Georgia.

2. The Domain Names and Registry

The disputed domain names <afflelou.com.ge>, <afflelou.ge>, <alainafflelou.com.ge>, and <alainafflelou.ge> are registered with Caucasus Online LLC (the .GE Registry).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 28, 2021. On July 29, 2021, the Center transmitted by email to the .GE Registry a request for registry verification in connection with the disputed domain names. On August 2, 2021, the .GE Registry transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 5, 2021, providing the registrant and contact information disclosed by the .GE Registry, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 5, 2021.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .GE Domain Name Dispute Resolution Policy (the .GE Policy), the Rules for .GE Domain Name Dispute Resolution Policy (the .GE Rules), and the WIPO Supplemental Rules for .GE Domain Name Dispute Resolution Policy (the Supplemental Rules).

In accordance with the .GE Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 24, 2021. In accordance with the .GE Rules, paragraph 5, the due date for Response was September 13, 2021. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 20, 2021.

The Center appointed Luca Barbero as the sole panelist in this matter on September 29, 2021. 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 .GE Rules, paragraph 7.

4. Factual Background

The Complainant was founded by Alain Afflelou in 1972 and is a franchisor of optical products and hearing aids operating in the European Union and worldwide.

The Complainant is the owner of several trademark registrations for AFFLELOU and ALAIN AFFLELOU, including the following, as per trademark certificates submitted as annexes to the Complaint:

- French trademark registration No. 4267761 for AFFLELOU (word mark), filed on April 26, 2016 and registered on August 19, 2016, in international classes 3, 5, 9, 10, 35, 36, 37, 38 and 44;
- International Trademark registration No. 1305969 for AFFLELOU (word mark), registered on April 26, 2016, in classes 3, 5, 9, 10, 35, 36, 37, 38 and 44;
- French trademark registration No. 1365616 for ALAIN AFFLELOU (word mark), filed on July 25, 1986, registered in 1987 and duly renewed, in international classes 5, 10, 14, 18, 20, 24, 25, 35 and 38;
- French trademark registration No. 96648390 for ALAIN AFFLELOU (word mark), filed on October 29, 1996, registered in 1997 and duly renewed, in international class 9;
- International trademark registration No. 555412 for ALAIN AFFLELOU (word mark), registered on June 21, 1990 and duly renewed, in international classes 5, 9, 10, 14, 18, 20, 24, 25, 35 and 38;
- International trademark registration No. 1302914 for ALAIN AFFLELOU (word mark), registered on March 10, 2016, in international classes 3, 5, 9, 10, 35, 36, 37, 38 and 44.

The Complainant is also the owner of the domain names <afflelou.com>, registered on September 13, 1999, <afflelou.net>, registered on June 17, 1999, <alainafflelou.com>, registered on May 2, 1998, and <alainafflelou.fr>, registered on June 2, 2005, all of which are used by the Complainant to promote its services under the trademark AFFLELOU.

The disputed domain names <alainafflelou.ge>, <alainafflelou.com.ge>, <afflelou.ge> and <afflelou.com.ge> were registered on April 7, 2021 and are redirected to registrar parking pages.

5. Parties' Contentions

A. Complainant

The Complainant contends that disputed domain names are identical to the trademarks ALAIN AFFLELOU and AFFLELOU in which the Complainant has rights as they reproduce the trademarks in their entirety with the mere addition of the country code Top-Level Domain “.ge” and the Second-Level Domain “.com.ge”.

The Complainant further alleges that such identity with the Complainant's trademarks could inevitably cause likelihood of confusion especially considering the notoriety of the Complainant's trademark in France and worldwide in relation to optical products and services.

The Complainant states that the Respondent has no rights or legitimate interests in the disputed domain names, since the Respondent is not commonly known by the disputed domain names, has no registered

rights in the Complainant's trademarks and has never been authorized by the Complainant to use the trademarks ALAIN AFFLELOU or AFFLELOU in any way.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, on April 22, 2021, it sent a cease-and-desist letter to the Respondent via the concerned Registrar, notifying the infringement of its trademark rights and requesting that the Respondent transfer all disputed domain names to the Complainant. The Complainant informs the Panel that the Respondent never replied to such letter and continued to passively hold the disputed domain names.

The Complainant emphasizes that, due to their world renown, the Respondent could not have been unaware of the Complainant's trademarks at the time of registering the disputed domain names and that, considering the Respondent registered the disputed domain names by hiding its identity in the public Whois records, the Respondent was undoubtedly acting in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the .GE Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the .GE Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the .GE Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademarks ALAIN AFFLELOU and AFFLELOU based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as annex 4 to the Complaint.

The first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the trademark is recognizable within the disputed domain name.

The Panel finds that the disputed domain names <afflelou.ge> and <afflelou.com.ge> are identical to the Complainant's trademark AFFLELOU whilst the disputed domain names <alainafflelou.ge> and <alainafflelou.com.ge> are identical to the Complainant's trademark ALAIN AFFLELOU.

As held in other prior decisions rendered under the .GE Policy, the applicable Top-Level Domain ("TLD") in a domain name, such as the country code Top-Level Domain ".ge", is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Likewise, the Panel finds that also the Second-Level Domain ".com.ge" is irrelevant for purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the .GE Policy. See *Carrefour v. Tool Domains Ltd*, WIPO Case No. DGE2018-0002 (<carrefour.com.ge>), where the Panel held: "The addition '.com.ge' is in this case irrelevant or neutral at a minimum".

Therefore, the Panel finds that the Complainant has proven that the disputed domain names are identical to the trademarks in which the Complainant has established rights according to paragraph 4(a)(i) of the .GE Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the .GE Policy, Respondent may establish its rights or legitimate interests in the disputed domain names, among other circumstances, by showing any of the following elements:

- “(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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 the Complainant has made a *prima facie* case and that the Respondent, by not having submitted a Response, has failed to demonstrate rights or legitimate interests in the disputed domain names in accordance with paragraph 4(c) of the .GE Policy.

According to the evidence on record, there is no relationship between the Complainant and the Respondent and the Complainant has not authorized the Respondent to register or use its trademarks or the disputed domain names. In addition, there is no evidence that the Respondent might be commonly known by the disputed domain names.

Moreover, as highlighted above, the disputed domain names have been pointed to mere parking pages of the concerned Registrar. The Panel finds that the Respondent’s use does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name without intention to misleadingly divert the consumers or to tarnish the Complainant’s trademarks.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain names according to paragraph 4(a)(ii) of the .GE Policy.

C. Registered or Used in Bad Faith

Paragraph 4(b) of the .GE Policy provides that the following circumstances, in particular but without limitation, are evidence of the registration and use of the disputed domain name in bad faith:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s

mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”.

As to bad faith at the time of the registration, the Panel finds that, in light of i) the prior registration and use of the Complainant’s trademarks ALAIN AFFLELOU and AFFLELOU in connection with the Complainant’s products and services; ii) the well-known character of the Complainant’s trademarks in their sector, as demonstrated by the documents submitted as annex 9 to the Complaint; and iii) the correspondence of the disputed domain names with the Complainant’s trademarks and the patronymic name of Alain Afflelou, the Respondent very likely registered the disputed domain names having the Complainant’s trademarks and the patronymic name of the Complainant’s founder in mind.

With reference to the use of the disputed domain names, the Panel notes that they do not resolve to dedicated websites, but to mere parking pages promoting the Registrar’s services.

The Panel finds that, as held in prior panel decisions, in view of i) the distinctiveness and reputation of the Complainant’s prior trademarks; ii) the failure of the Respondent to reply to the Complainant’s cease and desist letter and to submit a Response, providing any evidence of actual or contemplated good-faith use; and iii) the implausibility of any good faith use to which the disputed domain names may be put considering the high risk of implied carried by domain names identical to the Complainant’s trademarks, the lack of active use of the disputed domain names does not prevent a finding of bad faith use.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and has been using the disputed domain names in bad faith according to paragraph 4(a)(iii) of the .GE Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the .GE Policy and 15 of the .GE Rules, the Panel orders that the disputed domain names, <afflelou.com.ge>, <afflelou.ge>, <alainafflelou.com.ge> and <alainafflelou.ge> be transferred to the Complainant.

Luca Barbero

Sole Panelist

Date: October 13, 2021