



URS | DETERMINATION
(URS Procedure 9, URS Rules 13)

URS DISPUTE NO. 456CBEEE

Determination DEFAULT

I. PARTIES

Complainant: Sol de Janeiro IP, Inc.
Complainant's authorized representative: IP Twins (FR)

Respondent: Domains By Proxy, LLC (US)

(collectively referred to as 'the Parties')

II. THE DOMAIN NAME, REGISTRY OPERATOR AND REGISTRAR

Domain Name: soldejaneiro.shop ('the disputed domain name')
Registry Operator: GMO Registry, Inc.
Registrar: GoDaddy.com, LLC

III. PROCEDURAL HISTORY

Complaint submitted: 21 October 2024
Lock of the domain name: 31 October 2024
Notice of Complaint: 31 October 2024
Default Date: 14 November 2024
Notice of Default: 15 November 2024
Panel Appointed: 15 November 2024
Default Determination issued: 19 November 2024

IV. EXAMINER

Examiner's Name: Gustavo Moser

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

V. RELIEF SOUGHT

The Complainant requests that the disputed domain name be suspended for the balance of the registration period.

The Respondent has not submitted a Response.

VI. STANDARD OF REVIEW

Clear and convincing evidence.

VII. DISCUSSIONS AND FINDINGS

A. Disputed domain name

The disputed domain name was registered on 19 October 2024.

At the time of writing, the disputed domain name resolves to a landing page headed with the following message:



*‘Oups, une erreur s'est produite.
Que s'est-il passé ?
This store is unavailable
Que puis-je faire ?’*

(for present purposes, ‘the Respondent’s website’).

B. Complainant:

B.1 Trade mark standing

For the purposes of this URS administrative proceeding, the Complainant relies on the following registered trade marks:

- EU trade mark registration no. 009485954, registered on 29 October 2010, for the figurative mark  (SOL DE JANEIRO), in class 3 of the Nice Classification; and
- EU trade mark registration no. 018901589, registered on 14 July 2023, for the figurative mark  , in classes 3, 4, 5, 35, and 44 of the Nice Classification.

(Collectively referred to as ‘the Complainant’s trade mark’).

B.2 Complainant’s Factual Allegations

The Complainant, founded in 2015, is a global cosmetics company part of the L’Occitane group of companies. The Complainant’s official website is available at the domain name <www.soldejaneiro.com>

The Complainant seeks to obtain the suspension of the disputed domain name on the grounds advanced in section B.3 below.

B.3 URS grounds

i. The disputed domain name is identical or confusingly similar to a word mark

The disputed domain name is identical to the Complainant’s trade mark. The terms ‘sol de janeiro’ in relation to cosmetics are arbitrary, such that the Respondent cannot claim that the disputed domain name was registered due to its dictionary meaning.



ii. Respondent has no rights or legitimate interests in respect to the disputed domain name

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not been authorised by the Complainant to use the Complainant's trade mark or to register any domain name bearing the Complainant's trade mark. Furthermore, there is no legal or business relationship between the Parties.

iii. The disputed domain name was registered and is being used in bad faith

The Complainant submits that the disputed domain name was registered and is being used in connection with a website reproducing the Complainant's trade mark in an attempt to impersonate the Complainant. Therefore, the Respondent intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation, or endorsements of the Respondent's website and/or the goods offered or promoted through the Respondent's website.

C. Respondent:

The Respondent has defaulted in this URS administrative proceeding and has therefore failed to advance any substantive case on the merits.

D. Procedural findings:

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under the URS Procedure paragraphs 3 and 4 and URS Rules paragraph 4.

In accordance with URS Rules Paragraph 9(d), in absence of a Response, the language of the Determination shall be English.

E. Findings of fact:

The disputed domain name <soldejaneiro.shop> was registered on 19 October 2024.

At the time of writing, the disputed domain name does not hold active content. Nonetheless, the Complainant has adduced evidence of the disputed domain name being connected with a website in the past which mimicked elements of the Complainant's own website, including the use of the Complainant's trade mark.

The Complainant has, to the satisfaction of the Examiner, adduced proof that the Complainant has trade mark rights in the terms 'sol de janeiro'.

F. Reasoning:

Pursuant to paragraph 13 of the URS Rules, the Examiner shall make a Determination of a Complaint in accordance with the URS Procedure, the URS Rules and any rule and principles of law that the Examiner deems applicable.

Paragraph 1.2.6 of the URS Procedure sets out the grounds which the Complainant must establish to succeed:

1. The disputed domain name is identical or confusingly similar to a word mark;
2. The Respondent has no rights or legitimate interests in the disputed domain name; and
3. The disputed domain name was registered and is being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the URS procedure is clear and convincing, which lays down the foundations for examiners to determine each of the three URS Procedure grounds.

1. The disputed domain name is identical or confusingly similar to a word mark

The Examiner is satisfied that the Complainant has URS-relevant rights in the registered trade mark SOL DE JANEIRO since 2010 as supported by its submission into evidence of screenshots from the websites of the trade mark offices referencing the particulars of the Complainant's trade mark registrations.

The disputed domain name <soldejaneiro.shop> contains the Complainant's trade mark SOL DE JANEIRO in its entirety. The Top-Level Domain (TLD) suffix, whilst generally disregarded in the assessment of confusing similarity for being part of the anatomy of a domain name, in this case (<.shop>) may actually heighten the risk of confusion given its descriptive nature.

Accordingly, the Examiner finds that the Complainant has succeeded under paragraph 1.2.6.1 of the URS Procedure.

2. Respondent has no rights or legitimate interests in the disputed domain name

The Complainant must first make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name under the URS Procedure. Consequently, the burden of production shifts to the Respondent to come forward with evidence it has rights or legitimate interests.

There is no evidence of the Complainant's affiliation and/or association with, or authorisation for, the Respondent of any nature. Moreover, the Examiner is convinced that the Respondent (as an individual, business, or other organisation) has not been commonly known by the disputed domain name, and it likewise has not been authorised by the Complainant to make any use of the disputed domain name.

Furthermore, the Examiner finds on the undisputed evidence on record that the Respondent has made no use of the disputed domain name whether for a *bona fide* offering of goods or services, or for a legitimate noncommercial or fair use. Instead, it appears that the Respondent has attempted to create a connection with, and take advantage from the goodwill and reputation associated with, the Complainant, as discussed in section F.3. below.

For the foregoing reasons, the Examiner finds that the Complainant has made a *prima facie* showing of the Respondent's lack of rights or legitimate interests in the disputed domain name under paragraph 1.2.6.2 of the URS Procedure.



3. The disputed domain name was registered and is being used in bad faith

The Examiner notes a number of factors which point towards a finding of bad faith registration. Firstly, the Complainant's trade mark SOL DE JANEIRO predates the registration of the disputed domain name by nearly fifteen years. Secondly, the disputed domain name is composed of the trade mark SOL DE JANEIRO only. Furthermore, the disputed domain name is identical to the Complainant's own domain name <soldejaneiro.com>, which was registered in 2009. The Examiner has therefore no hesitation in finding that the Respondent registered the disputed domain name with knowledge of, and intention to target, the Complainant.

As regards the use in bad faith, the Complainant submits that the Respondent has engaged in the conduct set out in paragraph 1.2.6.3 of the URS Procedure, which provides as follows:

'd. By using the domain name, the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location'.

The Examiner has considered the available record and found convincing evidence that the Respondent would have purposefully used the Complainant's trade mark SOL DE JANEIRO on the Respondent's website to deceive Internet users into a mistaken belief of affiliation or connection with the Complainant.

In view of the above, the Examiner finds that the Complainant has met the requirement under paragraph 1.2.6.3 of the URS Procedure.

4. Abusive Complaint

For the avoidance of doubt, the Examiner finds that the Complaint was not brought by the Complainant abusively nor does the Complaint contain any deliberate material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Complaint and remedy

Complaint: Accepts

Domain Name: soldejaneiro.shop

Suspends for the balance of the registration period

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Gustavo

Surname: Moser

Date: 19 November 2024