



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1801067
Complainant:	Essilor International
Respondent:	Jay Binkowitz (Gatework Provider Network, LLC)
Disputed Domain Name(s):	<essilor-experts.com>

1. The Parties and Contested Domain Name

1. The Complainant is Essilor International, of 147 Rue De Paris 94220, Charenton Le Pont, France.
2. The Respondent is Jay Binkowitz (Gatework Provider Network, LLC), of 7 Eckert Street, Huntington, NY, 11746 USA.
3. The domain name at issue is <essilor-experts.com>, registered by the Respondent with Register.com, Inc. of 12808 Gran Bay Pkwy, West Jacksonville, Florida, USA.

2. Procedural History



4. The Complainant filed this complaint with the Asian Domain Name Dispute Resolution Centre (ADNDRC) (Hong Kong Office) on 31 January 2018.
5. The ADNDRC sent a copy of the Complaint to the Respondent on 1 February 2018.
6. The Respondent failed to respond within 20 calendar days as required under paragraph 5 of the UDRP Rules. On 22 February 2018, the Respondent was in default of filing its response.
7. On 23 February 2018, after confirming that he was able to act independently and impartially between the parties, the ADNDRC appointed David Allison as the sole Panelist in this matter.

3. Factual background

8. The Complainant, Essilor International, is a leader in the field of ophthalmic optics, manufacturing, producing and distributing a large range of ophthalmic lenses, instruments and equipment in more than hundred countries.

9. The Complainant has for many years used the mark “Essilor” both alone and in combination with other word elements, in connection with ophthalmic lenses and related services.

10. The Complainant owns numerous registrations for the Essilor marks in many jurisdictions and in this complaint relies upon the following registered trademarks:

	Trademark	Reg. No.	Registered Country	Class	Owner
1		IR1024167	Designations Under the Madrid Protocol (Australia, European Community, Japan, Republic of Korea, Norway, Singapore, United States of America)	05, 07, 09, 10, 35, 38, 40, 42 and 44	Essilor International (Formerly Essilor International (Compagnie Generale D'Optique))
2	ESSILOR	IR1231641	Australia, China, Colombia, Egypt, the United States, India, Israel, Japan, Mexico, Norway, New Zealand, the Philippines, South Korea, Singapore, Tunisia, Turkey, European Union	09, 16, 35, 36, 41	Essilor International (Formerly Essilor International (Compagnie Generale D'Optique))
3	ESSILOR	4890842	United States of America	09	Essilor International (Compagnie Generale D'Optique)
4	ESSILOR	72426930	United States of America	01, 09 and 10	Essilor International (Compagnie Generale D'Optique)
5	ESSILOR	4080145	France	09, 16, 35, 36, 41	Essilor International (Compagnie Generale D'Optique)
6		1610593	China	09	Essilor International (Compagnie Generale D'Optique)
7	ESSILOR	270076	China	09	Essilor International (Compagnie Generale D'Optique)

11. A preliminary issue to be addressed is the apparent discrepancy in ownership of the above marks. Whilst marks 1 & 2 in the table above are registered in the name of the Complainant, Essilor International, the remainder are registered in the name of Essilor International (Compagnie Generale D'Optique). The Complainant has provided a full and frank explanation of the apparent discrepancy and explained that while all marks are owned by the Complainant, the name Essilor International (Compagnie Generale D'Optique) is the former name of the Complainant and that recordal of change of name has not been completed in respect of all marks with all respective Registries.

12. The Panel accepts the Complainant's explanation and holds that all of the trademarks referred to above can be relied upon by the Complainant to establish it has prior trademark rights.
13. The evidence submitted by the Complainant demonstrates that the Complainant has extensive and long standing trademark rights. The evidence also suggests that it has become very well known to consumers throughout the world, particularly in relation to the fields of ophthalmic optics, lenses and equipment.
14. As the Respondent did not file any response to the Complaint, little is known about the background of the Respondent. However, according to the WHOIS search report of the disputed domain name, the Respondent appears to be an individual based in the United States of America.

4. Parties' Contentions

Complainant

15. The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to the trade marks of the Complainant.
- ii. The disputed domain name contains the Complainant's trademark "ESSILOR" in its entirety.
- iii. The owner of the disputed domain name is not a licensee of the Complainant nor have they been authorized to use the Complainant's trademarks.
- iv. The Respondent was well aware of the Complainant's trade marks and reputation prior to registering the disputed domain name.

Respondent

16. The Respondent has not filed a response to the Complainant's complaint.

5. Findings

17. The ICANN Uniform Domain Name Dispute Resolution Policy (UDRP) provides, at paragraph 4(a), that each of three findings must be made out in order for a Complainant to prevail:

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

18. Whilst the Respondent has not filed a response to this Complaint, the Panel has reminded itself that it is the Complainant who must establish each of the three elements required by paragraph 4(a) of the UDRP. The mere fact of the Respondent's non-response has not resulted in an automatic finding against it. The Panel has therefore,

considered whether each of the three requirements under paragraph 4(a) have been met and its findings are as follows:

A) Identical / Confusingly Similar

19. The disputed domain name consists of the elements "essilor-experts" and ".com". It is a well-accepted principle that TLD suffixes such as ".com", ".net", etc are ignored for the purposes of comparison and thus the Panel has not considered this suffix when comparing the disputed domain name to the Complainant's prior rights.
20. In relation to the main part of the disputed domain name, consumers will likely regard it as being comprised of the elements (a) essilor, (b) a dash (-) and (c) experts.
21. The element 'essilor' is identical to the Claimant's word marks and is the dominant feature of its composite marks. The fact that the disputed domain name reproduces this element at the beginning of the domain name and in its entirety is significant and this will be readily apparent to consumers.
22. While features such as the dash (-) may in certain cases add nothing to distinctiveness of the respective mark, in this case the dash is significant. It serves to clearly delineate the two elements and highlight to consumers that they must be regarded separately rather than as a composite word/ element. In the Panels view, the dash serves to highlight and increase the relative prominence and distinctiveness of the respective elements – in particular the "essilor" element.
23. The final element, 'experts', is a non-distinctive element that consumers would typically expect to see within the Complainant's field of business. To put it another way, consumers would expect that companies operating in respect of precision ophthalmic devices and lenses are 'experts' and as such the addition of this element is a natural and non-distinctive extension of a trademark or tradename rather than a distinctive element that would be recognizable and remembered separately by consumers. Accordingly, when assessing confusing similarity, the Panel has largely disregarded this element.
24. In comparing the Complainant's trade marks with the distinctive element of the disputed domain name (ie essilor), the Panel finds that trademarks are identical to the distinctive element of the disputed domain name. As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade marks and thus element 1 of UDRP paragraph 4(a) has been satisfied.

B) Rights and Legitimate Interests

25. The Complainant contends that the Respondent has never been authorized by the Complainant to use its trademarks. This is despite the fact that the 'essilor-experts' name features prominently on the landing page associated with the disputed domain name and the landing page also prominently features the word "Varilux" which is a well known product produced by the Complainant and a trademark in its own right.
26. The Complainant states that it has also undertaken trademarks searches in several key jurisdictions (including the US, EU and China) and has found no evidence that the Respondent has any trademarks in those jurisdictions and thus this suggest very

strongly that it has no rights or legitimate interests. While such evidence *may* constitute highly persuasive evidence, in this case the Complainant has unfortunately searched under the name "Perfect Privacy LLC" rather than the Respondent's name (ie Jay Binkowitz or Gateway Provider Network LLC) as shown on the relevant WhoIs Search report. As such, the Panel completely disregards this contention and evidence.

27. On the other hand, the Respondent has failed to adduce any evidence to show why it has chosen a domain name where the dominant and distinctive element is identical to that of the Complainant's trademarks. It has not provided any evidence to demonstrate that it has a right or legitimate interest in the disputed domain name.
28. While the Panel notes that the overall burden of proving this element rests with the Complainant, it also recognizes the well-established principle that once the Complainant has established a *prima facie* case that the Respondent lacks sufficient legitimate rights and interests, the burden then shifts to the Respondent.
29. In this case, the Panel finds that the Complainant has adduced a sufficient *prima facie* case whereas the Respondent has failed to adduce any evidence whatsoever. Therefore, the Panel finds therefore, that the Complainant has established the second element of UDRP paragraph 4(a).

C) Bad Faith

30. To prove this element, the Complainant must establish that the Respondent both registered and has used the disputed domain name in bad faith. To establish bad faith, reference may be made to the circumstances outlined in paragraph 4(b) of the UDRP. These circumstances are not exhaustive however, and the Panel may take into account other circumstances which demonstrate bad faith.
31. The Complainant notes that the landing page of the disputed domain name "*resolves to a parked page with links referencing Essilor-owned marks (Essilor and Variklux) and lenses*" and claims that the Respondent has at least a basic knowledge of key companies in this field. In essence, the Complainant claims that the Respondent knew of the existence and fame of the Complainant and has sought to free-ride on that fame for some purpose – mainly by directly links to websites that are not associated with the Complainant.
32. While the concept of knowledge or constructive knowledge will generally only apply where the Complainant's mark is "well-known", the Panel finds that this argument has some force in this case. Here, the Complainant has adduced significant evidence to show that the Complainant's trademarks are extensive both in terms of numbers registered and geographical reach and that they are reasonably well known to the public.
33. Further, the Complainant's trademarks have been registered for many years and well before the Respondent registered the disputed domain name.
34. Finally the use of both the Complainant's main house mark, Essilor, and its other various product lines and marks, (eg Varilux) suggests very strongly that use of the essilor-experts mark was deliberate and in no way a coincidence.

35. As a result of the above, the Panel finds that the Respondent was well aware of the Complainant's trade marks and rights prior to registering the disputed domain name and this is a clear indicia pointing towards bad faith.
36. In light of the matters described above, the Panel finds that it is highly likely the Respondent intentionally used the disputed domain name as a means to confuse and attract consumers to its site. Such use satisfies the definition of bad faith as outlined in UDRP paragraph 4(b)(iv).
37. Considering all of the matters discussed above, the evidence submitted by the Complainant and the complete failure of the Respondent to make any submissions whatsoever, the Panel finds that the third element of UDRP paragraph 4(a) has been made out and that the Respondent has registered and used the disputed domain name in bad faith.

6. Decision

38. For the reasons outlined above, the Panel finds that the Complainant has satisfied all three elements of UDRP paragraph 4(a). Accordingly, the Panel orders that the disputed domain name, <essilor-experts.com>, be transferred to the Complainant.



David Allison
Sole Panelist

Dated: 06 March 2018