Decision for dispute CAC-UDRP-101085

Case number	CAC-UDRP-101085
Time of filing	2015-09-29 12:31:06
Domain names	lefigaro.news

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	SOCIETE DU FIGARO S.A.

Complainant representative

Organization	Nameshield (Anne Morin)

Respondent

Name	Raymond Wang

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant relies upon various registered trade marks including international trade mark registration no 655549 dated 29 March 1996 for the word mark LE FIGARO in classes 3, 8, 9, 12, 20, 21, 24, 28, 30, 34, 35, 38, 39, 41 and 42. The mark relies upon a number of French registrations and has proceeded to grant in respect of goods or services in at least some of the claimed classes in 16 different jurisdictions.

FACTUAL BACKGROUND

The Complaint is a publisher of the "LE FIGARO newspaper. This newspaper has been published in France since 1826.

The disputed domain name (the "Domain Name") was registered on 10 September 2015. Since registration, it has resolved to a domain name parking page, which appears to have been provided by Name.com, the registrar (the "Registrar") of the Domain Name.

As at the date of the filing of the Complaint, the publicly available WhoIs record for the Domain Name, identified the registrant as the privacy service "Whois Privacy Protection Service, Inc.". In response to the Czech Arbitration Court's Registrar Verification request, the Registrar provided details of the underlying registrant of the Domain Name. That registrant

(and the entity hereinafter referred to as the Respondent in this decision) would appear to be an individual located in New York in the United States of America.

On 14 October 2015 (i.e. subsequent to the filing of these proceedings and 5 days prior to the filing of a Response) a purported blog page began to be displayed from the Domain Name, the text of which was and is as follows:

"Hello Opera fans of Le nozze di Figaro! After some surprising hiccups the long awaited blog site is finally here. I will try to post as much as possible and keep everyone updated with the latest!

First things first, the very first original original Figaro was a gentleman named Francesco Benucci, who sang many of Mozart's characters in his long career. Benucci rose to fame for his song "Non piu andrai, farfallone amoroso," and was known for his strong, deep powerful voice that impressed Mozart.

For those of you who are in town in NY for the holiday season, and as some of you know the Metropolitan Opera is in session with Otello, Tannhauser, and Tosca!"

It displays Google +, Twitter and Facebook counters and an invitation to add comments.

This page is still visible as at the date of this decision and all of these counters remain at zero and no comment appears to have been added.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that its trade mark is well-known throughout the world. In support of that contention it provides a copy of Google search results for the term "le figaro" on Google France. These results all appear to relate to the Complainant, with the first result being a link to the Complainant's website and the second and third results linking to French and English entries in Wikipedia about the Complainant's newspaper.

The Complainant further contends that the Domain Name is identical to its LE FIGARO mark. The "news" top level domain element of the Domain Name is said to increases the likelihood of confusion existing between the Complainant's trade and the Domain Name because the trade mark is said to cover newspapers.

The Complainant claims that the use of its trade mark in the Domain Name was not authorised by the Complainant and that as the Domain Name has been parked since registration this is sufficient to demonstrate a prima facie case of lack of rights or legitimate interests.

The Complainant also maintains that the given the distinctiveness and reputation of the Complainant's mark and the fact that this mark was registered in the Trademark Clearing House, the Respondent must have registered the Domain Name with full knowledge of the Complainant's intellectual property rights. It contends that such registration and passive holding thereafter constitutes registration and use in bad faith.

RESPONDENT:

The Respondent contends that the incorporation documents provided by the Complainant show that it did not come into existence until 1954. It therefore contends that the Complainant claim that it is "a newspaper of French press founded in 1826," is false. The Respondent also appears to be making some sort of claim that since the Complainant's foundation date pre-dates the creation of the French Fifth Republic in 1958, its legitimacy, existence or ownership of rights is somehow called into question.

The Respondent claims that "Le Figaro" is a "generic dictionary word and well known historically worldwide". So far as the claim that this is a "generic dictionary word" is concerned, the allegation appears to be that "le figaro" means "the barber", although no evidence is provided in this respect. So far as its historical connotations are concerned, the Respondent maintains that "Le Figaro is a well known character" in Mozart's opera "Le nozze di Figaro". He claims that "millions of places, streets, people, and businesses" have been named after the opera. In this respect the Respondent annexes a screenshot of a Google search in respect of the term "figaro" and the disambiguation page from Google in relation to the term "Figaro".

The Respondent claims to be a social blogger based in New York. He asserts that the Domain Name has been registered for a personal blog for art and theatre enthusiasts, especially for opera fans of "Le nozze di Figaro" and performance news. In this respect he provides a screenshot for a blog entry dated 14 October 2015. The screenshot would appear to have been taken on 14 October 2015 and records the blog entry to have been posted only 3 minutes earlier.

The Respondent seeks to belittle the fame of the Complainant's newspaper and mark contending that it is "a very small time newspaper" that is not even in the top 20 global news papers by circulation. He claims that the newspaper has only 408,361 circulated readers. This is compared unfavourably with the Instagram account of Kim Kardashian, which is said to have some 20 Million registered readers.

The Respondent claims that the "news" TLD in the Domain Name is not the same as "newspapers". There is also a section in the response in which the Respondent claims that the Complainant is attempting to deceive the Panel and is assuming that the Panel "does not know about Search Engine Optimization (SEO) strategies". It is not entirely clear what the Respondent is contending in this respect, but this may well amount to a claim that the Google search results relied upon by the Complainant do not demonstrate fame on the part of the Complainant and have been somehow engineered by the Complainant using SEO techniques.

The Respondent further maintains that he had no knowledge of the Complainant and its rights when the Domain Name was registered and only became aware of these on the filing of these proceedings.

The Respondent also contends that the Complainant is in this case attempting to engage in reverse domain name hijacking. In this respect he refers to the decision in favour of the Complainant in the SOCIETE DU FIGARO v. Michael Ehrhardt / Mike Hard WIPO Case no D2015-0094 (<lefigaro.paris> and <le-figaro.paris>). The factual basis for this allegation appears to be that although the Complainant succeeded in those proceedings over 7 months ago, it has done nothing with the Domain Name since that date.

RIGHTS

The Complainant clearly owns trade mark rights in the term "Le Figaro". It is recorded as the owner of the relevant marks at the relevant registries. The suggestion that by reason of the fact that it was incorporated prior to the Fifth Republic and therefore its existence or its ownership of these rights is called into question is fanciful, and unsupported by any serious argument or evidence

The Domain Name also clearly comprises the term "Le Figaro" with the space absent combined with the "news" TLD. The Complainant contends that as a consequence the Domain Name is identical to its trade mark. The Panel is not convinced that this is technically correct for the reasons it set out in some detail Philip Morris USA Inc. v. Marlboro Beverages / Vivek Singh WIPO Case No. D2014-1398. However, practically it does not matter, as the mark and the Domain Name are undoubtedly "confusingly similar", as those words are understood under the Policy. Although this is not necessary to establish confusing similarity in this case, the Panel also accepts that the fact that the Complainant's marks are registered, inter alia, for newspapers, and the Domain Name incorporates the "news" TLD enhances the similarity in this case. This involves no misunderstanding of the meaning of the words “news” and “newspapers” (as the Respondent appear to claims). It involves recognition of the simple fact that newspapers report the news.

The Complainant has, therefore, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar

to a trade mark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

There is a fundamental dispute of fact between the parties in this case. The Respondent contends that he registered and has started to use the Domain Name to take advantage of the historical associations of the term "Le Figaro" with Mozart's opera "Le nozze di Figaro" or “The Marriage of Figaro" and with the intention of using it for a personal blog for arts, theatre and opera enthusiasts. The Complainant contends that instead it was registered to take advantage of the reputation of the Complainant's mark.

Paragraph 4(c)(iv) of the UDRP identifies the following as one of a number of circumstances that shows rights or legitimate interests in a Domain Name:

"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;"

Strictly paragraph 4(c)(iv) of the Policy does not apply in this case as the Respondent did not use the Domain Name and has not demonstrated any preparations to use the Domain Name before notice of this dispute. The single page blog displayed from the Domain Name postdates the commencement of these proceedings by several weeks.

Nevertheless, the Panel does not find against the Respondent on this element of the Policy on this basis. For the reasons set out under the heading of bad faith below, the Panel has reached the conclusion that the Respondent's claims here are not true and the Domain Name was not registered and has not been held for the purpose claimed or with any reference to Mozart in mind. Instead, it finds that the Domain Name was registered to take advantage of the associations of the term "Le Figaro" with the Complainant's mark and newspaper. This does not provide a right or legitimate interest under the Policy

The Complainant has, therefore to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complaint in this case could have been more carefully prepared. There are numerous claims in the Complaint that "Le Figaro" newspaper is world famous, but apart from a Google search page there is very little evidence before the Panel to substantiate that claim. Nevertheless, the Google search page that is provided not only displays a link to the Complainant's website, but two Wikipedia pages describing the Complainant's newspaper. Further, and notwithstanding the obvious dangers in a panel relying upon its personal knowledge in relation to matters of fact in dispute between parties, this Panel believes that it is legitimate to take judicial notice of the fact that "Le Figaro" is a well known newspaper in France and has a reputation that to at least some degree extends beyond that country.

However, regardless of the exact extent of the fame of the Complainant's newspaper and mark outside of France, the Respondent's claims in this case come across as highly contrived and implausible and are not supported by the evidence produced by the Respondent.

In particular, the Respondent claims that “Le Figaro” is a well known character in the opera “The Marriage of Figaro” and at times appears to assert that “Le Figaro” is the name of the opera itself. The Panel accepts that “Figaro” alone is the name of a character in that opera. However, “le” is merely the definite article in Italian. Accordingly, “The Figaro” makes little sense as a name for either that character or the opera in which he appears.

Further, the Respondent claims “that millions of places, streets, people, and businesses have been named after the opera”. In this respect the Respondent provides evidence that the name “Figaro” alone has been adopted as a name by a couple of other businesses in New York. The Panel suspects that this claim, in common with other assertions in the Response, is somewhat exaggerated.

However, significantly no evidence is provided that supports the contention that any business other than the Complainant uses the name “Le Figaro”. If the Respondent’s claim that names that refer to the opera are common is true to at least some degree, then the Respondent’s failure to demonstrate that any person other than the Complainant has adopted the name “Le Figaro” is extremely revealing.

Next there is the form of the webpage that has recently appeared from the Domain Name. The Respondent appears to contend that no adverse inference can be drawn from this page’s first appearance after proceedings were commenced given that the Complainant filed these proceedings only 14 days after the domain name was registered. If the website that recently appeared had been a complex one and/or there were evidence of extensive activity on that site, this might have been a persuasive contention. However, there is merely a single simple post the text of which is set out in the Factual Background section of this decision and which has not subsequently been supplemented or updated since the date it first appeared. Further, the screenshot of that site that was appended to the Response was taken a mere 3 minutes after the post was made. In short, this looks more like material that has been manufactured after proceedings have been commenced in order to substantiate the Respondent’s claims in these proceedings, than real evidence of the Respondent’s actual intent at the time the Domain Name was registered.

A complainant must prove its case in proceedings on the balance of probabilities. When all the material before the Panel is considered in the round, the Panel has reached the conclusion that regardless of the Respondent’s denials, the Respondent was aware of the Complainant’s business and mark when the Domain Name was registered. It also concludes that it is more plausible that the Domain Name was registered and is being held in order to take some form of unfair advantage of its actual and potential associations with the Complainant, than for an opera related blog. This is sufficient to justify a finding of bad faith registration and use; see, for example, Match.com, LP v. Bill Zag and NWLAWS.ORG, WIPO Case No. D2004-0230.

Finally, and for completeness, the Panel notes the Complainant’s contention that its mark was registered in the Trademark Clearinghouse (the “TMCH”). Although this is not disputed, there is no attempt to explain why the fact that the mark was registered in the TMCH is of significance in these proceedings. The Panel suspects that what the Complainant may be trying to argue here is that the Domain Name was registered during the .news claims notification period (or has opted in to ongoing notifications service) and since the mark was registered in the TMCH, the Respondent is likely to have received notice of the existence of the mark as part of the Domain Name registration process. If this is correct, this would directly contradict the Respondent’s claims that it was not aware of the Complainant or its rights until these proceedings were commenced.

Unfortunately, none of this is clearly argued or properly substantiated in the Complaint. In the circumstances, the Panel has not taken this into account in coming to its decision in this case. Luckily for the Complainant, this has not on this occasion impacted upon the outcome of these proceedings.

The Complainant has, therefore, satisfied the requirements of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

Since the Complainant has succeeded in these proceedings there is no need to address the Respondent’s allegations of Reverse Domain Name Hijacking. However, the Panel records the fact that the Respondent’s contentions here appear to be based upon the assumption that if a complainant is successful in proceedings under the Policy and the domain name is transferred into the name of the complainant, the complainant is under an obligation to use that domain name. That assumption is misconceived. The circumstances in which a finding of Reverse Domain Name Hijacking are conveniently summarised in section 4.17 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition.

PRINCIPAL REASONS FOR THE DECISION

The Complainant demonstrated that it has registered trade mark rights in a number of jurisdictions for marks that incorporate or comprise the term “Le Figaro”. The Panel held that the Domain Name comprising that term alone together with the “.news” TLD was confusingly similar to those marks.

The Panel held as a matter of fact that the Respondent's claims that the Domain Name was registered for the purpose of a personal blog for arts, theatre and opera enthusiasts the arts were contrived and implausible and were not supported by the evidence produced by the Respondent. Although, "Figaro" was undoubtedly a well known character in the opera "The Marriage of Figaro", no evidence was produced evidence to the effect that "Le Figaro" was used or was a sensible name to adopt by any business or entity other than the Complainant. Further, the blog page relied upon by the Respondent post dated the complaint and took such a form that it appeared to be an after the event attempt to manufacture evidence in support of the Respondent's contentions in these proceedings. Given this, the Panel held on the balance of probabilities that it was more likely that the Domain Name had been registered and was being held to take some form of unfair advantage of its actual and potential associations with the Complainant's business and marks.

In the circumstances, the Panel held that the Respondent had no right or legitimate interests in the Domain Name and the Domain Name had been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **LEFIGARO.NEWS**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2015-11-09

Publish the Decision