Decision for dispute CAC-UDRP-102237

Case number	CAC-UDRP-102237
Time of filing	2018-11-28 09:53:28
Domain names	eutelsat-fr.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	EUTELSAT S.A.

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	kesk

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns several registered trademarks, including:

- International Registration for EUTELSAT No 479499, registered on June 20, 1983 in classes 7, 9, 12, 16, 35, 38 and 41, and renewed;

- International Registration for EUTELSAT No 777505, registered on December 31, 2001 in classes 9, 16, 35, 37 and 38, and renewed.

The Complainant is also the holder of various domain names containing the Trademarks, such as <eutelsat.com>, registered on October 29, 1996.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a French satellite operator and supplier of fixed satellite services.

The Complainant is one of the leading operators in the commercial satellite business. It launched its first satellite in 1983 and has a fleet of 38 satellites serving broadcasters, video service providers, telecom operators, ISPs and government agencies operating across Europe, Africa, Asia and the Americas. Its satellites are used for video broadcasting, satellite newsgathering, broadband services and data connectivity.

The Respondent is domiciled in the United Sates, it registered the disputed domain name on November 8, 2018. The disputed domain name points to an inactive page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Identical or confusing similarity

The Complainant contends that the disputed domain name is identical to the trademark EUTELSAT. Indeed, the disputed domain name includes in its entirety the Complainant's trademark with the only adjunction of "FR" to designate France, where the Complainant has its headquarters.

Lack of rights or legitimate interests.

The Complainant asserts that it's required to make a prima facie case that the Respondent lacks rights or legitimate interests.

According to the information available on the Whois, the Registrant is called KESK, which is different from the disputed domain name. The disputed domain name is inactive and the Respondent did not make any use of it since its registration. It confirms that it has no demonstrable plan to use the disputed domain name.

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use the trademark EUTELSAT. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent registered the disputed domain name in order to create a likelihood of confusion with the EUTELSAT trademarks.

Bad faith

The Complainant contends that adding FR to the EUTELSAT trademark aims at suggesting that this domain names is the official website dedicated to France.

The term "EUTELSAT" does not have any meaning, except in relation with the Complainant. All results to a search on 'EUTELSAT" on a search engine are related to the Complainant and to its EUTELSAT trademarks.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

Furthermore, the disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name.

The Complainant relies on the FORUM Case No. 1608735, VideoLink, Inc. v. Xantech Corporation ("Failure to actively use a domain name is evidence of bad faith registration and use pursuant to Policy ¶ 4(a)(iii).").

Consequently, the Complainant contends that the Respondent has registered the disputed domain name and is using it in bad faith.

The Complainant requests the Panel appointed in this administrative proceeding that the disputed domain name be transferred to the Complainant.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

Paragraph 4(a)(i) of the Policy requires the Complainants to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights.

The Complainant has submitted evidence of its registered EUTELSAT trademark rights in other countries than France. The EUTELSAT trademark is a coined trademark, which is well-known for satellites.

The disputed domain name incorporates entirely the Complainant’s EUTELSAT trademarks.

The adjunction of “FR” suggests that the disputed domain name is dedicated to the official French website of the Complainant.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's EUTELSAT trademarks.

The condition of paragraph 4(a)(i) of the Policy has therefore been satisfied.

NO RIGHTS OR LEGITIMATE INTERESTS

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

Pursuant to paragraph 4(c) of the Policy, a Respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent’s 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is 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 Respondent did not respond to the Complaint. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain name.

The Respondent is not known under the disputed domain name and has not been licensed or authorized to use the well-known EUTELSAT trademark or to register the disputed domain name.

The disputed domain name has not resolved to any website since its registration.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the

Respondent's lack of rights or legitimate interests in relation to the disputed domain name, which the Respondent has not rebutted. The condition of paragraph 4(a)(ii) of the Policy has therefore been satisfied.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of a domain name. It provides that:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or the respondent has 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your website 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 the respondent's website or location or of a product or service on the respondent's website or location."

Given the well-known character of the EUTELSAT trademarks, which is a coined trademark, the Panel finds that the Respondent could not ignore the Complainant's rights in the EUTELSAT trademark when it registered the disputed domain name. In this regard, the entire reproduction of the Complainant's EUTELSAT trademark with the only adjunction of "FR" to designate France, where the Complainant has its headquarters, proves that the Respondent targeted the Complainant when it registered the disputed domain name.

The Panel finds that the disputed domain name was registered in bad faith with the Complainant in mind, to disrupt the Complainant's activities, by creating a likelihood of confusion with the Complainant's EUTELSAT trademark.

Concerning bad faith use, the Panel first reminds that the Complainant has the onus of proof.

It merely asserts that the disputed domain name has never been used and relies on a FORUM decision 1608735, which is commented as deciding that "failure to actively use a domain name is evidence of bad faith registration and use pursuant to Policy par. 4 (a)(iii)".

This decision also relies on the offer to sell the disputed domain name, since it says: "Respondent has offered to sell the disputed domain name in excess of out-of-pocket expenses. Respondent uses the disputed domain to resolve to a blank or inactive page. Failure to actively use a domain name is evidence of bad faith registration and use pursuant to paragraph 4(a)(iii) of the Policy.

The consensus view amongst WIPO panelists is that "the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trade mark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the

respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trade mark, no response to the complaint having been filed, and the registrant's concealment of its identity".

These conditions have been first defined in the Telstra Corporation Limited v. Nuclear Marshmallows
WIPO decision D2000-0003.

In this case, there is no evidence that the Whois data are false or that they were concealed.

The three prior decisions cited concerning the EUTELSAT trademarks all concerned different situations where bad faith use could be proved on the basis of Respondent's declaration or use of the disputed domain name to create fraudulent e-mail addresses.

The Panel has to take into consideration all the circumstances of the case to decide.

The complaint is poorly drafted and the Complainant merely asserts that an inactive domain name evidences bad faith use.

The concept of "passive holding" of a domain name requires to prove cumulative circumstances found to be indicative of bad faith.

For the above reasons, the Panel considers that the Complainant failed to prove the bad faith use of the disputed domain name.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name is confusingly similar to the Complainant's EUTELSAT trademarks.

The Respondent did not respond to the Complaint. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain name.

The Respondent is not known under the disputed domain name and has not been licensed or authorized to use the well-known EUTELSAT trademark or to register the disputed domain name.

The disputed domain name has not resolved to any website since its registration.

The Complainant has established a prima facie case of the Respondent's lack of rights or legitimate interests.

Given the well-known character of the EUTELSAT trademarks, which is a coined trademark, the Panel finds that the Respondent could not ignore the Complainant's rights in the EUTELSAT trademark when it registered the disputed domain name. In this regard, the entire reproduction of the Complainant's EUTELSAT trademark with the only adjunction of "FR" to designate France, where the Complainant has its headquarters, proves that the Respondent targeted the Complainant when it registered the disputed domain name, what constitutes bad faith registration.

Concerning bad faith use, the Panel first reminds that the Complainant has the onus of proof.

The complaint is poorly drafted and the Complainant merely asserts that an inactive domain name evidences bad faith use.

The concept of "passive holding" of a domain name requires to prove cumulative circumstances found to be indicative of

bad faith.

For the above reasons, the Panel considers that the Complainant failed to prove the bad faith use of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **EUTELSAT-FR.COM**: Remaining with the Respondent

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2019-01-04

Publish the Decision