Decision for dispute CAC-UDRP-102586

Case number	CAC-UDRP-102586
Time of filing	2019-08-20 13:42:49
Domain names	lefigarofr.vip, lefigarofronline.com, lefigaro.site

Case administrator

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

Complainant

Organization	SOCIETE DU FIGARO

Complainant representative

Organization	GODIN ASSOCIES

Respondent

Organization	DMR Wahyu KARUNA

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain names.

The Complainant has brought three separate administrative proceedings related to the disputed domain names before the CAC. As soon as the Registrar revealed that the disputed domain names were registered in the name of the same Respondent, the Complainant requested the consolidation of the three proceedings and the CAC agreed to such consolidation.

See in details under Procedural Factors.

IDENTIFICATION OF RIGHTS

TRADEMARKS

The Complainant has shown to be owner of several trademarks containing the words LE FIGARO / FIGARO alone or associated with other terms registered worldwide. In particular, the Complainant holds the following trademarks:

- International registration LE FIGARO n°319381, filed on 26 August 1966 in renewal of the trademark number 138021 filed on 2 August 1948, in class 16, designated countries: Uzbekistan, Algeria, Armenia, Austria, Belarus, Benelux, Bosnia

Herzegovina, Croatia, Czech Republic, Egypt, Germany, Hungary, Italy, Kazakhstan, Kyrgyzstan, Latvia, Liechtenstein, Moldova, Monaco, Morocco, North Macedonia, Portugal, Romania, Russian Federation, San Marino, Serbia, Slovakia, Slovenia, Spain, Switzerland, Tajikistan, Ukraine, Vietnam;

- International registration LE FIGARO MAGAZINE n°442333, filed on 8 January 1979, in class 16, designated countries: Algeria, Austria, Belarus, Benelux, Bosnia Herzegovina, Czech Republic, Egypt, Germany, Hungary, Italy, Liechtenstein, Monaco, Morocco, Romania, Russian Federation, San Marino, Serbia, Slovakia, Spain, Switzerland, Vietnam;

- French trademark LE FIGARO n°1447624, filed on 11 May 1987 in renewal of a trademark filed on 16 May 1977, in classes 16, 35, 38, 39 and 41;

- International registration MADAME FIGARO n°555522, filed on 11 May 1990 in classes 16, 35, 38 and 41, designated countries: Algeria, Armenia, Austria, Belarus, Benelux, Bulgaria, China, Cuba, Czech Republic, Dem. People's Rep. of Korea, Egypt, Germany, Hungary, Italy, Kyrgyzstan, Latvia, Liechtenstein, Moldova, Monaco, Mongolia, Morocco, Portugal, Romania, Russian Federation, San Marino, Serbia, Slovakia, Spain, Sudan, Switzerland, Tajikistan, Ukraine, Vietnam;

- International registration LE FIGARO n°655549, filed on 29 March 1996, in classes 3, 8, 9, 12, 20, 21, 24, 28, 30, 34, 35, 38, 39, 41 and 42, designated countries: Austria, Belarus, Benelux, Germany, Italy, Liechtenstein, Moldova, Monaco, Poland, Portugal, Russian Federation, San Marino, Spain, Switzerland, Ukraine, Vietnam;

- French trademark LEFIGARO.FR n°(00)3062563 filed on 6 November 2000 in classes 9, 16, 35, 38, 41 and 42;

- International registration FIGARO n°1272039, filed on 19 January 2015 in classes 3, 9, 14, 16, 18, 19, 20, 21, 24, 25, 28, 35, 39, 41 and 43, designated countries: Greece, Japan, Mexico, Philippines, Republic of Korea, Singapore, United Kingdom, China, Germany, Italy, Monaco, Portugal, Russian Federation, Spain, Switzerland, Vietnam.

COMPANY NAME / TRADE NAME

The Complainant has carried on business and provided its services under the company / trade name SOCIETE DU FIGARO.

DOMAIN NAMES

The Complainant is owner of numerous domain names, among which <lefigaro.fr> registered on 14 August 1996, used as the main website of the Complainant.

FACTUAL BACKGROUND

The Complainant is the publisher of France's leading daily newspaper LE FIGARO.

LE FIGARO was founded in 1826 in Paris and it is the most distributed paper among daily titles with 309 492 copies sold each month in average in 2018.

The main edition of LE FIGARO has been developed into:

- the online edition available at <lefigaro.fr>;

- the supplement LE FIGARO MAGAZINE published weekly;

- the supplement MADAME FIGARO, dedicated to women, aka LE FIGARO MADAME, published weekly;

- several additional editions, in particular a business edition, available in paper and online versions.

The Complainant is owner of a large intellectual property rights portfolio (IPrs), comprising trademarks registered in several jurisdictions, company / trade name and domain names, all containing the words LE FIGARO / FIGARO alone or associated with other terms. Some of those IPrs are identified above and will be hereinafter referred to as FIGARO Trademark.

The Complainant has demonstrated to have well-established rights to the FIGARO Trademark which has become distinctive and well-known in association with newspaper and publication services at national (in France) and international level.

The disputed domain names were created by an Indonesian corporation with privacy service on 30 March 2019, hence well after the registration of the FIGARO Trademark.

The disputed domain names are inactive, except for <LEFIGARO.SITE> which resolved to a parking page in relation with news and direct reference to the Complainant at the moment of the filing of the Complaint.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT

On the first UDRP element the Complainant contends that the disputed domain names are highly similar to the Complainant’s prior trademarks, since they all reproduce the distinctive part of the FIGARO Trademark (i.e. the words LE FIGARO / FIGARO) in its entirety. The addition of the letters "FR" (which is a clear reference to France) in two cases, the generic and descriptive term "ONLINE" in one case and the gTLDs ".VIP", ".COM", ".SITE" (which are technical requirements of the registration) are irrelevant in the comparison of the disputed domain names and Complainant's marks.

On the second UDRP element the Complainant argues that the Respondent has not been licensed, contracted or otherwise permitted by the Complainant in any way to use the prior FIGARO Trademark or to register any domain name incorporating the FIGARO Trademark, nor has the Complainant acquiesced in any way to such use or registration of the FIGARO Trademark by the Respondent. Considering that two of the three disputed domain names are inactive and the third one resolves to a parking page in relation to news with direct reference to the Complainant, there is no fair or non-commercial use of the disputed domain names. Finally, the Complainant asserts that the multiple registration of the Respondent shows a pattern from the Respondent, who could not ignore the prior rights of the Complainant.

On the third UDRP element the Complainant affirms that the choice of the terms “LE FIGARO”, which are original, purely arbitrary and well-known in France and worldwide, could not have been accidentally made by the Respondent notably since the Complainant's prior rights significantly predate the creation of the disputed domain names. Hence, by registering the disputed domain names, the Respondent intended to take advantage of the Internet traffic related to the Complainant's activities. The content of one of the three disputed domain names (parking page with clear reference to the Complainant) confirms the constructive knowledge of the Complainant's mark and activities on behalf of the Respondent. On the other hand, the non-use of the other two disputed domain names does not prevent the finding of bad faith under the doctrine of passive holding.

Consequently, the Complainant requested the transfer of the disputed domain names.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

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

PROCEDURAL FACTORS

The Complainant initiated three separate administrative proceedings related to the disputed domain names. As soon as the Registrar revealed that the disputed domain names were registered in the name of the same Respondent, the Complainant requested the consolidation of the proceedings. The CAC, in accordance with the Complainant's request and given that the Respondent was duly informed about all the three proceedings by e-mail and written notice and the Response period elapsed in all three proceedings, consolidated such proceedings and appointed this Panel.

Paragraph 10(e) of the UDRP Rules grants the panel the power to consolidate multiple domain name disputes. At the same time, Paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

Any final determination on consolidation is to be made by the appointed panel.

Considering the above-mentioned reasons (domain names were registered in the name of the same Respondent, the Respondent was duly informed about the proceedings initiated against him), it would be equitable and procedurally efficient to permit the consolidation in the present proceeding and, therefore, this Panel accepts the Complainant's request and consolidates the proceedings No. 102642 and 102643 with the case No. 102586.

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

REQUIREMENTS OF PARAGRAPH 4(A) OF THE POLICY

According to Paragraph 4(a) of the Policy the Complainant shall prove each of the following three elements to obtain the transfer of the domain names:

1. the disputed domain names registered by the Respondent are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

2. the Respondent has no rights or legitimate interests in respect of the disputed domain names; and

3. the disputed domain names have been registered and are being used in bad faith.

1. THE COMPLAINANT’S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S MARK

The Complainant has proved to hold rights in the FIGARO Trademark.

All disputed domain names incorporate the entirety of the distinctive part of the Complainant's marks, i.e. the words LE FIGARO / FIGARO.

The differences are merely as follows:

<LEFIGAROFR.VIP>: the addition of the letters "FR", which is a clear reference to France, and the top-level domain name ".VIP"

<LEFIGAROFRONLINE.COM>: the addition of the letter "FR", which is a clear reference to France, the generic term "ONLINE" and the top-level domain name ".COM"

<LEFIGARO.SITE>: the addition of the top-level domain name ".SITE".

In assessing identity or confusing similarity the UDRP panels agree that, in cases where the relevant trademark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see paragraph 1.7 WIPO Overview 3.0).

It is also well-established UDRP case law that panels usually ignore the top-level domain for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain names are confusingly similar to the Complainant's mark.

2. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAMES

It is a consensus view of UDRP panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see paragraph 2.1 of the WIPO Overview 3.0: "where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element").

The disputed domain names were registered with privacy service on the same day on 30 March 2019 by DMR, an Indonesian corporation. There is no evidence that the Respondent has been commonly known by the disputed domain names.

Furthermore, the Respondent has not been licensed, contracted or otherwise permitted by the Complainant in any way to use the prior FIGARO Trademark or to register any domain name incorporating the FIGARO Trademark, nor has the Complainant acquiesced in any way to such use or registration of the FIGARO Trademark by the Respondent.

The disputed domain names are inactive, except for <LEFIGARO.SITE> which resolved to a parking page with direct reference to the Complainant at the moment of the filing of the Complaint. Such use of the domain name is clearly not a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's mark.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain names.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain names.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES

The Respondent used a privacy or proxy registration service when registering the disputed domain names. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used, including whether the Respondent is operating a commercial and trademark-abusive website, may however impact the Panel's assessment of bad faith (see paragraph 3.6 of the WIPO Overview 3.0).

The disputed domain names are to be considered confusingly similar to Complainant's mark, since they wholly incorporate the distinctive part of the well-known FIGARO Trademark, i.e. the words LE FIGARO / FIGARO. The mere addition of letters ("FR", which refers to France, the country in which the Complainant has been established) and/or generic and descriptive term ("ONLINE") and TLDs (".VIP", ".COM", ".SITE", which are technical requirements of the registration) are not sufficient elements to escape the finding of confusing similarity between the disputed domain names and the Complainant's mark.

Given the distinctiveness and reputation of the Complainant's prior mark in France and internationally, it is inconceivable that the Respondent could have registered the disputed domain names for a mere chance without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

Panels in other UDRP disputes initiated by the Complainant found that the Complainant did have a substantial reputation in and to the FIGARO Trademark in association with newspaper and publication services (inter alia see WIPO Case No. D2014-2159 <figaro.club>; WIPO Case No. D2015-0094 <le-figaro.paris> and <lefigaro.paris>; WIPO Case No. D2000-1389 <figaromagazine.com>).

The disputed domain names are not actively used, except for <LEFIGARO.SITE> which resolved (at the moment of filing of the Complaint) to a parking page related to news with direct reference to the Complainant. Such latter use can not be considered as a good faith use. The direct reference to the Complainant is indeed the clear evidence that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 his website or location or of a product or service on his website or location (paragraph 4(b)(iv) of the Policy).

With reference to the non-use of domain names, UDRP panels consider the following factors when applying the passive holding doctrine:

- the degree of distinctiveness and/or reputation of the Complainant's trademark;

- the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use;

- the Respondent's concealing its identity (privacy or proxy service) or use of false contact details;

- the implausibility of any good faith use to which the disputed domain name may be put.

Taken into account all circumstances of this case, the Panel finds that it is implausible that there is any legitimate purpose in the registration and use of the disputed domain names by the Respondent.

The Panel, thus, finds that the Complainant has discharged the burden of proof to show that the disputed domain names have been registered and are being used in bad faith (paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LEFIGAROFR.VIP**: Transferred
2. **LEFIGAROFRONLINE.COM**: Transferred
3. **LEFIGARO.SITE**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2019-10-01

Publish the Decision