Decision for dispute CAC-UDRP-102818

Case number	CAC-UDRP-102818
Time of filing	2019-12-12 10:17:52
Domain names	pantheon-assas.university

Case administrator

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

Complainant

Organization	Université Panthéon-Assas Paris 2

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	ABIS

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks containing the terms “PANTHEON ASSAS”:

- The French trademark PANTHEON-ASSAS Reg. No. 3063595 registered on November 9, 2000;
- The French trademark PANTHEON-ASSAS Reg. No. 3753971 registered on July 16, 2010.

FACTUAL BACKGROUND

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

The Complainant is considered as France’s first law university, dedicated to upholding the tradition from which it arose, preserving, yet ever-striving to raise its level of excellence. Its extensive partnerships not only with major French, European, and International agencies, but also with major financial and industrial firms, ensure anchorage in the professional world and guarantee the veritable polyvalence.

The Complainant is the owner of several trademarks containing the terms “PANTHEON ASSAS”:

- The French trademark PANTHEON-ASSAS Reg. No. 3063595 registered on November 9, 2000;
- The French trademark PANTHEON-ASSAS Reg. No. 3753971 registered on July 16, 2010.

The Complainant also owns a large portfolio of domain names “PANTHEON-ASSAS” such as the domain names <pantheon-assas.com> and <pantheon-assas.fr>, registered since February 25, 2010.

The disputed domain name <pantheon-assas.university> was registered on August 31, 2018 and points to a Registrar parking page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

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).

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).

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that a complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
(2) respondent has no rights or legitimate interests in respect of the domain name; and
(3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (Forum July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Rights

The Complainant contends that it has rights in the PANTHEON-ASSAS (e.g. Reg. No. 3063595 registered on November 9, 2000; Reg. No. 3753971 registered on July 16, 2010) through its registration of the mark with the French trademark authorities. Registration of a mark with national trademark authorities sufficiently establishes the required rights in the mark for purposes of the Policy. As such, the Panel finds that the Complainant has established its rights in the mark 'PANTHEON-ASSAS.'

The Complainant further contends that the disputed domain name is identical to the Complainant's trademark PANTHEON-ASSAS on the grounds that it incorporates the Complainant's mark in its entirety without any addition or deletion; and TLDs may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing disputed domain names and trademarks.

The Panel agrees with the Complainant, and thus it finds that the disputed domain name is confusingly similar to the Complainant's trademark PANTHEON-ASSAS.

No rights or legitimate interests

The Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (Forum November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent is not identified in the WHOIS database as the disputed domain name, and thus it is not commonly known by the disputed domain name; the Respondent is not related in any way with the Complainant; the Complainant does not carry out any activity for, nor has any business with the Respondent; neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark; the disputed domain name points to a Registrar parking page; the Respondent did not make any use of disputed domain name since its registration; and the Respondent has no demonstrable plan to use the disputed domain name.

The WHOIS information of record notes 'redacted for privacy' as the registrant and no information suggests that the Complainant has authorized the Respondent to use the PANTHEON-ASSAS mark in any way. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

The Complainant contends that the disputed domain name points to a Registrar parking page, and it has not demonstrated any activity in respect of the disputed domain name. Inactive holding of a domain name does not demonstrate rights or legitimate interests in the name per paragraph 4(c)(i) or (iii) of the Policy. See George Weston Bakeries Inc. v. McBroom, FA 933276 (Forum April 25, 2007) (finding that the respondent had no rights or legitimate interests in a domain name under either paragraph 4(c)(i) of the Policy or paragraph 4(c)(iii) of the Policy where it failed to make any active use of the domain name). The Panel therefore finds the Respondent does not have rights or legitimate interests in the domain name per paragraph 4 (c)(i) or (iii) of the Policy.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or

legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or 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 the 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 its website or other online 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.

The Complainant contends that the disputed domain name was registered many years after the Complainant had established a strong reputation and goodwill in its mark; by choosing the ".UNIVERSITY" new gTLD for registering the disputed domain name, the Respondent likely intended to create confusion or a sense of association with the Complainant, as the Complainant is considered as France's first law university; and it is unconceivable that the Respondent chose to register the disputed domain name without the Complainant and its trademark in mind, which is an evidence of bad faith.

While constructive knowledge is insufficient to support a finding of bad faith, actual knowledge can be used to demonstrate a respondent's bad faith registration and use. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum February 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding bad faith per paragraph 4(a)(iii) of the Policy, the Panel here finds actual knowledge through the name used for the domain and the use made of it."). The Panel infers, due to the notoriety of the Complainant's mark that the Respondent registered the disputed domain name with actual knowledge of the Complainant's rights in the PANTHEON-ASSAS mark and finds that it registered the disputed domain name in bad faith per paragraph 4(a)(iii) of the Policy.

Next, the Complainant contends that the disputed domain name points to a Registrar parking page; the Respondent has not demonstrated any activity in respect of the disputed domain name; and the Respondent's holding of the disputed domain name prevents the Complainant from reflecting its mark in the corresponding domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PANTHEON-ASSAS.UNIVERSITY**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2020-01-13

Publish the Decision