Decision for dispute CAC-UDRP-103036

Case number	CAC-UDRP-103036
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Domain names	fr-canalplus.com

Case administrator

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

Complainant

Organization	GROUPE CANAL +

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Jean Pierre benoit

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant, GROUPE CANAL +, "is the leading French audiovisual media group and a top player in the production of pay-TV and theme channels and the bundling and distribution of pay-TV services. With 16.2 million of subscribers worldwide and a revenue of 5.16 billion euros, the Complainant offers various channels available on all distribution networks and all connected screens".

The Complainant states and provides evidence to support, that it is the owner of a large portfolio of trademarks including the word "CANAL PLUS," such as international trademark CANAL PLUS® n° 509729, registered since March 16, 1987, and duly renewed, international trademark CANAL PLUS® n° 619540, registered since May 5, 1994, and duly renewed.

The Complainant further states that it also owns an important domain name portfolio, including the same distinctive wording "CANAL PLUS" such as <canalplus.com> registered since May 20, 2006, and <canal-plus.com> registered since March 28, 1996.

The disputed domain name <fr-canalplus.com> was registered on January 7, 2020.

FACTUAL BACKGROUND

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

The Complainant draws Panel attention to previous UDRP decisions:

- See WIPO Case No. DTV2010-0014 Canal + France Groupe Canal + SA v. Private Whois Service / Internet.bs Corp <canalplus.tv>;

- See WIPO Case No. D2016-2175 GROUPE CANAL+ v. Marc Martinet <canalplus-stream.com>;

- See WIPO Case No. D2006-1240 Groupe Canal+ Company v. Jinsoo Yoon <canalplus.com> (“The mark and the phonetic “canal plus” phrasing are widely known in Europe and other locations. The Complainant claims rights relating to the mark since the 1980s. It obtained formal registration of the mark in multiple jurisdictions, and used the mark in business operations long before the Respondent registered the domain name.”);

- See WIPO Case No. D2017-0660, Boehringer Ingelheim Pharma GmbH & Co.KG v. Pan Jing (“The Complainant has submitted evidence to show that its trade mark COMBIVENT enjoy a strong online presence and a cross-border reputation. A cursory Internet search would have disclosed the COMBIVENT trade mark and its extensive use by the Complainant. Thus a presumption arises that the Respondent was aware of the Complainant’s COMBIVENT trade mark and related domain names when it registered the disputed domain names, particularly given that the disputed domain names are identical to the Complainant’s mark. Registration of a domain name that incorporates a complainant’s distinctive trade mark suggests opportunistic bad faith.”); and

- See CAC Case No. 102827 JCDECAUX SA v. Handi Hariyono (“There is no present use of the disputed domain name but there are several active MX records connected to the disputed domain name. It is concluded that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address.”).

PARTIES’ CONTENTIONS:

COMPLAINANT:

• The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the disputed domain name <fr-canalplus.com> is confusingly similar to its trademark CANAL PLUS. The trademark is included in its entirety, without any addition or deletion.

The Complainant contends that the addition of the geographically descriptive abbreviation “FR” for "France" is not sufficient to avoid the likelihood of confusion with the Complainant, its trademarks and domain names. Geographic designations or terms descriptive of a complainant’s business operations do not remove a domain name from the realm of confusing similarity.

Moreover, the addition of a generic term and gTLD is insufficient in distinguishing a domain name from a mark under Policy 4(a)(i). Finally, the “use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark.".

• Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and it 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 CANAL PLUS, or apply for registration of the disputed domain name by the Complainant.

According to the Complainant, the disputed domain name redirects to a blank page and appears to be inactive. Therefore, the Complainant contends that the Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. The Complainant concludes that it demonstrates a lack of legitimate interests in respect of the disputed domain name.

• The disputed domain name has been registered and is being used in bad faith

According to the Complainant, the Respondent has registered and is using the disputed domain name in bad faith. The Complainant contends that the disputed domain name <fr-canalplus.com> is confusingly similar to its distinctive trademark CANAL PLUS. Past panels have confirmed a strong reputation and goodwill of the Complainant's marks in the cases listed above.

The Complainant further states that by choosing the country's geographically descriptive abbreviation “FR”, it is unconceivable that the Respondent chose to register the disputed domain name without the Complainant and its trademarks in mind. Consequently, the Respondent could not have ignored the Complainant’s trademarks CANAL PLUS at the moment of the registration of the disputed domain name <fr-canalplus.com>, which cannot be a coincidence.

The disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law.

The Complainant further states that the disputed domain name has been set up with MX records, which suggests that it may be actively used for e-mail purposes. The Complainant concludes that this is also indicative of bad faith registration and use because any e-mail emanating from the disputed domain name could not be used for any good faith purpose.

PARTIES CONTENTIONS

RESPONDENT:

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that 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.

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights

The Complainant has provided evidence and proved to be the owner of international trademark CANAL PLUS. Essentially, the Respondent has appropriated the trademark CANAL PLUS by adding a geographically descriptive abbreviation "FR" for "France" to presumably lead consumers to believe that it is affiliated with the Complainant. Since the Complainant is present in France, the Panel is convinced that the addition of the abbreviation “FR” worsens the likelihood of confusion between the disputed domain name and the Complainant’s trademark CANAL PLUS.

The disputed domain name consists of the same term "CANAL PLUS" preceded by a geographically descriptive abbreviation "FR" for "France." The disputed domain name is confusingly similar to the Complainant's trademarks CANAL PLUS since it fully incorporates the Complainant’s trademark CANAL PLUS despite the addition of the abbreviation “FR” which the Panel finds does not eliminate any confusing similarity. This is especially true where, as here, the trademark is “the dominant portion of the domain name,” LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents “the most prominent part of the disputed domain name[] which will attract consumers’ attention.” Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768., and since the term "CANAL PLUS" is fully distinguishable with respect to the additional component of the domain name, either because it is placed at the beginning of the domain name, which is where consumers mainly focus their attention, or because the additional element of the domain name is deprived of a distinctive character.

Moreover, the addition of a generic term and gTLD is insufficient in distinguishing a domain name from a mark under Policy 4(a)(i). See e.g., Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (Forum Jan. 22, 2016). Also, the “use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark.".

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark CANAL PLUS.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term “CANAL PLUS” as part of its domain name. The Respondent is not in any way connected with the Complainant, nor is it authorized to register the disputed domain name. The disputed domain name redirects to a blank page and appears to be inactive.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or

legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel finds that the disputed domain name <fr-canalplus.com> is confusingly similar to the Complainant's distinctive trademark CANAL PLUS, which is widely known and well-established. Past panels have also confirmed that (please see above).

Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. Since the Complainant is present in France, the addition of the abbreviation “FR” worsens the likelihood of confusion between the disputed domain name and the Complainant’s trademark. The Panel finds that such actions constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy, which provides: "by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site 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 respondent's web site or location or of a product or service on respondent's web site or location."

Also, the disputed domain name redirects to a blank page and appears to be inactive. According to the Panel, the passive holding of the disputed domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant’s well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v Polanski, WIPO Case No. D2000 1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000 0438; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The fact that a complainant’s trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (see section 3.3, WIPO Overview 3.0).

In the present case, the Panel is of the opinion that the Complainant’s CANAL PLUS trademark is distinctive and widely used, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy, that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FR-CANALPLUS.COM**: Transferred

PANELLISTS

Name	**Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION 2020-05-28

Publish the Decision