# Decision for dispute CAC-UDRP-103200

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| Case number | CAC-UDRP-103200 |
| Time of filing | 2020-07-28 09:56:09 |
| Domain names | harcourt-studio.net, studioharcourt.net |

## Case administrator

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

## Complainant

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| Organization | STUDIO HARCOURT |

## Complainant representative

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| Organization | Nameshield (Enora Millocheau) |

## Respondent

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| Organization | ProLight International Ltd |

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on the international trademarks <STUDIO HARCOURT> no°451329 and <HARCOURT> no°451330, both registered on March 24, 1980.

The Complainant also owns several domain names comprising the trademark <STUDIO HARCOURT>, such as the domain name <studio-harcourt.com>, registered since December 2, 2007.

FACTUAL BACKGROUND

The Complainant, STUDIO HARCOURT, claims to be a Parisian photography studio known in particular for its black and-white photographs of movie stars and celebrities. It has immortalized great personalities of the 20th century and continues to do so in the 21st century.

The Complainant asserts that the disputed domain names <harcourt-studio.net> and <studioharcourt.net> have been registered on July 5, 2020 and redirect to a parking page with commercial links related to the Complainant's activities.

The Respondent submits that it wants to keep these two domain names, that it has legitimate rights in relation to such, that

there is no collusion between its company and studio based in Taiwan with STUDIO HARCOURT based in Paris, that STUDIO HARCOURT never had any activity and a registered trademark in Taiwan, that the commercial links put on <harcourt-studio.net> and <studioharcourt.net> would have been put by <WHOIS.COM> and that there would be domain names on sale “(with affordable prices)” HARCOURT.NET, STUDIOHARCOURT.COM, HAROCURT.COM that might present interest for STUDIO HARCOURT.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's contentions are the following:

I. The domain name is
a. Identical
b. Confusingly similar to the protected mark

The disputed domain names <harcourt-studio.net> and <studioharcourt.net> are at least confusingly similar to its earlier international trademark registrations STUDIO HARCOURT and HARCOURT, (i) one - <harcourt-studio.net> - containing its trademark STUDIO HARCOUR in its entirety, the only difference being that the two terms that composed the trademark being reversed, and the addition of a hyphen being insufficient to avoid confusing similarity, previous UDRP panels having found that reversal of elements as well as the addition of a hyphen does not prevent a finding of confusing similarity, and (ii) the second one <studioharcourt.net> is identical to the Complainant’s trademark STUDIO HARCOURT as this international trademark registration is included in its entirety, without any addition or removal.

In both cases, the addition of a TLD, like .NET does not add any distinctiveness to the disputed domain name. It was mentioned that, according to WIPO Overview 3.0, section 1.11 (“The applicable Top Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”).

Therefore, the disputed domain names are confusingly similar to the Complainant’s trademarks STUDIO HARCOURT and HARCOURT.

II. The Respondent does not have any rights or legitimate interest in the domain names

Categories of issues involved:

a. Domain parking

The Complainant contends that the Respondent lacks rights or legitimate interests in the disputed domain names for a number of reasons.

First, the Complainant asserts that the Respondent is not known as the disputed domain names in the Whois database, and has not acquired trademarks mark rights on this terms.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names and he 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.

No licence nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks STUDIO

HARCOURT or HARCOURT, or apply for registration of the disputed domain names by the Complainant.
Furthermore, the Complainant contends that the disputed domain names resolve to a parking page with commercial links related to the Complainant's activities.

Therefore, the Respondent has no rights or legitimate interests to the disputed domain names.

III. The domain names has been registered and is being used in bad faith

Categories of issues involved:

a. Constructive knowledge/prior knowledge of potential rights
b. Domain parking
c. Attracting internet users for commercial gain by creating a likelihood of confusion with the Complainant
d. The Complainant further argues that the disputed domain names have been registered and are used in bad faith.

The Complainant argued that the disputed domain names are at least confusingly similar to the well-known trademarks STUDIO HARCOURT and HARCOURT and that the Respondent has registered the disputed domain names many years after Complainant had established a strong reputation and goodwill in its mark.

The Complainant contends that a Google search on the term "STUDIO HARCOURT" provide several results, all of them being related to the Complainant. Before this registration, the Respondent could have done a simple Google search and would have found the existence of the Complainant's trademark.

There, the Respondent could not have ignored the Complainant's trademarks STUDIO HARCOURT and HARCOURT at the moment of the registration of the disputed domain names.

Furthermore, the disputed domain names resolve to a parking page with commercial links related to the Complainant's activities. The Complainant contends the Respondent has attempt to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith.

Finally, the same Respondent, is involved in an other UDRP case No. 103143 as it is registered as the Registrant of the domain names <harcourt-studio.com> and <photo-harcourt.com> which evidences bad faith.

On these bases, the Complainant asserts that the Respondent has registered and is using the disputed domain names in bad faith.

RESPONDENT:

The Respondent responded in that it wants to keep these two domain names, that it has legitimate rights in relation to such, that there is no collusion between its company and studio based in Taiwan with STUDIO HARCOURT based in Paris, that STUDIO HARCOURT never had any activity and a registered trademark in Taiwan, that the commercial links put on <harcourt-studio.net> and <studioharcourt.net> would have been put by <WHOIS.COM> and that there would be domain names on sale "(with affordable prices)" <HARCOURT.NET>, <STUDIOHARCOURT.COM>, <HAROCURT.COM> that might present interest for STUDIO HARCOURT.

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 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

I. Confusing Similarity

The Panel agrees that in relation to the disputed domain name <harcourt-studio.net>, the trademark STUDIO HARCOURT is comprised in its entirety and that the reversal of the terms that composed the trademark and the addition of a hyphen is insufficient to avoid confusing similarity. With respect to the disputed domain name <studioharcourt.net> the Panel agrees that it is identical to the Complainant's trademark STUDIO HARCOURT as this international trademark registration is included in its entirety, without any addition or removal.

Moreover, the extension ".net" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain names (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".net" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

With respect to the jurisdiction(s) where the trademarks invoked by the Complainant in relation to this complaint are valid, such is/are not considered relevant to panel assessment under the first element, according to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), point 1.1.

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

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 burden of proof 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 Policy.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain names. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademarks, nor of a confusingly similar trademark in the disputed domain names.

Finally, the disputed domain names resolve to parking pages with commercial links related to the Complainant's activities. The response filed by the Respondent did not provide proofs to the contrary. Such use does not amount to a bona fide offering of goods or services, or to a legitimate non-commercial or fair use of the disputed domain names.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks

rights or legitimate interests in the disputed domain names and the Respondent failed to come forward with appropriate allegations or evidence. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

Based on the provided proofs, a Google search on the term “STUDIO HARCOURT” before registration would have provided several results, the majority being related to the Complainant. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant’s activity and trademarks and has intentionally registered the disputed domain names.

Furthermore, the disputed domain names resolve to a parking page with commercial links related to the Complainant’s activities. The response filed by the Respondent did not provide proofs to the contrary. Therefore, the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant’s trademarks for its own commercial gain, which is an evidence of bad faith.

Also, the Respondent was involved in another UDRP case No. 103143 as the Registrant of the domain names <harcourt-studio.com> and <photo-harcourt.com> in relation to which the Panel has decided the transfer of these two domain names to STUDIO HARCOURT, the Complainant in this case, which, in the Panel’s view, is an evidence of bad faith.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain names in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HARCOURT-STUDIO.NET**: Transferred
2. **STUDIOHARCOURT.NET**: Transferred

## PANELLISTS

| Name | **Delia-Mihaela Belciu** |
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DATE OF PANEL DECISION 2020-09-18

Publish the Decision