

Decision for dispute CAC-UDRP-103972

Case number CAC-UDRP-103972

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Domain names studiocanal.space

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization GROUPE CANAL +

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization FZ Media Design

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant, by itself or through its subsidiary STUDIOCANAL, owns several trademarks including the wording "STUDIO CANAL", such as:

- French trademark STUDIO CANAL No. 3015704 registered since 2000-03-20;
- European trademark STUDIO CANAL No. 001866151 registered since 2002-10-30;
- International trademark STUDIOCANAL COLLECTION No. 1030346 registered since 2009-12-11, which covers the United States of America;
- European trademark STUDIOCANAL No. 010093797 registered since 2011-12-02; and
- International trademark STUDIOCANAL No. 1109020 registered since 2011-12-23.

The Complainant also owns multiple domain names consisting of the wording "STUDIOCANAL" such as <studiocanal.com> registered since 2000-03-21.

FACTUAL BACKGROUND

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

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

The Complainant's subsidiary, STUDIOCANAL, is the leading studio in Europe for the production and distribution of movies and TV series with a strong European base as well as considerable international potential. The Complainant operates its distribution to movie theatres, video, digital and TV businesses directly in the three main European markets – France, the United Kingdom and Germany – as well as in Australia and New Zealand. STUDIOCANAL is also present in the United States and China.

The disputed domain name <studiocanal.space> was registered on 2021-05-03 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 that the disputed domain name is identical to 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.

The Complainant contends that the disputed domain name is identical to the Complainant's trademark "STUDIOCANAL", by its inclusion in its entirety.

The Complainant also contends that the addition of the new gTLD suffix ".SPACE" is not sufficient to escape the finding that the disputed domain name is identical to the Complainant's trademark and does not change the overall impression of the designation as being connected to its trademark.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc*, WIPO Case No. D2001-0902; *Dr. Ing. h.c. F. Porsche AG v Vasily Terkin*, WIPO Case No D2003-003-0888.

It is also a well-established principle in the domain name space that specific top-level domains such as ".COM", ".ORG" or ".NET" do not affect the domain name for the purpose of determining whether it is identical or confusingly similar. For example, *WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A*; WIPO Overview 3.0 Section 1.11.1.

The Panel considers that this well-established principle applies equally to new forms of gTLDs like ".SPACE".

Applying the above well-established principle to the present case, the Panel finds as follows:

(a) The addition of the gTLD suffix ".SPACE" does not change the overall impression of the designation of a disputed domain name as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant as the true owner of the trademark, and the domain name associated the Complainant.

(b) The Complainant's trademark "STUDIOCANAL" is a well-known registered trademark that has been used in connection with its business services and offerings for at least a decade. To incorporate the entirety of the Complainant's trademark

into the disputed domain name is, in the Panel's view, identical to or confusingly similar to the Complainant's trademark.

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.

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainant asserts that the Respondent is not identified in the WHOIS database as the disputed domain name.

Where information in the WHOIS database is not similar to the disputed domain name, a respondent is not commonly known by the disputed domain name. For example, Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>.

The Panel accepts this assertion, which is supported by the evidence from the WHOIS database adduced by the Complainant.

In further support of the ground that the Respondent has no rights or legitimate interests in the disputed domain name, the Complainant also contends the following:

- (a) the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- (b) the Respondent is not related in any way with the Complainant;
- (c) the Complainant does not carry out any activity for, nor has any business with the Respondent;
- (d) neither licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark "STUDIOCANAL", or apply for registration of the disputed domain name by the Complainant.

The Respondent has not filed any administrative compliant response to the Amended Complaint.

Accordingly, the Panel accepts these uncontradicted contentions.

Finally, the Complainant adduced evidence that the disputed domain name points to a registrar parking page. The Complainant contends that the Respondent did not make any use of the disputed domain name since its registration.

The Panel is prepared to draw the inference that the Respondent did not make any use of the disputed domain name since its registration, and therefore finds that the Respondent has no demonstrable plan to use the disputed domain name.

Accordingly, the Panel considers that the evidence adduced by the Complainant supports its contention that there is no bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name.

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.

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The evidence shows that the Complainant's trademark "STUDIOCANAL" is a well-known trademark registered in several

countries.

The Complainant also adduced evidence of Google search results for the wording "STUDIOCANAL". While Google search returned about 4,350,000 results, the Panel notes that the first entry refers to the Complainant's website. All the entries on the first web page of the Google search results refer to the Complainant.

The Panel accepts the Complainant's assertion that the Respondent could have done a simple Google search and would have found the existence of the Complainant's trademark or at least the wording "STUDIOCANAL" as referring to the Complainant.

Given the distinctiveness of the Complainant's trademark, the well-known nature of the Complainant's trademark and its reputation, the inescapable inference is that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent in bad faith.

Use in bad faith

The Panel has already referred to the uncontroverted facts set out in the Amended Complaint and accepts the evidence and contention that the disputed domain name points to a registrar parking page.

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 incorporation of a registered trademark that is famously known into a disputed domain name coupled with the disputed domain name pointing to a registrar parking page, without any administratively compliant response from a respondent, are irrefragable arguments in support of the requirement that the use by the Respondent of the disputed domain name is in bad faith. See also WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

The Czech Arbitration Court has also provided written notice of the Amended Complaint to the Respondent with no administratively compliant responses made in respect to any good faith use of the disputed domain name.

In the circumstances, the Panel considers that it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be legitimate.

The Panel, therefore, concludes that the Respondent's holding of the disputed domain name in this particular case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use were in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieved actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On 2021-09-03 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

- That neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court.
- As far as the e-mail notice is concerned, the CAC received a confirmation that the e-mail sent to charles@fzcreative.com was unsuccessfully relayed.
- The e-mail notice sent to postmaster@studiocanal.space was returned back undelivered as the e-mail address had permanent fatal errors.

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, the Panel is satisfied that CAC has discharged this responsibility.

PRINCIPAL REASONS FOR THE DECISION

The Complainant owns the trademark "STUDIOCANAL" registered in several countries, and the domain name <studiocanal.com > which are used in connection with its goods or services for a considerable time.

The Respondent registered the disputed domain name <studiocanal.space> on 2021-05-03.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is identical to or confusingly similar to the Complainant's well-known trademark "STUDIOCANAL".
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- (c) The disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. STUDIOCANAL.SPACE: Transferred

PANELLISTS

Name	Adjunct Prof William Lye, OAM QC
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DATE OF PANEL DECISION 2021-09-15

Publish the Decision
