

Decision for dispute CAC-UDRP-104031

Case number CAC-UDRP-104031

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Domain names carnalplus.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization GROUPE CANAL +

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Legrand Wolf

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 submitted evidence that it is the registered owner of several trademarks which include the wording 'CANAL PLUS' or 'CANAL+' (hereafter the "Canal Plus Trademark" or the "Canal Plus Trademarks"), including, amongst others:

- International trademark CANAL PLUS n° 509729 (word trademark), registered since March 16th, 1987, for various subclasses under classes 9, 16, 35, 38 and 41, valid for the following designated territories: AM, AT, BA, BG, BX, BY, CH, CZ, DE, DZ, EG, ES, HR, HU, IT, KG, MA, MC, MD, ME, MK, PT, RO, RS, RU, SI, SK, TJ, UA, UZ, VN;
- International trademark CANAL PLUS n° 619540 (word trademark), registered since May 30th, 1994, valid for various subclasses under classes 9, 16, 25, 28, 35, 38 and 41, valid for the following designated territories: CN, CU, LI, MN, PL, SD, SM;
- International trademark CANAL + n° 618943 (figurative mark with word elements), registered since May 30th, 1994, valid for various subclasses under classes 9, 16, 25, 28, 35, 38 and 41, valid for the following designated territories: AT, BY, PL, RU, UA; and
- US trademark CANAL+ n° 3902485 (figurative mark with word elements), registered since January 11th, 2011, valid for various subclasses under classes 38 and 41, valid in the US.

Of these trademarks, only the last one is valid in the home country of the Respondent, i.e. the United States.

The Complainant also claims that it is the registered owner of several domain names which incorporate the Canal Plus Trademark(s), amongst others: <canalplus.com> registered on May 19, 2006, and <canal-plus.com> registered on March 27, 1996.

The Respondent does not own a registered trademark. The Respondent claims that it owns United States common law unregistered trademark rights in 'CARNAL' since 2018 and in 'CARNAL+' since June 2021. The Respondent refers to respectively its domain name registration of <carnalmedia.com> in 2018 and the launch of its 'Carnal+' streaming platform in June 2021.

The Respondent also claims that it is the registered owner of several domain names which incorporate the term 'CARNAL', amongst others: <carnalplus.com>, registered on May, 3 2020; <carnalmedia.com>, registered on March 30, 2018; <carnalgoods.com>, registered on January 5, 2018; and <carnalcash.com>, registered on March 30, 2018. The Panel notes that the Respondent submitted the so called 'whois' data for the domain names <carnalmedia.com>, <carnalgoods.com>, and <carnalcash.com>. The 'whois' information submitted for these domain names mention as registrant 'Contact Privacy Inc.' (with various customer numbers), not the Respondent itself. In other words, the Respondent seems to be using a so called 'privacy shield' for these domain names.

The Respondent also refers to its company name, 'CARNAL MEDIA LLC', which incorporates its 'CARNAL' US common law trademark.

FACTUAL BACKGROUND

The Complainant claims to be a leading French audio-visual media group and a 'top player' in the production of pay-TV, theme channels and the bundling and distribution of pay-TV services. The Complainant claims to have nearly 22 million subscribers worldwide. From the evidence submitted by the Complainant, it seems that the Complainant focuses its activities on Europe, Africa, Asia, and the French overseas territories.

The Complainant owns the Canal Plus Trademarks mentioned above and the <canalplus.com> and <canal-plus.com> domain names mentioned above.

The Respondent claims to be the owner of the company 'CARNAL MEDIA LLC', a Minnesota Limited Liability Company. This company is a publisher of gay pornographic goods and services in the United States.

The Respondent claims to own United States common law unregistered trademark rights in 'CARNAL' through its first use in commerce with various offerings to the public since 2018. The Respondent claims that it uses the term 'CARNAL' in its company name; that it registered the domain names <carnalmedia.com> (registration on March 30, 2018), <carnalgoods.com> (registration on January 5, 2018), and <carnalcash.com> (registration on March 30, 2018); that it uses a 'CARNAL MEDIA' Twitter account (registration in October 2018); that it announced the so called 'CARNAL NETWORK' on December 7th, 2018; that it announced the so called 'CARNAL MEDIA PREMIUM' service (on an unspecified date); and that it has produced over a thousand copyrighted works including 24 DVD's, 600 other video's (it is not clear whether these videos mention the term 'CARNAL') and 14 subscription pay-sites (the domain names of these pay-sites do not seem to contain the word 'CARNAL').

The Respondent also claims to own United States common law unregistered trademark rights in 'CARNAL+' through its first use in commerce in June 2021. This use consists of the launch of 'CARNAL+'. The Respondent describes 'CARNAL+' as a 'streaming platform', a 'single site' featuring the combined content from Respondent's other websites (which do not contain or refer to the term 'CARNAL'), a 'premium video subscription service', a 'paysite' and a 'gay porn platform'.

The Respondent registered the disputed domain name <carnalplus.com> on May 3, 2020.

All the Complainant's Canal Plus Trademark registrations predate the registration of the disputed domain name. The Complainant's international trademark registrations date from 1987 and 1994. The Complainant's US trademark registration dates from 2011.

PARTIES CONTENTIONS

COMPLAINANT:

The disputed domain name is confusingly similar to the Complainant's registered Canal Plus Trademarks.

The Respondent does not have rights or legitimate interest in the disputed domain name. The Respondent is not identified in the 'whois' information as the disputed domain name. The Respondent is not known as the disputed domain name. The Respondent is not related to the Complainant. The Complainant does not carry out any activity for, nor has any business with, the Respondent. No authorisation was granted to the Respondent to use the Complainant's registered Canal Plus Trademark. The disputed domain name redirects to a commercial pornography website offering links to other porn websites. The Respondent disrupts the Complainant's activities by creating a likelihood of confusion with its registered trademarks and by redirecting traffic to pornographic content.

The disputed domain name has been registered and is being used in bad faith. The Complainant states that the disputed domain name is confusingly similar to its registered Canal Plus Trademarks. The Complainant submits that it is highly unlikely that the Respondent registered the disputed domain name without knowing the reputation of the Complainant and its trademarks. The disputed domain name is used as a portal to access other websites of the Respondent. The Complainant contends that the Respondent has registered the disputed domain name in bad faith to divert Internet traffic from the Complainant's site to its own website offering adult entertainment content (through other – linked - sites). The Complainant seems to argue that its Canal Plus Trademarks are "well-known" or "famous". However, the Complaint is not entirely clear on this point.

RESPONDENT:

The disputed domain name is not identical or confusingly similar to the registered Canal Plus Trademarks for the following reasons: First, the Complainant has very narrow and limited trademark rights in the United States because the Complainant has not registered a standard character mark in the United States for 'CANAL+' or 'CANAL PLUS' and only has a limited stylized mark. Second, the Respondent's 'CARNAL+' sign is visually different from the Complainant's US stylized mark. Third, 'canal' (French) and 'carnal' (English) are very different words (different spelling, different pronunciation, different meaning). The Respondent emphasizes that the word 'canal' is defined as a passageway and the word 'carnal' refers to 'feelings and desires that are sexual and physical'. The use of the word 'canal' suggests that the Complainant provides a passageway or a 'channel' to television content provided by others, whereas the word 'carnal' describes the actual goods and services offered by the Respondent. Fourth, the Complainant and the Respondent target an entirely different public. For the Complainant, the target public is a French-speaking public located in France and consisting of children and the general public. For the Respondent, the target-public is an English-speaking public located in the United States and consisting of 'gay men with specific fetishes'.

The Respondent has rights and/or legitimate interest in the disputed domain name. First, before any notice to the Respondent of the dispute, the Respondent used the disputed domain name or a name corresponding to it in connection with a bona fide offering of goods or services. The Respondent has been offering a wide variety of goods and services under the Respondent's unregistered trademark rights in 'CARNAL', 'CARNAL PLUS', and 'CARNAL+'. Second, the Respondent is commonly known by the disputed domain name. Under the 'CARNAL' brand, the Respondent has produced over a thousand copyrighted works including 24 DVDs, over 600 other videos, and 14 subscription pay-sites.

According to the Respondent, he did not act in bad faith for the following reasons: First, the Respondent registered the disputed domain name and used it for bona fide goods and services. Second, the Complainant and the Respondent are not competitors and target different markets. Third, the Respondent did not register the disputed domain name to disrupt the Complainant's business. Fourth, the Respondent did not register the disputed domain name in an intentional attempt to

attract for commercial gain, Internet users to the Respondent's 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 web site or location or of a product or service on the Respondent's web site or location. The Respondent argues that he had in fact no knowledge of the Complainant or its trademarks prior to this proceeding. Fifth, the Respondent was sufficiently identified in the domain's whois information. The Respondent had a legitimate purpose for using a privacy service, i.e. to avoid publicising the address where adult industry performers can be found and reduce the chances of unwanted attention from fans and/or dangerous individuals. Sixth, the Respondent did not register the disputed domain name for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant. The Respondent registered the domain name to offer Respondent's own goods and services to the public.

Finally, the Respondent asks the Panel to find that the Complaint was brought in bad faith. The Respondents argues that the Complainant makes issue of the fact that Respondent uses the domain name to offer gay pornography, suggesting that this should persuade the Panel to rule in the Complainant's favour. According to the Respondent, the cases cited by the Complainant involved intentionally misdirecting consumers to tarnish a competitor's mark, which is entirely inapplicable to the Respondent and unrelated to this case since the Respondent uses the domain name to offer its own legitimate gay porn goods and services. According to the Respondent, the Complainant's attack on the Respondent's association with gay pornography is an attempt to incite discrimination, which is evidence of bad faith.

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 not 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 not 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

1. Similarity

The disputed domain name <www.carnalplus.com> consists of the Complainant's registered Canal Plus Trademark(s), with the addition of the letter 'r' (between the letters 'a' and 'n') and the ".com" suffix.

The Panel finds that the mere addition of the letter 'r' in the disputed domain name does not sufficiently change the overall impression of confusing similarity to the Canal Plus Trademark(s).

The Panel notes that the Complainant did not only invoke a US trademark, but also several international trademarks. Some of the Complainant's Canal Plus Trademarks are word marks and others are figurative trademarks with word elements (where the word element 'canal' can be considered as the predominant element of the mark). The Panel finds that the investigation under the first prong of paragraph 4(a) of the Policy cannot be limited to the Complainant's US figurative mark only. The fact that the Respondent is based in the US is not relevant in this regard. The first prong of paragraph 4(a) of the Policy requires that the disputed domain name should be identical or confusingly similar to "a trademark or service mark in which the complainant has rights" and does not limit these trademarks to the location of the respondent.

There is also the addition of the “.com” suffix, which, in this case, can be disregarded when it comes to considering whether the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As concerns paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous Panels have found that 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 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, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Panel finds that the Complainant has not made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant made no reference to the meaning of the word ‘carnal’ in the English language. The Respondent’s arguments about the meaning of the word ‘carnal’ (as pertaining to the flesh or the body) in the English language are pertinent in the sense that this creates at least the impression that the Respondent has some rights or legitimate interests to use this word in its domain name for the type of goods or services that the Respondent is offering.

The Complainant failed to argue or substantiate why the Respondent would not have a right or legitimate interest to use the word ‘carnal’ in his domain name.

As to the combination of the word ‘carnal’ with the word ‘plus’: it seems to the Panel that many digital content providers are offering its paying services (or premium services) by using the word ‘plus’. The Complainant failed to argue or substantiate why the Respondent would not have a right or legitimate interest to use the word ‘plus’ in his domain name or to use this word in combination with the word ‘carnal’.

The Panel finds that the Complainant did not provide sufficient argumentation or evidence that the circumstances of paragraph 4(c) of the Policy are absent. The Panel finds that the Complainant did not provide sufficient argumentation or evidence that the Respondent had knowledge or should have had knowledge of its trademark rights. In particular, the Complainant did not substantiate that its Canal Plus Trademarks are “well-known” or “famous” trademarks, let alone in the United States, i.e., the home country of the Respondent.

It is true that the Respondent has no registered trademark rights to the term ‘carnal’ or to the term ‘carnalplus’ and is not identified in the ‘whois’ information as the disputed domain name, but the Complainant failed to explain why this would be relevant in light of the specific circumstances of the case (especially, in light of the fact that the word ‘carnal’ is a common word in the English language and in light of the frequent use of the word ‘plus’ for offering premium services).

The same is true for the Complainant’s argument that the Respondent is not affiliated with the Complainant and has no authorisation to use its trademark. The Panel would need more factual elements and more detailed argumentation why this is relevant in light of the circumstances of the case (especially, the fact that the words ‘carnal’ and ‘plus’ seem to be common words in the English language for the type of services offered by the Respondent).

The Complainant argues that the disputed domain name redirects to a commercial pornography website offering links to other porn websites, but failed to argue or substantiate why the offering of a pornography website should be considered as

evidence of a lack of rights or legitimate interests in the light of the meaning of the word 'carnal' in English. The Complainant did not argue that the exploitation of a pornography website constitutes an infringement of the law in any relevant country.

The Panel is of the opinion that, in the light of the facts of this case (and especially the meaning of the word 'carnal' in the English language as referring to 'the flesh' or 'the body', and the common use of the word 'plus' to refer to paying services), the fact that the disputed domain name is used to offer pornography services as such cannot in itself be considered sufficient proof of a lack of rights or legitimate interests.

The Complainant did not sufficiently explain, let alone substantiate, why the Complainant believes that the Respondent tries to disrupt the Complainant's activities by creating a likelihood of confusion with its registered trademarks.

In sum, the burden of proof under Paragraph 4(a)(ii) of the Policy lies ultimately and predominantly with the Complainant and the Panel believes that the Complainant did not meet this burden. The Panel emphasises that it is bound by Article 15 (a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"): "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

The Panel therefore decides that the Complainant failed to prove that the Respondent lacks rights or legitimate interests in the disputed domain name.

3. Bad faith

In view of the Panel's finding that the Complainant failed to establish the second element of Paragraph 4(a) of the Policy, the Panel does not need to consider the Complainant's assertions that the Respondent registered and uses the disputed domain name in bad faith. Nevertheless, the Panel will state for the record its conclusions on the third element of Paragraph 4(a) of the Policy as well.

As a general remark, this Panel finds that one should not lightly conclude that a respondent registered and/or used a domain name in bad faith.

First, the Complainant did not substantiate that its Canal Plus Trademarks are 'well-known' or 'famous' trademarks or have a particular name, fame or reputation. The Panel did not see any evidence of any presence of the Complainant and its Canal Plus Trademarks in the country where the Respondent is active (the United States). The Complainant did not even submit any evidence that its trademarks are used in the home country of the Respondent (the United States). From the evidence submitted by the Complainant, it seems that the Complainant focuses its activities on Europe, Africa, Asia, and the French overseas territories, not on the United States.

It might be the case that the Canal Plus Trademarks are in fact 'well-known' or 'famous', but it is up to the Complainant to formulate such claim in a convincing manner and to provide sufficient evidence of such claim.

In sum, the Panel finds that the Complainant failed to substantiate that the Respondent had constructive or prior knowledge of the Complainant's Canal Plus Trademark rights.

Second, the Panel believes that the disputed domain name <carnalplus.com> is comprised of common terms in the English language ('carnal' and 'plus') that have a meaning apart from the use of the words 'canal' and 'plus' (or '+') in the Complainant's Canal Plus Trademark(s). The registration and use of a domain name comprising such common terms is not necessarily done in bad faith. The Panel finds that a respondent is free to register a domain name consisting of descriptive terms, and that the domain name currently in dispute contains such descriptive terms for the services or goods offered by the Respondent.

Third, the fact that the Respondent is offering pornography goods or services (more in particular gay pornography) is not in itself proof of bad faith.

Fourth, the Panel finds that there is no sufficient evidence that the Respondent tried to conceal his identity or deliberately provided incomplete, false or misleading 'whois' information. The Panel also notes that using a privacy/proxy service is not in itself an indication of bad faith, especially in the light of the circumstances of the case (given the fact that the nature of the services or goods offered might be conceived as controversial by a part of the public, the Respondent seems to have had legitimate reasons to not publish his name and contact information or the data of his company in the 'whois' data).

The Panel finds that the Complainant did not provide sufficient convincing argumentation or evidence that any of the circumstances of paragraph 4(b) of the UDRP are present. The Panel notes that the Complainant did not provide sufficient convincing argumentation or evidence that any other circumstances of bad faith at registration or during use of the disputed domain name are present.

The Panel emphasises that the burden of proof under the third prong of Paragraph 4(a) of the Policy is with the Complainant. The Panel reiterates that it is bound by Article 15 (a) of the Rules and that it should thus decide the complaint based on the statements and documents submitted by the parties. On the balance of probabilities, and given the lack of convincing evidence of bad faith, the Panel concludes that the Complainant failed to establish the third element of Paragraph 4(a) of the Policy.

Finally, the Panel finds that the Complaint was not brought in bad faith and did not constitute an abuse of the administrative procedure. Lack of success of a complaint is not itself sufficient for a finding of Reverse Domain Name Hijacking. The Panel refers in particular to the fact that Complainant prevailed on the first prong of the Policy. Furthermore, the Panel emphasises that the Complainant's arguments about the Respondent offering gay pornography cannot be seen as an incitement to discrimination. The Complainant took issue of the fact that pornography is being offered via the disputed domain name, not that gay pornography is offered.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **CARNALPLUS.COM**: Remaining with the Respondent

PANELLISTS

Name	Bart Van Besien
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DATE OF PANEL DECISION **2021-11-22**

Publish the Decision
