Decision for dispute CAC-UDRP-105154

Case number	CAC-UDRP-105154
Time of filing	2023-02-22 15:17:07
Domain names	droit-technologies.org

Case administrator

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

Complainant

Organization	Max & Zoe SRL

Complainant representative

Name	Philippe Navez

Respondent

Name	Mr Frederic Peters

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 claims to have unregistered trademark rights in the trade name “Droit & Technologies” and the domain name <droit-technologie.org>.

FACTUAL BACKGROUND

The Complainant claims to be linked to the law firm Ulys and its founder, Mr. Etienne Wéry. Based on limited factual research, the Panel was able to verify that Mr. Etienne Wéry is the director of the Complainant.

The Complainant is the holder of the domain name <droit-technologie.org>, registered since August 4, 1998 and resolving to a portal/blog of articles and studies related to tech law, innovation and intellectual property.

According to the Complainant’s evidence, a person with a name corresponding to the Respondent’s name has sent an e-mail to Mr. Etienne Wéry on December 1, 2017, announcing the registration of the disputed domain name.

According to the information provided by the registrar, the disputed domain name <droit-technologies.org> has been registered on December 21, 2022, and appears to resolve to a blocked web page.

The Complainant also provides a screenshot, dated January 17, 2023, of a LinkedIn post sent under a name corresponding to the Respondent's name. This post announces content to be posted on a blog linked to the disputed domain name and mentions the name of Mr. Etienne Wéry.

PARTIES CONTENTIONS

Complainant´s contentions are summarised above.

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 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity of confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights.

The term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks (see section 1.1.1 WIPO Overview 3.0).

To establish unregistered or common law trademark rights for purposes of the Policy, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services. Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning. Also noting the availability of trademark-like protection under certain national legal doctrines (e.g., unfair competition or passing-off) and considerations of parity, where acquired distinctiveness/secondary meaning is demonstrated in a particular UDRP case, unregistered rights have been found to support standing to proceed with a UDRP case including where the complainant is based in a civil law jurisdiction. The fact that a respondent is shown to have been targeting the complainant’s mark may support the complainant’s assertion that its mark has achieved significance as a source identifier (see section 1.3 WIPO Overview 3.0).

The Complainant claims to have unregistered trademark rights in the trade name “Droit & Technologies” and the domain name <droit-technologie.org>. The Panel observes that both signs are comprised solely of descriptive terms which are not inherently distinctive, namely “droit” and “technologie(s)” (and the “.org” gTLD). Therefore, the Panel finds that the Complainant’s evidence regarding the acquired distinctiveness of the trade name “Droit & Technologies” is insufficient, as nearly all the evidence originates from the Complainant’s own website.

However, the Panel finds that the Complainant’s evidence shows some form of secondary meaning acquired by its domain name <droit-technologie.org>. More importantly, the Complainant’s evidence indicates an intention of the Respondent to target the Complainant’s director and the Complainant’s domain name <droit-technologie.org>. According to the Panel, this circumstance supports that the Complainant’s domain name has achieved some significance as a source identifier, also considering the Belgian case law and legal doctrine regarding trade names as referenced by the Complainant. In these circumstances, the Panel finds that the Complainant has established unregistered trademark rights in the sign “droit-technologie.org” for purposes of the Policy.

The disputed domain name <droit-technologies.org> is nearly identical to the Complainant’s unregistered trademark “droit-technologie.org”, merely adding one letter “s”.

Therefore, the Panel finds that the disputed domain name <droit-technologies.org> is confusingly similar to the Complainant’s unregistered trademark. Accordingly, the Complainant has made out the first of the three elements that they must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent (see section 2.1 WIPO Overview 3.0 and Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. The Whois records relating to the disputed domain name indicate that the Respondent is known as “Frederic Peters”. The Respondent’s use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Fundamentally, a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant’s mark is often central to this inquiry. Generally speaking, UDRP panels have found that domain names identical to a complainant’s trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 WIPO Overview 3.0). The disputed domain name being almost identical to the Complainant’s unregistered trademark “droit-technologie.org”, merely adding one letter “s”, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant and cannot constitute fair use in the circumstances of this case, as described below.

Moreover, the Panel observes that the disputed domain name appears to be inactive, and neither the Respondent nor the facts of the case indicate any demonstrable preparations to a good faith use of the disputed domain name. On the contrary, the Complainant’s evidence indicate that the Respondent registered and announced his intention to use the disputed domain name to somehow target the Complainant’s director and the Complainant’s domain name <droit-technologie.org> in the framework of a dispute between the Respondent and a client of the Complainant’s director.

While the (intention of) use of a domain name for fair use such as noncommercial free speech can in principle support a respondent’s claim to a legitimate interest under the Policy, a respondent’s criticism must be genuine and not a pretext for tarnishment. UDRP panels find that even a general right to legitimate criticism does not necessarily extend to registering or using a domain name identical to a trademark as this creates an impermissible risk of user confusion through impersonation (see section

2.6 WIPO Overview 3.0).

In the present case, the Panel finds that the Complainant's evidence shows at least an indirect intent of the Respondent to harm the Complainant's director and the Complainant's domain name <droit-technologie.org>. In an e-mail of December 1, 2017 to the Complainant's director, a person with a name corresponding to the Respondent's name clearly implied that the disputed domain name was registered as some kind of retaliation measure and to at least bother the Complainant's director. The Panel finds that the LinkedIn post of January 2023, announcing a blog linked to the disputed domain name and mentioning the Complainant's director, can be reasonably considered as a confirmation of the Respondent's intention to cause harm. The disputed domain name being almost identical to the Complainant unregistered trademark, the Panel also finds that this creates an impermissible risk of user confusion through impersonation.

Moreover, the Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors are the registration of a domain name primarily for the purpose of disrupting the business of a competitor. Noting that the scenarios enumerated in UDRP paragraph 4(b) are non-exhaustive, panels have applied the notion of a "competitor" beyond the concept of an ordinary commercial or business competitor to also include the concept of "a person who acts in opposition to another" for some means of commercial gain, direct or otherwise (see section 3.1.3 WIPO Overview 3.0). Using a domain name to tarnish a complainant's mark (e.g., by posting false or defamatory content) may also constitute evidence of bad faith (see section 3.12 WIPO Overview 3.0).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070).

In the instant case, the Panel finds that the Respondent was undoubtedly aware of the Complainant and the website linked to the Complainant's domain name <droit-technologie.org> at the moment the Respondent registered the disputed domain name. The Complainant's evidence indicates that the Respondent even informed the Complainant about the registration of the disputed domain name back in 2017 with the intention to harm the Complainant in some way. According to the Panel, this indicates that the Respondent registered the disputed domain name primarily to disrupt the business of the Complainant.

The Panel observes that the Respondent is not presently using the disputed domain name but as mentioned above, evidence suggest that the Respondent announced the start of a blog linked to the disputed domain name. In view of the totality of the circumstances of this case as discussed above, the Panel finds that there is a reasonable risk that the Respondent uses the disputed domain name to cause harm to the Complainant.

The Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was 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. **droit-technologies.org**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2023-04-06

Publish the Decision