

Decision for dispute CAC-UDRP-105629

Case number **CAC-UDRP-105629**

Time of filing **2023-07-17 11:32:23**

Domain names **canal-plus.digital**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **GROUPE CANAL +**

Complainant representative

Organization **NAMESHIELD S.A.S.**

Respondent

Organization **Domain Administration**

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

In this proceeding the Complainant relies on the following trademark registrations:

- The international trademark registration No. 509729 “Canal Plus” (word), registered on March 16, 1987, effective *inter alia* in Austria, Benelux, Switzerland, Spain, Vietnam and Ukraine, and;
- The international trademark registration No. 619540 “CANAL PLUS” (word), registered on May 30, 1994, effective *inter alia* in China, Cuba, Poland and Mongolia.

The Complainant also refers to multiple domain names that incorporate the “Canal Plus” mark, including <canalplus.com> registered since May 20, 2006 and <canal-plus.com> registered since March 28, 1996.

FACTUAL BACKGROUND

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states it is the leading French audiovisual media group and one of the global leaders in the production of “pay-TV” and theme channels, the bundling and distribution of “pay-TV” services.

It claims to have 20.3 million of subscribers worldwide and a revenue of 5.268 billion euros.

The Complainant offers various channels available on all distribution networks, VOD and streaming services.

The Complainant alleges that the disputed domain name was registered on December 29, 2022 and resolves to a parking page with commercial links.

The Complainant claims the disputed domain name is identical to its trademark since it includes the trademark in its entirety. The Complainant refers to previous UDRP decisions that confirmed Complainant's trademark rights.

The <.digital> gTLD shall be disregarded in the appreciation of identity or confusing similarity.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

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

The Complainant alleges that it 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, or apply for registration of the disputed domain name by the Complainant.

The disputed domain name points to a parking webpage displaying sponsored links. The Complainant contends that such use is not legitimate non-commercial or fair use of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant claims that the disputed domain name has been registered many years after the Complainant had established a strong reputation and goodwill in its marks.

The Complainant states the Respondent could not have ignored the Complainant's trademark at the moment of the registration of the disputed domain name.

The Respondent is using the disputed domain name in connection with a website which points to a parking webpage displaying sponsored links. The Complainant contends that such use is made only to attract Internet traffic and refers to past panels' decisions.

The Complainant alleges that by using the disputed domain name the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the Respondent's website or location or of a product or service on the respondent's website or location, as mentioned by Policy, paragraph 4(b) (iv).

Therefore, the Complainant claims the disputed domain name was registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section 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

A. Identical or confusingly similar

The Complainant provides evidence of the registrations for the trademark “Canal Plus” protected in various jurisdictions.

As confirmed by the “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition” (“WIPO Overview 3.0”): “where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case” (see par. 1.2.1).

The Panel notes that the Complainant’s address in the international registrations is different from the Complainant’s address in the present proceeding. The Complainant clarified that it changed its address and the address in the complaint is its current address, whereas the address recorded in the WIPO registry is its previous address.

The disputed domain name fully incorporates the Complainant’s trademark and is identical to the “Canal Plus” trademark of the Complainant as it has no other elements other than “Canal Plus” separated by a hyphen.

The gTLD “.digital” is to be disregarded under the confusing similarity/identity test as it does not affect the public’s perception in these circumstances of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

- (i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
- (ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see *Julian Barnes v. Old Barn Studios*, WIPO Case No. D2001-0121; *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110.

The Panel notes that contrary to Complainant’s statement the disputed domain name was registered on November 4 or 5, 2022 (rather than December 29, 2022, as claimed by the Complainant). This is confirmed by “whois data” (Whois provides date November 5, 2022) and Registrar’s verification (provided verification confirms date November 4, 2022).

The disputed domain name resolves to a page with commercial links.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and CAC Case No. 101284: “A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant”.

The Complainant has made a prima facie case of Respondent’s lack of rights or legitimate interests.

The Respondent is not known by the disputed domain name and has no apparent connection to the Complainant’s business or the disputed domain name.

The Complainant has not granted any license or authorization to use its trademark to the Respondent and the Complainant is not doing any business with the Respondent.

While use of a domain name for hosting PPC links may, in some circumstances, create rights and legitimate interests, the Panel finds that this is not the case in the present dispute.

As stated in the WIPO Overview 3.0, par. 2.9: “Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain

name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark..." At the same time "the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users."

In the present case the disputed domain name is identical with the Complainant's mark and this cannot create a bona fide use or any other rights or legitimate interests as it creates a risk of impersonation, indicates an intent to capitalize on the Complainant's reputation and suggests targeting of the Complainant.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see par. 3.1 of the WIPO Overview 3.0). Targeting is important in establishing bad faith under the UDRP.

The Panel finds that the Complainant provided sufficient evidence that the disputed domain name was registered and is being used in bad faith based on the following:

1. The nature of the disputed domain name (includes the Complainant's mark in its entirety), the timing of the registration of the disputed domain name – November 4 or 5, 2022, many years after the Complainant obtained protection for its trademarks and the gTLD chosen that indicates connection with the Complainant and its business (.digital). The nature of the disputed domain name indicates that the Respondent was likely aware of the Complainant and its trademarks when he/she registered the disputed domain name.
2. The WIPO Overview 3.0 confirms that "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith", see par. 3.1.4. The Complainant claims that it "established a strong reputation and goodwill in its marks". The Panel is somewhat concerned that the Complainant offered only limited evidence to support this statement, namely information from Complainant's own website with some figures and description of Complainant's business, copies of trademark registrations and references to previous UDRP decisions. Normally, more extensive evidence is required to establish that a trademark is well-known/ has a strong reputation (e.g. evidence of awards, publications by independent sources, media reports, etc.). However, this is not fatal to the Complainant in the present dispute taking into account other evidence available as well as facts of the dispute (including previous UDRP decisions in Complainant's favor and the nature of the disputed domain name).
3. The website by the disputed domain name contains PPC links and the following disclaimer: "**The website and the domain name don't represent any potential trademark. Ads are generated automatically based on the generic meaning of the domain name. Inquire for more information.**" First, the Panel notes that PPC links as such do not necessarily indicate bad faith of respondents in UDRP proceedings. However, in general "respondent cannot disclaim responsibility for content appearing on the website associated with its domain name" and "neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith" (see par. 3.5 of the WIPO Overview 3.0). The disputed domain name, as noted above, is identical to the Complainant's trademark "Canal Plus" and even the gTLD <.digital> may be seen as indicating some sort of connection with the Complainant's activities (e.g. "digital TV"). The presence of the disclaimer in these circumstances does not help the Respondent. As noted in the WIPO Overview 3.0: "where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith" (see par. 3.7).
4. The Panel finds, on the balance of probabilities, that this is a case of targeting and an attempt to take unfair advantage of the Complainant's trademark by the Respondent and that the disputed domain name was registered and being used in bad faith. There are no rights or legitimate interests of the Respondent taking into account evidence on the record and facts of this case and in the absence of the response the only apparent reason for registration of the disputed domain name appears to be an intent of the Respondent to take unfair advantage of the Complainant's "Canal Plus" mark.

Based on the above, the Panel finds that Respondent's conduct falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent takes unfair advantage of the Complainant's mark.

The Panel holds that the third requirement of the Policy has been satisfied.

Accepted

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

- 1. **canal-plus.digital**: Transferred

PANELLISTS

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| Name | Igor Motsnyi |
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| DATE OF PANEL DECISION | 2023-08-11 |
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Publish the Decision