Decision for dispute CAC-UDRP-106920

Case number	CAC-UDRP-106920
Time of filing	2024-10-07 11:24:53
Domain names	reply-leparisien.com

Case administrator

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

Complainant

Organization	LE PARISIEN LIBERE, SAS

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	adil kedjouti

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 has established by evidence that it owns several trademarks for LE PARISIEN including the following:

- the French trademark for LE PARISIEN, number 98732441, registered on May 14, 1998;
- the French trademark for LE PARISIEN, number 98732442, registered on May 14, 1998;

(collectively “the LE PARISIEN trademark”).

FACTUAL BACKGROUND

The Complainant is a French company that publishes the daily newspaper Le Parisien which it has done since 1944, initially under the name Le Parisien Libere but more recently under its current name Le Parisien. It is the registered owner of the aforesaid LE PARISIEN trademark and has also registered the following domain names which it uses in its business in connection with the publication of Le Parisien, namely the <leparisien.com> domain name, registered on February 3, 1997 and the <leparisien.fr> domain name, registered on February 9, 2009. The Complainant has continuously used the LE PARISIEN trademark since its registration to designate its goods and services provided under the trademark and in particular for the publication of Le Parisien. The LE PARISIEN trademark has attracted substantial goodwill and is uniquely associated with the Complainant’s goods and services and in particular with the Le Parisien newspaper. The Respondent registered the <reply-leparisien.com> domain name on September 30, 2024 (“the

disputed domain name") but has not used it for any purpose other than to allow or cause it to be redirected to an error message and to configure MX servers. The Complainant is concerned that the Respondent has registered the disputed domain name which incorporates the LE PARISIEN trademark and is using it to pass itself off as the Complainant and to suggest that it is an official domain name of the Complainant which it is not. Accordingly, the Complainant has instituted this proceeding to have the disputed domain name transferred to itself.

PARTIES CONTENTIONS

A. COMPLAINANT

The disputed domain name is confusingly similar to the LE PARISIEN trademark. That is so because it embodies, without the consent of the Complainant, the LE PARISIEN trademark and the Respondent in registering the domain name has added to the trademark the word "reply", a hyphen and the generic Top Level Domain ".com", none of which can negate a finding of confusing similarity that is otherwise made out.

The disputed domain name resolves to an error page and MX servers have been configured to it, showing the probability of its being used for e-mail purposes.

The Respondent has no rights or legitimate interests in the disputed domain name. That is so because:

- the Respondent is not commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the UDRP Policy;
- the Respondent is not related in any way to the Complainant and the Complainant does not carry on any business with the Respondent; nor has the Complainant given any licence or authority to the Respondent to use the LE PARISIEN trademark or register the disputed domain name; and
- the Respondent has not used or demonstrated any plan to use the disputed domain name for any legitimate purpose.

The Respondent has registered and used the disputed domain name in bad faith.

That is so because:

- the Respondent registered the disputed domain name many years after the Complainant started to publish its well-known newspaper and accordingly the Respondent had notice of the Complainant and its trademark when it registered the disputed domain name;
- the disputed domain name redirects to an error page showing that the Respondent has not used it for any or any legitimate purpose;
- it is impossible to conceive of any circumstances on the basis of which it could be contended that the Respondent has not registered and used the disputed domain name in bad faith;
- all of the relevant acts, facts, matters and circumstances revealed by the evidence will show that the Respondent has registered and used the disputed domain name in bad faith by way of passing off, or infringement of consumer protection and trademark law.

It is therefore submitted that as the Complainant will be able to show all of the elements that it must prove it is entitled to the relief it seeks, namely the transfer of the disputed domain name to itself.

B. RESPONDENT

The Respondent failed to submit a Response in this proceeding.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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 that 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

DISCUSSION AND FINDINGS

A. Administrative compliance

By notification dated October 7, 2024 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that it did not sufficiently identify the Respondent. The notification invited the Complainant to have regard to the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. Also on October 7, 2024, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the UDRP Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15(a) of the Rules instructs this Panel to "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."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See: eGalaxy Multimedia Inc. v. ON HOLD By Owner Ready To Expire, FA 157287 (Forum June 26, 2003) ("Because Complainant did not produce clear evidence to support its subjective allegations [. . .] the Panel finds it appropriate to dismiss the Complaint").

Identical and/or Confusingly Similar

The first question that arises is whether the Complainant has rights in a trademark or service mark on which it may rely. The evidence has established that the Complainant is the registered owner of several trademarks for LE PARISIEN including the following:

- the French trademark for LE PARISIEN, number 98732441, registered on May 14, 1998;
- the French trademark for LE PARISIEN, number 98732442, registered on May 14, 1998;

(collectively "the LE PARISIEN trademark").

The Complainant has established those registrations by documentary evidence that the Panel has examined and finds to be in order.

The Complainant has thus established its trademark rights and hence its standing to bring this proceeding.

The next question that arises is whether the disputed domain name is identical or confusingly similar to the LE PARISIEN trademark. The Panel finds that the disputed domain name is confusingly similar to the LE PARISIEN trademark for the following reasons. The disputed domain name embodies, without the consent of the Complainant, the LE PARISIEN trademark and the Respondent in registering the disputed domain name has added to the trademark the word "reply", a hyphen, and the generic Top Level Domain ".com". It is clear and well established that if a domain name includes a trademark, as in the present case, it is more likely than not

that the domain name is both similar to the trademark and confusingly similar. That is so in the present case. The addition of the word “reply”, which is a generic word, gives to the disputed domain name the meaning that it is invoking the LE PARISIEN trademark, the provision of the Complainant’s publication Le Parisien under the trademark and that the disputed domain name may be legitimately used for replying to and contacting the Complainant on matters relating to the publication. The addition of the hyphen after the word “reply” is too insignificant to influence in any way the interpretation of the disputed domain name. Finally, the generic Top Level Domain “.com” or any other TLD has long been held to have no effect, as all domain names must have such an extension. The Panel therefore finds that the disputed domain name is similar to the trademark and confusingly so, the confusion being that it raises a question mark whether it is a genuine domain name of the Complainant or not.

The Complainant has thus made out the first of the three elements that it must establish.

Rights or Legitimate Interests

It is now well-established that the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii) and that, if the prima facie case is made out, the burden then shifts to the Respondent to show that it does have such rights or legitimate interests. See Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (Forum Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy 4(a)(ii)).

The Panel finds on the evidence that the Complainant has made out the requisite prima facie case that arises from the following considerations that are the basis of the Complainant’s submissions:

(a) the Respondent is not commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy; the evidence shows that the Respondent is not commonly known by the disputed domain name within the meaning of that paragraph; there is no evidence to show that the Respondent is commonly known by the disputed domain name and it is impossible to conceive that it is so known; nor is there any evidence that the Respondent is known by any other name than its own, being the name it supplied when registering the disputed domain name;

(b) the Respondent is not related in any way to the Complainant and the Complainant does not carry on any business with the Respondent; nor has the Complainant given any licence or authority to the Respondent to use the LE PARISIEN trademark or register the disputed domain name ; thus it could not be said that the disputed domain name has been registered and used with any sort of express or implied consent by or permission from the Complainant, thus negating any notion that the Respondent has a right or legitimate interest in the disputed domain name;

(c) the Respondent has not used or demonstrated any plan to use the disputed domain name for any legitimate purpose; it cannot be legitimate to take another party’s trademark, use it to create a domain name that is confusingly similar to a registered trademark, include in the domain name the word “reply” which is an invitation to contact the trademark owner on matters relating to the trademark, configure the domain name for MX servers and cause or allow it to resolve to an “error” message, all of which the Respondent has done; moreover, such a registration and use of the disputed domain name shows that it has not been used for a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy; and

(d) nothing has emerged from the evidence to show that there is any other ground on which it could conceivably be shown that the Respondent has a right or legitimate interest in the disputed domain name.

The Complainant has therefore convincingly made out all of the grounds it relies on to show a prima facie case that the Respondent does not have a right or legitimate interest in the disputed domain name.

The Respondent has not filed a Response or attempted by any other means to rebut the Complainant’s contentions. That being so, the Panel finds on the evidence that there is a prima facie case that the Respondent does not have a right or legitimate interest in the disputed domain name and that the prima facie case has not been rebutted.

The Complainant has thus made out the second of the three elements that it must establish.

Registration and Use in Bad Faith

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered and used in bad faith. It is also clear that the criteria set out in paragraph 4(b) of the UDRP Policy are not exclusive but that domain name proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

The Complainant has submitted that the Respondent has registered and used the disputed domain name in bad faith and the Panel finds that it has made out its case on the evidence. In particular, the evidence shows that:

(a) the Respondent registered the disputed domain name many years after the Complainant started to publish its well-known newspaper under the name Le Parisien libere and subsequently under the name Le Parisien and well after the Complainant registered and commenced to use the LE PARISIEN trademark; moreover, the publication and its name have clearly become very well- known during the ensuing years; accordingly the Complainant is correct in submitting that the Respondent had actual notice of the Complainant and its trademark when it, the Respondent, registered the disputed domain name; thus, knowingly registering the disputed domain name invoking the trademark can only be regarded as an act of bad faith registration as the Complainant has never consented to the LE PARISIEN trademark being used by the Respondent in the aforesaid manner or at all;

(b) the evidence shows that the disputed domain name redirects to an error page, showing that the Respondent has not used it for any legitimate purpose; also, the very fact that the Respondent has caused or allowed the disputed domain name to redirect to

an error message shows that this is an act of bad faith use of the disputed domain name because of its disruptive nature; moreover, the fact that the disputed domain name has been configured for MX servers with the obvious potential for it to be used for phishing is a further showing of bad faith use of the disputed domain name by the Respondent;

(c) it is impossible to conceive from the evidence any circumstance on the basis of which it could be contended that the Respondent has not registered and used the disputed domain name in bad faith; this is a logical conclusion from the known facts; it must therefore be bad faith for the Respondent to have engaged in the conduct so described; and

(d) all of the relevant acts, facts, matters and circumstances revealed by the evidence have shown that the Respondent has registered and used the disputed domain name in bad faith by way of passing off, or infringement of consumer protection and trademark law; the registration and use of the disputed domain name show in effect that the Respondent has tried to pass itself off as the Complainant or to pretend that it is acting with the knowledge and consent of the Complainant which it is not; in addition, the conduct of the Respondent is inconsistent with generally accepted principles of consumer protection law and in any event is a classic case of trademark infringement; all of these matters complete the general picture of the Respondent having registered and used the disputed domain name in bad faith.

Finally, in addition to the specific provisions of the UDRP Policy and having regard to the totality of the evidence, the Panel finds that, in view of the Respondent's registration of the disputed domain name and its use of the Complainant's trademark and in view of the conduct of the Respondent as shown by all of the available evidence, the Respondent registered and used the disputed domain name in bad faith within the generally accepted meaning of that expression.

The Complainant has thus made out the third of the three elements that it must establish.

The Complainant has therefore established all of the elements that it must show under the Policy and it is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **reply-leparisien.com**: Transferred

PANELLISTS

Name	**Neil Brown**

DATE OF PANEL DECISION 2024-11-01

Publish the Decision