

ADMINISTRATIVE PANEL DECISION

Photomaton v. Domains By Proxy, LLC / Ehren Schaiberger
Case No. D2022-0593

1. The Parties

The Complainant is Photomaton, France, represented by Inlex IP Expertise, France.

The Respondent is Domains By Proxy, LLC, United States of America (“United States”) / Ehren Schaiberger, United States.

2. The Domain Name and Registrar

The disputed domain name <photomaton.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2022. On February 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 23, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 28, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 23, 2022. On March 8, 2022, the Respondent requested an automatic four day extension. The Center granted that extension on March 9, 2022. The Response was filed with the Center on March 27, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 1, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a French company, established in 1925. It manufactures and distributes photo booths. According to the Complaint it has done so throughout the world for many years. According to the Complaint, the Complainant adopted "Photomaton" as its corporate name in 1996.

The Complainant owns a number of registered trademarks:

(1) French Registered Trade Mark No. 1235655, PHOTOMATON, which, according to the extract included in the Complaint, also includes some form of device or stylisation. This trademark has been registered in International Classes 1, 9, and 16 since May 10, 1983;

(2) European Union Registered Trade Mark (EUTM) No. 010284123, PHOTOMATON, which was filed in September 2011 and registered on March 7, 2012, in respect of a range of goods and services in International Classes 1, 6, 9, 16, 35, 38, 40, 41, and 42; and

(3) International Registration No. 143144, PHOTOMATON (in a slightly stylised script), in respect of a range of goods in International Classes 1, 9, and 16, and which was registered on September 9, 1949, on the basis of a French registration dating from 1929. The International Registration designates a number of jurisdictions under the Madrid Protocol: Austria, Benelux, Switzerland, Germany, Algeria, Spain, Hungary, Italy, Liechtenstein, Morocco, Monaco, Montenegro, Portugal, Romania, Serbia and Viet Nam. Notably, the United States is not one of the designated countries.

The Complainant states that, as a result of its extensive use, its trademark has become notorious. The Complainant does say some 12 million photos were taken in Photomaton booths in France in 2021 and numerous Photomaton booths are located in public places in France such as subway stations, train stations, city halls, and supermarkets. The Complainant has also submitted a ruling that the French Trademark Office (INPI) ruled the Complainant's trademark was distinctive in an opposition proceeding in 2017 against "Le Potomaton".

The Complainant states it owns numerous domain names and provides evidence that it holds two:

(a) <photomaton.fr>, which it registered in 2002; and

(b) <photomaton.be>, which it registered in 2014.

Although not mentioned by the Complainant, it appears that the Complainant also held the disputed domain name until the registration expired in January 2020. For example, the Wayback Machine at <archive.org> has a capture of the Complainant's website at the disputed domain name dated September 16, 2015.

The Respondent operates a business, Mega Domains, through which he registers and offers for sale domain names. According to the Response, he currently holds more than 10,000 domain names.

The Respondent became the registrant of the disputed domain name in January 2020 when he was the successful bidder through a "drop catching" sale of expiring domain names. The Respondent has not disclosed how much that successful bid was for.

The Respondent has submitted a declaration stating that he did not know of the Complainant or its trademark when he became the registrant.

The next capture by the Wayback Machine after the capture of the Complainant's website in September 2015 is on December 18, 2021. That is, a six year gap. This capture is for a redirect to the website at Dan.com where the disputed domain name is offered for sale for a price of USD 37,000.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

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

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the registered trademarks for PHOTOMATON identified in section 4 above.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy, e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, the disputed domain name is identical to the Complainant's trademark. Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The Panel accepts that the Complainant must show that the Respondent does not have any right or legitimate interest in the disputed domain name; it is not sufficient for the Complainant to establish a “better” claim.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. The Respondent does not hold any trademarks for the disputed domain name.

The Respondent registered the disputed domain name after the Complainant had registered its trademark and also after the Complainant began using its trademark.

In addition, the only use being made of the disputed domain name is its offer for sale for a price of USD 37,000.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent contends that he is in the legitimate business of buying, holding, and selling descriptive keyword, phrasal, and brandable “.com” domain names. He says that this is in the business of curating and supplying domain names to new businesses. He registered the disputed domain name “for the wide scope of possible uses for either a company offering physical or digital products or services”. The Respondent further points out that, over the course of 10 years, he has bought tens of thousands of domain names and, prior to this dispute, had been subject to only five complaints under the Policy. Two were resolved amicably

and the three contested decisions resulted in dismissal of the complaints.

The Panel notes that in one, *En-Powered Inc. d.b.a. EnPowered v. Ehren Schaiberger*, FA2003001888728, the primary basis for the decision appears to have been that the Respondent registered the domain name before the complainant registered its trademark and, insofar as the complainant demonstrated rights in an unregistered trademark, its business was small and largely local and remote from the respondent, being located in another country.

The other two disputes concerned domain names which the respective panels considered descriptive or in common usage with numerous different applications: *Quinco & Cie Inc. v. Ehren Schaiberger*, FA2006001901282 (<smarttiles.com>) and *The Hype Company, S.L. v. Ehren Schaiberger*, WIPO Case No. [D2021-1850](#) (<thehypecompany.com>).

The Panel accepts that aggregating and holding domain names for resale consisting of acronyms, dictionary words, or common phrases can constitute a good faith offering of goods or services under the Policy and is not necessarily illegitimate. However, it is also well-established that mere registration of a domain name comprised of a dictionary word or phrase does not by itself confer rights or legitimate interests under the Policy. See e.g., [WIPO Overview 3.0](#), section 2.10.

The Respondent contends that “Photomaton” is a descriptive word which he can legitimately register and resell for whatever price the market will bear. In support of his claim that “Photomaton” is descriptive, meaning “photo booth” in French, he points to the results of Google Translate, a range of images of or taken in or near photo booths uploaded to Getty Images, a search of “Amazon.fr” showing a range of products available for sale in response to a search for “photomaton”, a Google search for “photomaton” limited to a date range around the time of the drop sale, the registration of other domain names based on “photomaton” in the names of 10 other people, and that it is the title of a very successful “pop” song by the French group Jabberwocky.

The general public often misuse trademarks as nouns or verbs where the term is still a trademark. For example, it is not uncommon for people to say they are going to google something when they are going to conduct an Internet search.

The Panel is not convinced, therefore, these references demonstrate that “Photomaton” is a descriptive word in French which translates into English as “photo booth”. At least as recently as 2017, INPI, the French trademarks office, found to the contrary upholding its registration as a trademark. Nor is it, at least in the Panel’s experience, commonly used in English to refer to photo booths.

Even if the word is, or has become, descriptive, [WIPO Overview 3.0](#) section 2.10.1 explains:

“In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights.”

That is not the case here. Moreover, the use the Respondent is making of it is to offer it for sale for USD 37,000, which appears to be a price calculated by reference to the trademark significance of the term “photomaton”. See e.g., *Supernac’s (Holdings) Limited v. Domain Administrator, DomainMarket.com*, WIPO Case No. [D2018-0540](#).

In these circumstances, the Respondent has not rebutted the *prima facie* case established by the Complainant. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, however, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see *e.g.*, *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

The Complainant says this can be inferred in the present case because its trademark is an invented word with no meaning in any language and which has been found to be distinctive in French case law. (In this respect it provides as support the 2017 decision of INPI already mentioned.) Further, it says, as noted above, that the trademark is very famous *at least in France* as it has been in use for almost 100 years, over 12 million photos were taken in its booths last year and its booths can be found “everywhere”. Accordingly, the Complainant says, it cannot be coincidence that the Respondent has registered the trademark as the disputed domain name. The Complainant, however, has not provided any evidence of the use of its trademark, or the extent of that use if any, in the United States where the Respondent is located.

The Complainant also invokes the Respondent’s use of a privacy service to colour the Respondent’s motives. The Respondent claims that the Registrar’s policy is to register all domain names with the use of proxy service. He also points out that his business, Mega Domains, was clearly identified as the registrant of the disputed domain name on the Dan.com website page offering the disputed domain name for sale and a simple internet search would disclose who Mega Domains was and its contact details. This is also clear from the letter which the Complainant sent to the proxy service seeking to buy the disputed domain name before filing the Complaint.

As noted above, the Respondent has provided a declaration stating that he was unaware of the Complainant or its trademark when registering the disputed domain name through the auction. He points out that his business is to register for resale what he considers to be descriptive words. Further, the Respondent points out that he has registered numerous domain names which start with or include “photo”. He has also registered numerous domain names which end with “on”.

The Respondent gives as examples of such domain names:

“Starting with Photo: Photomenon.com, PhotoCorp.com, PhotoCreativ.com, PhotoDose.com, Photodron.com, PhotoForce.com, PhotoFuzz.com, PhotoHolidays.com, PhotoHorse.com, PhotoLanguage.com, Photolier.com, PhotoLuck.com, PhotoCherry.com, PhotoMidia.com, PhotoPostive.com, PhotoSites.com, PhotosTruck.com, Photoverse.com.”

“Photo Booth related: CrazyPhotobooth.com, GlamPhotobooth.com, Photobooth4u.com, LEDPhotobooth.com, PhotoFunBooths.com, PixPhotobooth.com, EventPhotoBox.com.”

“Ending in Photo: aaaPhoto.com, DeJaVuPhoto.com, EmpirePhoto.com, ExcellencePhoto.com, FrontRowPhoto.com, HarmonyPhoto.com, ImperialPhoto.com, KickPhoto.com, LeisurePhoto.com, OKPhoto.com, OneStopPhoto.com, PlushPhoto.com, SpotPhoto.com, TheClickPhoto.com, VivaPhoto.com.”

“Ending in Photos: BespokePhotos.com, BluePhotos.com, CreaPhotos.com, EmpathyPhotos.com, FlashbackPhotos.com, MemorialPhotos.com, MetroPhotos.com, NextDayPhotos.com, ProudPhotos.com, RodeoPhotos.com, SerenityPhotos.com, TakeMyPhotos.com, TeenPhotos.com, VidaPhotos.com, WorldsPhotos.com.”

“Ending in On: AccountOn.com, BocatOn.com, ComfyOn.com, CoverOn.com, EchoOn.com, FluentOn.com, GogglesOn.com, IdeatOn.com, LakeOn.com, LatchedOn.com, MaveOn.com, PepperOn.com, Photomenon, PloughOn.com, PWROn.com, UxOn.com, Uxton.com.”

“Other relevant: ThePhotoMan.com, ThePhotoNinja.com, ThePhotoHub.com, ThePhotoZone.com, LAPhotographer.com, AmorPhotography.com, LustPhotography.com, WinePhotography.com, WinkPhotography.com.”

As already noted, he says he has registered tens of thousands of such names over the past 10 years and has successfully defended the five complaints brought against him under the Policy.

However that may be, the successful defence of prior complaints is not determinative of this Complaint. Nor, having regard to what appears to be the distinctive nature of the Complainant’s trademark, is the Respondent’s denial of knowledge of the Complainant and the trademark.

The Panel is not in a position to decide the truth or otherwise of the Respondent’s denial.

As recorded in [WIPO Overview 3.0](#), section 3.2.3, however, panels have often held that registrants, particularly (but not only) those registering large numbers of domain names through automated processes, have a duty to establish whether the domain name will infringe on the rights of some third party. As the learned panelist in the *Supermacs* case, above, noted, knowledge for these purposes is approached objectively, not just subjectively.

The *Supermacs* case, above, like the present case concerned a domainer who had obtained the domain name at issue through a drop-catching sale.

The inclusion of the disputed domain name in a drop-catch sale is a factor which has contributed to a finding that the respondent was on notice, or should have been on notice, of a third party’s trademark rights. The Respondent says that the Complainant had abandoned the disputed domain name and allowed it to lapse. The basis for that claim is not clear. On the other hand, the Complainant has not explained how the registration of the disputed domain name came to expire. Apart from the fact that it was included in a drop-catching sale as an expiring domain name, some support for the Respondent’s claim can be derived perhaps from the six year gap in website captures by the Wayback Machine. Also, the Complaint was not brought until some two years after the disputed domain name expired.

Whatever the true position is, it is clear that the Complainant has not abandoned its trademark so, whether it wished to continue using the disputed domain name or not, a subsequent acquirer would not be able to use it in a way which conflicted with the Complainant’s trademark right or which may be in contravention of the Policy.

As in this case also, the complainant in the *Supermacs* case, above, did not hold a trademark registered in the United States where the respondent was located. As the panel pointed out, however, the domain name in issue was offered for sale from a website accessible from anywhere in the world and there was no evidence that the respondent limited sales only to people in the United States. On the contrary, the respondent’s website described itself as “the world’s best online store”.

In that decision, noting that the domain name had been obtained through drop-catching, the complainant was the immediately prior registrant, the domain name was effectively the complainant’s trademark, and the high price being asked by the respondent for the sale of the domain name, the learned panelist explained:

“Thus, it can be seen that the value of the disputed domain name derives primarily from the fact that it is the Complainant’s trademark, rather than from the fact that it contains arguably a descriptive term. In these circumstances, and absent any attempt by the Respondent to avoid registering a domain name that is another person’s trademark, the Respondent must accept that, judged objectively, it will be considered to have registered the disputed domain name for the primary purpose of selling it to the Complainant – which is deemed by the Policy to be evidence of registration and use in bad faith.”

In the present case, the Respondent does claim to have attempted to avoid registering a domain name which included a trademark. The Respondent says that there are some 100,000 expiring domain names each day. To winnow these down, he says he employs a custom negative keyword list to filter out problematic domain names which include terms such as “porn”, “porno”, “xxx” “as well as hundreds of major and commonly abused trademarks and brands”. He provides a list of these by way of example:

“Disney, CocaCola, Microsoft, Samsung, Toyota, Budweiser, Mercedes, Netflix, Starbucks, Gillette, Realtor, Olympics, HarleyDavidson, Heineken, HelloKitty, iPhone, Jeep, Viagra, Nintendo, Porsche, StarWars, WordPress, YouTube, and so on.”

The Respondent does not claim that the Complainant’s trademark was on this list but instead claims he also undertook a “spot-check” of the United States Patent Trademark Office’s TESS database and “Trademarkia.com”.

So far as the record in this case shows, the Complainant does not have a registered trademark in the United States. It has certainly not claimed one in the Complaint so, understandably, a search of that database would not have disclosed the Complainant’s rights.

It also appears from a time limited Google search (included in Annex M to the Response) that, unlike a present day search, a search around the time of the drop-catch sale would not have disclosed the Complainant’s website at least on the first few screens. Most of the links appear to be to the locations of photo booths in France – e.g., “Photomatons – Centre Commercial Arcades”. Some of the linked images do include the word Photomaton on the photo booth but not in a way that is obviously a trademark.

In these circumstances and based on the evidence presented, the Panel does not think a finding of registration in bad faith can be made. As the Respondent appears to be offering the disputed domain name for sale to anyone anywhere in the world, the limitation of these searches to the United States trademark database and the Trademarkia.com database is not adequate.

The Respondent says his searches were limited to these databases in the absence of a reliable means of searching trademarks in multiple jurisdictions using automated processes. The Panel does not consider that reliance solely on automated processes necessarily provides exoneration. Just because someone wishes to adopt a business practice based on automated processes does not excuse them from adopting a domain name in conflict with another person’s trademark rights. If the person wishes to provide their service, or make it available, on a global or worldwide basis, they cannot claim protection on the basis of a search limited to their own local jurisdiction, however large or significant that jurisdiction may be. The Global Brand Database maintained by WIPO does provide a convenient means of checking trademark status in many jurisdictions. The service is free.

A respondent who chooses to rely on a search limited to its own jurisdiction when it is proposing to operate on a global basis, therefore, should not expect so easily to avoid its duty under the Policy to avoid conflicts with third party trademark rights given the availability of more appropriate and convenient tools such as the Global Brand Database.

From the evidence of the time limited Google search included in the Response, however, it would appear that a Google search around the time of the drop-catch sale did not clearly disclose the Complainant’s trademark (as opposed to the existence of its photo booths).

With considerable reservations given the price the Respondent is seeking for the disputed domain name and its match to the Complainant’s mark and its prior ownership by the Complainant, therefore, the Panel does not think the Respondent can be found to have registered the disputed domain name in bad faith given the efforts that the Respondent apparently undertook to “clear” the disputed domain name (at least so far as the record in this proceeding on the papers reveals). Whether a failure to use an appropriate global brand database in the future would be similarly excused in the future would need to be determined in light of the facts at that time.

In light of this conclusion, it is unnecessary to consider whether or not the disputed domain name is being used in bad faith.

Accordingly, the Complaint must fail as the Complainant has not established all three requirements under the Policy.

6. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: April 15, 2022