

ADMINISTRATIVE PANEL DECISION

Le Géant des Beaux-Arts, SARL v. BRUCE WONG

Case No. D2022-4632

1. The Parties

The Complainant is Le Géant des Beaux-Arts, SARL, France, represented by Gerstaecker Verlag GmbH, Germany.

The Respondent is BRUCE WONG, United States of America (“United States” or “US”), represented by John Berryhill, Ph.d., Esq., United States of America.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 2, 2022. On December 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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 (Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 7, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Also, in response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amended Complaint on December 7, 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 December 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 2, 2023. Further to the automatic four calendar day extension for response, the Response was filed with the Center January 6, 2023.

The Center appointed Manuel Moreno-Torres, Michel Vivant, and Steven M. Levy as panelists in this matter on February 8, 2023. The Panel finds that it was properly constituted. Each member of 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 doing business as a distributor of material for artistic purposes.

The Complainant is the owner of European Union figurative trademark number 010462653 registered on May 31, 2012. The textual components of the mark are: I LOVE ART GERSTAECKER G. The Complainant also obtained registration of this trademark before the United States Patent and Trademark Office (“USPTO”) (No. 4762504 of June 30, 2015) but ultimately it was cancelled on January 14, 2022.

The disputed domain name has had, since 2001, different owners and at least two public auctions. The Complainant has not been the direct registrant of the disputed domain name but since September 2013 it was redirected to <greatart.co.uk> which had some sort of relation with the Complainant.

The disputed domain name was bought by the Respondent via Dropcatch.com auction for USD 10,163 after the previous owner did not renew its registration. The WHOIS records show as January 22, 2022, the date the Respondent registered the disputed domain name.

5. Parties’ Contentions

A. Complainant

The Complainant submits to be legal owner of the I LOVE ART GERSTAECKER G trademark which is used for selling art products and have a whole product division based on the trademark.

The disputed domain name was dropped by the Complainant due a provider change ignored by their marketing division. Indeed, the Complainant alleges to be the legal owner of the disputed domain name for 19 years.

Regarding the second element, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. Indeed, the Complainant alleges that the Respondent is known for using Dropcatch.com for reselling purposes and has lost several disputes in the past.

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith because he is known for registering domain names for reselling purposes. Being the legal owner of the disputed domain name for 19 years, the Complainant request the domain name back.

B. Respondent

The Respondent points out that the disputed domain name constitutes eight letters out of twenty in the Complainant’s figurative mark and that the comparison should consider the distinctive portion with the disputed domain name. However, alleges the Respondent, there is no evidence or allegation as to believe that “I love art” is a distinctive part of the mark associated with the Complainant. Indeed, the Respondent says that “I love art” is a common expressive statement while “Gerstaecker” is likely to be new for anyone who come across with it.

Moreover, the Complainant abandoned its United States trademark application for the mark in which a procedure had been required to disclaim the word “art” and to claim for the graphical presentation of the mark.

The Respondent provides evidence of more than forty trademark registrations owned by third parties in different jurisdictions containing “love art” with additions as pronouns or logos to show how undistinctive it is. From these, the Respondent highlights the textual and figurative French trademark, expired in 2019, for between other elements “iloveart.fr” and its corresponding domain name <iloveart.fr> currently pending expiration which demonstrates that the Complainant has not been exclusively associated with “I love art”.

Likewise, the Respondent says that the Complainant further suggests reputational rights through longstanding use. For such the Respondent refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0.](#)”), section 1.3 to deny such rights upon the lack of evidence or the untrue declaration of possession of the disputed domain name for 19 years.

Regarding the second requirement of the Policy, the Respondent focuses on the Complainant’s statement that it was the “legal owner” of the domain name for 19 years. The Respondent produces the historical WHOIS data provided by DomainTools. Accordingly, between 2001 and 2006 the disputed domain name was registered and used by a third person. Later and after the disputed domain went expired and consequently auctioned by Namebio.com, it was acquired again by a different person.

From April 2011, the disputed domain name is seemingly sold to a French developer who by September 2013 redirected it to <greatart.co.uk> which apparently has some sort of relationship with the Complainant. The Respondent concludes that the disputed domain name has not been used or associated with the Complaint at the very least until 2013.

In November 2021, the disputed domain name registration expired. The Respondent notes that ICANN regulation concedes an extension and certain warnings in favor to the registrant in order to renew the registration of a domain name again. However, the Complainant did not contact any registrar and took no action. Being that as it is, by January 2022 the disputed domain name was dropped, picked by Dropacth.com, auctioned and bought for USD 10,163 by the Respondent without the Complainant’s attempt to buy the disputed domain name.

The Respondent further alleges that prior to notice of this dispute he used the disputed domain name to highlight the work of different artists on Instagram and a website under the banner “I love art”. However, upon notice of the dispute, the Respondent discontinued featuring the works of different artists via the disputed domain name. The Respondent’s use of the disputed domain name shows rights in contrast to the Complainant’s accusations which lack evidence, alleges the Respondent. Therefore, the Respondent registered an available descriptive domain name used in connection with the category of goods which the domain describes.

The Respondent rejects the Complainant’s allegation to be known for using Dropcatch.com to register domains only for reselling purposes and had several lost disputes in the past. However, insists the Respondent, the Complainant provides no basis for such allegation and notes that the prior UDRP decisions were against a default privacy service and not the Respondent.

Moreover, says the Respondent, had he conducted a search for trademark registration in his jurisdiction at the time he acquired the disputed domain name, he would only have checked the simultaneous abandonment of the Complainant’s US registration along with the domain name.

While the Respondent provides many examples of the use of “I love art” as domain names such as and, by way of example, <iloveart.us>, <iloveart.show> or <iloveart.club>, he notes that he is entitled to promote artists online which indeed is a legitimate purpose he had pursued before having received notice of this dispute.

With regard the third requirement, the Respondent contends that he registered the disputed domain name in connection with the legitimate reasons explained above and to be used in connection with art. Thus, expressing rejection of the Complainant’s allegations who provides no evidence that the Respondent is known for registering domains for reselling purposes or of the Respondent’s attempt to sell the disputed

domain name to anyone. The Complainant does not provide evidence of having been the registrant and neither does it explain how the Respondent is to be held responsible for the disputed domain name having been dropped. And, finally, insists the Respondent, the Complainant is not the exclusive owner of the corresponding trademark to the disputed domain name but is one of many parties around the planet who use "I love art" in combination with other graphics and words as marks or in domain names.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

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

The onus of proving these elements is on the Complainant. Paragraph 15(a) of the Rules establishes that the Panel shall 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. The three requirements of the Policy

The Panel finds that the requirements of paragraph 4(a) of the Policy are conjunctive and the key requirement in this case is whether the disputed domain name was registered and used in bad faith. The Panel notes *Edward G. Linskey Jr. v. Brian Valentine*, WIPO Case No. [D2006-0706](#) where the panel states: "As the requirements of paragraph 4(a) of the Policy are conjunctive, the Panel need not address whether Complainant has satisfied the requirements of paragraphs 4(a)(ii) and 4(a)(iii) of the Policy".

Under the circumstances of the case the Panel need not address whether the Complainant has satisfied the requirements of paragraphs 4(a)(i) and 4(a)(ii) of the Policy for the following findings.

The Panel looks at section 3.1. [WIPO Overview 3.0](#) on how to address the third requirement when says: "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark". In other words when the respondent targets the complainant and its trademarks.

In the present case, the Panel concludes that the Complainant has failed to prove that the Respondent registered or used the disputed domain name in bad faith. The file shows no indication of the Respondent targeting the Complainant's trademark, taking unfair advantage of, or abusing the Complainant's mark based on the following observations:

The Complainant alleges that the Respondent is known for registering domains for reselling purposes. However, the Respondent never "offered" the domain name for sale. See *Cloudfm Group Limited v. Barry Garner, MyMailer Ltd*, WIPO Case No. [D2021-3251](#): "There is no suggestion arising from the facts and circumstances of this case that the Respondent ought to have been on notice of the Complainant's identity or of its trademark rights at the point when it acquired the disputed domain name. Thereafter, the Respondent notably did not approach the Complainant to initiate any discussions regarding the disputed domain name". Neither the reselling of domain names itself is illegal except when it breaches the Policy.

The Respondent contends that the disputed domain name was registered in an open auction and to promote Internet artists and thus, never targeted the Complainant's trademark. The Panel considers that there is no evidence to demonstrate that the Respondent should have known of the Complainant's trademark at the time when he bought the disputed domain name. See [WIPO Overview 3.0](#) at section 3.2.2.

Indeed, there is no evidence that the similarity between the disputed domain name and mark was deliberate or that the Complainant or its trademark were targeted. On one hand, the Respondent has provided evidence of the common use of the phrase “I love art” and on the other hand, the Complainant let expire the USPTO application for its trademark at the same time the disputed domain expired.

Further, the Complainant has not provided evidence as to the public recognition in the US of its European trademark or the corresponding part which is included in the disputed domain name. See *Kelin S.r.l. v. Privacy Service provided by Withheld for Privacy ehf / Vincent Cammarata*, WIPO Case No. [D2022-0746](#) “one would expect that the Complainant in the present case provide evidence of its reputation in the United States to demonstrate that the Respondent was likely to have known of the Complainant at the time of registration of the disputed domain name. The Complainant chose not to do so”.

It appears that the disputed domain has been used by third parties in the past. The Panel finds that the Respondent, legitimately, registered the disputed domain name based on its value as a common. Indeed, the phrase “I love art” is widely used as an Internet domain name, alone or adding a term, such as “deco”, “store”, or “studio” by artists and businesses. Only once the previous owner had let the disputed domain name expire and it was subsequently offered for auction, the Respondent acquired ownership. See *Poundland Limited v. Dealz.com*, WIPO Case No. [D2012-0918](#): “The Panel notes that a domain name registration is on a “first come, first served” basis and more than one trader may have a legitimate interest in using any particular domain name. The purpose of the Policy is not to determine who is the ‘best’ owner of a domain name”.

The Complainant alleges to have been the owner of the disputed domain name for the last 19 years. The evidence shows that the Complainant has never been registrant of the disputed domain name or at the very least the beneficiary of the disputed domain name. The Panel notes that from 2013 the disputed domain name was redirected to a different domain name which apparently had some relation or at least knowledge of the Complainant. However, the lack of evidence produced by the Complainant leaves the Panel with nothing to assess in the present case regarding ownership of the disputed domain name, and moreover in that respect nothing to support a claim of targeting in bad faith.

Based on the evidence provided, there is no support for a finding that the Respondent registered the disputed domain name in bad faith. Accordingly, the third requirement under the Policy is not met by the Complainant, and there is no need to address the question of bad faith use.

B. Reverse Domain Name Hijacking and other requests

The Respondent asked the Panel to “consider the Complaint under Rule 15(e)” that is to say, in the present case, a declaration of RDNH. The Rules define RDNH as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name”. The onus of proving this is generally on the Respondent. Paragraph 15(e) of the Rules provides that if “after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”.

A finding of Reverse Domain Name Hijacking seems to this Panel to be appropriate in the circumstances. The Panel notes that the Complainant is represented by a third party who failed to provide adequate evidentiary support for its statements.

Respondent’s Representative has asked “that the Panel redact the name of the Respondent, who has done absolutely nothing to deserve to have his reputation dragged through the mud...”. The Panel finds no grounds upon which redact Respondent’s name and neither can it find grounds to alternatively identify Complainant’s counsel in the decision beyond the name of the law firm mentioned above.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Manuel Moreno-Torres/

Manuel Moreno-Torres

Presiding Panelist

/Michel Vivant/

Michel Vivant

Panelist

/Steven M. Levy/

Steven M. Levy

Panelist

Date: February 22, 2023