

ADMINISTRATIVE PANEL DECISION

Pathé Marques v. Registration Private, Domains By Proxy, LLC
Case No. DAI2023-0019

1. The Parties

The Complainant is Pathé Marques, France, represented by Ardan, France.

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <pathe.ai> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 16, 2023. On August 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 18, 2023, 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 (REDACTED FOR PRIVACY). The Center sent an email communication to the Complainant on August 21, 2023, 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 August 25, 2023.

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 August 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 19, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on September 25, 2023. 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 incorporated in 1999 and part of the French Pathe Group, a relevant film production and distribution company which has its origins in 1896, and presently is also owner of the cinema chains through its subsidiary Les Cinémas Pathé Gaumont and televisions network across Europe.

The Complainant is the owner of the following, amongst others, trademarks (Annex 5 to the Complaint):

- International trademark registration No. 715871, for PATHÉ ! and design, registered on May 17, 1999, successively renewed, in classes 9, 14, 16, 25, 28, 35, 38, 41, and 42; and
- European Union Trade Mark registration No. 008463391, for PATHE, filed on October 12, 2009, and registered on June 28, 2010, successively renewed, in classes 9, 16, 25, 28, 35, 38, 41, 42, and 43.

The Complainant's official website can be found at "www.pathe.com".

The disputed domain name was registered on January 13, 2023, and resolves to a parked webpage displaying pay-per-click ("PPC") links.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name entirely reproduces the well-known PATHE trademark.

Also according to the Complainant, the Respondent has no rights or legitimate interests in the disputed domain name given that:

- (i) the The Complainant has not granted any authorization to anyone, which includes the Respondent, to register domain names containing the Complainant's trademarks or otherwise make use of its marks;
- (ii) the Respondent has intentionally hidden itself behind a privacy shield and provided false contact details what further corroborates its lack of rights or legitimate interests in the disputed domain name;
- (iii) the Respondent cannot claim to commonly known by the disputed domain name;
- (iv) the Respondent is not using nor preparing to use the disputed domain name in connection with a *bona fide* offering of goods or services and is not 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, rather having used the disputed domain name in connection with parked pages displaying PPC links; and
- (v) the disputed domain name was registered in 2023, years after PATHE was registered by the Complainant and used by the Complainant's group since 1896.

The Complainant further contends that the disputed domain name was both registered and used in bad faith given the well-known status of the Complainant's trademark and the PPC links which used to be displayed at the website that resolved from the disputed domain name and which redirected Internet users to competing websites clearly creating a risk of confusion. Also, according to the Complainant, the Respondent's bad faith is further corroborated by the Respondent's choice to retain a privacy protection service and to provide false contact details.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements which the Complainant must meet in order for the Panel to order the transfer of the disputed domain name:

- (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.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. These circumstances are:

- (i) before any notice 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, in spite of not having acquired 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.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent who has used the disputed domain name in connection with a website displaying PPC links, what clearly does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name in these circumstances.

Also, the lack of evidence as to any trademarks registered by the Respondent corresponding to the disputed domain name, corroborates the indication of an absence of rights or legitimate interests in the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, both the registration and use of the disputed domain name in bad faith can be found pursuant to Policy, paragraph 4(b)(iv), in view of the website at the disputed domain name, which creates a likelihood of confusion with the Complainant’s goodwill and the Respondent unlawfully earning PPC revenues from the advertisements therein placed.

Having reviewed the record, the Panel notes the distinctiveness and reputation of the Complainant’s trademark, and the composition of the disputed domain name (identical to the Complainant’s trademark and domain name <pathe.com>), and finds that in the circumstances of this case, this is further evidence of bad faith under the Policy.

Moreover, in these circumstances, bad faith of the Respondent is also supported here by (i) the lack of reply by the Respondent invoking any rights or legitimate interests; and (ii) the choice to retain a privacy protection service so as to conceal the Respondent’s identity.

Based on the available record, the Panel finds the third element of the Policy has been established.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <pathe.ai>, be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: October 9, 2023