

ADMINISTRATIVE PANEL DECISION

McMahon Distributeur Pharmaceutique inc. v. Eric Grant,
Contrast Technologies, Inc.
Case No. D2024-2935

1. The Parties

The Complainant is McMahon Distributeur Pharmaceutique inc., Canada, represented by Norton Rose Fulbright Canada LLP, Canada.

The Respondent is Eric Grant, Contrast Technologies, Inc., United States of America (“United States”), represented by John Berryhill, United States.

2. The Domain Name and Registrar

The disputed domain name <brunet.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 17, 2024. On July 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 2024 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 July 24, 2024.

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 July 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2024. At the Respondent’s request under the Rules, paragraph 5(b), the Response due date was extended to August 19, 2024. The Response was filed with the Center on August 16, 2024. Following the Parties’ request, the proceeding was suspended from August 26,

2024 to September 25, 2024 for the purposes of settlement negotiations. Further to the Respondent's request for reinstatement, the proceeding was reinstated as of September 25, 2024.

The Center appointed Matthew Kennedy, Reyes Campello Estebaranz, and David H. Bernstein as panelists in this matter on October 8, 2024. 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 operates or services a network of food stores and drugstores in Canada, including 139 Brunet pharmacies in the province of Quebec. The first Brunet pharmacy was founded in 1855 by Wilfrid-Étienne Brunet. The Complainant owns multiple Canadian trademark registrations, including the following:

- TMA340199 for BRUNET and device, registered on May 13, 1988, specifying services in class 35;
- TMA503798 for BRUNET and device, registered on November 6, 1998, specifying goods in multiple classes; and
- TMA790407 for BRUNET and device, registered on February 11, 2011, specifying services in multiple classes.

The above trademark registrations are current. The Leger market research company's WOW rankings for 2018 placed "Brunet" among the top 10 best retailers in the Canadian province of Quebec. The Complainant has also registered multiple domain names that incorporate "brunet", the earliest of these being <brunet.ca>, which the Complainant uses in connection with a website in French and English that provides information about its health products and services. The website prominently displays a BRUNET and device logo similar to the Complainant's registered trademark number TMA790407. The Complainant has used that domain name in connection with a website since at least November 28, 1999, although its current registration dates from October 18, 2000.

The Respondent is a company, and its principal, based in Florida, United States. According to the evidence, the Respondent's domain name portfolio has at different times included several domain names referencing a hair color (i.e., <blonde.org>, <blondepix.com>, <brunette.net>, <netblondes.com>, <redhead.com>, and <sexyblonde.com>), all of which were registered between March 1998 and May 1999.

The disputed domain name was created on April 17, 1998. A partially redacted internal email message submitted by the Respondent indicates that, as at May 10, 1998, the disputed domain name was under the control of the Respondent's principal and intended to be registered by a business unit that the Respondent submits is itself. According to the evidence in the Complaint, the disputed domain name resolves to a website that features a photograph of a swimsuit model with a brown complexion and brown hair alongside links to websites related to Latina Girls, Brunette Singles, and Free Ringtones, various dating, chat, and webcam websites, and other links, including some related to Brunette Girls. At the time of drafting this decision, the Panel notes that the website features the same photograph but, depending on the location, the links may be related to people and places named Brunet, including "Pharmacie Brunet" (meaning "Brunet Pharmacy" in French).

On May 2, 2023, the Complainant, acting via an agent, made an offer to purchase the disputed domain name for USD 2,500. The offer was made anonymously on a domain name broker's platform and requested a hint of the seller's price range. On May 7, 2023, the Respondent made a counter-offer on the platform of USD 115,000. In June 2023, the Complainant made a final offer of USD 5,000 anonymously on the same platform and possibly also using a third party email account. This final offer was declined.

The Respondent submits that it is preparing an action against the Complainant for filing in the Mutual Jurisdiction to which the Complainant has agreed to be sued. As at the date of this Decision, it has not indicated that the action has been filed.

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 it holds both registered and common law trademark rights. The Complainant has acquired rights in the wordmark "Brunet" through its longstanding use of the mark in association with the well-known Brunet pharmacy brand. The Brunet trademarks are well-known in Canada in association with the Complainant's pharmaceutical products and services. The Complainant's trademarks are featured in its publications for investors and the public, in press releases published on its website or Canada Newswire, and on its social media accounts and mobile applications. The disputed domain name is identical or confusingly similar to the Complainant's marks as it incorporates the entirety of the wordmark "Brunet" and the entire textual portion of three of its registered marks.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not an affiliate of the Complainant and has not been authorized or licensed by the Complainant to use any of the Brunet trademarks in any way. The Respondent's website offers affiliate links for sexually suggestive content and online dating websites. The Respondent capitalizes on the goodwill of the Complainant's mark to drive traffic to these affiliate links, all of which are unrelated to the word "Brunet". This is a misleading use of the Complainant's mark and does not represent a bona fide use. There is no evidence that the Respondent has been commonly known by the disputed domain name. The Respondent earns revenue through the advertising of sponsored and/or affiliated links. The Respondent's principal appears to be, or has been, president of another company known for registering and monetizing domain names with a history of defending UDRP complaints.

The disputed domain name was registered and is being used in bad faith. At the time of registration of the disputed domain name, the Respondent had actual knowledge, or ought to have known, of the Complainant's rights in the BRUNET trademarks, which precede the date of registration of the disputed domain name by over a century. The Respondent's use of the Complainant's entire mark in the disputed domain name is also an indicator of bad faith. The Respondent's bad faith is likewise demonstrated by its use of the disputed domain name in a manner that tarnishes the Complainant's trademark while also exploiting it for commercial gain. The Respondent is using the Complainant's trademark to direct Internet users to its website, where it features sexually suggestive headings leading to affiliate links for online dating websites and other lewd content. The Respondent's clear intent to profit from the domain name is evidence of bad faith. It would not demand such a high price were it not aware of the Complainant's trademarks and interest in protecting the goodwill developed therein.

B. Respondent

The Respondent contends that the Complainant has not satisfied all the elements required under the Policy for a transfer of the disputed domain name.

"Brunet" is a common dictionary word by no means exclusively associated with the Complainant, and is thus a marketable commodity as a domain name to a wide variety of potential users. "Brunet" is defined as a person of dark complexion and hair by the Oxford English Dictionary and defined as a less common variant of the word "brunette" by the Merriam-Webster Dictionary. There is no serious argument that the dictionary meaning of the word is not directly relevant to romantic or even erotic interests. The Complaint does not allege the Respondent has ever used this dictionary word domain name for any purpose implicating the Complainant's narrow trademark rights in the operation of a provincial pharmacy.

The Respondent agrees that the first criterion is satisfied. There is also no reason to quibble over the fact that, as of the time the Respondent registered the disputed domain name, the Complainant possessed two figurative trademark registrations in Canada relating to a regional pharmacy.

The Respondent's principal is also principal of another company operating a similar business that has been found to be a good faith monetizer of dictionary words or other common terms in seven prior cases under the UDRP. Within the span of a few months in 1998 and early 1999, the Respondent registered several hair style or hair color domain names and associated them with a portfolio of names subject to monetization with potential adult topics. The Respondent does not monetize in relation to pharmacy services or French language content at all. The Respondent's use of the disputed domain name is related to the generic meaning of "brunet". Cf. *Etam, plc v. Alberta Hot Rods*, WIPO Case No. [D2000-1654](#) (registration of <tammy.com>, which is comprised of a woman's name and a generic Top-Level Domain ("gTLD") extension, is not bad faith when the domain name is used for an adult content website).

The Complaint is entirely devoid of any basis to allege that the Respondent was aware of the Complainant's regional mark for a chain of many fewer than its present number of locations in Quebec in 1998. The Complainant itself admits that, when the Respondent registered the disputed domain name, the Complainant had no online presence whatsoever. The Respondent has no recollection of having ever heard of the Complainant prior to this dispute, nor did the Respondent have any reason, let alone duty, to know of a chain of pharmacies in Quebec. The Complainant approached the Respondent anonymously. An unsolicited offer directed to the Respondent in 2023 is hardly relevant evidence of an intent of the Respondent to sell it to the Complainant upon acquiring the name in 1998. At no time has the Respondent ever communicated with the Complainant concerning the disputed domain name. The Complaint does not provide any reason to believe the domain name was registered in bad faith with the Complainant in mind. The Complaint additionally does not provide any evidence that the domain name has been used in bad faith.

6. Discussion and Findings

6.1. Language of the Proceeding and Translation

The language of the Registration Agreement for the disputed domain name is English. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the Parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement. Both Parties have filed their submissions in English. Accordingly, the Panel determines that the language of this proceeding is English.

The Respondent notes that one annex to the Complaint, in particular, includes correspondence conducted in French and requests that it be indicated to the Complainant that materials in languages other than English require translation.

The Panel notes that three annexes to the Complaint are in French. To the extent their meaning is not obvious, these should have been accompanied by an English translation if the Complainant intended to rely on them.

The Panel has considered the possibility of issuing a procedural order under the Rules, paragraph 11(b), requiring that documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part. However, the Panel is mindful that, in accordance with the Rules, paragraph 10(c), it shall ensure that the administrative proceeding takes place with due expedition. In the circumstances of this case, the Respondent has raised the issue of translation as regards one annex only, which is only partly in French. That annex is brief and contains correspondence between the Complainant and its agent regarding an unsuccessful attempt to purchase the disputed domain name. The actual negotiation history has been provided in English by both Parties (in the case of the Complainant, in the same annex). The Respondent has addressed that negotiation history and its relevance, or lack of it, and the part of the annex in French does not alter the Panel's conclusions below. Accordingly, the Panel declines to issue a procedural order requiring translation of any documents.

6.2. Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements:

- (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 has been registered and is being used in bad faith.

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. See [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown registered rights in respect of BRUNET and device trademarks for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. It is unnecessary to consider the Complainant's claim to common law trademark rights in "Brunet".

The sole textual element of the registered marks is reproduced within the disputed domain name. The figurative elements of these marks cannot be reflected in a domain name and may therefore be disregarded in the assessment of identity or confusing similarity. The only additional element in the disputed domain name is a gTLD extension which, as a standard requirement of domain name registration, may also be disregarded in this assessment. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7, 1.10, and 1.11.1.

Therefore, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Given the Panel's findings in Section 6.2C below on the third element of paragraph 4(a) of the Policy, it is unnecessary for the Panel to consider the second element.

C. Registered and Used in Bad Faith

The Panel notes that the third element of paragraph 4(a) of the Policy contains two requirements that apply conjunctively. A complainant must show both that the disputed domain name has been registered in bad faith and also that it is being used in bad faith. The former requires a demonstration that the Respondent knew, or should have known of the Complainant and/or the Complainant's trademark at the time when it registered or acquired the disputed domain name and that it registered the disputed domain name with a bad faith intention targeting the Complainant and/or its mark.

In the present case, the disputed domain name was registered in April 1998, ten years after the Complainant's earliest trademark registration for BRUNET and device in Canada. The disputed domain name is identical to the sole textual element of that mark. However, the Panel does not infer from these facts that the Respondent knew, or should have known, of the Complainant's trademark because "brunet" is also an English dictionary word as well as a surname. The Panel accepts the dictionary definitions presented by the Respondent, which show that "brunet" is a noun or adjective referring to a girl or woman having a dark complexion or, now especially, brown hair. "Brunet" is also a variant of "brunette".

The Complainant presents no evidence that the Respondent had actual knowledge of its mark, and little evidence that the Respondent should have been aware of its mark at the time of registration of the disputed domain name 26 years ago. Most of the Complainant's evidence demonstrates its reputation at the present

time. While the history page on the Complainant's website shows that the first Brunet pharmacy was founded in 1855 and that the chain had five stores in 1982, the mark has only ever been used with pharmacies that operate in the Canadian province of Quebec. There is no evidence that Brunet pharmacies had an online presence until 1999, which was after the registration of the disputed domain name. The Respondent is based in Florida, United States and has no apparent connection to pharmacies or Quebec. The Complainant does not submit, and the Panel does not find, that the Respondent should be deemed to have knowledge of the contents of the Canadian trademark register.

The Respondent submits that it has no recollection of ever having heard of the Complainant prior to this dispute and it provides a plausible alternative explanation for its registration of the disputed domain name based on the dictionary meaning of "brunet". The disputed domain name was one of several domain names registered during the period 1998 to 1999 that the Respondent has held and that contain or consist of hair colors, namely <blonde.org>, <blondepix.com>, <brunette.net>, <netblondes.com>, <redhead.com>, and <sexyblonde.com>. The Respondent submits that these can be monetized with potential adult topics based on their dictionary meaning. That submission is borne out, as regards the disputed domain name, by screenshots of the associated website from May 2024, presented by the Complainant, which show a picture of a swimsuit model with a dark complexion and brown hair (i.e., a brunet) alongside hyperlinks to dating, chat, and webcam websites, including some related to "Brunette Singles" and "Brunette Girls" (spelt "brunette", of which "brunet" is a variant).

The Panel takes note that, when the Complainant's agent made an unsolicited offer to purchase the disputed domain name in 2023, the Respondent made a counter-offer of USD 115,000. However, the price negotiation was conducted anonymously, and no circumstances have been drawn to the Panel's attention from which the inference could be drawn that the offer indicated any awareness and targeting of the Complainant, let alone at the time of registration of the disputed domain name 25 years prior. Moreover, generally speaking, prior UDRP panels have found that the practice as such of registering a domain name for subsequent resale (including for a profit) would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling to a trademark owner (or its competitor). See [WIPO Overview 3.0](#), section 3.1.1.

Accordingly, the Panel is unable to conclude that the disputed domain name was registered in bad faith.

Based on the record, the Panel finds that the Complainant has not established the third element of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Matthew Kennedy/

Matthew Kennedy
Presiding Panelist

/Reyes Campello Estebarez/

Reyes Campello Estebarez
Panelist

/David H. Bernstein/

David H. Bernstein
Panelist

Date: October 22, 2024