

## **ADMINISTRATIVE PANEL DECISION**

Société Librairie Fernand Nathan-Fernand Nathan & Cie v. Domain Administrator, DomainMarket.com  
Case No. D2022-0016

### **1. The Parties**

The Complainant is Société Librairie Fernand Nathan-Fernand Nathan & Cie, France, represented internally.

The Respondent is Domain Administrator, DomainMarket.com, United States of America (“United States”), represented by Brian H. Leventhal, United States.

### **2. The Domain Name and Registrar**

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

### **3. Procedural History**

The Complaint was filed in French with the WIPO Arbitration and Mediation Center (the “Center”) on January 4, 2022. On January 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 4, 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 January 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amended Complaint. The Center sent a communication the same day to the Parties regarding the language of the proceeding and the Registrar confirmed English as the language of the registration agreement. Accordingly, the Complainant filed a translated complaint into English on January 10, 2022, and another amended Complaint on January 11, 2022. The Respondent did not submit any comments.

The Center verified that the Complaint together with the amended Complaints 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 January 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2022 and extended to February 5, 2022 upon the Respondent's request. The Response was filed with the Center on February 5, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on February 8, 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

The Complainant is Société Librairie Fernand Nathan-Fernand Nathan & Cie, a French company operating in the publishing, education, games, and TV programs field that owns several trademark registrations for KIDIDOC, including the following:

- French Trademark Registration No. 99773339 for KIDIDOC and design, registered on February 5, 1999, and duly renewed on November 24, 2008, and on December 6, 2018.

The Complainant also operates on the Internet, owning the domain name <kididoc.fr> that redirects to its official website "www.site.nathan.fr".

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on June 21, 2012, and it resolves to a landing page in which the disputed domain name is offered for sale for USD 9,888.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain name is identical to its trademark KIDIDOC.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since the Respondent is a company that resells domain names and holds no rights on the KIDIDOC trademark.

The Complainant submits that the Respondent has registered and is using the disputed domain name in bad faith, since the latter was bought by the Respondent essentially in order to resell or rent it to the Complainant or to a competitor of the Complainant for a consideration higher to the documented fees directly in relation to the disputed domain name.

## B. Respondent

The Respondent concedes that the disputed domain names is identical to the Complainant's trademark, although takes no position as to the validity or enforceability of such trademark, noting that the only KIDIDOC trademark registration claimed by the Complainant that predates the Respondent's registration of the disputed domain name does not show a registration date in Complainant's Annex 3.

Moreover, the Respondent asserts to have rights or legitimate interests in respect of the disputed domain name since the latter was bought in connection with its legitimate business of buying and selling domain names comprised of descriptive, geographic and generic terms, common phrases, and combinations thereof, to be considered as *bona fide* offering of goods or services: the disputed domain name was registered, without any knowledge of the Complainant, because it is comprised of a combination of generic terms "kidi" and "doc" that form a short creative brand well suited for use by a pediatric doctor or practice or other potential legal uses, as many other "doc" domain names registered by the Respondent, among which <canidoc.com>, <glassdoc.com>, <motodoc.com>, <blogdoc.com>, <educodoc.com>.

The Respondent submits that the disputed domain name was not registered and is not used in bad faith, since the Respondent was not aware of the Complainant's alleged KIDIDOC trademark rights at the time it registered the disputed domain name, nor was the disputed domain name registered with an intent to profit from or otherwise abuse any trademark right that the Complainant may have, but instead in order to sell it in the ordinary course of its legitimate business in good faith. The Respondent adds that the fact that the Complainant may have a French trademark registration matching the disputed domain name that predates the Respondent's registration is not in and of itself evidence of bad faith when the Respondent had no knowledge of the Complainant's trademark or existence, particularly when there are no registered trademarks for the "kididoc" or the "kidi doc" in the United States where the Respondent operates its business, nor were there at the time the Respondent registered the disputed domain name.

## 6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (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.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark KIDIDOC both by registration and acquired reputation and that the disputed domain name is identical to the trademark KIDIDOC.

As regards the doubts raised by the Respondent about the validity of the only Complainant's French trademark registration for KIDIDOC that predates the Respondent's registration of the disputed domain name, by noting that Complainant's Annex 3 does not show its registration date, the Panel, in accordance with its powers to consult matters of public record (see, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8), verified in the database of the French PTO (namely the INPI) that the registration date of the Complainant's French Trademark Registration No. 99773339 for KIDIDOC and design is the same as the application date, namely February 5, 1999, and that the trademark registration has been duly renewed on November 24, 2008, and on December 6, 2018, having validity until February 5, 2029.

It is well accepted that a generic Top-Level Domain (“gTLD”), in this case “.com”, is ignored when assessing the similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is identical to the Complainant’s trademark, pursuant to the Policy, paragraph 4(a)(i).

## **B. Rights or Legitimate Interests**

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

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

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially difficult, since proving a negative circumstance is more complicated than establishing a positive one.

As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since the Respondent has acknowledged it is a company that resells domain names and therefore on that basis apparently it flows that it holds no independent rights on or registration for any KIDIDOC trademark based on the domain name registrations alone.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name.

The Respondent claims to have rights or legitimate interests in the disputed domain name because its business is buying and selling domain names comprising descriptive, geographic and generic terms, common phrases, and combinations thereof, and the disputed domain name is such a domain name. The Panel recognizes that the business of buying and selling domain names containing descriptive terms is not *per se* illegitimate under the Policy and that it can establish a right or legitimate interest in a disputed domain name. That does not mean, however, that a company conducting such a business will automatically have rights or legitimate interests in every domain name it buys and sells: each case will have to be analyzed by considering the nature of the complainant’s trademark, the characteristics of the disputed domain name, and

the specific respondent's use of the disputed domain name.

In the present case, both the Complainant's trademark and the disputed domain are comprised of the term "kidi" followed by the term "doc". The Panel accepts the Respondent's assertion that both "kidi" and "doc" are in effect generic terms – albeit misspellings or shortened versions of the component words, but is of the opinion that the combination of them in one single word makes a distinctive trademark, in which the Complainant has proved to have rights. Thus, the Panel does not consider that the entirety of the disputed domain name is generic.

Moreover, even considering the entirety of the disputed domain name as a generic or descriptive term, it does not follow automatically that the Respondent thereby has rights or legitimate interests in it, as stated in section 2.10.1 of the [WIPO Overview 3.0](#): "Panels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent; panels have held that mere arguments that a domain name corresponds to a dictionary term/phrase will not necessarily suffice. 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".

The Respondent is not using the disputed domain in relation to any of the generic or descriptive meaning that the Respondent asserts the disputed domain name to have, but instead is just offering it for sale at a high price, USD 9,888. The Panel believes that this high price would be paid only by the Complainant or by someone trying to trade off the Complainant's trademark rights. The Panel is of the opinion that buying for reselling a domain name that is identical to a trademark in which a third party has rights, cannot be considered a purpose that, of itself, gives rise to rights or legitimate interests in the domain name, even if the domain name is partially or entirely descriptive.

Therefore, since the disputed domain name is not inherently generic or descriptive (but rather functions as a registered mark), it is not clear how the Respondent would use it in a way that relates to the asserted generic or descriptive meaning of the disputed domain name; the disputed domain name is identical to a trademark in which the Complainant has rights; and, the Respondent is seeking to trade off the Complainant's trademark rights, the Panel finds that paragraph 4(a)(ii) of the Policy has been satisfied.

### **C. Registered and Used in Bad Faith**

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

- (i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) that [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) that [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location."

The Respondent submits that the disputed domain name was not registered and is not used in bad faith, since the Respondent was not aware of the Complainant's alleged KIDIDOC trademark rights at the time it registered the disputed domain name, nor was the disputed domain name registered with an intent to profit from or otherwise abuse any trademark right that the Complainant may have, but instead in order to sell it in the ordinary course of its legitimate business in good faith.

The Respondent is a domainer and undertakes bulk purchases and automated registrations of domain names, and from what the Panel can tell from the Response, without any screening as to whether by doing so it may abuse third-party's trademark rights (focusing instead on its claimed lack of knowledge of the Complainant). Although the Panel acknowledges that probably many of the Respondent's domain name registrations are for *bona fide* purposes as their value derives primarily from their generic or descriptive meaning, the present case is different, since the disputed domain name is identical to the Complainant's trademark and the Panel is of the view that the value of the disputed domain name derives primarily from that trademark.

In other UDRP cases of automated domain names registration by domainers, previous panels have approached the issue of "objectively" instead of "subjectively" knowledge, considering what the Respondent "should have known" rather than what it actually did or did not know. This, in turn, has led panels to recognize that the registrant of a domain name may have a duty to establish whether the registration of the domain name will infringe on the trademark rights of a third party, as stated in section 3.2.3 of [WIPO Overview 3.0](#): "Panels have held that especially domainers undertaking bulk purchases or automated registrations have an affirmative obligation to avoid the registration of trademark-abusive domain names. Panelists will look to the facts of the case to determine whether such respondent has undertaken good faith efforts to screen such registrations against readily-available online databases to avoid registration of trademark-abusive domain names (...) Noting registrant obligations under UDRP paragraph 2, panels have however found that respondents who (deliberately) fail to search and/or screen registrations against available online databases would be responsible for any resulting abusive registrations under the concept of willful blindness; depending on the facts and circumstances of the case, this concept has been applied irrespective of whether the registrant is a professional domainer."

The Respondent claims that the Complainant has no trademark registrations for KIDIDOC in the United States, where the Respondent operates its business, nor were there at the time the Respondent registered the disputed domain name. The Panel acknowledges that the Complainant does not have, and does not claim to have, any United States trademark registration for KIDIDOC, but finds that the Respondent's website to which the disputed domain name resolves and in which the disputed domain name is offered for sale is accessible also from outside of the United States, without anything on the website that limits sales of domain names to the United States.

As set out under the section of rights and legitimate interests, the Panel further notes that the disputed domain name is also used in bad faith since it is offered for sale for USD 9,888, which exceeds out-of-pocket costs. The Panel is of the opinion that the value of disputed domain name derives primarily from the fact that it is identical to the Complainant's trademark, rather than from the fact that it contains a combination of arguably descriptive terms. In these circumstances, and absent any evidence of an attempt by the Respondent to avoid registering a domain name that corresponds to a third-party's trademark, the Respondent shall 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. The Respondent points out that it has not put up pay per click links competitive of the Complainant; the Panel is unable to see how this fact by itself would support a claim not to have registered a domain name with a particular brand owner target in mind.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

## **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 <kididoc.com> be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: February 18, 2022