

ADMINISTRATIVE PANEL DECISION

Ponthier S.A.S. v. Domains By Proxy, LLC / Shannon Ponthier
Case No. D2022-1787

1. The Parties

The Complainant is Ponthier S.A.S., France, represented by Cabinet Nuss, France.

The Respondent is Domains By Proxy, LLC, United States of America (“United States”) / Shannon Ponthier, United States, represented by Edward J Tracy, Jr., United States.

2. The Domain Name and Registrar

The disputed domain name <ponthier.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 May 18, 2022. On May 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 19, 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 May 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 amendment to the Complaint on May 27, 2022.

The Center verified that the Complaint together with the amendment to the 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 May 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 30, 2022. The Respondent submitted a Response on June 30, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on July 14, 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's business began in 1946 in France when André Ponthier and his wife began growing and marketing fresh fruit. The business subsequently expanded by developing a range of frozen fruit products as well.

The Complainant itself was incorporated in 1978 to carry on the business and continued to engage in product innovation as well as marketing existing products. For example, in 1993, according to the Complaint the Complainant introduced a range frozen fruit purees which received the "Bol d'Or Interglace" award and the "House of Quality" prize from the Tokyo confectioners' association. In 1998, the Complainant introduced a range of refrigerated fruit purees. In 2015, the Complainant launched new ranges of vegetable purees in frozen and chilled versions. These products have been marketed under the Complainant's "Ponthier" trademarks.

In 2016, the Complainant generated revenues of EUR 30 million from sales of its products under the "Ponthier" trademark including exports to 65 countries outside France, which comprised 70 *per cent* of its sales. In 2021, the Complainant employed 104 personnel with revenues of EUR 43.4 million including exports to 68 countries which comprised some 65 *per cent* of its sales.

The Complainant also promotes and sells its products from its website at "www.ponthier.net" which domain name it has held since 2012.

The Complainant has also exhibited its products under the "Ponthier" trademark at numerous international trade fairs including in Malaysia and Germany in 2015, Singapore, Japan, and Paris in 2016, Jakarta and Hong Kong, China in 2017, Rimini, Italy in 2018, Barcelona in 2019, San Francisco and Dubai in 2020.

The Complaint includes evidence that the Complainant has registered four versions of its trademark in various countries.

(a) The oldest registrations are for PONTHER in an ellipse device which is registered in France, Registered Trademark No. 93465919; United Kingdom Registered Trademark No. 1551713 and an International Registration No. 608533 designating Austria, Benelux, Switzerland, China, Germany, Denmark, Spain, Finland, Italy, and Sweden; and Canadian registration No. 551244. These trademarks were all registered for relevant goods in International Class 29 in 1993, except for the Canadian registration which was registered in 1999 in respect of goods in International Classes 3, 5 and 30 also;

(b) A second version of the trademark featuring PONTHER with a device of a partial apple and a green "flag" or parallelogram and a strap line "Le Mellieur du Fruit". The strap line is in very much smaller type than PONTHER. The Complainant registered this trademark in France, Registration No. 3284650, the European Union, Registration No. 003813599 and as an International Registration, Registration No. 835099 designating China, Japan, and the Republic of Korea. These trademarks are registered in respect of goods in International Classes 29, 31 and 32 on various dates between April 7, 2004 and September 10, 2004;

(c) A third version features the word PONTHER arranged obliquely with the strap line "Le Fruit Depuis 1946". The strap line is in much less prominent lettering so that the word PONTHER stands out. This trademark is registered in respect of goods in International Classes 29, 30 and 32 in, amongst other places, France, Registered Trademark No. 3971333; the European Union, registration number 011456993; International Registration No. 1 160 252 designating China, Mexico, and the United States. These registrations date from 2012 and 2013. However, United States Registered Trademark No. 1,160,252 was

filed on November 20, 2015 and registered in the Principal Register on January 24, 2017;

(d) A fourth version of the trademark is the word PONTHER which has been registered from 2021 in respect of goods in International Class 29 in, amongst other places, Saudi Arabia (Registered Trademark No. 1442018787), United Arab Emirates (Registered Trademark No. 344804) and Kuwait (Registered Trademark No. KW1629367). This trademark has also been registered in Japan since 1995, Registered Trademark No 3062575 and in Chile from August 7, 2020, in respect of goods in International Classes 29 and 30, Registered Trademark No. 1326585.

The disputed domain name was first registered on October 9, 2008.

The Respondent¹ states the Respondent first became the registrant in 2015.

The Respondent appears to be an IT consultant.

On April 10, 2015, the Respondent incorporated Ponthier LLC as a domestic limited liability company in Texas, United States. The Response includes some form of income tax declaration for "Miscellaneous Income" showing that Ponthier LLC received a payment of USD 308,000 from Delta Energy Consultants LLC in the 2018 fiscal year.

Subsequently, on January 10, 2019, the Respondent also incorporated Ponthier Enterprises Inc. in Texas, United States. The Respondent is the President and the Director of Ponthier Enterprises. The Response includes a copy of the Income Tax Return for Ponthier Enterprises showing that company had revenues of USD 168,000 in the 2020 fiscal year. The Response also includes evidence of two payments to Ponthier Enterprises in May 2022 including one payment for USD 28,000 in respect of IT services by the County of Newton in Texas, United States.

The Complaint includes evidence that between January and May 2022 the disputed domain name resolved to a parking page provided by the Registrar which included pay-per-click ("PPC") advertising links to competitors of the Complainant.

The Response includes evidence from the Wayback Machine that since May 2015 the disputed domain name has resolved to a parking page provided by the Registrar stating "This domain is registered, but may still be available. If you are interested, try our Domain Broker service."

In January and February 2022, the Complainant approached the Respondent through the Registrar's Domain Broker service seeking to "buy" the disputed domain name for EUR 2,000. The broker reported back that the Respondent was not interested in transferring the disputed domain name.

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;
- (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.

¹ As the first Respondent is the Registrar's privacy service, the Panel will refer to the second Respondent as the Respondent unless the context requires the contrary.

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 various registered trademarks 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. See 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.

It is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. See for example, [WIPO Overview 3.0](#), section 1.10. That is particularly appropriate in the present case for the first and second versions of the Complainant's trademark as the word PONTHER is clearly the prominent verbal element; in the case of the first version of the trademark being the only verbal element.

On that basis and disregarding the ".com" gTLD, the disputed domain name is identical to both the first and fourth versions of the Complainant's trademark.

Although not strictly necessary, the Panel considers the disputed domain name is also confusingly similar to the second and third versions of the Complainant's trademark as the word PONTHER is in significantly larger type than the strap lines and clearly serves as a key distinctive feature.

Accordingly, the Panel finds that the Complainant has established 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 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 Respondent registered the disputed domain name well after the Complainant began using its trademark and also after the Complainant registered its trademarks.

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

These factors are often sufficient to establish the required *prima facie* case especially where, as here, there is evidence that the disputed domain name resolves to a parking page with links to the Complainant's competitors.

In the present case, however, the Respondent's own surname is "Ponthier". In addition, the Respondent is operating, or has operated, through two different companies – Ponthier LLC and Ponthier Enterprises Inc.

The Respondent appears to claim that the disputed domain name is used in connection with email services for the companies' business and may in future be used for a website. The Response, however, does not include any evidence of usage of the disputed domain name in emails. Nor does it include any evidence of preparations for a website. Accordingly, the Panel does not give weight to these claims.

Although both companies were incorporated under their respective names long after the Complainant began using its trademarks, there is an obvious basis for derivation from the Respondent's own name. Importantly, there is also evidence, albeit limited, that the Respondent's companies are carrying on business in providing IT services and IT consultancy services, which is a field quite remote from the Complainant's business so that the risk of confusion, if it exists, is very low.

There is evidence that the Complainant's products are distributed in the United States. However, the evidence does not indicate the scale and extent of distribution. Nor does it indicate when sales and promotion of the Complainant's products by reference to the PONTHER trademark started in the United States.

There is the evidence of the disputed domain name resolving to a Registrar provided parking page with PPC links. The Respondent cannot escape liability under the Policy on the basis that the Respondent did not arrange the PPC advertising and has not, it is claimed, received any revenues from that advertising in circumstances where there is no evidence of any steps that the Respondent took to preclude advertising targeting the Complainant's trademark. See e.g., [WIPO Overview 3.0](#), section 2.9.

However, the evidence of the PPC links appears to be from searches in France. The Respondent's evidence from the Wayback Machine shows captures in the English language which do not include PPC links. The Wayback Machine did not make any captures in 2022. There is nothing in the evidence to suggest that there was some change in the nature of the Complainant's business that PPC links would start to be generated in 2022. On the other hand, it seems very likely that the Complainant's trademark is very well known in France. Whether the extent of use of the Complainant's trademark in the United States has been on a substantial scale is not clear on the evidence.

On the limited evidence of use in the United States, the Panel would not infer the Respondent was likely to have known about the Complainant and its trademark when registering the disputed domain name in circumstances where there is an obvious connection with the Respondent's own surname.

Given that obvious derivation from the Respondent's surname and the evidence that the Respondent's companies appear to operate in a very different field to the Complainant, therefore, the Panel finds that the Complainant has not established that the Respondent does not have rights or legitimate interests in the disputed domain name

As the Complainant has not established the second requirement under the Policy, the Complaint must fail.

C. Registered and Used in Bad Faith

As the Complaint must fail, there is no point considering the third requirement under the Policy.

D. Reverse Domain Name Hijacking

For the record, the Panel does not consider this is an appropriate case for a finding of Reverse Domain Name Hijacking under paragraph 15(e) of the Rules. First, it does not appear to have been possible for the Complainant to ascertain the Respondent's identity until receipt of the Registrar's verification response. In addition, the only use being made of the disputed domain name apparent to the Complainant was the resolution of the disputed domain name to a parking page with PPC links to the Complainant's competitors.

In these circumstances, the Panel is not able to find that the Complaint was brought in bad faith.

6. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: July 28, 2022