

ADMINISTRATIVE PANEL DECISION

Compagnie Générale des Etablissements Michelin v. Souleevanh Thao,
Michelin Finance LLC
Case No. D2022-2575

1. The Parties

The Complainant is Compagnie Générale des Etablissements Michelin, France, represented by Dreyfus & associés, France.

The Respondent is Souleevanh Thao, Michelin Finance LLC, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <michelinfinance.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 14, 2022. On July 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 15, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 18, 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 amended Complaint on July 22, 2022.

On July 19, 2022, the Respondent sent an email expressing his willingness to discuss the matter. On July 22, 2022, the Center received an email from the Complainant requesting for the proceeding to be suspended in order to explore settlement possibilities. Accordingly, the Center notified the Parties on July 25, 2022 that the proceeding was suspended for 30 days. On August 26, 2022, September 22, 2022, and October 27, 2022, respectively, the Center received emails from the Complainant requesting for extension to the suspension of the proceeding, which were granted by the Center, and the proceeding was further suspended until November 28, 2022. During the suspension period, the Respondent sent several emails stating that they had changed their business name. On November 28, 2022, the Center received the Complainant’s request for reinstatement of the proceeding and notified the Parties that the proceeding was reinstated as of November 28, 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 November 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Parties on December 20, 2022 that it would proceed to panel appointment.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on January 4, 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 that owns the trademark MICHELIN which is largely protected in the world in connection with the automobile and tire manufacturing industries, as well as in connection with travel, hotel and restaurant guides, maps and road atlases.

In particular, the Complainant is the owner of the International trademark No. 771031, for MICHELIN, registered on June 11, 2001, successively renewed, covering goods and services in classes 5, 7, 8, 9, 10, 11,12, 16, 17, 18, 20, 21, 24, 25, 39, and 42.

The disputed domain name <michelinfinance.com> was registered on January 16, 2022 and presently does not resolve to an active webpage.

5. Parties’ Contentions

A. Complainant

The Complainant, founded in 1889, asserts that it presently employs 107,800 people and is present in more than 171 countries in the world, having become the leader in tire technology for every type of vehicle, also offering unique mobility experiences through road maps, travel itineraries, hotel and restaurant guides and award-winning lifestyle products.

The Complainant further states that before starting the present proceeding, it made efforts to resolve this matter amicably, having sent on January 21, 2022, a cease-and-desist letter to the Respondent via the privacy service asserting its trademark rights and requesting the transfer of the disputed domain name free of charge. Despite several reminders, no response was received.

According to the Complainant, the disputed domain name reproduces the Complainant’s trademark MICHELIN in its entirety, which previous panels have considered to be “well-known” or “famous” (See, for example, *Compagnie Générale des Etablissements Michelin v. World Industrial*, LNQ, WIPO Case No. [D2019-0553](#); *Compagnie Générale des Etablissements Michelin v. Kanoksak Puangkham*, WIPO Case No. [D2018-2331](#); *Compagnie Générale des Etablissements Michelin v. WhoisGuard, Inc., WhoisGuard Protected / Saad Zaeem, Caramel Tech Studios*, WIPO Case No. [D2017-0234](#); *Compagnie Générale des Etablissements Michelin v. Oncu, Ibrahim Gonullu*, WIPO Case No. [D2014-1240](#); *Compagnie Générale des Etablissements Michelin (Michelin) v. Zhichao Yang*, WIPO Case No. [D2013-1418](#); *Compagnie Générale des Etablissements Michelin v. Milan Kovac / Privacy--Protect.org*, WIPO Case No. [D2012-0634](#); *Compagnie Générale des Etablissements Michelin v. Vyacheslav Nechaev*, WIPO Case No. [D2012-0384](#);

Compagnie Générale des Etablissements Michelin v. Transure Enterprise Ltd, Host Master / Above.com Domain Privacy, WIPO Case No. [D2012-0045](#); and *Compagnie Générale des Etablissements Michelin v. Cameron David Jackson*, WIPO Case No. [D2015-1671](#)).

Thus, also according to the Complainant, the disputed domain name is confusingly similar to the Complainant's famous trademark MICHELIN, reproducing it in its entirety with the addition of the generic term "finance", which is not sufficient to avoid any likelihood of confusion.

Furthermore, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- a) the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating the MICHELIN trademark;
- b) the Respondent is not commonly known by the disputed domain name or the name "MICHELIN", in accordance with paragraph 4(c)(ii) of the Policy;
- c) the Respondent cannot assert that, before any notice of this dispute, it was using, or had made 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, in accordance with paragraph 4(c)(i) of the Policy;
- d) the disputed domain name resolves to an inactive webpage, what indicates that the Respondent has no legitimate interest or rights in the disputed domain name; and
- e) given the Complainant's goodwill and renown worldwide, and the nature of the disputed domain name, which is virtually identical or at least confusingly similar to the Complainant's trademark, it is not possible to conceive a plausible circumstance in which the Respondent could legitimately use the disputed domain name, as it would invariably result in misleading diversion and taking unfair advantage of the Complainant's rights.

As to the registration of the disputed domain name in bad faith the Complainant asserts that it is implausible that the Respondent would be unaware of the Complainant at the time of registration of the disputed domain name given both the fame of its MICHELIN trademark as well as to the choice of the generic term "finance".

Moreover, given that multiple email servers were configured on the disputed domain name the Respondent is probably engaged in a phishing scheme, having past panels concluded that the use of a disputed domain name for the purpose of defrauding Internet users by the operation of a "phishing" website is perhaps the clearest evidence of registration and use of a domain name in bad faith. Also, previous panels have already considered that the passive holding of a disputed domain name can satisfy the requirements of paragraph 4(a)(iii), and that in such cases the panel must give close attention to all the circumstances of the respondent's behavior (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

B. Respondent

On July 19, 2022, the Respondent sent an email expressing their willingness to discuss the matter. On September 2, 2022, the Respondent sent an email stating that they were changing their business name. On September 21, 2022, the Respondent sent a subsequent email stating that they had already changed their business name, and "it is no longer Michelin Finance". On September 22, 2022, the Respondent sent a further email stating that their new name should be released soon. Lastly, on October 20, 2022, the Respondent acknowledged receipt of the Center's message referring to the end of the suspension period.

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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

The Complainant has established rights in the MICHELIN trademark, duly registered.

The Panel finds that the disputed domain name reproduces the Complainant's trademark in its entirety with the addition of the term "finance" which does not prevent a finding of confusing similarity under the Policy which, as recognized by past UDRP panels involves a "comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name" (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7).

The first element of the Policy has therefore been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate a respondent's rights to 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.

The Complainant contends that the Respondent is neither affiliated with Complainant in any way nor has it been authorized by the Complainant to use and register its trademark, or to register any domain name incorporating said trademark. The Panel finds that the Complainant has made out its *prima facie* case, and the burden of production has shifted to the Respondent to show their rights and legitimate interests in the disputed domain name.

The Respondent, Souleevanh Thao, Michelin Finance LLC, appears to operate a company formerly named "Michelin Finance LLC". The Respondent in their abovementioned emails, in particular the one sent on September 21, 2022, stated that they have changed their business name to something else, and "it is no longer Michelin Finance". The Respondent, moreover, has not provided any evidence to demonstrate that they have been commonly known by the name "Michelin Finance". When the Panel used his general

powers, articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, to search on the Internet for “Michelin Finance”, the top results all pointed to the Complainant and its trademark MICHELIN. There is no evidence before the Panel showing that paragraph 4(c)(ii) applies in the present case, nor is there any evidence showing that the Respondent is using or preparing to use the disputed domain name in relation with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use, as the disputed domain name has been resolving to an inactive webpage.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of a trademark relating to the disputed domain name or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s website or other location, by creating a likelihood of confusion with the Complainants’ 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.

Past UDRP panels have already dealt with the question of whether the “passive holding” of a domain name could constitute bad faith. Section 3.3 of the already quoted [WIPO Overview 3.0](#) states that “[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put”.

In the present case, the passive holding of the disputed domain name by the Respondent amounts to the Respondent acting in bad faith, given that the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name. In addition to that, in the circumstances of this case, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law.

The registration and use of the disputed domain name in bad faith are further corroborated in the present case in view of the following circumstances:

- (i) the well-known nature of the Complainant's trademark and the confusing similarity between the disputed domain name and said trademark indicate that the Respondent is most likely to have the Complainant and its trademark in mind when registering the disputed domain name;
- (ii) the disputed domain name has been resolving to an inactive webpage, and the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name;
- (iii) the Respondent's immediate response to the dispute is changing their company name which contains the Complainant's famous trademark, without giving any explanation on their choice of the confusingly similar disputed domain name or a formal response to the Complaint on the merits; and
- (iv) the Respondent's potential use of the disputed domain name in connection with email addresses.

For the reasons stated above, the Respondent's conduct amounts, in this Panel's view, to bad faith registration and use of the disputed domain name.

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 <michelinfinance.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: January 16, 2023