

## **ADMINISTRATIVE PANEL DECISION**

**PAULINE v. Domain Vault, Domain Vault LLC**  
**Case No. D2022-4231**

### **1. The Parties**

The Complainant is PAULINE, France, represented by INLEX IP EXPERTISE, France.

The Respondent is Domain Vault, Domain Vault LLC, United States of America (“United States”).

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2022. On November 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 8, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 14, 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 November 16, 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 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 12, 2022. The Response was filed with the Center on December 12, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on January 26, 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.

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 PAULINE, a French company operating in the field of women fashion, and owning several trademark registrations for BRÉAL and including BRÉAL, among which:

- French Trademark Registration No. 1467984 for PATRICE BRÉAL and design, registered on May 26, 1988;
- French Trademark Registration No. 92419022 for B LIKE BRÉAL and design, registered on May 15, 1992;
- International Trademark Registration No. 1190522 for BRÉAL, registered on July 22, 2013, designating also United States.

The Complainant also operates on the Internet, being “www.breal.net” its official website.

The Complainant provided evidence in support of the above.

The disputed domain name was registered on September 18, 2003, according to the Whois records, and it currently resolves to a parking page.

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

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

The Complainant states that the disputed domain name is confusing similar to its trademark BRÉAL and to its trademarks including BRÉAL, as it fully incorporates the dominant portion of its trademark, namely BRÉAL.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, it is not commonly known by the disputed domain name and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The Complainant states that, since the registration of the disputed domain name, the Respondent has been either not using it, or using it in connection with a parking page, or redirecting it, in some case to the Complainant's website.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademark is known in the field of women fashion. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain name and the Complainant contends that the use of the disputed domain name redirecting to the Complainant's website qualifies as bad faith registration and use. Finally, the Complainant suspects that the Respondent might also use the disputed domain name in connection with phishing or fraudulent email communications, since the MX records attached to the disputed domain name have been activated.

## **B. Respondent**

The Respondent states the term “B Real” has a generic meaning to Americans, and likely to most English speakers, as in “be real”, like in the Instagram domain name <breal.tv> and as used by a famous United States rapper, called B-Real.

The Respondent asserts to have rights in respect of the disputed domain name, since it was registered as an investment, being a valuable, generic term, and denies the disputed domain name redirection to the Complainant’s website.

The Respondent states that the Complainant’s trademark was not registered or known in the United States when the disputed domain name was registered in 2003.

The Respondent finally submits that there is no evidence of the disputed domain name being used in connection with email services.

## **6. Substantive Issues**

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 BRÉAL and that the disputed domain name is identical to such trademark.

It is well accepted that a generic Top-Level Domain (“gTLD”), in this case “.com”, is typically ignored when assessing the similarity between a trademark and a domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.11.1.

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 quite 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.

The Complainant, as set out above, asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, nor is making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The Complainant states that, since the registration of the disputed domain name, the Respondent has been either not using it, or using it in connection with a parking page, or redirecting it, in some case to the Complainant’s website.

The Respondent, on the other hand, claims to have rights in respect of the disputed domain name, since it was registered as an investment, being a valuable, generic term, and denies the disputed domain name redirection to the Complainant’s website.

In any event, in light of the Panel’s findings below it is not necessary to make a determination on the matter.

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

Even though the circumstances under the second element present a *prima facie* case to be rebutted, the Panel deems that the Complainant has not met its burden of proof on this third element for the following reasons.

Regarding the registration in bad faith of the disputed domain name, the Panel finds that the term “breal” is likely to be understood as an expression “b real” by English speaking users and that it has not been proved that in 2003, when the disputed domain name was registered, the Complainant’s trademark was necessarily widely known and therefore it cannot be stated that based on the evidence before the Panel the Respondent knew or at least should have known of the Complainant and deliberately registered the disputed domain name (in this regard the Complainant primarily relies on the redirection which the Respondent denies; even if there was such redirection (in 2020 per the Complaint) this may show knowledge at the time but not necessarily some 20 years prior).

As regards the past use of the disputed domain name, currently redirecting to an parking page, the Panel, in accordance with its powers to consult matters of public record (see [WIPO Overview 3.0](#), section 4.8), has checked the Wayback Machine (“www.archive.org”) and found out that the disputed domain name has been either not used or used in connection with parking pages, while it has not been possible to find a redirection of the disputed domain name to the Complainant’s website. For the same reason, “passive holding” as claimed by the Complainant cannot be considered as the Respondent’s bad faith use of the disputed domain name.

In light of the above, the Panel finds that the Complainant has failed to prove that the Respondent has registered and is using the disputed domain name in bad faith, in accordance with paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: February 9, 2023