

ADMINISTRATIVE PANEL DECISION

**Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v.
panuwat assawinjaipecth and banana banana
Case No. D2022-4974**

1. The Parties

The Complainant is Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco, Monaco, represented by De Gaulle Fleurance & Associés, France.

The Respondents are Panuwat Assawinjaipecth, Thailand, and Banana Banana, Thailand.

2. The Domain Names and Registrar

The disputed domain names <montecarlo168.co> and <montescarlo.org> are registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 23, 2022. On December 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 9, 2023, providing the multiple underlying registrants 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 January 12, 2023.

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 Respondents of the Complaint, and the proceedings commenced on January 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on February 7, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on February 23, 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 company organized under the laws of Monaco with its registered office in the Principality of Monaco and was founded on April 6, 1863, by a Sovereign Decree passed by Prince Charles III. Its main shareholders are the Principality of Monaco and its ruling family, namely, the House of Grimaldi.

The Complainant currently employs almost 3,000 people and is the largest employer in the Principality of Monaco.

Besides being quoted as the setting in novels such as “Rebecca”, by Daphne Du Maurier, the Complainant has also featured in many well-known films, books, television programs, magazine, and newspaper articles, such as the James Bond films “Goldeneye” and “Never Say Never Again”, amongst others. Its trademarks or premises have also been featured in several other films including “Cars 2”, “Ocean Twelve”, “Iron Man 2”, and “Madagascar 3”.

In addition to its main casino, the Complainant also owns and operates three other casinos and gaming rooms in Monaco (the Monte-Carlo Bay Casino, the Casino Café de Paris and the Sun Casino) but also a complete resort including two palaces and two deluxe hotels, 40 conference and banqueting rooms, 34 restaurants and bars, three spas, as well as cultural and leisure venues among which the Jimmy’s Monte-Carlo night club, the Salle des Etoiles, the Monte-Carlo Golf Club, and the Monte-Carlo Country Club. These venues form part of a complete resort enjoying a very high reputation among the sphere of luxury palaces around the world.

The Complainant’s casino and resort in Monaco have become famous worldwide as one of the most luxurious gambling facilities in the world, attracting a clientele that comes from numerous European and non-European countries.

The Complainant is the owner of trademark registrations for MONTE CARLO, including the following, as per trademark certificates submitted as annexes to the Complaint:

- Monegasque trademark registration No. 773867 for CASINO DE MONTE-CARLO (word mark), registered on January 21, 2002, in class 41;
- Monegasque trademark registration No. 1218042 for MONTE CARLO (word mark), registered on May 21, 2014, in international class 41.

The disputed domain names <montecarlo168.co> (the “first disputed domain name”) and <montescarlo.org> (the “second disputed domain name”) were registered on October 6, 2021, and May 4, 2022, respectively. The first disputed domain name currently resolves to an inactive website but, according to the screenshot submitted by the Complainant, it was pointed in the past to a gambling site displaying a logo including the wording MONTE CARLO along with a card with aces, gaming chips, and a crown. The second disputed domain name currently resolves to a website promoting online gambling and casino activities under the trademark MONTE CARLO and displaying the same logo featured on the website to which the first disputed domain name previously resolved.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to the trademark MONTE CARLO in which the Complainant has rights as they reproduce the trademark in its entirety with the mere addition, in the case of the disputed domain name <montescarlo.org>, of one letter "s" between the words "Monte" and "Carlo", followed by the generic Top-Level Domain ("gTLD") ".org", and of the number "168" and the country-code Top-Level Domain ("ccTLD") ".co" in the case of the disputed domain name <montecarlo168.co>.

The Complainant submits that the addition of the letter "s" and the number "168" is irrelevant considering the name and content of the websites evocate the trademark on which the Complainant acquired significant reputation.

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainant submits that the Respondents own no rights in the trademark MONTE CARLO or even in "Montescarlo". The Complainant also states that it has never authorized the Respondents to register and use the disputed domain names and that, considering the use they have made of the disputed domain names, they can claim no legitimate interest or *bona fide* use of the disputed domain names, especially due to the fact that they deliberately attempted to create a likelihood of confusion with the Complainant by publishing content that directly refers to the Complainant's field of activity.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering its strong reputation and world renown, it is highly unlikely that the Respondents would not have been aware of the Complainant when registering the disputed domain names, especially considering the trademarks MONTE CARLO and CASINO DE MONTE-CARLO are well-known in the field of gambling.

The Complainant emphasizes that in the "About Us" section of the website to which the disputed domain name <montescarlo.org> resolves, a thorough explanation about the activities, business and the content of the website is provided, referring to the same field of activity as the Complainant.

The Complainant therefore submits that, considering the Respondents claim to be professionals in the field of gambling, they should have been reasonably aware of the Complainant's strong notoriety and of the fact that the Complainant has a strong policy in protecting its intellectual property rights. Nevertheless, they opted to register the disputed domain name <montescarlo.org>, which is a clear proof of bad faith registration.

In addition, the Complainant highlights that, despite the disputed domain name <montescarlo.org> encompasses the wording "Montescarlo", the contents and logos used on the correspondent website always refer to MONTE CARLO without the letter "s".

With reference to the disputed domain name <montecarlo168.co>, the Complainant submits that, though it currently redirects to an inactive website, it was pointed in the past to a website providing gaming and gambling services, also using the same logo as the one illustrated on the website to which <montescarlo.org> resolves.

The Complainant further states that, in view of the degree of distinctiveness and reputation of the Complainant's trademark, the fact that the disputed domain name was registered anonymously and that a good faith use of the disputed domain name <montecarlo168.co> can be excluded given the circumstances of the case, the current passive holding should not prevent a finding of bad faith use.

The Complainant also submits that the Respondent Banana Banana was involved in a prior case, *Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v. Banana banana*, WIPO Case No. [D2021-4320](#), in which the panel ordered the transfer of the domain names <montescarlo.com> and

<montecarlo168.net> to the Complainant.

B. Respondents

The Respondents did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1. Consolidation of multiple Respondents

Paragraph 10(e) of the Rules provides that a panel shall decide a request by a party to consolidate multiple domain name disputes in accordance with the Policy and the Rules.

As stated in section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)".

The Complainant asserted that the disputed domain names, although registered in the name of different named registrants, are under common control since:

- i) the disputed domain names have been registered with the same Registrar;
- ii) the disputed domain names have been pointed to identical websites referring to MONTE CARLO and using the same logo;
- iii) both registrants are located in Thailand and the disputed domain names have been used in connection with websites dedicated to users located in such country;
- iv) the Respondent Banana Banana registered the domain names <montescarlo.com> and <montecarlo168.net>, identical to the disputed domain names and which were transferred to the Complainant pursuant to the panel decision rendered in *Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v. Banana banana*, WIPO Case No. [D2021-4320](#).

The Panel finds that the elements highlighted by the Complainant and referenced above demonstrate that the disputed domain names, which both incorporate the trademark MONTE CARLO, are under common control.

In view of the above, this Panel concludes that the consolidation of the disputed domain names is appropriate in this case and is consistent with the Policy and Rules as well as with prior relevant UDRP decisions in this area (see, amongst others, *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#)).

Therefore, the Panel will now proceed to a decision on the merits of the case.

6.2. Substantive Issues

According to paragraph 15(a) of the Rules: “A Panel shall decide a 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.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain names registered by the Respondents are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark MONTE CARLO based on the trademark registration cited under section 4 above and the related trademark registration certificate submitted as annex F to the Complaint.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain names and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain names.

The Panel finds that the disputed domain names are confusingly similar to the trademark MONTE CARLO as they reproduce the trademark in its entirety within the ccTLD “.co” and gTLD “.org”, which can be disregarded when comparing the similarities between a domain name and a trademark, and the mere addition of the letter “s” and the number “168”, which does not prevent a finding of confusing similarity.

Indeed, where the relevant trademark is recognizable within the disputed domain names, the addition of generic or descriptive terms or even letters, or numbers does not prevent a finding of confusing similarity under the first element (sections 1.8 and 1.9 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain names are confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent’s rights or legitimate interests in respect of the domain names according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the complainant show a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain names 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 names 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.

In the case at hand, by not submitting a Response, the Respondents have failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names.

Moreover, it has been repeatedly stated that when a respondent does not avail itself of its right to respond to a complaint, it can be assumed in appropriate circumstances that the respondent has no rights or legitimate interests in the disputed domain name (*Nordstrom, Inc. and NIHC, Inc. v. Inkyu Kim*, WIPO Case No. [D2003-0269](#)).

According to the evidence on record, there is no relationship between the Complainant and the Respondents and the Complainant has not authorized the Respondents to register or use its trademark or the disputed domain names.

Moreover, there is no indication before the Panel that the Respondents might be commonly known by the disputed domain names.

Indeed, as highlighted above, the disputed domain name <montecarlo168.co>, currently resolving to an inactive website, was pointed in the past to a website providing online gaming and gambling, whilst the disputed domain name <montescarlo.org> still resolves to a website promoting the same services and publishing multiple references to the trademark MONTE CARLO.

Considering the notoriety of the Complainant's trademark MONTE CARLO in the field of casino gaming services, the references to such trademark on the websites corresponding to the disputed domain names and the Respondents' provision of online casino services which directly compete with ones of the Complainant, the Panel finds that the Respondents' use does not amount to a *bona fide* offering of goods or services or a legitimate non-commercial or fair use of the disputed domain names without intention to misleadingly divert consumers or to tarnish the Complainant's trademark. See, along these lines, *La Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v. Whois Agent, Domain Protection Services, Inc. / Nilesh Hirani, Synergy Technical Solutions*, WIPO Case No. [D2017-0507](#).

Therefore, the Panel finds that the Complainant has proven that the Respondents have no rights or legitimate interests in the disputed domain names according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain names were registered and are being used by the Respondents in bad faith.

The Panel finds that, in light of i) the prior registration and use of the Complainant's trademark MONTE CARLO in connection with the Complainant's casino gaming services, ii) the well-known character of the trademark in its sector and iii) the confusing similarity of the disputed domain names with the Complainant's trademark, the Respondents very likely registered the disputed domain names having the Complainant's trademark in mind.

Furthermore, the circumstance that the disputed domain names have been pointed to websites featuring a logo including the wording MONTE CARLO along with a card with aces, gaming chips and a crown, and providing online gaming and gambling services, demonstrates that the Respondents were indeed well aware of the Complainant and its trademark and specifically intended to refer to the Complainant's gambling activities and location within the Principality of Monaco, which is governed by a Sovereign Prince.

The Panel also shares the view of a number of panel findings of "opportunistic bad faith" in the registration of renowned or even somewhat less famous trademarks, as found in *Gateway, Inc. v. Lorna Kang*, WIPO Case No. [D2003-0257](#). Along the same lines, see *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#); *Expedia, Inc. v. European Travel Network*, WIPO Case No. [D2000-0137](#); *Prada S.A. v. Mark O'Flynn*, WIPO Case No. [D2001-0368](#); *Ferrari S.p.A. v. Inter-*

Mediates Ltd., WIPO Case No. [D2003-0050](#), and *The Nasdaq Stock Market, Inc. v. Act One Internet Solutions*, WIPO Case No. [D2003-0103](#). As stated *inter alia* in *DHL Operations B.V v. Net Marketing Group*, WIPO Case No. [D2005-0868](#) “[...] it is obvious that the value and goodwill, of the Complainant’s mark DHL which has an extensive world wide recognition, would have been known to the Respondent at the time of registration of the disputed domain name. The registration and use of the mark by an entity unconnected to the Complainant gives rise to the presumption of opportunistic bad faith”.

The Panel also finds that, by pointing the disputed domain name <montescarlo.org> to a website promoting and offering online gaming and gambling services under the trademark MONTE CARLO using a logo that clearly references to the Complainant, whilst failing to accurately and prominently disclose the relationship with the trademark owner; and by also using in the past the disputed domain name <montecarlo168.co> to publish the same content, the Respondents have intentionally attempted to attract Internet users to their websites for commercial gain, by causing a likelihood of confusion with the trademark MONTE CARLO as to the source, sponsorship, affiliation or endorsement of their websites and the services promoted therein according to paragraph 4(b)(iv) of the Policy.

As to the current resolution of the disputed domain name <montecarlo168.co> to an inactive website, the Panel agrees with prior UDRP panels who have found that passive holding does not prevent a finding of bad faith under certain circumstances, as decided, *i.a.*, in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

In the case at hand, in view of i) the reputation of the Complainant’s trademark MONTE CARLO in the field of casino gaming services; and ii) the Respondents’ failure to respond to the Complaint and the absence of any documented rights or legitimate interests of the Respondents in the disputed domain names, the Panel finds that the current passive holding of the disputed domain names by the Respondents does not prevent a finding of bad faith registration and use. See Section 3.3. of [WIPO Overview 3.0](#).

The Panel also finds that paragraph 4(b)(ii) is applicable in this case since the Respondents registered two additional domain names, encompassing the Complainant’s trademark MONTE CARLO and identical to the two disputed domain names involved in this proceeding (*i.e.* <montescarlo.com> and <montecarlo168.net>), which were transferred to the Complainant pursuant to the decision rendered in *Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v. Banana banana*, WIPO Case No. [D2021-4320](#). As stated in section 3.1.2, “UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner”.

Therefore, the Panel finds that the Complainant has also proven that the Respondents registered and are using the disputed domain names in bad faith according to paragraph 4(a)(iii) of the Policy.

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 names <montecarlo168.co> and <montescarlo.org> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: March 10, 2023