

ADMINISTRATIVE PANEL DECISION

Le Parisien Libere, SAS v. Zox Marketing
Case No. D2023-3711

1. The Parties

Complainant is Le Parisien Libere, SAS, France, represented by Nameshield, France.

Respondent is Zox Marketing, Canada.

2. The Domain Name and Registrar

The disputed domain name <le-parisien.org> (“Domain Name”) 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 September 4, 2023. On September 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 5, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to Complainant on September 6, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on September 7, 2023.

The Center received an email communication from Respondent on September 6, 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 Respondent of the Complaint, and the proceedings commenced on September 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 28, 2023. The Response was filed with the Center on September 19, 2023.

The Center appointed Marina Perraki as the sole panelist in this matter on September 28, 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

Complainant is a French daily newspaper covering both international, national news and local news of Paris and its suburbs. The Complainant was established in 1944 and the newspaper was published for the first time on August 22, 1944.

Complainant owns trademark registrations for LE PARISIEN, including French trademark registration No. 98732442 for LE PARISIEN (word), registered on May 14, 1998. Complainant also owns domain name registrations for LE PARISIEN, including the domain name <leparisien.com>, registered on February 3, 1997, and <leparisien.fr>, registered on February 9, 2009.

The Domain Name was registered on August 31, 2023. At the time of filing of the Complaint it resolved to an error page. After the Complaint was filed, however, it resolved to a website (“Website”) with text in French with titles such as “chats sur webcam” (chats on webcam in English), “adultere” (adultery in English), “rencontres” (meetings in English), “Le guide ultime pour monter les échelons à Paris” (the ultimate guide to climb stairs in Paris, in English) with article titles that all bear the date 4 or 5 September 2023, duration of reading 1 or 2 minutes and refer, for example, to the best restaurants in Paris for a healthy diet or the best supplements for musculation and where to find them in Paris. At the bottom of the Website there was a statement “© 2023, Le Parisien | Le guide ultime pour monter les échelons à Paris”.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name. Namely, Complainant contends that the Domain Name is identical to its LE PARISIEN trademark, Respondent has no rights or legitimate interests in respect of the Domain Name, and; the Domain Name was registered and is being used in bad faith.

B. Respondent

Respondent an email communication to the Center on September 19, 2023, stated that it has legitimate interests in the Domain Name and was not acting in bad faith that it was not aware of Complainant and its LE PARISIEN trademark as it is based in Canada; that words like “Paris” are of common place and the registration of the trademark of Complainant violates free speech; that it would not be targeting Complainant as it is a domain investor and also registered the domain name <le-marseillais.org> on the same day of the registration of the Domain Name, that applying French trademark law to a resident of Canada raises jurisdictional issues. Lastly and although it did not admit to any guilt, Respondent proposed a settlement to Complainant for the amount of 500 USD.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Domain Name incorporates Complainant's trademark in its entirety with the sole addition of a hyphen between the words "le" and "parisien". This is sufficient to establish confusing similarity. (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7).

The generic Top-Level Domain ("gTLD") ".org" is disregarded, as gTLDs typically do not form part of the comparison for the confusing similarity test under the first element on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)). See also [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Domain Name is confusingly similar to Complainant's trademark.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, Respondent's 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) Respondent (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) Respondent is 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.

The Panel finds that Respondent lacks rights or legitimate interests in respect of the Domain Name.

As per Complainant, Respondent was not authorized to register the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, at the time of filing of the Complaint, the Domain Name resolved to an error page.

Respondent argues that it has rights or legitimate interest because the Domain Name is a common place word. Merely registering a domain name comprised of a dictionary word does not by itself automatically confer rights or legitimate interests on the respondent ([WIPO Overview 3.0](#), section 2.10). 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 ([WIPO Overview 3.0](#), section 2.10). Respondent does not claim or prove that it used or intended to use the Domain Name in accordance with such geographical meaning. Moreover, as panels tend to assess claimed respondent rights or legitimate interests at the time of the filing of the complaint, Respondent's use of the Domain Name to resolve to the Website cannot support any claims of rights or legitimate interests in the Domain Name as the Website was made available only after the filing of the Complaint([WIPO Overview 3.0](#) section 2.11).

Respondent further provides an example of its domain name registrations. There is nothing wrong *per se* in owning a portfolio of domain names provided that the circumstances do not indicate illegitimate conduct or bad faith. However, the Panel also considers that owning a portfolio of domain names would not by itself give rise to rights or legitimate interests in a disputed domain name, particularly if the latter was registered to take advantage of the mark of another ([WIPO Overview 3.0](#), section 2.10). Then, it seems relevant to consider whether, on the balance of probabilities, Respondent registered and used the Domain Name with a likely knowledge of Complainant's trademark, registering it due to its similarity. The Panel incorporates here its discussion from the next section concerning Respondent's registration and use of the Domain Name in bad faith.

The Panel finds that Complainant has established a *prima facie* case under this element of the Policy, and the circumstances of this case do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Name in "bad faith":

(i) circumstances indicating that 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 that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that 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 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, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that it is more likely than not that Respondent has registered and used the Domain Name in bad faith. Because the LE PARISIEN trademark had been used and registered at the time of the Domain Name registration by Respondent, noting the composition of the Domain Name, the Panel finds that Respondent knew of Complainant's mark when registering the Domain Name, and probably registered it due to its similarity to the LE PARISIEN mark of Complainant.

Respondent's allegation that it was not aware of Complainant based in France and the LE PARISIEN trademark because it is based in Canada are not convincing in view of the long online presence of Complainant demonstrated mainly through its website at "www.leparisien.com".

The Panel notes that Respondent claims to be a domain name investor and provides an example of another domain names in its portfolio namely <le-marseillais.org>. While it may be that Respondent is also interested in the acquisition of geographical domain names, that is not sufficient to establish in the circumstances of this case that Respondent acquired the Domain Name only due to it corresponding to a geographical domain name. The Panel notes that the circumstances of this case point towards a likely knowledge of Complainant, in view *inter alia* of Complainant's Internet presence.

In addition, Respondent offered the Domain Name for sale for an amount that apparently exceeded the acquisition price. This, in view of the circumstances of the case, where the Panel finds it probable that Respondent knew of Complainant's mark the Panel finds that the offer for sale for an amount substantively over the out-of-pocket costs constitutes further evidence of bad faith (*Aygaz Anonim Şirketi v. Arthur Cain*, WIPO Case No. [D2014-1206](#); [WIPO Overview 3.0](#), section 3.1).

Additionally, the Domain Name was registered using a privacy service. The use of a privacy protection service is a further indication of bad faith in the circumstances of this case.

Under these circumstances and on this record, the Panel finds that Respondent registered and is using the Domain Name in bad faith.

Complainant has established Policy, paragraph 4(a)(iii).

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 Domain Name, <le-parisien.org>, be transferred to the Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: October 12, 2023