

ADMINISTRATIVE PANEL DECISION

Panavision International, L.P. and Panavision Inc. v. Ahmad Elhaj,
Panavision
Case No. D2024-4115

1. The Parties

Complainants are Panavision International, L.P. and Panavision Inc., United States of America (“United States” or “U.S.”) (collectively, the “Complainant”), represented by Bryan Cave Leighton Paisner LLP, United States.

Respondent is Ahmad Elhaj, Panavision, United States.

2. The Domain Name and Registrar

The disputed domain name <panavisionco.com> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2024. On October 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 8, 2024, 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 (Contact Privacy Inc. Customer 0171673095) and contact information in the Complaint.

The Center sent an email communication to Complainant on October 9, 2024, 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 October 12, 2024.

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 October 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on November 7, 2024.

The Center appointed John C. McElwaine as the sole panelist in this matter on November 12, 2024. 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 leading provider of high-precision camera systems and lenses for the motion picture and television industries. Relevant to this matter, Complainant owns numerous trademark registrations worldwide, including:

- PANAVISION (Stylized) (U.S. Registration No. 627,362) registered on May 22, 1956 for “anamorphosers that are used in the projection and taking of motion pictures” in International Class 9;
- PANAVISION (U.S. Registration No. 845,014) registered on February 27, 1968 for “motion picture films produced by special purpose or conventional lenses supplied by applicant” in International Class 16; and
- PANAVISION (U.S. Registration No. 834,705) registered on September 5, 1967 for “motion picture cameras and lenses therefor and associated photographic equipment” in International Class 9.

Collectively, these registered trademark rights are referred to as the “PANAVISION Mark”.

The Domain Name was registered on July 5, 2024. The Domain Name resolves to a website that appears to offer clothing for sale.

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.

Complainant alleged that it and its related and affiliated entities, provide a comprehensive suite of end-to-end production and post production services to the largest studios, networks, independent production companies and over-the-top (“OTT”) content streaming providers. Complainant asserts that it is the world's most recognized providers of ultra-precision digital imaging and visual cinematographic equipment, including cameras, optical lenses, photographic and related lighting equipment, and accessories. Founded in 1954, Complainant has consistently been at the forefront of cinematographic equipment development.

Complainant contends that its lenses and imaging equipment sold under the PANAVISION Mark are used by the most well-known and respected filmmakers in the world, and many of the most successful and highly acclaimed films of all time have been photographed using Complainant's camera systems, lenses, lighting equipment and other equipment, including such well-known films as Barbie, Oppenheimer, Deadpool & Wolverine, Dunkirk, Mean Girls, Star Wars, and Guardians of the Galaxy 2. Indeed, Complainant claims to have won numerous prestigious awards, including “Oscar” awards from the American Academy of Motion Picture Arts and Sciences, and “Emmy” awards from the Academy of Television Arts & Sciences.

With respect to the first element of the Policy, Complainant asserts that the Domain Name wholly incorporates Complainant's PANAVISION Mark and simply adds the letters "co". Complainant contends that the addition of the letters "co" to the Domain Name should be disregarded.

With respect to the second element of the Policy, Complainant alleges that Respondent has no rights or legitimate interests in the Domain Name because Respondent is not in any way associated with Complainant and has never sought nor received authorization or a license to use Complainant's valuable, famous and distinctive PANAVISION Mark in any way or manner. There is no evidence that Respondent is commonly known by "Panavision", "Panavision Co" or any other variation thereof.

With respect to the third element of the Policy, Complainant alleges that Respondent registered and is using the Domain Name in bad faith, as evidenced by the fact that Respondent registered the Domain Name nearly sixty-eight years after Complainant and its predecessors began using the PANAVISION Mark, and well after Complainant became one of the world's leaders in the field of ultra-precision visual cinematographic and digital imaging equipment for the motion picture, television, and related industries. Additionally, Complainant alleges that upon information and belief, the Domain Name redirects to the <shopcobeyou.com> domain name, which is being used to advertise, market, offer for sale, and sell clothing goods.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Even though Respondent has defaulted, paragraph 4(a) of the Policy requires that, in order to succeed in this UDRP proceeding, Complainant must still prove its assertions with evidence demonstrating:

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

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows.

A. Identical or Confusingly Similar

The Panel finds that Complainant has established rights in the PANAVISION trademark through its numerous trademark registrations worldwide for PANAVISION, including the registrations for the PANAVISION Mark, discussed supra.

As stated in section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy.

The Domain Names incorporate Complainant's PANAVISION Mark in its entirety, with the addition of the term "co". As noted in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element. The Panel finds that the PANAVISION Mark is clearly recognizable within the Domain Name.

Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in the Domain Name. Complainant need only make a prima facie showing on this element, at which point the burden of production shifts to Respondent to present evidence that it has rights or legitimate interests in the Domain Name. If Respondent has failed to do so, Complainant is deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy.

Complainant has established that it has not licensed or otherwise permitted Respondent to use any of its trademarks or to apply for or use any domain name incorporating any of those marks. As set forth above, Respondent adopted and continues to use the Domain Name that wholly incorporates Complainant's PANAVISION Marks for the illegal and improper purpose of (i) illegally trading upon Complainant's goodwill to confuse, mislead, deceive and divert customers; and (ii) intentionally diluting Complainant's valuable and well-known trademarks.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy¹

The Panel finds that Respondent's use of the Domain Name to redirect to <shopcobeyou.com> to sell clothing goods is not a legitimate use. Panels have consistently held that use of a famous mark, "even if it is in connection with an otherwise legitimate business, does not provide a right or legitimate interest for the purposes of the Policy". *Harry Winston Inc. and Harry Winston, S.A. v. Harry Pluiose*, WIPO Case No. [D2010-0210](#). The use of another's famous trademark to divert interest to one's product that would otherwise not exist does not constitute a bona fide offering of goods so as to confer legitimate interests upon Respondent.

Furthermore, the PANAVISION Marks are made up of an invented word, and as such, third parties would not legitimately choose this name unless seeking to intentionally create an impression of an association with Complainant. The Panel finds particularly relevant that Respondent registered the Domain Name using "Panavision" as its organization name and "contact.panavision@[...]" as its contact email, further evidencing an attempt to create a false association with Complainant.

Accordingly, the Panel finds that Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name, which Respondent has not rebutted. The Panel concludes that Complainant has satisfied the second element of the Policy.

¹ The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name: "(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."

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

As noted in section 3.1.4 of the [WIPO Overview 3.0](#), the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Bad faith registration can also be found where respondents “knew or should have known” of the complainant’s trademark rights and nevertheless registered a domain name in which they had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). Here, Respondent registered the Domain Name nearly sixty-eight years after Complainant began using the PANAVISION Mark, and well after Complainant became one of the world’s leaders in the field of ultra-precision visual cinematographic equipment.

Furthermore, Respondent is using the Domain Name to redirect to <shopcobeyou.com> to sell clothing goods, intentionally attempting to attract Internet users for commercial gain by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website. Such use constitutes bad faith under paragraph 4(b)(iv) of the Policy. The Panel also notes that the fact that Respondent initially used a privacy shield for registration of the Domain Name is further evidence of bad faith.

In light of these circumstances, particularly Respondent’s intentional registration of a domain name incorporating Complainant’s famous mark to divert Internet traffic and dilute the distinctiveness of the PANAVISION Mark, the Panel concludes that the Domain Name was registered and is being used in bad faith.

Complainant has satisfied the third element 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 Domain Name, <panavisionco.com>, be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: November 26, 2024