

ADMINISTRATIVE PANEL DECISION

ARSENE v. arsene

Case No. DAU2024-0019

1. The Parties

The Complainant is ARSENE, France, represented by CLEACH AVOCATS, France.

The Respondent is arsene, Australia, self-represented.

2. The Domain Name and Registrar

The disputed domain name <arsene.com.au> is registered with GoDaddy.com, LLC (“the Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 31, 2024. On July 31, 2024, the Center transmitted by email to the Registrar, a request for registrar verification in connection with the disputed domain name. On August 1, 2024, 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 (Eric Vanpeperstraete) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 7, 2024, 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 August 8, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 12, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was September 1, 2024. The Response was filed with the Center on August 31, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on September 4, 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

The Complainant is a French law firm, composed of more than 100 lawyers specialising in taxation, customs, and corporate law. According to the Complaint, the Complainant has been providing national and international clients with a diverse range of services in the fields under the name “ARSENE-TAXAND” for almost 20 years.

In 2023, “Best Lawyers” ranked the Complainant as amongst the best law firms in France for Tax Law. It was ranked Tier 2 by Legal 500 for Tax law services in France “as a credible alternative to ‘Big Four’ firms”. Chambers ranked two of the Complainant’s principals in Band 2 in its Europe 2023 profiles.

The Complainant also founded the international network of tax and corporate law advisers, “TAXAND”, comprising more than 400 partners and 2,000 tax specialists in 48 countries, including Australia.

Amongst other things, the Complainant registered the domain names <arsene-taxand.com> on March 20, 2007, and <arsene-avocats.com> on December 22, 2003. While the Complaint states both resolve to the Complainant’s active website, the Panel was able to access a website at “www.arsene-taxand.com” which does promote the Complainant’s services. Entering the second domain name in a browser generated a message “You don’t have permission to access on this server” at “www.wmaker.net”.

The Complainant claims to be the exclusive licensee of a number of trade marks registered by Société Civile Phoenix:

- (a) French Registered Trade Mark No 3263433, filed on December 17, 2003 and entered on the Register on March 2, 2007;
- (b) European Union Trade Mark No 018004249, filed on December 21, 2018 and entered on the Register on May 17, 2019;
- (c) United Kingdom Registered Trade Mark No UK00918004249, filed on December 21, 2018 and entered on the Register on May 17, 2019; and
- (d) International Registration No 1453924, which was registered on December 24, 2018 designating Switzerland.

However, the licence agreement provided in support of this claim appears to relate only to exploitation of the trade mark in France. (For the reasons discussed below, nothing substantive turns on this apparent discrepancy.)

Each Registered Trade Mark is for ARSENE and is registered in respect of accounting, financial, tax and legal services in International Classes 35, 36, and 45.

The disputed domain name was registered on October 18, 2023.

At this point in time, it does not resolve to an active website. Instead, it resolves to a parking page provided by the Registrar. When the Complaint was filed, there were three pay-per-click (“PPC”) advertising links on the page: “Acquisition de Prospects”, “Paiement Instantané”, and “Gestion de Tickets” (respectively, according to Google Translate “Prospect Acquisition”, “Instant Payment”, and “Ticket Management”). The Complaint does not include screenshots of what those links linked through to. The PPC links appear to have been removed during the course of the proceeding.

The parking page includes the usual link to GoDaddy’s domain name broking service offering to attempt to “buy” the disputed domain name. The advertisement includes a notice that using the service will incur an EUR 131.99 brokerage fee.

Earlier, on October 17, 2023, Eric Vanpepenstraete registered the business name “Arsene” as a sole trader mainly located in New South Wales.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark 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 or subsequently used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the 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 the Panel deems applicable.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s name, trade mark or service mark.

The Complainant has proven ownership of the several Registered Trade marks for ARSENE identified in section 4 above.

The Complainant has provided evidence of its exclusive licence and satisfaction of the notice requirements under the terms of that licence to bring these proceedings. Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDA Overview 2.0”), section 1.4.2.

On the question of identity or confusing similarity, what is required is simply a visual or aural comparison and assessment of the disputed domain name itself to the Complainant’s trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#). This test is narrower than and thus different to the question of “likelihood of confusion” under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any impugned use is involved, geographical location or timing. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

That none of the Complainant’s trade marks are registered in Australia is not a bar to finding this requirement under the Policy satisfied. auDA Overview 2.0, section 1.2.1.

Typically and as is appropriate in this case, it is permissible to disregard the Second Level Domain, “.com.au”, as a functional component of the domain naming system. See for example auDRP Overview 2.0, section 1.11.

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant’s trade mark and the Complainant has established the first requirement under the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed 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 (not being the offering of domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Previous panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent under this head and an evidential burden will shift to the respondent to rebut that prima facie case. The ultimate burden of proof, however, remains with the Complainant. See e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, supra.

It is not in dispute between the Parties that neither the Complainant nor its licensor (Société Civile Phoenix) have authorised the Respondent to use ARSENE in the disputed domain name. Nor is the Respondent affiliated with them in any way. Further, the disputed domain name was registered well after the Complainant registered its trade mark rights. The Complainant points out the Respondent (in his own name) has an online presence as the managing director of “Certifer Solutions Australia”, which promotes itself as a global leader in certification and independent assessment of urban and rail transportation.” The Complainant further relies on the lack of any active website and the presence of the PPC links and the GoDaddy brokerage service to establish that the Respondent is not making a good faith offering of goods or services or otherwise engaging in fair use of the disputed domain name.

These factors are sufficient to establish the required prima facie case.

In response, the Respondent states that he registered the disputed domain name in connection with a proposed business in a men’s luxury leather goods brand in Australia. The Respondent has not explained how he came to choose the name “Arsene” for this proposed business.

However, the Respondent has provided evidence of a contract a “company” apparently called “Arsene Pty Ltd” entered into with Sapaf SRL in Italy. This contract was executed by the Italian company on January 23, 2024. By this contract, the “company” commissioned Sapaf SRL to develop a sample bag according to a range of specifications set out in the contract. The contract refers to the ownership of intellectual property in the products of the commission being in accordance with the arrangements of “the on-going NDA” signed by both parties on June 21, 2023. (The terms of that NDA have not been disclosed in this proceeding.)

The Panel’s search of the online companies register maintained by the Australian Securities and Investments Commission (ASIC) does not disclose any company registered under the name “Arsene Pty Ltd”. The Australian Business Number (ABN) recorded in the contract against the “company”, however, is the Respondent’s ABN. Accordingly, the Panel takes it as a contract with the Respondent.

The Response also includes two invoices dated January 17, 2024 from Sapaf SRL to the “company”. The first is for the production of a paper model and felt prototype of a luxury men’s duffel bag. The expected delivery date was April 19, 2024. The second is for the development of three leather prototypes which were expected to be delivered by May 31, 2024. In addition, the Response includes photographs the Respondent and his business partner visiting the studio of Sapaf SRL in June 2024.

According to the Respondent, production of the bags is expected to be completed by January 2025. The Response further includes evidence that the Complainant has arranged for a copywriter to be on “standby” to prepare the content of the website once the bags become available for sale.

The Panel does not consider that the Registrar’s offering of its domain broking service on the parking page constitutes an offering of a domain name for sale, rental or other transfer in violation of paragraph 4(b)(i) of the Policy. This is an automatic, or nearly automatic, consequence of such parking arrangements. Unlike many cybersquatting cases, there is no evidence that the disputed domain name was actually being offered for sale. While the Complainant is correct that EUR 131.99 is considerably in excess of the standard fee for registering a domain name in the “.com.au” domain space, that was not an offer by the Respondent but, rather, the brokerage fee which GoDaddy would charge if someone wished to approach the Respondent to make an offer.

The presence of PPC advertising links will very often, if not usually, lead to a finding disqualifying rights or legitimate interests under the Policy in the absence of efforts by the registrant to suppress such links. auDA Overview 2.0, section 2.9.

In the present case, such use appears to have been temporary only and promptly removed. Furthermore, the Respondent’s evidence referred to above appears to indicate that the Respondent is making demonstrable preparations to use the disputed domain name in connection with the proposed business in luxury men’s luggage. See e.g. auDA Overview 2.0, section 2.2.

These facts distinguish the present case from *Odaseva Technologies SAS LLC v. Taku Taneka, The Feature Enterprises Pty Ltd*, WIPO Case No. [DAU2021-0032](#), which the Complainant relies on. For example, the learned panelist in that case expressly held:

“the Response does not use the disputed domain name in connection with that alleged meaning and it does not provide any evidence of any preparations to do so, despite having registered the disputed domain name a year ago.”

The Complainant has referred to the fact that its “TAXAND” network operates in Australia. The evidence in the Complaint of those operations is a document which features the trade mark TAXAND. The Complainant’s trade mark ARSENE does not appear to have been used at all in the document. In these circumstances, the Complainant’s evidence falls far short of demonstrating it has any reputation in ARSENE in Australia.

Moreover, as the Respondent contends, the Complainant’s fields of accountancy, financial, tax, and legal services seem very different to the field of the Respondent’s proposed business. As a result, it seems unlikely that someone would mistakenly assume a connection between the two – at least on the evidence before the Panel – and bearing in mind also that “Arsene” is a male forename in French-speaking countries.

Bearing in mind the apparent lack of any use of ARSENE by the Complainant or its network in Australia and the very different fields of activity (or proposed activity) of the Parties, the Panel is not willing to infer that the Respondent must have been aware of the Complainant’s trade mark and is seeking to take advantage of that trade mark’s reputation and goodwill.

In these circumstances, the Panel finds that the Respondent has rebutted the Complainant’s prima facie case by demonstrating the circumstances set out in paragraph 4(c)(i).

C. Registered or Subsequently Used in Bad Faith

As the Complaint must fail, no good purpose would be served by addressing this requirement under the Policy.

6. Decision

For all the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: September 18, 2024