

## **PANEL DECISION**

### **POUJOLAT SA v. Zoran Ristic**

### **Case No. DEU2022-0033**

#### **1. The Parties**

The Complainant is Poujoulat SA, France, represented by Ebrand France, France.

The Respondent is Zoran Ristic, Serbia.

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

The Registry of the disputed domain name <poujoulat.eu> is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the disputed domain name is EURid vzw.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 18, 2022. On October 18, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On October 19, 2022, the Registry transmitted by email to the Center its verification response. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on October 24, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 31, 2022. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was December 12, 2022. The Respondent sent informal email communications to the Center on November 12, 2022, and November 17, 2022. On November 18, 2022, the Complainant requested to suspend the proceedings. The Center sent a Notification of Suspension to the parties on November 18, 2022. The Respondent sent an informal communication to the Center on November 28, 2022. The Complainant requested to reinstitute the proceedings on November 29, 2022. The Center reinstated the proceeding on November 30, 2022, and the due date for response was December 21, 2022. The Respondent did not submit any formal response.

The Center appointed Luca Barbero as the sole panelist in this matter on January 18, 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 ADR Rules, Paragraph B(5).

#### **4. Factual Background**

The Complainant is a European leader in the flue and industrial chimney markets. Created in 1950, it is now present in 8 countries (France, Germany, United Kingdom, Belgium, Switzerland, the Netherlands, Denmark and Poland), it has 11 factories and exports to 30 countries, working with more than 1700 employees. The Complainant had a turnover of EUR 302.200.000 between 2021 and 2022.

The Complainant is the owner of the following trademark registrations for POUJOULAT:

- French trademark registration No. 3346567 for POUJOULAT (word mark), filed on March 11, 2005, in international classes 6, 17 and 19;

- International trademark registration No. 874076, for POUJOULAT (word mark), registered on September 12, 2005, in international Classes 6 and 19, designating amongst others Austria, Benelux, Germany, Denmark, Spain, Italy, Latvia, Poland and Portugal.

The Complainant is also the owner of numerous domain names, including <poujoulat.com>, registered on September 25, 1997, <poujoulat.fr>, registered on April 19, 1998 and <poujoulat.group>, registered on June 8, 2016, all used by the Complainant to promote its products under the trademark POUJOULAT.

The disputed domain name <poujoulat.eu> was registered on June 29, 2022, and is not pointed to an active website.

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

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

The Complainant contends that the disputed domain name <poujoulat.eu> is identical to the Complainant's trademark POUJOULAT and to the Complainant's domain names, including <poujoulat.com> and <poujoulat.fr>.

The Complainant states that, considering the Complainant is the owner of French and International trademark registrations for POUJOULAT, registered in Classes 6, 17 and 19, specifically for chimney flues, as well as of numerous domain names composed of the trademark POUJOULAT, and that all such registrations predate the registration of the disputed domain name, the Respondent must have undoubtedly been targeting the Complainant when registering the disputed domain name.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that, since the disputed domain name does not resolve to an active website, the Respondent has not used the disputed domain name in connection with the offering of goods or services and has not made demonstrable preparation to do so, nor has it made a legitimate and non-commercial or fair use of the disputed domain name, without intent to mislead consumers or to damage the reputation of a name in which a right is recognized or established by national and/or European Union law.

The Complainant also states that the Respondent is not commonly known by the disputed domain name and highlights that online searches for the term "Poujoulat", including on the WIPO Global Brand Database, return results that are exclusively related to the Complainant.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, at the time of the registration of the disputed domain name, the Respondent could not ignore the prior rights of the Complainant on the trademark POUJOLAT, considering a simple search on an Internet search engine shows numerous results related to the Complainant.

The Complainant notes that the Respondent is passively holding the disputed domain name, since it is not pointed to any active website, and submits that the Respondent registered the disputed domain name in order to prevent the Complainant from reflecting its trademark in a corresponding domain name as well as with a view to sell it to the Complainant, as it is sold on the "sedo.com" website for EUR 3.999.

## **B. Respondent**

The Respondent did not formally reply to the Complainant's contentions, however on November 12, 2022, the Center received an informal communication from the Respondent's representative, stating that the Respondent would be willing to transfer the disputed domain name without any obligations, but requesting that the Complainant devolve a certain sum to a Charity of its choice.

A further informal communication was sent to the Center on November 17, 2022, acknowledging the Center's communication dated November 14, 2022, and confirming that a request for authorization code had been sent to the registrar and would be available as soon as possible.

On November 23, 2022, (following suspension of proceedings requested by the Complainant to reach an agreement, dated November 18, 2022), a third informal communication was sent to the Center stating that the authorization code could not be sent as the disputed domain name was on hold and providing proof of the status.

On November 24, 2022, the Respondent's representative sent a further communication stating the disputed domain name had been unblocked, only to confirm again on November 28, 2022, that it was still on hold and that the procedure could not be completed due to the present pending proceeding.

## **6. Discussion and Findings**

Under Paragraph B(11)(d)(1) of the ADR Rules the Complainant is required to demonstrate the following:

- (i) that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a Member State and/or European Union law; and either
- (ii) that the disputed domain name has been registered by the Respondent without rights or legitimate interests in the name; or
- (iii) that the disputed domain name has been registered or is being used in bad faith

Paragraph B(11)(b) of the ADR Rules, stating that the sole remedies available pursuant to an ADR proceeding where the Respondent is the domain name holder in respect of which domain name the complaint was initiated shall be limited to revocation or to the transfer of the domain name to the Complainant provided that it satisfies the eligibility criteria established for the registration of .eu domain names.

### **A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law**

Paragraph B(11)(d)(1)(i) of the ADR Rules determines that the Panel shall issue a decision granting the remedies requested in the event that the Complainant proves "The domain name is identical or confusingly similar to a name in respect of which a right is recognized by the national law of a Member State and/or Community law".

The Panel finds that the Complainant has established rights over the trademark POUJOLAT based on the trademark registrations cited under section 4 above, namely the French trademark No. 3346567 and the International trademark No. 874076, designating amongst others Austria, Benelux, Germany, Denmark, Spain, Italy, Latvia, Poland and Portugal.

The Panel notes that the Complainant's trademark POUJOLAT is entirely reproduced in the disputed domain name, with the mere addition of the .eu country code Top-level Domain ("ccTLD") suffix which, as stated in several prior cases, is disregarded, being a mere technical requirement for registration.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is identical to a name in respect of which it has rights, according to the first requirement of Paragraph B(11)(d)(1)(i) of the ADR Rules.

## **B. Rights or Legitimate Interests**

According to Paragraph B(11)(e) of the ADR Rules, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights or legitimate interests in a domain name:

- (a) prior to any notice of the dispute, the Respondent has used the domain name or a name corresponding to it in connection with the offering of goods or services or has made demonstrable preparations to do so;
- (b) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;
- (c) the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognised or established by national and/or Community law.

The Complainant is required to make a *prima facie* case that the Respondent lacks rights or legitimate interests and, once such *prima facie* case is made, the burden of production shifts to the Respondent to submit appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element.

In the present case, the Panel finds that the Complainant has made out a *prima facie* case and that the Respondent has failed to demonstrate rights or legitimate interests in the disputed domain name.

It is clear that the Complainant is not related to the Respondent and has not authorized the Respondent to use its trademark POUJOLAT in any way. In addition, there is no indication before the Panel that the Respondent might be commonly known by the disputed domain name.

Moreover, there is no evidence that the Respondent might have used the disputed domain name in connection with an offering of goods or services or a legitimate and non-commercial or fair use since, as mentioned above, the disputed domain name has not been pointed to an active website.

Furthermore, since the disputed domain name is identical to the Complainant's trademark, users may believe that it is owned by the Complainant or one of the Complainant's affiliated entities with the Complainant's consent. As stated in section 2.5.1 of the [WIPO Overview 3.0](#), "Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation"<sup>1</sup>.

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<sup>1</sup> Considering the substantive similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy (the "UDRP"), the Panel also refers to UDRP case law and analysis, where appropriate.

In light of the foregoing, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to the second requirement of Article 21 (1) of the Regulation and Paragraph B(11)(d)(1)(ii) of the ADR Rules.

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

There is no need to separately address bad faith registration or use, in view of the Panel's finding that the Respondent lacks rights or legitimate interests in the disputed domain name. However, for the sake of completeness, the Panel will also briefly examine the registration or use of the disputed domain name in bad faith.

According to Paragraph B(11)(d)(1)(iii) of the ADR Rules a Complainant is required to demonstrate that a domain name has been registered or used in bad faith.

Paragraph B(11)(f) of the ADR Rules provide a non-exhaustive list of circumstances which, if found by the Panel to be present, may be evidence of the registration or use of a domain name in bad faith:

- (1) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognized or established by national and/or European Union law, or to a public body; or
- (2) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognized or established by national and/or European Union law, or a public body, from reflecting this name in a corresponding domain name, provided that:
  - (i) the Respondent has engaged in a pattern of such conduct; or
  - (ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or
  - (iii) there are circumstances where, at the time the ADR Proceeding was initiated, the Respondent has declared its intention to use the domain name, in respect of which a right is recognized or established by national and/or Community law or which corresponds to the name of a public body, in a relevant way but failed to do so within six months of the day on which the ADR Proceeding was initiated;
- (3) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or
- (4) the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent; or
- (5) the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered.

The Panel notes that, in light of the Complainant's prior registration and use of the trademark POUJOLAT in connection with the promotion and sales of the Complainant's products in Europe, also online via the Complainant's official websites at <poujoulat.com>, <poujoulat.fr> and <poujoulat.group>, and considering that searches for POUJOLAT on main search engines return results exclusively referred to the Complainant and its trademark in the first pages, the Respondent was or could have been aware of the Complainant and its trademark when it registered the disputed domain name, which is identical to the Complainant's trademark and domain names.

Considering the disputed domain name is identical to the Complainant's trademark, which appears to have no meaning in any language and to be a trademark exclusively associated with the Complainant, and has been offered for sale for EUR 3.999 on the "sedo.com" website, the Panel also finds that, on balance of probabilities, the Respondent registered the disputed domain name primarily for the purpose of selling it to the Complainant, which is the holder of a name in respect of which a right is recognized by national laws, according to Paragraph B(11)(f)(i) of the ADR Rules.

In light of the circumstances of the case, the Panel also finds that the current passive holding of the disputed domain name does not prevent a finding of bad faith.

In view of the above, the Panel finds that the disputed domain name was registered and is being held in bad faith and thus the Complainant has also met the requirement of Paragraph B(11)(d)(1)(ii) of the ADR Rules.

## 7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <poujoulat.eu> be transferred to the Complainant, which satisfies the general eligibility criteria for registration set out in Article 3 of Regulation (EU) No 2019/517, being an undertaking that is established in the European Union<sup>2</sup>.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: February 1, 2023

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<sup>2</sup> The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction, as defined in Paragraph A(1) of the ADR Rules.