

ADMINISTRATIVE PANEL DECISION

Interbasic Holding S.A. v. Francois Carrillo

Case No. D2012-0656

1. The Parties

The Complainant is Interbasic Holding S.A. of Luxembourg, Luxembourg represented by Studio Turini, Italy.

The Respondent is Francois Carrillo of Everett, Washington, United States of America (“U.S.”) represented by The Muscovitch Law Firm, Canada.

2. The Domain Name and Registrar

The disputed domain name <zut.com> (the “Disputed Domain Name”) is registered with Moniker Online Services, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 29, 2012. On March 29, 2012, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 30, 2012, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 2, 2012. In accordance with the Rules, paragraph 5(a), the due date for the Response was April 22, 2012. The Response was filed with the Center on April 20, 2012.

The Center appointed John Swinson, Fabio Angelini and Diane Cabell as panelists in this matter on May 9, 2012. The Panel finds that it was properly constituted. Each member of 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 Interbasic Holding S.A., a company located in Luxembourg. The Complainant currently owns the IP rights of Elsa Schiaparelli, a deceased Italian fashion designer.

The Complainant is the owner of the following trade marks:

- (i) ZUT, International Trade Mark No. 701302 (registered October 20, 1998);
- (ii) ZUT, U.S. Trade Mark No. 2881956 (filed October 30, 1999 and registered September 7, 2004); and
- (iii) ZUT, Community Trade Mark No. 5951843 (registered May 21, 2007) (together, the "Trade Marks").

The Respondent is Francois Carrillo, a French citizen residing in Juvignac, France. The Respondent is the administrator of the business, Cybertonic, which was registered with the Tribunal De Commerce De Montpellier on August 1, 2004.

The Respondent purchased the Disputed Domain Name at a Sedo auction in 2008 for EUR 8,600.

5. Parties' Contentions

A. Complainant

The Complainant makes the following submissions.

Identical or Confusingly Similar

Elsa Schiaparelli was an Italian fashion designer. Nowadays she is a fashion icon whose creations are well-known around the world. She was one of the most important figures in haute couture between the World Wars and was famous for her collaboration with contemporary artists (e.g., Salvador Dali). Her clients included Greta Garbo, Wallis Simpson and Mae West.

Ms Schiaparelli's perfumes were noted for their fragrance, unusual packaging and bottles. In 1948, she created the fragrance "Zut", which means "damn" in French and was considered a rude expletive at the time. The fragrance had a bottle shaped like a leg, which caused great scandal when it was released. The fragrance was re-launched in 1998, on its 50th anniversary.

The Complainant is the exclusive owner of numerous trade marks for "Zut", including the Trade Marks. The Disputed Domain Name and the Trade Marks are identical.

Rights or Legitimate Interests

The following establish *prima facie* evidence that the Respondent has no rights or legitimate interests in the Disputed Domain Name:

- (i) the Respondent is not commonly known by the Disputed Domain Name; and
- (ii) the Complainant has not authorized, licensed or otherwise allowed the Respondent to use the name "Zut", or to apply for any domain name incorporating its Trade Marks.

Registered and Used in Bad Faith

The Disputed Domain Name was registered and is being used in bad faith.

The Complainant had at least one of the Trade Marks registered four years before the registration of the Disputed Domain Name. There is no evidence that the Respondent made reasonable efforts to establish whether any third party had rights in the Disputed Domain Name (see e.g., *SportSoft Golf, Inc. v. Hale Irwin's Golfers' Passport*, NAF Claim No. FA94956; *Marriott International Inc. v. John Marriot*, NAF Claim No. FA94737; *Centeon L.L.C./Aventis Behring L.L.C. v. Ebiotech.com*, NAF Claim No. FA95037).

The Respondent is not making a *bona fide* offering of goods or services with the Disputed Domain Name. It was selected with clear intent for commercial gain, to be achieved by its sale to the highest bidder at auction. The url "www.zut.com" leads to a website which shows advertisements of the website "www.catchy.com" and auctions the Disputed Domain Name for a starting price of USD 90,000 and a reserve price of USD 120,000.

The Respondent has refused to voluntarily transfer the Disputed Domain Name. The Complainant has expressed its interest in purchasing the Disputed Domain Name on three occasions. The Respondent replied with "Zut!" on the first occasion and did not reply to the further offers. This supports a finding of bad faith registration and use (see e.g., *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/ka Cupcake Party*, WIPO Case No. D2000-0330; *General Electric Company v. CPIC NET and Hussain Syed*, WIPO Case No. D2001-0087).

The registration of the Disputed Domain Name prevents the Complainant from reflecting its Trade Marks in a corresponding domain name, as the gTLD ".com" is the most common. Searches indicate that the Respondent owns approximately 358 other domains, thus it is likely that he is engaging in a pattern of such conduct.

B. Respondent

The Respondent makes the following submissions.

Preliminary Matters

The Complainant fails to disclose that the perfume "Zut" was discontinued in 1954, and only re-launched in 1998. The date of first use of the Complainant's U.S. trade mark was December 1, 2003. This is consistent with the fact that the perfume was only re-launched recently.

The Complainant does not provide any evidence of widespread reputation, fame, advertising expenditures, or significant sales volume of its brand "Zut". The background of the perfume designer is of no relevance.

The Respondent submits that Moniker Privacy Services is a standard privacy service offered by the Registrar and is not objectionable, as it has not been used to hinder legal proceedings (see *Mediaset S.p.A. v. Didier Madiba, Fenicius LLC*, WIPO Case No. D2011-1954; WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0")). The Respondent's identity was promptly disclosed upon receipt of the Complaint.

Identical or Confusingly Similar

The Respondent acknowledges the Complainant owns the Trade Marks and they are nearly identical to the Disputed Domain Name.

Rights or Legitimate Interests

The term "zut" is a common dictionary word in the French language, meaning "damn" or "darn". It is also widely used by English speakers as an expression and is a common brand name worldwide.

The Respondent did not require the Complainant's authorization to register a common dictionary word that is used by countless people and businesses worldwide.

The Complainant must establish that the Respondent has a “total” lack of any right or legitimate interest, establishing a “better” legitimate interest is insufficient (see *e.g.*, *Borges, S.A., Tanio, S.A.U. v. James English*, WIPO Case No. D2007-0477).

Prior to notification of the Complaint the Respondent was using the Disputed Domain Name in connection with a *bona fide* offering of an interactive “hangman” type game. Although this was only for a limited period of time, any *bona fide* use is sufficient.

When the Respondent lost interest in developing the game, he listed the Disputed Domain Name for sale on his own website “www.catchy.com”, which deals in “catchy” and clearly generic domain names for both development and resale (including developing logos to assist in marketing).

It has been held that the sale of a generic domain name of itself may constitute use in connection with a *bona fide* offering of goods or services (see *e.g.*, *Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016). Accordingly, by lawfully selling generic domain names via catchy.com, the Respondent has demonstrated a legitimate interest.

The Respondent has a right or legitimate interest in the Disputed Domain Name as it is wholly comprised of a common dictionary word. Panels have held that the first person to register a descriptive or generic domain name in good faith is entitled to the domain name (see *e.g.*, *Target Brands, Inc. v. Eastwind Group*, NAF Claim No. 267475; *HP Hood LLC v. hood.com*, NAF Claim No. 313566; *CRS Technology Corporation v. CondeNet, Inc.*, NAF Claim No. FA93547; *Spherion Corporation v. Neal Solomon*, NAF Claim No. FA112454)

Registered and Used in Bad Faith

The Respondent submits that the following cases cited by the Complainant are irrelevant:

- (i) *SportSoft Golf, Inc. v. Hale Irwin’s Golfers’ Passport*, NAF Claim No. FA94956 (the Complainant has no monopoly in the common dictionary word “Zut”);
- (ii) *Marriott International Inc. v. John Marriot*, NAF Claim No. FA94737 (the Respondent’s registration of “Zut” is not comparable to the registration of a typo of the “Marriott” trade mark); and
- (iii) *Centeon L.L.C./Aventis Behring L.L.C. v. Ebiotech.com*, NAF Claim No. FA95037 (the circumstances of the case are completely different, the respondent in this case was selling the complainant’s products under the complainant’s unique and distinctive marks).

The Respondent had the right to register the Disputed Domain Name and was not aware of the Complainant’s limited trade mark rights for “Zut” in respect of perfume.

There is no evidence that the generic Disputed Domain Name was registered for the purpose of profiting from the Complainant’s trade mark rights, therefore, there can be no finding of bad faith registration or use (see *e.g.*, *Ultrafem, Inc. v. Warren R. Royal*, NAF Claim No. FA097682). On this point, the Respondent submits the following:

- (i) it was not aware of the Complainant’s trade mark rights until it received notice of the Dispute;
- (ii) it never approached the Complainant to sell the Disputed Domain Name;
- (iii) it has not interfered with the Complainant’s business; and
- (iv) it never attempted to intentionally deprive the Complainant of the Disputed Domain Name, the Complainant could have purchased the Disputed Domain Name itself at the auction, or could have purchased it at any time since its original creation date.

The Respondent submits that Mr. Gallinari (who is not counsel, but a domain name specialist) approached the Respondent and made offers to purchase the Disputed Domain Name without any solicitation from the Respondent. He did not identify himself as being associated with the Complainant and did not assert any trade mark rights. The Respondent replied to the first offer with “Zut!”, to express his displeasure at the offer. The Respondent thought he was replying to an automated or general offer and not a genuine offer to purchase the Disputed Domain Name for market value.

The Complainant has not provided any facts to support its allegation of bad faith registration. Accordingly there is no basis for a finding of bad faith registration (see *e.g.*, *TMG Technologie Management Gruppe Unternehmensberatung für Markt und Innovation GmbH v. Whois Privacy Protection Service, Inc.*, WIPO Case No. D2005-0161).

Reverse Domain Name Hijacking

The Respondent requests a finding of Reverse Domain Name Hijacking (“RDNH”).

The Respondent submits that the Complainant knew of the Respondent’s unassailable right or legitimate interest in the Disputed Domain Name or the clear lack of bad faith registration and use, and nevertheless brought the Complaint in bad faith (see *e.g.*, *Sydney Opera House Trust v. Trilynx Pty. Limited*, WIPO Case No. D2000-1224; *Goldline International Inc. v. Gold Line*, WIPO Case No. D2000-1151) or the Complaint was brought in knowing disregard of the likelihood that the Respondent possessed legitimate interests (see *e.g.*, *Smart Design LLC v. Carolyn Hughes*, WIPO Case No. D2000-0993). In this regard the Respondent submits:

- (i) the Complainant knew, and admitted, that “Zut” was a common French word meaning “damn” or “darn”;
- (ii) the Complainant knew the word “Zut” was used by people and businesses worldwide;
- (iii) the Complainant knew that the Respondent never infringed its trade mark rights;
- (iv) the Complainant proceeded with the Complaint after its offer to buy the Disputed Domain Name was refused by the Respondent;
- (v) the Complainant never sent a letter to the Respondent demanding transfer of the Disputed Domain Name based on legal rights (if it had done so it would have received a response from the Respondent that it was not cybersquatting); and
- (vi) the Complainant has put the Respondent to substantial time and expense in responding to a legal proceeding that should not have been brought.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the Disputed Domain Name is identical or confusingly similar to a 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 and is being used in bad faith.

The Complainant bears the onus of proving these elements.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the Disputed Domain Name is identical or confusingly similar to the Trade Marks.

It is not disputed that the Complainant has rights in the Trade Marks. (It is also not in dispute that the registrations of the Trade Marks predate the registration of the Disputed Domain Name, although this factor is not relevant to the first element under the Policy.) The parties agree that the Disputed Domain Name and the Trade Marks are almost identical.

The first element of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy provides that the Complainant must establish that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant is required to make out a *prima facie* case showing that the Respondent lacks rights or legitimate interests.

The Complainant's submissions on this element can be summarized as follows: The Complainant owns a trade mark registration for "ZUT" and the Respondent, who is not commonly known by that name, is using the Disputed Domain Name without license from the Complainant.

This barely establishes a *prima facie* case. The Respondent has provided substantial submissions to rebut the Complainant's *prima facie* case, and in the opinion of the Panel, succeeds in doing so for the reasons set out below.

The Disputed Domain Name consists of a common and widely used dictionary word in the French language. The mere registration of a domain name that is comprised of a common dictionary word may not of itself confer rights or legitimate interests in the domain name. Generally, in order to find rights or legitimate interests in a domain name based on the generic or dictionary meaning of a word contained therein, the domain name would need to be genuinely used or at least demonstrably intended for such use in connection with the relied-upon meaning (and not, for example, to trade off third-party rights in such a word) (see WIPO Overview 2.0, paragraph 2.2).

Both the Respondent and the Complainant have referred to the fact that the Disputed Domain Name leads to a website which advertises the Disputed Domain Name for sale by auction. The Panel has verified this use through an examination of the relevant website.

The sale of domain names can be legitimate interest if a respondent was not aware of a complainant's trade mark rights (see *e.g.*, *Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016; *Audiopoint, Inc. v. eCorp a/k/a Chad Folkening*, WIPO Case No. D2001-0509).

Here, the following factors are relevant:

- The Complainant has provided no evidence that the Respondent was aware of its trade mark rights at the time it registered the Disputed Domain Name.
- The Respondent is a native French speaker, and resides in France.
- "Zut" is a common French word.
- The Complainant's Zut brand of perfume was launched in 1948, discontinued in 1954 and re-launched in 1998. Although well-known in the 1940s, the brand is not so well known today.

- There is no evidence that the Respondent was otherwise targeting the Complainant or its Trade Marks. This conclusion is supported by the fact that part of the Respondent's business is to register dictionary words in order to take advantage of the commercial value of such words as domain names, purchased the Disputed Domain Name at an auction for a substantial sum of money, and owns many domain names.

On the facts of this case, the Panel concludes that the Respondent purchased the Disputed Domain Name not for its association with the Complainant's trade mark, but because of its dictionary meaning. The Respondent's subsequent use and conduct is consistent with that view.

For the Panel to decide in favour of the Complainant on this element, the Panel would in effect be deciding that a domain name owner who acquires a dictionary term domain name in good faith, and then warehouses the domain name, does not have rights or legitimate interests in the domain name. This Panel is not prepared to reach such a broad conclusion.

The Respondent's brief use of the Disputed Domain Name to host a "hangman" type game also evidences *bona fide* use, but the Panel does not need to rely upon such use for the purposes of this element.

In light of the above, the Complainant has failed to show that the Respondent lacks a legitimate interest. The second element of the Policy is not satisfied.

C. Registered and Used in Bad Faith

To establish the requirement under paragraph 4(a)(iii) of the Policy, the Complainant must prove that both registration and use of the Disputed Domain Name are in bad faith.

Although the Panel is not required to address bad faith due to its finding in relation to the second element, it makes the following comments on the evidence presented.

There is no evidence of any bad faith registration or use of the Disputed Domain Name by the Respondent. Specifically, the Panel concludes that:

- (i) the Respondent was unaware of the Complainant's trade mark rights;
- (ii) the Respondent has never approached the Complainant to sell the Disputed Domain Name;
- (iii) the website which the Disputed Domain name redirects to does not sell goods/services which compete with the goods sold under the Trade Marks;
- (iv) the website which the Disputed Domain name redirects is not a pay-per-click website; and
- (v) the Complainant provided no evidence that the public has been confused or misled by Respondent's use of the Disputed Domain Name.

In light of the above, the Complainant has failed to show that the Disputed Domain Name was registered and is being used in bad faith. The third element of the Policy is not satisfied.

D. Reverse Domain Name Hijacking

The Respondent requested that the Panel make a declaration of RDNH pursuant to paragraph 15(e) of the Rules. The Rules define RDNH as "using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name". The onus of proving this is generally on the Respondent.

This is not an appropriate case for such a declaration. Although the Complainant provides little evidentiary support for its allegations, it appears that the Complainant genuinely believes that the Respondent is attempting to profit from a bad faith registration of the Disputed Domain Name. The Panel notes that the fact

the Disputed Domain Name was being offered at such a high price may have led the Complainant to believe that this was an offer to sell in excess of out-of-pocket expenses.

7. Decision

For all the foregoing reasons, the Complaint is denied.

John Swinson
Presiding Panelist

Fabio Angelini
Panelist

Diane Cabell
Panelist
Dated: May 16, 2012