

## **ADMINISTRATIVE PANEL DECISION**

### **Compagnie Générale des Etablissements Michelin v. Jaime Paternina Case No. D2022-0171**

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

The Complainant is Compagnie Générale des Etablissements Michelin, France, represented by Dreyfus & associés, France.

The Respondent is Jaime Paternina, United Kingdom.

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

The disputed domain name <michelinguide.online> 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 January 19, 2022. On January 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 20, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 21, 2022, 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 January 21, 2022.

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 the Respondent of the Complaint, and the proceedings commenced on February 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2022. The Respondent’s informal communication was received on January 26, 2022, and the Center’s possible settlement email was sent to the Parties on the same day. The Complainant’s suspension request was received on February 1, 2022, and the Center’s Notification of Suspension email was sent to the Parties on the same day. On February 7, 2022, the Complainant notified the Center that the Parties failed to reach a settlement, the proceeding was reinstated on the same day. Pursuant to paragraph 6 of the Rules, the Center notified the Parties of the commencement of the panel appointment process on March 1, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on March 7, 2022. 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 leading global manufacturer of tires under the trademark MICHELIN and has marketing operations in over 170 countries, and the Complainant also publishes the famous travel, hotel, and restaurant guides “Michelin Guide” (French: “Guide Michelin”).

The Complainant operates numerous websites to promote its goods and services, including “www.michelin.com”, “www.guidemichelin.com”, and “www.michelin.uk”.

The Complainant is the proprietor of numerous registrations for the MICHELIN mark in jurisdictions worldwide, including the following:

- United Kingdom trademark MICHELIN No. UK00904836359, filed on January 4, 2006 and registered on March 13, 2008, duly renewed and covering goods and services in classes 1, 3, 5, 6, 7, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 24, 25, 26, 28, 34 and 39;
- United Kingdom trademark MICHELIN No. UK00909914731, filed on April 21, 2011 and registered on September 27, 2011, duly renewed and covering goods and services in classes 9, 35, 37, 38, 39, 41, 42, and 43; and
- International trademark MICHELIN No. 771031, registered on June 11, 2001, covering goods and services in classes 5, 7, 8, 9, 10, 11, 12, 16, 17, 18, 20, 21, 24, 25, 39, and 42, and designating, *inter alia*, United Kingdom.

The disputed domain name was registered on June 14, 2020. According to the Panel’s research and the material in the case file, the disputed domain name resolves to an empty website.

#### **5. Parties’ Contentions**

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

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that:

- the disputed domain name reproduces the Complainant’s trademark which previous UDRP panels have considered to be “well known” or “famous”, in its entirety;
- the incorporation of a well known trademark MICHELIN in its entirety is sufficient to establish that the disputed domain name is confusingly similar to the Complainant’s trademark;
- the addition of the term “guide” increases the likelihood of confusion as it makes reference to the Complainant’s famous “Michelin Guide”; and
- the extension “.online” is not to be taken into consideration when examining the identity or confusing similarity between the Complainant’s trademark and the disputed domain name.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent is not affiliated with the Complainant in any way nor has he been authorized by the Complainant to use and register its MICHELIN trademark, or to seek registration of any domain name incorporating the MICHELIN trademark;
- in the absence of any license or permission from the Complainant, no actual or contemplated *bona fide* or legitimate use of the disputed domain name can reasonably be claimed; and
- the Respondent has not made any reasonable and demonstrable preparations to use the disputed domain name and therefore failed to show any intention of noncommercial or fair use of the disputed domain name.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Complainant's MICHELIN trademark is well known throughout the world including United Kingdom where the Respondent is located;
- reproduces the Complainant's trademark MICHELIN in its entirety and by adding the term "guide" makes direct reference to the Complainant's Michelin Guide and official website;
- given the notoriety of the trademark MICHELIN which is exclusively associated with the Complainant's trademark, it is inconceivable that the Respondent was unaware of the Complainant and its rights in the trademark MICHELIN when he registered the disputed domain name;
- knowledge of the Complainant's trademark rights at the time of registration of the disputed domain name proves bad faith registration;
- given the Complainant's goodwill and notoriety worldwide, it is not possible to conceive that the Respondent could legitimately use the disputed domain name, as its use would invariably result in misleading diversion and taking unfair advantage of the Complainant's rights; and
- the "passive holding" of the disputed domain name does not preclude a finding of bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions. On January 26, 2022, February 2 and 7, 2022, and on March 7, 2022, the Respondent sent informal communications inquiring whether the Complainant wished to purchase the disputed domain name and questioning the fairness of this proceeding.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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.

## A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns multiple trademark registrations for the mark MICHELIN prior to the registration of the disputed domain name on June 14, 2020.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases. (See sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In this case, the disputed domain name contains the MICHELIN trademark in its entirety. As set forth in section 1.7 of the [WIPO Overview 3.0](#): "in cases where a domain name incorporates the entirety of a trademark [...] the domain name will normally be considered confusingly similar to that mark." (See, e.g., *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy").

Moreover, it has been held in many UDRP decisions and has become a consensus view among panelists (see section 1.8 of the [WIPO Overview 3.0](#)), that the addition of other terms (whether, e.g., descriptive or otherwise) does not prevent a finding of confusing similarity under the first element of the UDRP. Accordingly, the addition of the term "guide" which makes reference to the Complainant's famous "Michelin Guide" does not prevent a finding of confusing between the Complainant's MICHELIN trademark and the disputed domain name.

Finally, it is well accepted in past UDRP decisions that the generic Top-Level Domain ("gTLD"), such as (e.g., ".com", ".club", ".nyc"), is typically not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable gTLD may itself form part of the relevant trademark (see section 1.11 of the [WIPO Overview 3.0](#)). This practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to "new gTLDs").

The Panel therefore concludes that the disputed domain name is confusingly similar to the Complainant's MICHELIN trademark in which the Complainant has exclusive rights.

## B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a 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 you [the Respondent] 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 [the 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) you [the Respondent] 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."

The Complainant also stated that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to register the disputed domain name.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant 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. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, the disputed domain name resolves to an empty website, and there is no other evidence to support the assumption that the Respondent has used disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

Moreover, the Respondent sent informal communications inquiring whether the Complainant wished to purchase the disputed domain name. Noting the composition of the disputed domain name, the Panel finds that the Respondent register the disputed domain name to intent to derive profits from the sale of it to the Complainant.

The Panel therefore concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Complainant holds multiple trademark registrations for the MICHELIN trademark in various jurisdictions that predate the registration of the disputed domain name.

Given that the Complainant's MICHELIN mark is widely known in many countries worldwide and that the disputed domain name is identical to the title of the Complainant's famous travel and hotel guide "Michelin Guide", it is inconceivable that the Respondent coincidentally registered the disputed domain name without

any knowledge of the Complainant's rights in the MICHELIN mark.

The fact that there is no evidence that the disputed domain name has not yet been actively used does not prevent a finding of bad faith use.

Although the circumstances listed in paragraph 4(b) are all phrased in terms of affirmative actions by the Respondent, it is by now well accepted that the passive holding of a domain name, in certain circumstances, can constitute bad faith use under the Policy. (See, e.g., *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

While panels will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:

- (i) the degree of distinctiveness or reputation of the complainant's mark;
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; and
- (iii) the implausibility of any good faith use to which the domain name may be put.

The circumstances of the present case are sufficiently similar to those present in *Telstra* to establish bad faith passive holding of the disputed domain name.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's MICHELIN mark is distinctive and widely-known, including in the United Kingdom, where the Respondent is located.

Given that the Complainant's MICHELIN mark is solely connected with the Complainant and does not have any generic or descriptive meaning, the disputed domain name is also not susceptible to be used in a good faith generic or descriptive sense.

In addition, noting the Respondent's communications inquiring whether the Complainant wished to purchase the disputed domain name after the filing of the Complaint, the Panel is also satisfied that the Respondent registered the disputed domain name, confusingly similar to the Complainant's trademark, for the purpose of deriving profit from its sale to the Complainant.

Furthermore, the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the disputed domain name.

The Panel therefore finds that the circumstances, as described above, show that the Respondent registration and passive holding of the disputed domain name equals a bad faith registration and use of the disputed domain name and therefore the Complainant also established 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 disputed domain name, <michelinguide.online>, be transferred to the Complainant.

*/Torsten Bettinger/*

**Torsten Bettinger**

Sole Panelist

Date: March 21, 2022