

ADMINISTRATIVE PANEL DECISION

42 v. Ryan Dorsey
Case No. D2023-0490

1. The Parties

The Complainant is 42, France, represented by Scan Avocats AARPI, France.

The Respondent is Ryan Dorsey, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <program42.com> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 2, 2023. On February 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2023, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 17, 2023, 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 February 19, 2023.

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 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 15, 2023. The Center received two informal communications from the Respondent on March 13 and 15, 2023. The Complainant filed a supplemental filing on March 17, 2023. The Complainant sent an informal communication to the Center on March 28, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 4, 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 Rules, paragraph 7.

On April 21, 2023, the Panel issued Procedural Order No. 1 inviting the Respondent to address a number of matters in the Response and arising from the Complainant's unsolicited supplemental filing. The Respondent did not make a further submission.

4. Factual Background

The Complainant is a free and non-profit provider of computer programming educational services. It was established in France in 2013. The Complainant has a distinctive approach to education: there are no professors, no grades, does not charge fees, and is open to students 24/7. Within months of its establishment it was receiving extensive media coverage including in *Le Monde*, *The New York Times*, and *Wired* amongst others.

In 2015, the then French President, François Hollande, paid the Paris campus an impromptu visit. President Macron has also visited the school to praise its distinct educational model.

In 2017, the online computer programming platform, CodinGame, (which had 1.3 million programmer members) ranked it as the best code school in the world.

The Complainant now has 47 campuses in 26 countries around the world including six in France, seven in Spain, three each of in Germany and Brazil, two each of in Italy, Belgium and the Russian Federation, one each in the Netherlands, Finland, Austria, the Czech Republic, the United Kingdom, Portugal, Luxembourg, Switzerland, Armenia, Türkiye, Morocco, Jordan, Canada, Japan, Republic of Korea, Thailand, Malaysia, Australia, and the United Arab Emirates. Its website also lists a site in California in the United States as temporarily closed.

It appears that the Complainant's main website is at "42.fr" although it has a number of other domain names based on "42" as well, including <ecole42.fr> and <ecole42.com>.

The Complainant's Facebook page has over 27,000 "likes" and just under 27,000 followers; its Twitter account, 44,000 followers; its YouTube page, 7,500 followers; its Instagram account, 11,600 followers, and its LinkedIn page, 65,000 followers. Some of these accounts have a URL such as @42born2code. The number in plain Arabic numerals and the stylized logo form also feature prominently.

Amongst other things, the Complainant owns:

- (a) French registered trademark No. 3966091, 42, which has been registered with effect from December 4, 2012, in respect of a range of services in International Classes 35, 41 and 42;
- (b) International Registration No. 1488612, 42 (figurative), which has been registered since June 26, 2019, in respect of a range of services in International Classes 35, 38, 41 and 42. The International Registration designates a number of countries including Armenia, Australia, Colombia, Indonesia, Japan, Morocco, Oman, Russian Federation, Republic of Korea, Switzerland, Thailand, Türkiye, and the United States.
- (c) United States Registered Trademark No. 6,285,236 derived from the International Registration in International Class 42 and which was entered on the Principal Register on March 9, 2021.
- (d) European Union Trade Mark No. 018037820, 42 (figurative) which was registered on August 13, 2019, in respect of educational and training services in International Class 41.

The figurative version of the trademark is:



The disputed domain name was registered on January 11, 2022.

The disputed domain name resolves to a website which is a parking page with pay-per-click (“PPC”) advertising links. Clicking on these links can take the browser to websites promoting services in competition with the Complainant’s services.

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 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.

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 it deems applicable.

A. Supplemental Filings

Apart from documents requested by the Panel pursuant to paragraph 12 of the Rules, neither the Policy nor the Rules expressly provide for supplemental filings. Their admissibility is therefore in the discretion of the Panel bearing in mind the requirements under paragraph 10 of the Rules to ensure that the proceeding is conducted with due expedition and both parties are treated equally, with each party being given a fair opportunity to present its case.

Where unsolicited supplemental filings are admitted, it is usually because the material corrects some error or addresses something raised in a Response which could not reasonably have been anticipated or which was not otherwise appropriate to deal with until a respondent’s position on a particular point was clear.

Those requirements are clearly satisfied in respect of the Complainant’s supplemental filing submitted on March 17, 2023. As discussed below, the Response was made in the name of someone other than the registrant identified by the Registrar. It also claimed some relationship with a previously unknown company and claimed the author of the Response had previously been the holder of the disputed domain name.

These are all matters which are not apparent from the website to which the disputed domain name resolves or the information disclosed by the Registrar. Accordingly, the Panel admits the supplemental filing as part of the record.

B. 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 trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of registered trademarks for 42 and 42 (figurative).

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

It is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, [WIPO Overview 3.0](#), section 1.10.

In the present case, the disputed domain name contains the Complainant’s trademark 42 in its entirety. Moreover, while the figurative aspect of the Complainant’s trademark 42 (figurative) has some distinctive force, 42 remains clearly recognisable within the mark and not so insignificant or obscure that the exception to the usual rule applies.

Disregarding the “.com” gTLD, therefore, the disputed domain name consists of the Complainant’s registered trademarks and the term “program” as a prefix. As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g. [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant’s trademarks remain visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademarks and the requirement under the first limb of the Policy is satisfied.

C. 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 can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or

- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark 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. 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., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name after the Complainant began using its trademark and also after the Complainant had registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name and, subject to a claim made by the Respondent and discussed below, it does not appear that the Respondent is known by some other name from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The use of the disputed domain name to generate revenue through PPC links does not qualify as a legitimate noncommercial or fair use for the purposes of paragraph 4(c)(iii) of the Policy. Nor, in the absence of some prior or independent entitlement to the disputed domain name, does using it for PPC links in competition with the Complainant generally constitute a good faith offering of goods or services for the purposes of paragraph 4(c)(i) as the Respondent appears to be targeting the Complainant's trademark.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name.

The Response has been submitted by a John Smith, not the name of the person identified by the Registrar as the registrant. The Response was submitted, however, from the email address confirmed by the Registrar as the email address for the Respondent.

In the Response, Mr. Smith says that he originally registered the disputed domain name in 2014 but lost it when he failed to renew the registration. He says that re-registered the disputed domain name (presumably on January 11, 2022) when he noticed it had become available again.

Mr. Smith also says he registered the disputed domain name for Program42 Inc., a company incorporated in Delaware in the United States. In support of that claim, the Response included a Certificate of Incorporation issued by Harvard Business Services Inc. confirming that the company was incorporated under that name on September 29, 2014. The certificate does not identify the nature of the business or who the directors or shareholders were or are. Further, the certificate of incorporation does not disclose whether the company is still registered and in existence.

Mr. Smith also contends that much of the Complainant's marketing is based around the name "ecole42" or "school42" and so would not be confused with "program 42".

As noted above, in reply to the Response, the Complainant submitted a supplemental filing. The Complainant's supplemental filing includes DomainTools' Whois History reports showing that:

- (a) the registrant of the disputed domain name between 2014 and 2016 was one Mark Hufstetler; and
- (b) the registrant of the disputed domain name in 2019 was Alabama Baseball Educational & Leadership Foundation, Inc.

In light of these discrepancies, the Panel issued the Procedural Order No.1 inviting the Respondent to explain:

- (1) the relationship between Mr. Smith and the named Respondent;
- (2) whether the company Program42 Inc. is still registered and who its directors and shareholders are; and
- (3) the basis on which Mr. Smith claimed to have registered the disputed domain name for Program42 Inc.

No reply was received to that invitation.

In these circumstances, the Panel cannot accept Mr. Smith's claims. His claim to have previously been the registrant of the disputed domain name in 2014 is directly contradicted by the Whois History records. He has not sought to dispute that. Therefore, he could not have registered the disputed domain name for Program42 Inc. at that time. Given this and Mr. Smith's failure to address the other matters raised in the Procedural Order No.1, the Panel is also not prepared to accept the claim (if that is what is being claimed) that Mr. Smith registered the disputed domain name "this time" for Program42 Inc.

Further, the Respondent's argument that the Complainant is often referred to as "ecole 42" ignores the existence of the Complainant's registered trademarks for 42 and the use of the disputed domain name for PPC links to services competing with the Complainant's services.

Accordingly, the Respondent has not rebutted the *prima facie* case established by the Complainant. Therefore, the Panel finds the Complainant has established the second requirement under the Policy also.

D. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd.*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

By the time the Respondent registered the disputed domain name, the Complainant's reputation around the world was very well established. Further, for the reasons explained in section 5D above, the Panel has not accepted the Respondent's explanation of the basis on which he registered the disputed domain name. Instead, the only objective evidence of the Respondent's intentions in registering the disputed domain name is its use for a website with PPC links to services competing with the Complainant. In that connection, the "program" element of the disputed domain name is not a distinguishing feature. It could well be used with or to describe the Complainant's services and does not operate to exclude the potential for confusion with the Complainant and its trademark.

In these circumstances, the Panel infers the Respondent registered the disputed domain name to target the Complainant and its trademark. That constitutes registration in bad faith under the Policy. The manner of use clearly qualifies as use in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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, <program42.com>, be transferred to the Complainant.

/Warwick A Rothnie/

Warwick A Rothnie

Sole Panelist

Date: May 5, 2023