

ADMINISTRATIVE PANEL DECISION

HUMANOIDS, Inc. v. Christopher Bain

Case No. D2023-2896

1. The Parties

The Complainant is HUMANOIDS, Inc., United States of America (“United States”), represented by Cabinet Lex-Insight, France.

The Respondent is Christopher Bain, Canada, represented by Weintraub Tobin Chediak Coleman Grodin, United States.

2. The Domain Name and Registrar

The disputed domain name <humanoidstudios.com> 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 6, 2023. On July 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 7, 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 (no information, Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 10, 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 July 10, 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 July 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2023. On July 31, 2023, the proceeding was suspended until August 30, 2023, to enable settlement discussion between the parties. The Response was filed with the Center on August 31, 2023.

The Center appointed Adam Taylor as the sole panelist in this matter on September 8, 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.

4. Factual Background

The Complainant and its predecessors have published comics and graphic novels since the 1970s, originally in France under the mark LES HUMANOÏDES ASSOCIÉS and, from the 1990s, internationally under the mark HUMANOIDS.

The Complainant owns the following trade marks for HUMANOIDS:

- French trade mark No. 3089743, registered on March 19, 2001, in classes 9, 16, 28, 35, 38, 41 and 42;
- International Registration No. 772817, registered on September 19, 2001, in classes 9, 16, 28, 35, 38, 41 and 42;
- Canadian trade mark No. TMA619465, filed on September 9, 2001, registered on September 9, 2004, in classes 9, 16, 28, 35, 38, 41 and 42; and
- United States trade mark No. 3367419, filed on October 31, 2001, registered on January 15, 2008, in classes 9, 16, 35, 38, 41 and 42.

The Complainant operates a website at “www.humanoids.com”.

The Respondent is Chief Financial Officer of a company called Humanoid Studios, Inc., which was incorporated in Canada on May 19, 2021. It currently employs over 50 people. References to “the Respondent” hereafter include that company unless otherwise stated.

The Respondent registered the disputed domain name on April 29, 2021.

The disputed domain name resolves to a website branded HUMANOID STUDIOS, promoting the Respondent’s computer and video game services. The homepage states: “Humanoid Studios was founded on the axiom that creative freedom and independence lead to better, more innovative games”.

On February 15, 2022, the United States Patent and Trademark Office refused an application by the Respondent to register HUMANOID STUDIOS as a trade mark (under serial No. 90731536) on the grounds of likelihood of confusion with the Complainant’s United States trade mark No. 3367419, as well as with a third party trade mark.

On April 13, 2023, the Canadian Intellectual Property Office refused a similar application by the Respondent (International registration No. 1635093) on the basis of the Complainant’s Canadian trade mark No. TMA619465.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends: that its trade mark registrations cover the services supplied by the Respondent; that the Respondent “unduly benefits” from the reputation of the Complainant’s marks by using a “close imitation” thereof, namely the word “humanoid”, as part of the disputed domain name and on its

website; that the Respondent persists in exploiting the Complainant's mark despite being aware of the Complainant's prior rights following the refusals by the United States and Canadian offices on grounds of similarity with the Complainant's marks; and that the Complainant is using the disputed domain name to create a risk of association with the Complainant's mark.

B. Respondent

The Respondent contends that the Complainant has failed to satisfy any of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Respondent contends: that the Respondent was unaware of the Complainant or its trade marks when the Respondent registered the disputed domain name; that the Respondent chose the word "humanoid" because of its common and generic meaning; that the Complainant does not assert that it is actually developing or selling video and computer games; that the Respondent has established use of the disputed domain name for a *bona fide* offering of goods or services; that the Complainant's reliance on the Respondent's knowledge of the Complainant's mark arising after the Respondent registered the disputed domain name does not support a finding of bad faith; and that there is no risk of association given that the parties' respective offerings are sufficiently unrelated.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognisable (in singular form) within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, here, "studios", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

It is unnecessary to consider this element in light of the Panel's finding under the third element below.

C. Registered and Used in Bad Faith

The Panel notes the following:

1. The Complainant has provided little information or evidence regarding the nature and scale of its activities.
2. The Complainant asserts that the Respondent's knowledge of the Complainant's brand arises from the refusals of the Respondent's United States and Canadian trade mark applications based on likelihood of confusion with the Complainant's prior marks, but the Complainant does not suggest, let alone supply evidence indicating, that the Respondent was likely to have been aware of the Complainant's marks as of the earlier date when the Respondent registered the disputed domain name. The Complainant has not given the Panel any reason to disbelieve the Respondent's denial of knowledge of the Complainant.
3. The parties are engaged in what, on the face of it, are relatively distinct activities, namely publication of comics and graphic novels, and of computer and video games, respectively. The Complainant asserts that its registered trade marks cover the latter, but does not suggest that it has ever actually engaged in such activities.
4. The Complainant has not provided any evidence that the Respondent has specifically set out to target the Complainant in any way other than by selecting the term "humanoid", but this is a common dictionary term.

Based on the available record, the Panel finds the third element of the Policy has not been established.

The Panel would add that, in the Panel's view, the refusals of the Respondent's trade mark applications based on the Complainant's prior marks do not of itself assist the Complainant. In this proceeding, the Panel is more concerned with the Respondent's state of mind when registering and using the disputed domain name rather than the extent to which the Respondent's trade mark applications or activities happen to impinge on the Complainant's registered trade marks. The Policy is not designed to address trade mark infringement, which the Complainant's submissions appear to encompass. However, it is of course open to the Complainant to pursue such a case in the relevant national court if it considers that it has grounds to do so.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: September 22, 2023