

## **ADMINISTRATIVE PANEL DECISION**

Publicis Groupe SA v. Super Privacy Service LTD c/o Dynadot / malao ban  
Case No. D2022-1434

### **1. The Parties**

The Complainant is Publicis Groupe SA, France, represented by Fieldfisher LLP, United Kingdom.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States of America (“United States”) / malao ban, Hong Kong, China.

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

The disputed domain name <publicis-gz.com> is registered with Dynadot9, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 21, 2022. On April 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 23, 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 April 25, 2022, providing to the registrant contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on April 29, 2022.

The Center verified that the Complaint together with the amendment to 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 23, 2022.

The Center appointed William R. Towns as the sole panelist in this matter on May 27, 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 Publicis Groupe SA, a multi-national advertising and public relations company established in 1926 and headquartered in Paris, France. The Complainant has enjoyed considerable growth and is present in over 100 countries, holding a number of subsidiaries including Publicis, Sapient, and Starcom, and employing over 16,000 professionals.<sup>1</sup> The Complainant on an annual basis since 2015 consistently has generated revenues in excess of EUR 9 billion, including revenues of over EUR 10 billion in 2021.<sup>2</sup>

The Complainant is the owner of the PUBLICIS trademark, registered in a number of jurisdictions including Argentina, Brazil, Canada, China, European Union, Hong Kong, China, Singapore, and the United Kingdom. The earliest registrations of the PUBLICIS marks include Brazil in 1992, Argentina in 2014, China in 2001 and 2009, Singapore in 2002, and Canada in 2004. The European Union and United Kingdom PUBLICIS marks were first registered in 2020.<sup>3</sup>

The Complainant also is currently the holder no less than 25 other domain names reflecting its PUBLICIS mark, including among them <publicis.com>, <publicis.fr>, <publicis.uk>, <publicis.net>, <publicis.nyc>, <publicis.io>, <publicis-asia.com>, and <public-china.com>. The Complainant utilizes a number of these domain names with its websites.

The disputed domain name was registered by the Respondent on September 4, 2021, according to the Registrar's Whois database. At the time of filing of the Complaint, the disputed domain name redirected to a third party website presenting pornographic content. At the time of this decision, the disputed domain name was not in connection with any active website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant submits the disputed domain name <publicis-gz.com> is confusingly similar if not identical to the Complainant's PUBLICIS mark. According to the Complainant, the disputed domain name reproduces the PUBLICIS trademark, which while lacking any particular meaning nonetheless is highly distinctive. The Complainant asserts that "gz" simply refers to the geographical location, namely the province of Guangzhou in China. The Complainant explains that neither the presence of a hyphen (-) between "publicis" and "gz" in the disputed domain nor the generic Top-Level Domain ("gTLD") extension ".com" is taken into consideration when assessing the confusing similarity of the disputed domain name to the Complainant's mark. The Complainant cites UDRP decisions in support thereof.

The Complainant asserts the Respondent lacks rights or legitimate interests in respect of the disputed domain name, which the Complainant asserts bears no resemblance to the PUBLICIS mark. The Complainant maintains that the Respondent has not been licensed or otherwise authorized to use the Complainant's PUBLICIS mark or register domain names incorporating the Complainant's mark. The

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<sup>1</sup> See "https://publicis.com" ("Publicis Worldwide").

<sup>2</sup> See "https://statista.com/statistics/revenue-of-the-publicis-groupe-since-2008".

<sup>3</sup> Chinese Trademark Reg. No. 1683677, filed November 2, 1998, and registered December 14, 2001; Chinese Trademark Reg. No. 4112706 filed June 10, 2004, and registered December 14, 2009; Argentinian Trademark Reg. No. 2694018, filed January 21, 2014, and registered November 6, 2014; European Union Trademark Reg. No. 018218907, filed April 1, 2020, and registered August 5, 2020; United Kingdom Trademark Reg. No. UK00918218907, filed April 1, 2020, and registered August 5, 2020; Brazilian Trademark Reg. No. 815526881, filed June 18, 1990, and registered May 5, 1992; Singaporean Trademark Reg. No. T9613050I, filed December 5, 1996, and registered April 2, 2002; Canadian Trademark Reg. No. TMA627764, filed October 15, 2002, and registered December 7, 2004; and Hong Kong, China Trademark Reg. No. 300223334, filed May 29, 2004, and registered August 8, 2006.

Complainant emphasizes that the PUBLICIS mark is highly distinctive and adopted to distinguish from others its business in the marketplace. The Complainant contends that the Respondent's registration and use of the disputed domain name if any in trading over a period of seven months is insufficient to generate goodwill or reputation with customers. The Complainant points to the decision in *The Saul Zaentz Company d/b/a Tolkein Enterprises v. Eurobox Ltd. / "The Saul Zaentz Company"*, WIPO Case No. [D2008-0156](#).

The Complainant maintains that the disputed domain was registered and is being used in bad faith. According to the Complainant, the disputed domain name is identical to the Complainant's PUBLICIS mark, and was registered by the Respondent primarily to disrupt the business of the Complainant. The Complainant submits moreover that the disputed domain name has been redirected to a website displaying pornographic content and tarnishing the Complainant's mark.

The Complainant concludes that the Respondent intentionally and for commercial gain has used the disputed domain name in order to create a likelihood of confusion, directing Internet users to websites displaying sexually oriented and pornographic materials, and potentially tarnishing the Complainant's goodwill in the PUBLICIS name and trademarks.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **A. Scope of the Policy**

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the First WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169-177. The term "cybersquatting" is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.* at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests with respect to the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Cancellation or transfer of the domain name is the sole remedy provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing

all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the consensus view is that the burden of production shifts to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.1. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

## **B. Identical or Confusingly Similar**

The Panel finds that the disputed domain name <publicis-gz.com> is confusingly similar to the Complainant’s PUBLICIS mark, in which the Complainant has established rights through registration and extensive use of the mark. In considering identity and confusing similarity, the first element of the Policy serves essentially as a standing requirement.<sup>4</sup> The threshold inquiry under the first element of the Policy involves a relatively straightforward comparison between the complainant’s trademark and the disputed domain name.

The Complainant’s PUBLICIS mark is clearly recognizable in the disputed domain name.<sup>5</sup> The inclusion in the disputed domain name of the term “publicis” followed by a hyphen (-) and the letters “gz” does not dispel the confusing similarity of the disputed domain name to the Complainant’s mark. See, e.g., *Instagram, LLC v. Temp name Temp Last Name, Temp Organization*, WIPO Case No. [D2019-0109](#). See also *Instagram, LLC v. A S*, WIPO Case No. [D2020-1327](#). When the relevant trademark is recognizable in the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not preclude a finding of confusing similarity under paragraph 4(a)(i) of the Policy.<sup>6</sup> Top-Level Domains (“TLDs”) such as “.com”, generally are disregarded when evaluating the identity or confusing similarity of the Complainant’s mark to the disputed domain name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.<sup>7</sup>

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

## **C. Rights or Legitimate Interests**

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) of the Policy has been made. It is undisputed that the Respondent has not been authorized to use the Complainant’s PUBLICIS mark. The Respondent notwithstanding has registered and used the disputed domain name, misappropriating the Complainant’s PUBLICIS mark. As previously noted, the disputed domain name redirected to a third party website presenting pornographic content, and currently does not appear to resolve to any active website and has been passively held by the Respondent.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

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<sup>4</sup> See WIPO Overview 3.0, section 1.7.

<sup>5</sup> See WIPO Overview 3.0, section 1.8 and cases cited therein.

<sup>6</sup> *Id.*

<sup>7</sup> See WIPO Overview 3.0, section 1.11.

(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is 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 Respondent has not submitted any response to the Complaint, in the absence of which the Panel may accept all reasonable inferences and allegations in the Complaint as true. See *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#). The Panel has carefully reviewed the record in this case, and finds nothing therein that would bring the Respondent's registration and use of the disputed domain name within any of the "safe harbors" of paragraph 4(c) of the Policy.

The Panel concludes from the record that the Respondent was aware of and had the Complainant's PUBLICIS marks firmly in mind when registering the disputed domain name. The Respondent has brought forward no credible evidence of use or of any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. See [WIPO Overview 3.0](#), section 2.2 and cases cited therein. Nor has the Respondent asserted any claim to be making a legitimate noncommercial or fair use of the disputed domain name.

In view of the foregoing, the Panel concludes that the Respondent has neither used nor demonstrated preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, and is not making a legitimate noncommercial or fair use of the disputed domain name. Moreover, there is no indication that the Respondent has been commonly known by the disputed domain name at any time within the meaning of paragraph 4(c)(ii) of the Policy.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the respondent registered the 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) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For the reasons discussed under this and the preceding heading, the Panel concludes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of paragraph 4(a)(iii) of the Policy. The Panel concludes that the Respondent was aware of the Complainant and had the Complainant's PUBLICIS mark in mind when registering the disputed domain name, more likely than not with the intention of exploiting and profiting from the Complainant's trademark rights by creating a likelihood of confusion with the Complainant's mark, with the ultimate aim to profit from offering pornographic content on the website. Such use also tarnishes the Complainant's trademark.

What might now appear otherwise to be the Respondent's passive holding of the disputed domain name does not preclude a finding of bad faith in the attendant circumstances of this case. As set forth in *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*, "the relevant issue is not whether the Respondent is taking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. [...] [I]t is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith". See also *Red Bull GmbH v. Kevin Franke*, WIPO Case No. [D2012-1531](#). The Panel finds such circumstances to be present in this case.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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, <publicis-gz.com>, be transferred to the Complainant.

*/William R. Towns/*  
**William R. Towns**  
Sole Panelist  
Date: June 10, 2022