

ADMINISTRATIVE PANEL DECISION

Kensington 1 v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)/
CHAILLOUX SABINE
Case No. D2022-1499

1. The Parties

The Complainant is Kensington 1, France, represented by Jackson Walker, LLP, France.

The Respondent is Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)/ CHAILLOUX SABINE, France.

2. The Domain Name and Registrar

The disputed domain name <kensington-1.com> is registered with Launchpad.com Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2022. On April 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 27, 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 28, 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 April 28, 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 May 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 30, 2022.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on June 9, 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.

On June 22, 2022, the Panel issued Administrative Panel Order No.1 (“Panel Order No. 1”) requesting evidence regarding Complainant’s unregistered trademark rights. The Panel also invited the Complainant to provide further evidence to demonstrate that the Disputed Domain Name was used to generate emails as part of a phishing scam. The Respondent was granted the opportunity to comment on the Complainant’s filing.

On June 29, 2022, the Complainant filed further evidence in response to the Panel Order No. 1. The Respondent did not reply to the Complainant’s filing.

4. Factual Background

The Complainant is a French Company providing services as a landlord for commercial real estate assets.

The Complainant has provided its services under the name “KENSINGTON 1” since 2016.

The Disputed Domain Name was registered on April 1, 2021, and is linked to a website purporting to be the Complainant, providing contact details such as the Complainant’s postal address in Paris and a telephone number and an email address that are not those of the Complainant. The Disputed Domain Name was also configured to MX servers to generate email addresses as part of a phishing scam.

5. Parties’ Contentions

A. Complainant

First, the Complainant states that the Disputed Domain Name is identical to a trademark in which it claims to hold established common law rights. The Complainant argues that the mark “KENSINGTON 1” has been regularly used to identify the Complainant to its customers. The Complainant specifies that due to the extensive promotion and enforcement of its KENSINGTON 1 mark in France, consumers associate the KENSINGTON 1 mark with the Complainant and its services. The Complainant explains that it carries significant business under the KENSINGTON 1 mark with sales amounting to EUR 25.5 million in 2020.

Then, the Complainant states that the Respondent has no established rights or legitimate interests in the Disputed Domain Name. The Complainant specifies that the Respondent was not authorized to use the KENSINGTON 1 mark and that the Disputed Domain Name was only used to perpetrate fraud upon unsuspecting businesses who believe they are dealing with the Complainant. The Complainant submits that the Respondent is using the Disputed Domain Name to intentionally trade off the extensive goodwill associated with the Complainant’s KENSINGTON 1 mark. The Complainant then contends that the Respondent began using the Disputed Domain Name with full knowledge of the Complainant’s KENSINGTON 1 mark given that the Respondent is purporting to be the Complainant. Furthermore, the Complainant argues that there is no evidence that the Respondent holds any propriety rights in the KENSINGTON 1 mark or that it known under this name.

Finally, the Complainant submits that the Disputed Domain Name was registered and is being used in bad faith. The Complainant explains that the Respondent is using the Disputed Domain Name to confuse Internet users for commercial gain by creating confusion with its KENSINGTON 1 mark. The Complainant specifies that the Respondent has been using the Disputed Domain Name to pass itself off as the Complainant and perpetrate fraud. The Complainant explains that MX servers were configured with the Disputed Domain Name and thus email addresses were generated from the latter. The Complainant provides evidence of complaints from companies believing they were dealing with the Complainant when they receive emails and orders from email addresses derived from the Disputed Domain Name. Moreover,

the Complainant contends that the website linked to the Disputed Domain Name purports to belong to the Complainant while using the same trade name and postal address. Finally, the Complainant concludes the Respondent is not using the Disputed Domain Name for a *bona fide* offering of goods or services.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed 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 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

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Unregistered and common law trademarks may meet the criteria for a UDRP Complaint and meet the requirements of the Policy, paragraph 4(a)(i) if the Complainant shows that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys (see section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Prior UDRP panel decisions have admitted the standing of a complaint when the mark benefits from a protection similar to that of a trademark in the country where the complainant provides its services. This is particularly the case when the mark benefits from a protection under the national law of the country in which the Complainant is established or when the registration of the disputed domain name could provide a basis for an action for unfair competition in that same country (see *S.N.C. Jesta Fontainebleau v. Po Ser*, WIPO Case No. [D2009-1394](#) and *Government of Canada v. David Bedford a.k.a. DomainBaron.com*, WIPO Case No. [D2001-0470](#) and *Government of Quebec v. Peter McCann*, WIPO Case No. [D2002-1010](#)).

In addition, prior UDRP panel decisions have recognized that the use of a mark as a corporate name or trade name, could constitute a prior right to a disputed domain name and be treated as an unregistered mark (see *Théâtre du Gymnase Marie Bell SAS v. Mr. Erol Topal*, WIPO Case No. [D2018-2944](#)).

First of all, the Panel finds that the Complainant has evidenced that it is known under the trade name "KENSINGTON 1" in France. The Complainant has provided with several official documents and contracts it has entered with its customers and its service providers which demonstrate that the Complainant conducts its business and provide its services under the "KENSINGTON 1" mark. Moreover, research conducted by the Panel on official French governmental website has shown that in 2020 the Complainant's turnover amounted to more than EUR 20 million thus demonstrating an active conducting of business of the Complainant under the mark "KENSINGTON 1".

Furthermore, the fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier (see section 1.3 and 1.15 of the [WIPO Overview 3.0](#)).

The Panel finds that the Disputed Domain Name is linked to a website purporting to be the Complainant while using its trade name, postal address and same incorporation number.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the [WIPO Overview 3.0](#)).

The Panel finds that the First Disputed Domain Name is composed of the word "KENSINGTON" in its entirety; a hyphen; the number "1" (or, the KENSINGTON1 mark with a hyphen); and the generic Top-Level Domain ("gTLD") ".com".

According to prior UDRP panel decisions, it is sufficient that the domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of another word to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

The Panel considers that, in this case, the simple use of a hyphen in between the two signs composing the KENSINGTON 1 mark does not prevent a finding of confusing similarity between the Disputed Domain Name and the KENSINGTON 1 mark.

Moreover, the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Therefore, the Panel holds that the Disputed Domain Name is confusingly similar to the KENSINGTON 1 mark and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute, the respondent's 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
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

- 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.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* that a 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 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](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Indeed, it appears that the Complainant has never authorized nor consented to the use of the KENSINGTON1 mark by the Respondent. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. On the contrary, the Disputed Domain Name reverts to a website purporting to be the Complainant’s and was used to generate email addresses via the setting of MX servers as part of a phishing scam. In particular, the Panel notes that the Complainant has received several complaints from businesses that have been victims of such scams while thinking they were dealing with the Complainant.

In any case, the Respondent did not reply to the Complainant’s contentions.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Respondent does not have rights to or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent’s bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is 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) the respondent has 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) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the 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.

First, the Panel considers that it is established that the Complainant has been actively using the KENSINGTON 1 mark before the registration of the Disputed Domain Name and that there is no doubt that the Respondent knew the Complainant since it has specifically targeted the Complainant by impersonating it. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name.

Moreover, the Panel points out that the Disputed Domain Name revolves to a website purporting to be that of the Complainant using the same postal address as the Complainant as well as its incorporation number. The Complainant has also provided evidence that the Disputed Domain Name has been used to configure MX servers and to generate emails addresses that are being used as part of a phishing scam.

In this case, the Panel believes that such use of the Disputed Domain Name proves that the Respondent acts in bad faith. In addition, the Respondent has not provided any answer to the Complainant's contentions.

Considering all of the above, the Panel finds that it is not possible to conceive of any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the disputed domain name in bad faith according to the Policy, paragraph 4(a)(iii) and 4(b).

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, <kensington-1.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: July 9, 2022