

ADMINISTRATIVE PANEL DECISION

Panavision International, L.P. and Panavision Inc. v. Registration Private, Domains By Proxy, LLC / Madan Pania, PANIAVISION
Case No. D2022-1835

1. The Parties

The Complainant is Panavision International, L.P., United States of America (“United States”) and Panavision Inc., United States, represented by Bryan Cave Leighton Paisner LLP, United States.

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Madan Pania, PANIAVISION, India.

2. The Domain Name and Registrar

The disputed domain name <paniavision.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 May 19, 2022. On May 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 24, 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 May 30, 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 the first amended Complaint on June 3, 2022. In response to a notification by the Center, the Complainant filed the second amended Complaint on June 14, 2022.

The Center verified that the Complaint, together with the first and second amended Complaints, 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 June 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 5, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 12, 2022.

The Center appointed John Swinson as the sole panelist in this matter on July 19, 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.

The Panel issued a procedural order on August 10, 2022 requesting further information from the Parties, as discussed below. The Complainant filed a response to the procedural order. No response was filed by the Respondent.

4. Factual Background

The Complainants provide ultra-precision digital imaging and visual cinematographic equipment, including cameras, optical lenses, photographic equipment, lighting, and accessories. The Complainants business was founded in 1954 to design and manufacture wide-screen film photographic and projection lenses.

The First Complainant owns more than 180 trademark registrations around the world for PANAVISION, including United States Registration No. 627,362 for a stylized representation of PANAVISION that was registered on May 22, 1956 for anamorphosers that are used in the projection and taking of motion pictures, and United States Registration No. 834,705 for PANAVISION that was registered on September 5, 1967 for motion picture cameras and lenses therefor, and associated photographic equipment.

For simplicity, in this decision, both Complainants will be referred to as “the Complainant”.

The Respondent did not file a Response, so little is known about the Respondent. The Complainant provided a printout of a LinkedIn profile page for a person with the same name as the Respondent. This person appears to live in India and is said to be associated with the “Society for Animation in Delhi”.

The disputed domain name was registered on January 8, 2022.

On July 30, 2022, the disputed domain name resolved to a “HTTP Test Page” provided by a software program called CentOS Web Panel, which is a free web hosting control panel. At the present time, the disputed domain name does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The Complainant’s PANAVISION trademark has been in use since 1954 and is world famous. The Complainant owns many longstanding trademark registrations for the PANAVISION trademark. Prior court decisions and decisions under the Policy have decided that PANAVISION is a famous trademark. Since 1998, the Complainant has maintained an active Internet presence.

The disputed domain name is an obvious misspelling of the Complainant’s PANAVISION trademark. The Respondent’s use of a confusingly similar domain name seeks to exploit typing mistakes on the part of Internet users who are looking for the Complainant’s primary website at <panavision.com>, through the slight variation in the addition of the letter “i” to the middle of the Complainant’s PANAVISION trademark.

The Respondent is not in any way associated with the Complainant and has never sought nor received authorization or a license to use the Complainant’s PANAVISION trademark, or any variation thereof, in any way or manner. The Respondent is not making any legitimate noncommercial use of the disputed domain name.

The Respondent is not commonly known as “Panivision”. The Respondent cannot rely solely on his given name to establish a legitimate right to use the disputed domain name and must demonstrate that he is commonly known by the complete disputed domain name.

The PANAVISION trademark is an invented word, and as such, third parties would not legitimately choose this name, unless seeking to create an impression of an association with the Complainant.

The Complainant has made a *prima facie* showing that the Respondent has no legitimate right or interest to the disputed domain name. Accordingly, the Respondent must show by “concrete evidence” that it has such rights or interests pursuant to Policy Paragraph 4(a)(ii).

The Respondent plainly knew of the Complainant’s long and continuous use of its PANAVISION trademark at the time it registered the disputed domain name and that he had no right, title, or interest, whatsoever, in, to, or under these trademarks or the disputed domain name.

There is substantial authority that registration of a domain name that is confusingly similar to a famous trademark by any entity that has no relationship to that trademark is itself sufficient evidence of bad faith registration and use.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (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.

The onus of proving these elements is on the Complainant.

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. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns trademark registrations for PANAVISION.

The Complainant was a party in a well-known court decision in 1996, which is one of the first court decisions involving cybersquatting. This decision was prior to the Policy coming into effect. In that case, the Court stated:

“The Court finds that the Panavision marks are famous marks. Panavision owns the federal registration for the Panavision marks. The distinctiveness and fame of the ‘Panavision’ marks are well established and

undisputed. Neither mark can be found in the dictionary. The ‘Panavision’ mark in particular has developed strong secondary meaning because of Panavision’s long period of exclusive use of the mark and its status as a major supplier of photographic equipment.”

See *Panavision International, L.P. v. Toeppen*, 945 F. Supp. 1296 (C.D. Cal. 1996).

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation. See, for example, *Consumer Reports, Inc. v. Wu Yan, Common Results, Inc.*, WIPO Case No. [D2017-0371](#); and *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

Moreover, where the Complainant’s trademark and the disputed domain name differ only because the addition of one letter in the disputed domain name, and the differences between them could be attributed to a typographical error, confusing similarity will be found. *Panavision, Inc., Panavision International, L. P. v. Roomwithnet Systems (I) P.Ltd./ Eyecircus Studio Pvt. Ltd*, WIPO Case No. [D2005-0521](#).

The Panel concludes that the disputed domain name is confusingly similar to the Complainant’s PANAVISION trademark.

The Complainant succeeds on the first element of the Policy.

B. 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.

Previous UDRP 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 sufficient for a complainant to raise a *prima facie* case against the respondent under this element and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

As referred to above, one way in which rights or legitimate interests can be demonstrated is by the Respondent’s *bona fide* use of the disputed domain names in connection with an offering of goods or services, before he received notice of the dispute (paragraph 4(c)(i) of the Policy).

The Complainant asserts that the Respondent is not in any way associated with the Complainant and has never sought nor received authorization or a license to use the Complainant's PANAVISION trademark, or any variation thereof, in any way or manner. The Complainant also asserts that the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name.

The Complainant addressed the issue that the Respondent's surname is "Pania". If the Respondent is commonly known by the disputed domain name, then paragraph 4(c)(ii) of the Policy may apply. The Complainant correctly states that the disputed domain name is <paniavision.com>, and for paragraph 4(c)(ii) of the Policy to assist the Respondent, there must be evidence that the Respondent is commonly known as "paniavision".

In *The California Milk Processor Board v. Domains by Proxy Inc / (ERA) Holiday Real Estate, Inc.*, WIPO Case No. [D2011-1870](#), the Respondent's Vice President was Mr. Milko. This was not sufficient to establish rights or legitimate interests in respect of the domain name <gotmilko.com>.

The Panel undertook some limited factual research as the Panel is entitled to do. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8. The Panel discovered that the Respondent appears to operate in the audio-visual media field (a field in which the Complainant is widely known) in India. Further, even though the disputed domain name is not being used for an active website, the Respondent may be using the term "paniavision" in relation to an online television station in New Delhi and related audio-visual presentations. The Procedural Order invited the Respondent to confirm his knowledge (or lack thereof) of the Complainant's widely-known trademark PANAVISION and to clarify (and provide evidence of) his use of the term "paniavision". No response was received from the Respondent. It is likely that the Respondent, Mr. Pania, who operates in a field of business in which the Complainant is well-known, selected "vision" as part of the disputed domain name because of the Complainant.

The mere fact that the Respondent's name is "Madan Pania", does not *per se* entitle him to take advantage of the Complainant's PANAVISION trademark for his own gain. Compare *Galvin Green AB v. Stephen Galvin - Galvin Green*, WIPO Case No. [DCO2013-0016](#). In this regard, there is no evidence or explanation of why the Respondent would choose to combine his surname "Pania" with the term "vision", which choice creates a confusingly similar approximation – different by only a single letter – of the Complainant's long-standing and famous trademark. Rather, the choice of the term "vision" instead of any other industry terms, such as "animation" or "media", seems precisely intended to suggest an association with the Complainant and take advantage of the fame and recognition of the Complainant's trademark.

The Panel finds that the Complainant has established a *prima facie* case under the second element.

The Respondent had the opportunity to come forward and present evidence that he has rights or legitimate interests in the disputed domain name. He did not do so.

The Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain names in bad faith.

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 the complainant. *Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. [D2014-1747](#).

The Panel is of the view that the Respondent was aware of the Complainant and the PANAVISION trademark when the disputed domain name was registered. As discussed above, the PANAVISION

trademark is famous. PANAVISION is an invented word. It appears from the evidence provided by the Complainant that the Respondent has an interest in animation.

The disputed domain name is not being used.

The Complainant relies on the doctrine of passive holding to demonstrate bad faith use, in accordance with the principles set out in well-known cases cited by the Complainant, including *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). See also *Virgin Enterprises Limited v. Cesar Alvarez*, WIPO Case No. [D2016-2140](#). In the *Nuclear Marshmallows* case, the Complainant's trademark was one of the most famous in Australia, the complainant provided substantial evidence of its reputation in Australia, the respondent had an Australian address and was likely aware of the complainant, and the respondent used a fake name (Nuclear Marshmallows) to conceal his or her identity. In the present case, the Complainant's trademark is famous, has been registered and used around the world, and as stated above, the Respondent was likely aware of the Complainant's trademark.

The disputed domain name likely diverts Internet traffic away from the Complainant's true websites and is being passively held. The passive holding of a domain name that is nearly identical to a well-known trademark, without obvious use for a legitimate Internet purpose, or any explanation from the respondent, can be evidence of bad faith as required by the third element of the Policy. See, for example, *Philip Morris USA Inc. v. Gabriel Hall*, WIPO Case No. [D2015-1779](#).

The Complainant succeeds on 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 <paniavision.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: August 25, 2022