

ADMINISTRATIVE PANEL DECISION

Pathe Marques v. Tim van den Eijnden
Case No. D2022-3239

1. The Parties

The Complainant is Pathe Marques, France, represented by Cabinet Delucenay & Staeffen, France.

The Respondent is Tim van den Eijnden, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <pathe-thuis.com> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 31, 2022. On September 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 2, 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 September 2, 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 September 7, 2022.

On September 7 and 8, 2022, the Center received communications from the Parties, expressing wishes to settle the dispute. Accordingly, the Center sent a possible settlement email to the Parties. The Center received further emails from the Parties on September 13, 14, and 16, 2022. The Complainant did not request for a suspension of the proceedings.

The Center verified that the Complaint 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 September 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2022. The Respondent did not submit any formal

response. The Center notified the Parties of Commencement of Panel Appointment Process on October 11, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on October 18, 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 has not received any requests from the Complainant or the Respondent regarding further submissions, waivers, or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to the Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules, and the Supplemental Rules and without the benefit of a formal response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Pathe Marques, a French company operating in the field of film production and distribution, owning several trademark registrations for PATHE, among which:

- European Union Trade Mark No. 008463391 for PATHE, registered on June 28, 2010.

Moreover, the Complainant's Dutch subsidiary Pathé Theatres B.V. owns the following trademark registrations for PATHÉ THUIS:

- Benelux Trademark Registration No. 907464 for PATHÉ THUIS, registered on January 10, 2012; and

- Benelux Trademark Registration No. 907468 for PATHÉ THUIS and design, registered on January 10, 2012.

The Complainant also operates on the Internet at the main website "www.pathe.com", while its Dutch subsidiaries Pathé Theatres B.V. and Thuisbioscoop B.V. respectively operate at the websites "www.pathe.nl" and "www.pathe-thuis.nl".

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on February 25, 2014, and when the Complaint was filed, it resolved to a website where movie trailers and links to streaming platforms are provided, including links to the Complainant's Dutch subsidiaries websites as well as to the Complainant's competitors.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to its trademark PATHE, as the disputed domain name wholly incorporates the Complainant's trademark with the addition of the term "thuis"

(meaning “home/at home” in Dutch), and is identical to its Dutch subsidiary trademark PATHÉ THUIS.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, it is not commonly known by the disputed domain name and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The Respondent was using the disputed domain name for a website redirecting consumers to movie trailers and streaming platforms belonging to the Complainant’s competitors.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant’s trademark PATHE is distinctive and internationally known in the film industry. Therefore, the Respondent targeted the Complainant’s trademark at the time of registration of the disputed domain name, and the Complainant contends that the use of the disputed domain name with the purpose of redirecting consumers to movie trailers and streaming platforms belonging to the Complainant’s competitors, creating a likelihood of confusion with the Complainant’s trademark, and trading upon the Complainant’s reputation, qualifies as bad faith registration and use.

B. Respondent

The Respondent has made no formal reply to the Complainant’s contentions. However, as noted above, the Respondent submitted several email communications regarding possible settlement of the dispute.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (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.

A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark PATHE both by registration and acquired reputation and that the disputed domain name is confusingly similar to the trademark PATHE.

Regarding the addition of the term “thuis” (meaning “home/at home” in Dutch), the Panel notes that it is now well established that the addition of other terms (whether descriptive, geographical terms, letters, or otherwise) to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark (see, e.g., *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. D2005-0037; *Red Bull GmbH v. Chai Larbthanasub*, WIPO Case No. [D2003-0709](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)). The addition of the term “thuis” does not therefore prevent the disputed domain name from being confusingly similar to the Complainant’s trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8.

It is also well accepted that a generic Top-Level Domain (“gTLD”), in this case “.com”, is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not using the disputed domain name for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services, but instead on the website at the disputed domain name the Respondent is redirecting consumers to movie trailers and streaming platforms belonging to the Complainant's competitors.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain name.

Should the Complainant's services provided on the website to which the disputed domain name is directing Internet users be genuine services, legitimately acquired by the Respondent, the question that would arise is whether the Respondent would therefore have a legitimate interest in using the disputed domain name that is confusingly similar to the Complainant's trademark in circumstances that are likely to give rise to confusion.

According to the current state of UDRP decisions in relation to the issue of resellers, distributors, or service providers as summarized in the [WIPO Overview 3.0](#), section 2.8.1:

"[...] resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark."

This summary is based on the UDRP decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Even if the services provided by the Respondent were the Complainant's genuine services, from inspection of the Respondent's website, the Panel finds that the lack of any disclaimer and the links to the Complainant's competitors would not make, under the Oki Data principles (see above), a *bona fide* offering of goods and services and thus a legitimate interest of the Respondent in the disputed domain name.

The Panel therefore concludes that the disputed domain name is not being used in connection with a *bona fide* offering of goods or services.

Moreover, the Panel finds that the composition of the disputed domain name carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that “[...] for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [the Respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

(ii) that [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) that [the Respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent’s] 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.”

Regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant’s trademark PATHE in the film industry is clearly established and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the disputed domain name, especially because the disputed domain name resolves to a website consisting of links to movie trailers and streaming platforms.

The Panel further notes that the disputed domain name is also being used in bad faith since the Respondent is trying to attract Internet users to its website by creating a likelihood of confusion with the Complainant’s trademark in order to provide the same or similar services as the Complainant, including directing users to the services of several of the Complainant’s competitors, an activity clearly detrimental to the Complainant’s business.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain name in order both to disrupt the Complainant’s business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain name, which includes the Complainant’s trademark in its entirety with the mere addition of the term “thuis”, a term associated with the trademark of the Complainant’s subsidiary, further supports a finding of bad faith. See, [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain name in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

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 <pathe-thuis.com> be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: October 27, 2022