

ADMINISTRATIVE PANEL DECISION

Mediakiosk v. Private Registry Authority / Luke Barrett, Carden Group
PTY LTD

Case No. DCO2022-0004

1. The Parties

The Complainant is Mediakiosk, France, represented by Nameshield, France.

The Respondent is Private Registry Authority, Australia / Luke Barrett, Carden Group PTY LTD, Australia.

2. The Domain Name and Registrar

The disputed domain name <mediakiosk.co> (the “Domain Name”) is registered with Dreamscape Networks International Pte Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 19, 2022. On January 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 4, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 7, 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 February 7, 2022. The Center received two email communications from the Respondent on February 7 and February 12, 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 February 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the commencement of Panel appointment process on March 3, 2022. The Center received a further email communication from the Respondent on March 3, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on March 8, 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 a French simplified joint stock company that is a part of the French multinational JCDecaux Group, which specializes in outdoor advertising. For more than a century, the Complainant has been “the only company in France specializing in the establishment and management of press kiosk[s]”, operating 770 kiosks in France with annual revenues of EUR 30 million. The Complainant operates a website in French at “www.mediakiosk.fr”.

The Complainant holds French trademark registration number 3695386 (registered effective December 1, 2009) for the combined mark MEDIA KIOSK.

The Domain Name was registered in the name of a domain privacy service on January 17, 2022. After receiving notice of the Complainant in this proceeding, the Registrar identified the underlying registrant as the Respondent Luke Barrett of Carden Group PTY LTD (“Carden Group”), Australia. The registration includes Carden Group’s Australian Company Number (“ACN”). The Panel notes that the Australian Business Register lists the Respondent as an Australian private company registered since July 1, 2010, and Dun & Bradstreet shows Mr. Barrett as the principal of Carden Group, a single-employee company providing computer system design and related services. Carden Group does not appear to have an active website.

On January 18, 2022, the Domain Name was parked at a page hosted by “CrazyDomains.com” advertising the domain name registration and hosting services of CrazyDomains.com. At the time of this Decision, the Domain Name does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that the Domain Name is identical to its registered MEDIA KIOSK trademark. The Complainant states that the Respondent has no permission to use the Complainant’s mark and does not appear to be known by a name corresponding to the Domain Name. Moreover, by simply allowing the Domain Name to be parked, the Respondent has not used the Domain Name for a *bona fide* commercial offering.

The Complainant observes that the term “mediakiosk” is not a dictionary word and that a Google search produces results that predominantly refer to the Complainant. Thus, the Complainant argues that it is reasonable to conclude that the Respondent registered the Domain Name with “full knowledge of the Complainant’s trademark”. The Complainant argues that merely parking the Domain Name, knowing that it is identical or confusingly similar to the Complainant’s trademark, represents bad faith under the “passive holding” doctrine, citing *S.P.M.D. v. Dengpinghua* (郑平华), WIPO Case No. [D2020-2410](#).

B. Respondent

The Respondent sent emails to the Center on February 12 and March 3, 2022, asking about procedures and deadlines but did not reply to the Complainant’s contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following:

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a 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

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a straightforward comparison between the complainant’s trademark and the domain name”. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. The Domain Name incorporates in its entirety the textual element of the Complainant’s registered trademark MEDIA KIOSK, which is the dominant feature of that combined word and design trademark. As usual, the country code Top-Level Domain (“ccTLD”) “.co” is disregarded as a standard registration requirement. See *id.* section 1.11.2.

The Panel finds, therefore, that the Domain Name is confusingly similar to the Complainant’s registered MEDIA KIOSK mark for purposes of the Policy, paragraph 4(a)(i) and concludes that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which 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 domain name in connection with a *bona fide* offering of goods or services; or
- (ii) that 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.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, and the Respondent’s failure to make use of the Domain Name. Thus, the Complainant has made a *prima facie* case, and the burden of production shifts to the Respondent. The Respondent has not come forward with evidence of rights or legitimate interests.

The Panel finds that the Respondent has not met the burden of production and concludes that the Complainant prevails on the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a, illustrative list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”. These examples are expressly non-exclusive, however, and the Complainant correctly observes that UDRP panels from the beginning have entered findings of bad faith in cases where respondents have not yet made active use of domain names confusingly similar to distinctive trademarks, in circumstances where any legitimate use is implausible. As summarized in [WIPO Overview 3.0](#), section 3.3, WIPO panels typically weigh “(i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put”.

Here, the mark is distinctive and long-established. The textual element is a compound term, not a dictionary word in French or English. Top query results for “mediakiosk” on popular search engines point to the Complainant and its mark; it is not necessary to be familiar with the French market. Thus, it is fair to presume prior awareness of the distinctive mark, and the Respondent does not deny such knowledge. The Respondent registered the Domain Name through a domain privacy service. This may be done for credible reasons such as avoiding spam and preserving personal privacy, so this factor alone is not determinative of an attempt to conceal identity. However, the Respondent ultimately failed to submit a substantive Response offering an alternative motive for choosing the Domain Name and holding it for later use or resale, apart from a presumed intent ultimately to profit from the Domain Name’s confusing similarity to a trademark.

On balance, the Panel finds that the Respondent’s conduct fits the pattern of passive holding and concludes that the Respondent more likely than not registered and used the Domain Name in bad faith within the meaning of the Policy; notably the Respondent did not answer the claims to have done so. Thus, the Complainant has established the third element of the Complaint.

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 Domain name, <mediakiosk.co>, be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: March 22, 2022