

## **ADMINISTRATIVE PANEL DECISION**

Panavision International, L.P., Panavision Inc. v. Michael Nava /or Domain Nerdz LLC

Case No. DCO2022-0042

### **1. The Parties**

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

Respondent is Michael Nava /or Domain Nerdz LLC, United States.

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

The disputed domain name <panavision.co> is registered with Sav.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 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 20, 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 Complainants on May 23, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to Complaint. Complainants filed an amended Complaint on May 25, 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 Respondent of the Complaint, and the proceedings commenced on May 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 16, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 17, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on June 22, 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**

Complainants Panavision International, L.P., a Delaware limited partnership, and Panavision Inc., a Delaware corporation (collectively “Complainant” or “Panavision”), provide ultra-precision digital imaging and visual cinematographic equipment, including cameras, optical lenses, photographic equipment, lighting, and accessories, as well as end-to-end production and post production services. Founded in 1954 to design and manufacture wide-screen film photographic and projection lenses, Complainant has developed global name-recognition and a reputation for making premier cinematographic equipment development associated with a high-quality visual experience. For decades, Complainant has continuously maintained its PANAVISION brand and trademark through extensive use and protection. Complainant’s brand, trade name, and other intellectual property are the result of significant investment.

Complainant provides PANAVISION equipment and services in the United States and around the world, through its affiliates in the United Kingdom, South Africa, Canada, Poland, Czech Republic, Ireland, France, Belgium, Australia, and New Zealand, and through a network of distributors throughout Asia and in Italy, Spain, and Mexico.

Complainant owns over 180 trademark registrations for the PANAVISION mark (the “Mark”) in multiple jurisdictions, with sample registration details as follows:

- PANAVISION, United States Trademark Reg. No. 627,362, registered on May 22, 1956;
- PANAVISION, United States Trademark Reg. No. 845,014, registered on February 27, 1968;
- PANAVISION, United States Trademark Reg. No. 834,705, registered on September 5, 1967.

Complainant has continuously used the PANAVISION mark in connection with cinematographic equipment and services for over 65 years. Complainant also owns and operates the <panavision.com> domain name, which it has continuously used in commerce since 1998. The disputed domain name was registered on April 13, 2022. Currently and at the time of the submission of the Complaint, the disputed domain name resolves to a parked page with an offer to sell the domain.

#### **5. Parties’ Contentions**

##### **A. Complainant**

According to Complainant, the disputed domain name is identical to Complainant’s PANAVISION trademark in which Complainant has rights as demonstrated through its cited registrations. The Mark was adopted and has been continuously used since at least as early as 1956 in connection with cinematographic equipment and services. Complainant maintains its online presence through its website hosted at its domain name <panavision.com>.

Complainant argues that the disputed domain name fully incorporates the Mark. Complainant argues that, due to the complete reproduction of Complainant’s prior well-known trademarks, Internet users will obviously and wrongly think that the disputed domain name belongs to Complainant or has been registered in its name. Complainant argues that a likelihood of confusion is therefore undeniable and is reinforced by the high degree of recognition enjoyed by Complainant in relation to a wide range of cinematographic equipment and services. Complainant also argues that previous panels have found that the PANAVISION Mark enjoys a degree of fame around the world.

Complainant asserts that Respondent lacks any rights or legitimate interests in the disputed domain name. According to Complainant, Respondent is not known by nor does it have any trademark rights to the Mark.

Complainant also asserts that it has not granted Respondent, by license or otherwise, permission to use the Mark in any way. Complainant argues that the disputed domain name was registered by Respondent without Complainant's consent. Complainant also argues that PANAVISION is an invented word, and so Respondent would not have any reason to use it unless to trade on Complainant's fame and reputation.

Complainant argues that Respondent both registered and is using the disputed domain name in bad faith. Complainant argues that Respondent specifically and personally sent both Complainant as well as counsel for Complainant explicit offers to sell the disputed domain name. Complainant argues that this offer was for an unreasonable expense, which likely surpassed Respondent's out-of-pocket costs, and that previous Panels have found that an offer to sell a domain name for an amount in excess of reasonable out-of-pocket costs is evidence of bad faith pursuant to paragraph 4(b)(i) of the Policy. Complainant argues that Respondent could not have been unaware of the existence of Complainant's famous trademarks and company name when registering the disputed domain name. Complainant argues that the mere fact that Respondent has registered the disputed domain name which incorporates the famous PANAVISION mark, especially without having any rights to the Mark, is sufficient to give rise to an inference of bad faith. Additionally, Complainant argues that the explicit offer to Complainant to sell the disputed domain name is clear evidence of bad faith. Complainant also argues that Respondent's pattern of cybersquatting domain names utilizing famous marks, as evidenced by numerous Panel decisions against Respondent, clearly shows bad faith. Complainant argues that such actions clearly show that the disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Under paragraphs 5(f) and 14(a) of the Rules, the effect of a default by a respondent is that, in the absence of exceptional circumstances, the panel shall proceed to a decision on the basis of the complaint.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A respondent's default does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that the complainant's allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Thus, even though Respondent has failed to address Complainant's contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

### **A. Identical or Confusingly Similar**

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the PANAVISION trademark as referenced above. Therefore, Complainant has established that it has rights in the Mark.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain (“TLD”) in which the domain name is registered) is identical or confusingly similar to Complainant’s mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7. 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 disputed domain name. *Id.*

Here, the disputed domain name incorporates the entirety of the Mark without any additional language. A side-by-side comparison of the Mark and the disputed domain name reveals that the Mark is easily identifiable within the disputed domain name, as they are identical.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is identical to its PANAVISION mark.

## **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

- (i) before any notice of the dispute, 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) Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) 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.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant’s contention that Respondent is not an assignee or licensee of Complainant and that Respondent has no other business relationship with Complainant. Complainant has contended that Respondent is not commonly known by the disputed domain name and that there is no evidence that Respondent has established trademark rights in the disputed domain name. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights. Respondent has used the identical disputed domain name to resolve to a parked page where it is offered for sale, which cannot constitute a *bona fide* offering nor noncommercial use supporting a finding of rights or legitimate interests.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain name.

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

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy 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.

Here, Respondent's actions align with 4(b)(i) of the Policy. The disputed domain name contains the entirety of the PANAVISION mark. Due to the well-known nature of Complainant's brand, evidenced by its numerous trademark registrations for PANAVISION, along with the unauthorized use of the Mark in the disputed domain name, Respondent was undoubtedly aware of Complainant and the Mark when it registered the disputed domain name. The disputed domain name resolves to a parked webpage advertising the sale of the disputed domain name. Complainant has also provided evidence that Respondent directly and explicitly offered Complainant to sell the disputed domain name for an expense, likely greater than its out-of-pocket costs, and greater than any reasonable out-of-pocket costs. Respondent's use of the Mark in the disputed domain name in connection with Respondent's offer to sell the disputed domain name to Complainant clearly evidences bad faith on the part of Respondent in the registration and use of the disputed domain name.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain name, registered primarily for the purpose of selling the disputed domain name to Complainant who is the owner of the PANAVISION trademark, for valuable consideration likely to be in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name, as per paragraph 4(b)(i) 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 <panavision.co> be transferred to Complainant.

*/Brian J. Winterfeldt/*

**Brian J. Winterfeldt**

Sole Panelist

Date: July 6, 2022