

## **ADMINISTRATIVE PANEL DECISION**

### **UBISOFT ENTERTAINMENT v. Frax Frax**

#### **Case No. D2024-2217**

#### **1. The Parties**

The Complainant is UBISOFT ENTERTAINMENT, France, represented internally.

The Respondent is Frax Frax, United Kingdom.

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

The disputed domain names <ubisoft.wtf> and <ubisoft7.com> are registered with GoDaddy.com, LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) with respect to three disputed domain names on May 29, 2024. On May 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 30, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 31, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same date, the Respondent sent two informal email communications to the Center. The Complainant filed an amended Complaint on June 3, 2024, indicating that the domain name <ubisofts.com> should be removed from the Complaint. The Respondent sent another informal email communication to the Center on June 4, 2024. On June 4, 2024, the Center sent to the Parties the notification of partial withdrawal, indicating that the current proceedings should be carried out only with respect to the two disputed domain names <ubisoft.wtf> and <ubisoft7.com>.

On June 11, 2024, the proceeding was suspended upon the Parties’ request, and reinstated on June 21, 2024. 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 June 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2024. The Response was filed with the Center on June 30, 2024.

The Center appointed Andrea Mondini as the sole panelist in this matter on August 8, 2024. 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 headquartered in France and is a creator and publisher of videogames.

The Complainant holds several domain names containing the term “Ubisoft”, among them <ubisoft.com> which was registered in 1995 and hosts its main website.

The Complainant owns numerous trademark registrations in several jurisdictions, including:

TRADEMARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE	INTERNATIONAL CLASS
UBISOFT	European Union	003427986	May 12, 2005	9, 16, 25, 28, 35, 38, 41, and 42
UBISOFT	United States of America	2237933	April 13, 1999	9, 28

In its communications to the Center, the Respondent did not provide information on his or her identity and activities. Therefore, not much is known about the Respondent.

The disputed domain name <ubisoft.wtf> was registered on October 19, 2023, and the disputed domain name and <ubisoft7.com> was registered on December 13, 2023.

According to the evidence submitted with the Complaint, the disputed domain names resolve to inactive pages.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends as follows:

The disputed domains names are confusingly similar to the UBISOFT trademark in which the Complainant has rights, because they incorporate this trademark in its entirety, and the addition of the number “7” is not sufficient to avoid confusing similarity.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent has not been authorized by the Complainant to use this trademark, is not commonly known by the disputed domain names, and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain names in connection with a bona fide offering of goods and services.

The disputed domain names were registered in bad faith because it is obvious that the Respondent had knowledge of both the Complainant and its well-known trademark UBISOFT at the time it registered the disputed domain names.

The Respondent is using the disputed domain names in bad faith, by passively holding the disputed domain names.

## **B. Respondent**

The Respondent repeatedly stated in essence that it agrees to transfer the disputed domain names to the Complainant.

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the 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**

It is well accepted that the first element functions primarily 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain names.

Although the addition of other elements such as here the number "7" may bear on assessment of the second and third elements, the Panel finds that in the present case the addition of the number "7" does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The addition of the respective generic Top-Level Domains ("gTLD") in the disputed domain names is a standard registration requirement and as such may be disregarded under the confusing similarity test under the Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that for a complainant to prove that a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 a prima facie case that

the 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. Furthermore, the Panel notes the composition of the disputed domain names, which carries a risk of implied affiliation with the Complainant, [WIPO Overview 3.0](#), section 2.5.1.

The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise. To the contrary, the Respondent stated that it is willing to transfer the disputed domain names to the Complainant.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the view of the Panel, noting that that the Complainant's trademark predates the registration of the disputed domain names and considering that the Complainant's trademark is well-known, it is inconceivable that the Respondent could have registered the disputed domain names without knowledge of the Complainant's well-known trademark. In the circumstances of this case, this is evidence of registration in bad faith.

The disputed domain names currently resolve to inactive sites. Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, and the fact that the Respondent did not provide any evidence of actual or contemplated good-faith use, but to the contrary stated that it is willing to transfer the disputed domain names.

Therefore, the Panel finds that in the circumstances of this case the passive holding of these disputed domain names does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy with regard to the disputed domain names.

## 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 names <ubisoft.wtf> and <ubisoft7.com> be transferred to the Complainant.

*/Andrea Mondini/*

**Andrea Mondini**

Sole Panelist

Date: August 22, 2024