

ADMINISTRATIVE PANEL DECISION

Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v.
Privacy service provided by Withheld for Privacy ehf / Carolina Rodrigues
Case No. D2022-2899

1. The Parties

The Complainant is Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco, Monaco, represented by De Gaulle Fleurance & Associés, France.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Carolina Rodrigues, Panama.

2. The Domain Name and Registrar

The disputed domain name <montecarlosb.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 8, 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 August 10, 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 amended Complaint on August 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 August 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 5, 2022.

The Center appointed Douglas Clark as the sole panelist in this matter on September 14, 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 Monaco company founded in 1863 and is in the business of casino operation and casino gaming services. The Complainant operates under the trade name "Monte-Carlo SBM" and operates its social media accounts under the same name.

The Complainant owns several trade mark registrations including the following:

- the word mark CASINO DE MONTE-CARLO registered in Monaco on October 30, 1996, under No. 17485 and renewed on October 10, 2006, under No. R96.17407; and
- the word mark MONTE-CARLO registered in Monaco on February 12, 2014 under No. 14.30170.

The disputed domain name <montecarlosb.com> was registered on May 13, 2022. At the date of this decision, the disputed domain name resolved to a webpage with pay-per-click links to third-party websites.

The Respondent is an individual with an address in Panama.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

(a) The disputed domain name is confusingly similar to its trade mark. The disputed domain name is almost identical to the Complainant's trade mark along with the addition of the letters "sb". Further, it incorporates the Complainant's trade name save for the removal of the letter "m". The use of the generic Top-Level Domain ("gTLD") ".com" in the disputed domain name does not eliminate the overall notion that the designation is connected to the trade mark and the likelihood of confusion that the disputed domain name and the trade mark are associated;

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Complainant has never granted any authorization or license to use the Complainant's trade mark. The Respondent is not commonly known by the disputed domain name, and has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name; and

(c) The disputed domain name was registered and is being used in bad faith. The mere fact that the Respondent has registered the disputed domain name incorporating the trade mark of a well-known company gives rise to an inference of bad faith. Based on the use of the disputed domain name, the Respondent registered and is using the disputed domain name to attract Internet users for commercial gain, creating a likelihood of confusion with the Complainant's trade mark. Further the Respondent is a serial cybersquatter.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

- (i) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights to;
- (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 disputed domain name <montecarlosb.com> is confusingly similar to the Complainant's trade mark. The disputed domain name reproduces the MONTE-CARLO trade mark in its entirety save for the omission of the hyphen and the addition of the letters "sb". The gTLD ".com" is generally disregarded when considering the first element. (See section 11.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Panel notes that the Complainant did not rely on any registered trademarks in Panama where the Respondent is located. The ownership of a trademark is generally considered to be a threshold standing issue. The location of the trademark, its date of registration (or first use) and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP. These factors may however bear on a panel's further substantive determination under the second and third elements. (See section 1.1.2 of the [WIPO Overview 3.0](#)).

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent has no business with and is in no way affiliated with the Complainant. The Respondent is not authorized to use the Complainant's MONTE-CARLO trade mark or to apply for registration of the disputed domain name. There is no evidence that the Respondent holds any intellectual property rights over any mark that contains the name "montecarlosb".

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, the Respondent has no rights or legitimate interests in regard to the disputed domain name.

The Complainant has therefore satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Based on the given evidence, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered long after the Complainant has registered and used the MONTE-CARLO trade mark. Panels in previous UDRP proceedings have recognized the Complainant's trade mark as a well-known trade mark. Moreover, the Panel notes that the disputed domain name is identical to the Complainant's trade name "Monte-Carlo SBM" save for the omission of the hyphen and the removal of the letter "m" which shows that the Respondent seeks to target the Complainant through the disputed domain name. The Panel is satisfied that the Respondent was aware of the Complainant and its MONTE-CARLO trade mark when the Respondent registered the disputed domain name.

The Respondent has registered the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy. The Panel also notes that the Respondent has engaged in a pattern of registering domain names corresponding to marks held by third parties. Furthermore, the Respondent was offering the disputed domain name for USD 899, an amount exceeding the typical cost of registering a ".com" domain name.

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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, <montecarlosb.com>, be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: September 28, 2022