

## **ADMINISTRATIVE PANEL DECISION**

### **IMAX CORPORATION v. Goutam Sontakke**

#### **Case No. D2023-1390**

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

The Complainant is IMAX CORPORATION, Canada, represented by Bereskin & Parr, Canada.

The Respondent is Goutam Sontakke, India.

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

The disputed domain name <imaxprojector.com> is registered with BigRock Solutions Ltd. (the “Registrar”).

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 30, 2023. On March 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 7, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 April 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 5, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on May 10, 2023. 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 uses the trademark IMAX in connection with theatre projectors which it manufactures and distributes. The Complainant owns many trademark registrations for IMAX such as:

- Canadian trademark registration No. 170,718, registered on August 21, 1970;
- Indian trademark registration No. 754336, registered on March 7, 1997.

The disputed domain name was registered on October 24, 2020, and resolves to a webpage which offers IMAX branded products as well as third party products.

#### **5. Parties' Contentions**

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

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant's trademark IMAX is well-known and distinctive. The disputed domain name incorporates the Complainant's trademark IMAX in its entirety. The disputed domain name includes the word "projector", which is not enough to eliminate confusing similarity. The generic Top-Level Domain ("gTLD") ".com" should typically be ignored.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not known by the disputed domain name and is not licensed by the Complainant to use its trademark as there is no relationship between the Complainant and the Respondent. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Respondent is attempting to obtain commercial gain. There is no *bona fide* offering of goods or services.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Respondent knew of the Complainant's trademark as the disputed domain name was registered over 50 years after the use of the trademark by the Complainant and 23 years after the registration of the trademark by the Complainant. Also, the Complainant's trademark is famous and is used on the website to which the disputed domain name resolves. Showing the Complainant's trademark creates an impression of affiliation with the Complainant, which is evidence of bad faith. This is a case of opportunistic bad faith as the disputed domain name includes the Complainant's trademark together with the term "projector", which is one of the core businesses of the Complainant.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

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

The Complainant owns trademark registrations for IMAX. The Panel is satisfied that the Complainant has established its ownership of the trademark IMAX.

The disputed domain name incorporates the Complainant's trademark in its entirety. The term "projector" does not alter the fact that the disputed domain name is confusingly similar to the Complainant's trademark. The generic Top-Level Domain ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not affiliated with nor authorized by the Complainant to use its trademark. The Respondent should prove that it has rights or legitimate interests.

According to the Policy, the use of the disputed domain name would be legitimate if it is used in connection with a *bona fide* offering of goods or services. The website to which the disputed domain name resolves offers products including what seem to be products of the Complainant. Therefore, there may be an argument that the disputed domain name is being used in connection with a *bona fide* offering of products. In line with the *Oki Data* test, a number of requirements have to be met (see *Oki Data, supra*):

1. "Respondent must actually be offering the goods or services at issue";
2. "Respondent must use the site to sell only the trademarked goods";
3. "The site must accurately disclose the registrant's relationship with the trademark owner"; and
4. "The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name".

The Panel analyzes each of these requirements below:

- Requirement No. 1: This requirement is met;
- Requirement No. 2: This requirement is not met in the instant case as the disputed domain name resolves to a website which offers the Complainant's products together with third party products;
- Requirement No. 3: This requirement is not met as the website does not include a statement demonstrating that it does not belong or is not affiliated with the Complainant;
- Requirement No. 4: This requirement is met as there are no numerous registrations by the Respondent of domain names containing the trademark of the Complainant.

Requirements No. 2 and 3 have not been met. Therefore, it is the Panel's view that the requirements of the *Oki Data* test have not been met.

Moreover, the Respondent did not reply to the Complainant's contentions.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

The Respondent clearly knew of the Complainant's business and trademark as the disputed domain name resolves to a website offering the products of the Complainant. Also, the disputed domain name was registered 50 years after the registration of the Complainant's trademark. Additionally, the nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant's trademark which is well-known together with the word "projector", which is one of the key products of the Complainant.

The disputed domain name resolves to a website, which offers not only the Complainant's products but also other products of the same or similar nature. Offering competing products is an indication of bad faith use. As such, the disputed domain name suggests affiliation with the Complainant in order to attract consumers and offer competing services. This is an act of bad faith (see *Intex Recreation Corp. v. RBT, Inc., Ira*

Weinstein, WIPO Case No. [D2010-0119](#); *MasterCard International Incorporated v. Global Access*, WIPO Case No. [D2008-1940](#)).

Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy, and accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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, <imaxprojector.com> be transferred to the Complainant.

*/Nayiri Boghossian/*

**Nayiri Boghossian**

Sole Panelist

Date: May 17, 2023