

ADMINISTRATIVE PANEL DECISION

Pathe Marques v. Hortense PATHE, WEB C LTD

Case No. D2023-3277

1. The Parties

The Complainant is Pathe Marques, France, represented by ARDAN, France.

The Respondent is Hortense PATHE, WEB C LTD, France.

2. The Domain Name and Registrar

The disputed domain name <hdpathe.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 31, 2023. On July 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 1, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 1, 2023, 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 August 7, 2023.

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 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2023. The Respondent did not submit any formal response but sent an email communication to the Center on August 8, 2023, explaining that the disputed domain name corresponded to the Respondent’s given name. Accordingly, the Center notified the Parties with the Commencement of Panel Appointment Process.

The Center appointed Vincent Denoyelle as the sole panelist in this matter on September 7, 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.

On October 2, 2023, the Panel issued Procedural Order No. 1, requiring the Respondent to submit official proof of its identity. In Procedural Order No. 1 the Panel also invited the Complainant to comment on the submission of the Respondent. On October 9, 2023, the Respondent submitted relevant documentation. In response to the Respondent's submission and as invited by the Panel in Procedural Order No. 1, the Complainant filed its comment in the form of an amended Complaint on October 20, 2023. On October 25, 2023, the Respondent filed a Supplemental Filing. On October 26, 2023, the Center sent an acknowledgment of receipt of the Supplemental Filing to the Respondent and the Complainant and, in agreement with the Panel, granted an opportunity to the Complainant to submit comments on the Respondent's Supplemental Filing. The Complainant did not submit any comment on the Respondent's Supplemental Filing. On November 3, 2023, the Respondent submitted another unsolicited supplemental filing which included evidence previously submitted as well as a letter from the Respondent's lawyer.

4. Factual Background

The Complainant is a film production and distribution company headquartered in France.

The Complainant is the owner of several PATHE trade marks including the following;

European Union Trade Mark PATHE No. 008463391 filed on October 12, 2009, and registered on June 28, 2010, in classes 9, 16, 25, 28, 35, 38, 41, 42, and 43.

The disputed domain name was registered on April 9, 2021.

The disputed domain name pointed to a registrar parking page stating it "is parked free, courtesy of GoDaddy.com" and including a "Get This Domain" link as well as keywords which would appear to be Pay-Per-Click ("PPC") links, which according to the evidence on record varied over time. The Complainant produced screen captures of the website associated with the disputed domain name where the hyperlink categories referred to the Complainant's industry sector whilst the screen captures provided by the Center as part of the record communicated to the Panel, referred to hyperlink categories which referred to keywords that did not appear to refer to the Complainant's industry including references to hotels based in Türkiye.

The Respondent's given first and middle names include the initials "H.D.", and the Respondent's given last name is "Pathe" as the Respondent's documentation confirmed.

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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the PATHE trade mark in which the Complainant has rights as the disputed domain name incorporates the entire PATHE trade mark with the addition of the two letters "h" and "d" and that such addition does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trade mark.

The Complainant asserts that it has not granted any authorization to anyone, which includes the Respondent, to register domain name containing the Complainant's trade marks or otherwise make use of its marks. The Complainant considers that whilst the disputed domain name includes the Respondent's surname, the Respondent has no legitimate interests in registering the disputed domain name. The Complainant contends that that the Respondent is not using nor preparing to use the disputed domain name in connection with a *bona fide* offering of goods or services and is not 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 trade mark or service mark at issue.

Turning to the issue of bad faith, the Complainant argues that given its reputation in France it would not have been possible for the Respondent not to have known of the Complainant and its PATHE trade mark and that the disputed domain name was registered to target the Complainant's trade mark. As for use of the disputed domain name in bad faith, the Complainant points to the fact that it redirected to a parking page with links relating to the Complainant's industry which means that the disputed domain name is used with a view to attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trade mark.

B. Respondent

As the registrant and contact information disclosed by the Registrar showed that the first initial of the Respondent is the letter "h" and the Respondent's last name is "pathe", the Panel issued Procedural Order No. 1, concerning the Respondent's identity. The Respondent did provide evidence confirming that the letters "h" and "d" correspond to the initials of the Respondent first name and the Respondent's first middle name and confirming that "Pathe" is the Respondent's exact last name.

The Respondent also explained in unsolicited supplemental filings that she had used the moniker "hd pathe" as part of her online activities and provided several screen captures showing that this moniker had been used on several websites and social media accounts and in preparation for a *bona fide* offering of services under the disputed domain name.

6. Discussion and Findings

6.1 Preliminary Procedural Issue - Admissibility of Supplemental Filing from the Respondent

Under the Rules, no express provision is made for supplemental filings by either Party, except in response to a deficiency notification or if requested by the Center or the Panel. Paragraphs 10 and 12 of the Rules in effect grant the Panel sole discretion to determine the admissibility of unsolicited supplemental filings. Admissibility of supplemental filings is to be assessed based on relevance and foreseeability (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 4.6).

The Panel admits the first Supplemental Filing of the Respondent, dated October 25, 2023, given that it provides some clarification as to the potential contemplated use of the disputed domain name and preparations allegedly made in this respect and also because the Complainant was invited and given an opportunity to submit any comments on the Respondent's contentions. As for the second unsolicited supplemental filing from the Respondent dated November 3, 2023, the Panel will not admit it as the Respondent and the Respondent's lawyers would have had sufficient time and opportunities to submit such supplemental filing earlier in the proceeding.

6.2 Discussion and Findings

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 trade mark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trade mark 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 name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, the letters "hd", may bear on assessment of the second and third elements, the Panel finds that such addition does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, 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.

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. [WIPO Overview 3.0](#), section 2.1.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the disputed 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) the respondent has been commonly known by the domain name, even if it has acquired no trade mark 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 trade mark or service mark at issue.

After careful consideration of the record, the Panel is unable to conclude that the Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

According to [WIPO Overview 3.0](#), section 2.3: “Insofar as a respondent’s being commonly known by a domain name would give rise to a legitimate interest under the Policy, panels will carefully consider whether a respondent’s claim to be commonly known by the domain name – independent of the domain name – is legitimate. Mere assertions that a respondent is commonly known by the domain name will not suffice; respondents are expected to produce concrete credible evidence.”

In the present case, the Respondent has produced concrete credible evidence, which the Panel must accept in the absence of any rebuttal evidence from the Complainant, that the term “hdpathe” at the second level in the disputed domain name corresponds to the initials of the Respondent’s first name and the Respondent’s first middle name and the Respondent’s exact last name, to the exclusion of any other terms.

The registration of domain names is based on the “first come, first served” principle and the Policy provides a narrow exception to that principle. It is reasonable for someone to register a domain name that corresponds to their own given name. Whilst the Panel does not dispute the fact that the PATHE trade mark of the Complainant has acquired substantial goodwill, it does not mean that, for the purpose of the Policy, the Complainant could claim to have some form of exclusivity over a term which in part includes its mark. Deciding otherwise would render paragraph 4(a)(ii) of the Policy superfluous and would contradict the plain meaning of paragraph 4(c)(ii) of the Policy (see e.g., *Ken’s Foods Inc. v. kens.com*, WIPO Case No. [D2005-0721](#) and *Gail Guarulhos Indústria e Comércio Ltda. V. Kevin Watson*, WIPO Case No. [D2006-0655](#)).

The Panel recognizes that the disputed domain name was on several occasions resolving to a free PPC parking page provided by the Registrar, but it considers that such use in this case is not sufficient to override the fact that the disputed domain name consists of the Respondent’s given name to the exclusion of other terms and thus it should not preclude a finding that the Respondent has rights or legitimate interests in the disputed domain name (see e.g., *Raja v. Raja Aji, raja.com*, WIPO Case No. [D2019-1680](#)). The Panel recognizes that the initials of the Respondent’s first name and first middle name do have a meaning in the Complainant’s field of business however the meaning of these two letters is not exclusive and the Respondent has produced satisfactory evidence of the fact that the two letters in question correspond to its first two initials, in the same order as they appear on the evidence produced by the Respondent.

The Complainant’s reliance on the previous panel decision in *Irish Distillers Limited v. James Powers*, WIPO Case No. [D2010-2008](#) is misplaced as the previous case relied upon referred to the domain name <powerswhiskey.com> and the given name of the respondent was “Powers” and its combination with another term, “whiskey”, was not legitimate in that case. In the present case, the whole of the disputed domain name, at the second level, corresponds to the Respondent’s given name – initials plus family name.

Further, in the Respondent’s Supplemental Filing dated October 25, 2023, the Respondent provided some clarification as to the use made on other platforms (including social networks) of the moniker “hdpathe” and preparations allegedly made in respect of the use of the disputed domain name for the offering of marketing services, not related to or in competition with the Complainant. The Complainant was invited to submit any comments on the Respondent’s contentions but did not do so. Whilst the Panel is not fully convinced that the Respondent is unaware of the fact that the name also incorporates a well-known mark (and could conceivably take advantage of such fact), the fact is that the Complainant bears the ultimate burden of establishing under paragraph 4(a)(ii) that the Respondent has no rights or legitimate interests with respect to the disputed domain name and the Complainant has provided no rebuttal to the Respondent’s arguments and evidence related to its intended use of the disputed domain name.

While the present matter is not without doubt, on balance and on the basis of the respectively submitted evidences, the Panel is of the view that the Respondent has rights or legitimate interests in the disputed domain name.

In addition, it is not for the Panel to decide on whether the use of the Respondent’s own name could in any way infringe any intellectual property rights of the Complainant and this must be left to other fora.

Based on the available record, the Panel finds the second element of the Policy has not been established.

C. Registered and Used in Bad Faith

Given that the Panel has decided that the Respondent has a legitimate interest in the disputed domain name and as the three prongs of the UDRP are cumulative, the Panel concludes that the Complainant's application must be refused and it is not necessary to proceed to consider whether the disputed domain name has been registered and is being used in bad faith.

However, in the interests of completeness and for the integrity of the proceedings under the UDRP, the Panel will briefly address whether the Complaint met the requirements under the third element under paragraph 4(a) of the Policy.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances that suggest bad faith registration. In addition, panels may draw inferences about bad faith registration or use in light of the circumstances, such as whether the complainant has particularly strong trade mark rights, whether there is a lack of response to the complaint, and whether there exists a lack of conceivable good faith uses for the domain name.

Starting with the issue of whether the Respondent registered the disputed domain name in bad faith, the Panel considers that as the whole of the disputed domain name, at the second level, corresponds to the Respondent's given name, it is on balance plausible that the Respondent would have registered the disputed domain name in good faith, because it matches its given name. Whilst at the time of registration of the disputed domain name the Respondent could well have been aware of the Complainant and its trade mark given the reputation of the PATHE trade mark, especially within the French public, the Respondent effectively holds competing rights to the term "Pathe" on which the Complainant does not have an exclusivity. The Complainant, who has the burden to demonstrate that the disputed domain name was registered in bad faith, did not put forward a sufficient case to support such finding and the Panel thus considers that it is not established that the disputed domain name was registered in bad faith.

Turning to the use of the disputed domain name in bad faith, based on the available record it shows that at times the disputed domain name has directed to a registrar dynamic parking page stating it "is parked free, courtesy of GoDaddy.com" and a "Get This Domain" link as well as keywords which would appear to be PPC links, which according to the evidence on record varied over time, some relevant to the Complainant, some not. This specific circumstance taken individually could constitute evidence of bad faith use of the disputed domain name, but the Panel concludes that the Complaint also fails to meet the requirements of Policy paragraph 4(a)(iii) given that bad faith needs to be substantiated both for registration and use of the dispute domain name.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Vincent Denoyelle/

Vincent Denoyelle

Sole Panelist

Date: November 7, 2023