

WIPO Arbitration and Mediation Center

Case No. WIPO2021PL2

FINAL AWARD

In the matter of an arbitration under the
WIPO Expedited Arbitration Rules for Domain Name disputes under .PL

between:

Pierre Fabre Dermo-Cosmétique
45 Place Abel Gance
92100 Boulogne-Billancourt
France

Claimant

and

Mr Daniel Fuehrer
Gustav-Heinemann-Strasse 15A
Linden 35440
Germany

Respondent

Arbitral Tribunal

Dr. Christian Gassauer-Fleissner

Representatives of the Claimant

DE GAULLE FLEURANCE & ASSOCIÉS
Ms Adèle Binné
9, rue Boissy d'Anglas, 75008 Paris
France

Representatives of the Respondent

Mr Christian Kerschbaum
Pruefeninger Strasse 35
93049 Regensburg
Germany

This is the Award issued by me as Sole Arbitrator in a dispute between Pierre Fabre Dermo-Cosmétique (the "Claimant") and Mr Daniel Fuehrer (the "Respondent") regarding a dispute over the domain name <avene.pl> (the "disputed domain name").

1. THE PROCEEDINGS

1.1. Parties to the Arbitration:

1.1.1 The Claimant is Pierre Fabre Dermo-Cosmétique of France.

1.1.2 The Respondent is Mr Daniel Fuehrer of Germany.

1.2. Arbitration Agreement, Rules and Place of Arbitration:

1.2.1 This case has been submitted under Articles 6-9 of the WIPO Expedited Arbitration Rules for Domain Name disputes under .PL (the "Expedited Rules"; available at <https://www.wipo.int/amc/en/domains/rules/cctld/expedited/pl/index.html>). Both parties have signed the Arbitration Agreement in accordance with Article 6 Expedited Rules.

1.2.2 The version of the Expedited Rules applicable to the present arbitral proceedings is, pursuant to Article 2 (b) Expedited Rules, that in effect as of the date of commencement of this arbitration.

1.2.3 In accordance with Article 34 Expedited Rules, the parties agreed that the Place of Arbitration be Vienna, Austria.

1.3. Procedure:

1.3.1. On August 26, 2021, the Claimant transmitted by email to the WIPO Arbitration and Mediation Center (the "Center") and to the Respondent the Request for Arbitration together with the Statement of Claim (together, the "Statement of Claim") in accordance with Article 10 Expedited Rules. The Center requested the Respondent to file the Answer to the Request and Statement of Defense by September 15, 2021.

1.3.2. Pursuant to Article 8 Expedited Rules, the date of commencement of the arbitration is August 26, 2021.

1.3.3. On September 10, 2021, after receipt of the Statement of Acceptance, Impartiality and Independence, the Center appointed the undersigned, Dr. Christian Gassauer-Fleissner, as Sole Arbitrator pursuant to Article 15 Expedited Rules.

1.3.4. On September 15, 2021, the Center, upon request by the Respondent, extended the deadline to file the Answer to the Statement of Claim until September 22, 2021.

1.3.5. The Respondent transmitted by email to the Center the Answer to the Request and Statement of Defense on September 22, 2021.

1.3.6. On October 19, 2021, a preparatory conference was conducted pursuant to Article 39 in which the Parties agreed to Vienna as the place of arbitration and to the Uniform Domain Name Dispute Resolution Policy (the "UDRP" or the "Policy") as the law applicable to the substance of the dispute. Furthermore, the parties discussed the merits of the case. The parties waived their right to request a hearing and stated that they are not amenable to pursuing a settlement agreement.

1.3.7. On November 9, 2021, with reference to Article 44 Expedited Rules, the Tribunal declared the proceedings closed.

2. SUMMARY OF SUBMISSIONS

2.1. In its Statement of Claim and during the Preparatory Conference, the Claimant stated the following:

2.1.1. The Claimant is a company incorporated in France offering dermatological products and beauty treatments under several major brands of worldwide renown. Among them is the AVENE mark, which was launched in 1990 and is used for cosmetic products in more than 100 countries, notably in Europe, Japan and China.

2.1.2. The Claimant is the owner of numerous trademarks including the term "AVENE", among them

- A AVENE International Registration No. 440204, registered on August 24, 1978, in respect of goods in classes 3, 5 and 32, with a designation under the Madrid Protocol for Germany among others; and
- EAU THERMALE AVENE Polish Registration No. R-88342, registered on January 17, 1996, in respect of services in classes 3 and 5.

2.1.3. The Claimant also owns a wide domain name portfolio, including domain names composed with the term AVENE, such as the domain name <avene.it> registered on February 22, 2000, and <avene.us> registered on April 24, 2002.

2.1.4. The Claimant holds that the disputed domain name, registered by the Respondent on July 6, 2006, infringes its trademarks.

2.1.5. First, the disputed domain name is confusingly similar to Claimant's trademarks since it incorporates the A AVENE mark nearly in its entirety and furthermore contains the distinctive part of the EAU THERMALE AVENE mark. Furthermore, neither the disputed domain name nor the Claimant's trademarks are descriptive of the French commune Avène which is not known in France, let alone in the rest of Europe. Therefore, the term AVENE is associated by a far larger number of people in Europe with the Claimant's trademarks as with the commune. The Claimant's trademarks are therefore distinctive.

2.1.6. Second, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not commonly known by the disputed domain name and the Claimant never agreed to its use by the Respondent. The Respondent only used the disputed domain name to host a "parked" page comprising pay-per-click links related to the Claimant's trademark. Furthermore, the Respondent now offers the disputed domain name for sale.

2.1.7. Third, the disputed domain name was registered and is being used in bad faith. By using the domain name, the Respondent intentionally attempts to attract for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Claimant's trademarks. Additionally, the Respondent likely registered the disputed domain name for the purpose of selling it for valuable consideration exceeding the Respondent's out-of-pocket costs related to the disputed domain name. Lastly, Respondent has previously been involved in UDRP cases, which provides evidence that the Respondent registers domain names in bad faith.

2.1.8. The Claimant by way of relief pursuant to Article 36 (a) and (b) Expedited Rules requests that the disputed domain name be transferred to the Claimant

2.2. In its Statement of Defense and during the Preparatory Conference, the Respondent stated the following:

2.2.1. First, the disputed domain name is neither identical nor confusingly similar to a trademark in which the Claimant has rights. The disputed domain name is purely descriptive of a French commune named Avène. This commune is also known in Poland, which is evidenced by a Polish Wikipedia article about this commune. Due to this similarity with the commune Avène, also the Claimant's trademarks are not distinctive and furthermore misleading if they are not used for cosmetics originating in this commune. Furthermore, the descriptive character of the marks cannot be changed by the fact that the trademarks are known by a larger part of the European and, in particular, the Polish public than the commune Avène.

2.2.2. Second, a domain name investor is a legitimate business according to decisions by UDRP panels and the German Supreme court. Therefore, the Respondent has a legitimate interest in purchasing and selling domain names that have potential value for website development, email, mobile applications, or other lawful uses.

2.2.3. Third, the Respondent was unaware of the Claimant's marks when registering the disputed domain name. The Respondent owns thousands of domain names and is thus not able to check the registered domain name for potential trademark infringement. Also, the use of the disputed domain name to host a "parked" page comprising pay-per-click links related to the Claimant's trademark is not evidence of bad faith. These links were created automatically by a third party and the Respondent was never aware of any connection to the Claimant. After the commencement of the present proceedings, the Respondent also sent a cease-and-desist declaration to the Claimant, stating in essence that the Respondent will refrain from using the disputed domain name to offer goods and services for which the Claimant's marks are registered. Additionally, the Respondent offered the disputed domain name for sale only after the Claimant solicited such an offer by offering to buy the disputed domain name for EUR 10,000.-. The Claimant later admitted to the Respondent that this offer was only made to obtain information. This could be seen as reverse domain hijacking.

2.2.4. Furthermore, the Respondent acknowledges that the use of the disputed domain name to host a "parked" page comprising pay-per-click links related to the Claimant's trademark may have infringed the Claimant's trademarks. However, this cannot entitle the Claimant to request the transfer of the disputed domain name. Permissible under German law is only a prohibition to use a domain name in a way that creates likelihood of confusion with a registered trademark.

2.2.5. The Respondent by way of relief pursuant to Article 37 Expedited Rules requests that the Tribunal dismisses the claim of the Claimant as unfounded and to order the Claimant to bear all the costs of the arbitration, including the Respondent's costs on a full indemnity basis, including attorney's fees and expenses and all fees and other expenses incurred in participating in the present arbitration proceedings.

3. FINDINGS

3.1. The Applicable Law:

3.1.1 The Claimant and the Respondent signed the Arbitration Agreement on July 13, 2021, and August 9, 2021, respectively. The arbitration agreement includes the following paragraph:

"We, the undersigned parties, hereby agree that the dispute regarding the domain name <avene.pl> shall be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules for Domain Name Dispute Resolution under .PL."

3.1.2 Article 46 (a) Expedited Rules states:

“The Tribunal shall decide the substance of the dispute in accordance with the law or rules of law that it determines to be appropriate, taking into account any observations which the parties may have made. In all cases, the Tribunal shall decide having due regard to the terms of any relevant contract and taking into account applicable trade usages.”

3.1.3 Both the Claimant and the Respondent submit that the applicable law should be the UDRP. Both Parties developed their submissions under the UDRP requirements.

3.1.4 The UDRP was established by ICANN (the Internet Corporation for Assigned Names and Numbers) in 1999. ICANN runs a worldwide accreditation system for domain name registrars for gTLD, and draws up contracts with each registry. The UDRP has achieved wide acceptance since 1999. Paragraph 4 (a)-(c) of the UDRP establishes the substantive rules for the resolution of disputes between domain name owners and third parties, being an accepted international standard for cross-border domain name disputes. Paragraph 4(a)-(c) of the UDRP therefore is an authoritative, well-established and widely known set of transnational rules, designed for disputes, such as the present, relating to domain name registration alleged to infringe established trademarks or service marks. It provides the set of rules with which this dispute has the closest connection.

3.1.5. Moreover, previous Tribunals ruled that the UDRP may be the law according to Article 46(a) Expedited Rules based on which the substance of the dispute should be decided (WIPO2007PL1 Jagex Limited v. Mr Daniel Cox; WIPO2010PL2 Elite Licensing Company SA v. Jack Onopa; WIPO 2020PL2 Cristian Stollber v. MITON CZ, s.r.o.).

3.1.6. For these reasons and pursuant to Article 46 Expedited Rules the Tribunal decides that the appropriate substantive rules applicable to this dispute are those set out in the UDRP.

3.1.7. Paragraph 4(a) of the UDRP requires a Claimant to prove all three of the following elements: (i) that the disputed domain name *“is identical or confusingly similar to a trademark or service mark in which the Claimant has rights”*; (ii) that the respondent has *“no rights or legitimate interests in respect of the domain name”*; and (iii) that the respondent’s domain name *“has been registered and is being used in bad faith”*.

3.1.8. Paragraph 4(b) of the UDRP elaborates some circumstances that shall be evidence of the registration and use of the domain name in bad faith. Paragraph 4(c) sets out various circumstances which, if found by the Tribunal to be proven based on the evaluation of all the evidence presented, shall demonstrate that the Respondent has rights and legitimate interests in the disputed domain name.

3.1.9. Thus, in applying the UDRP in this case, the Claimant must prove these three elements in accordance with paragraph 4(a)-(c).

3.2 Paragraph 4(a)(i) UDRP: Identical or Confusingly Similar

3.2.1. The Tribunal finds that the disputed domain name is confusingly similar to the Claimant’s “A AVENE” trademark, in which the Claimant has established rights through registration.

3.2.2. Where the claimant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case (see paragraph 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, („WIPO Overview 3.0”). UDRP panels do not lightly disregard registered trademarks granted after examination by a national trademark authority. Previous UDRP panels, for example, have required clear and

convincing evidence of fraud or other grounds for invalidity under the relevant law, which generally should be proven before a court or trademark authority rather than in a limited UDRP proceeding (*Career Group, Inc. v. The Career Group Ltd v. Deborah Simonds*, WIPO Proceeding No. D2014-1296).

3.2.3. Regarding the allegation that a registered trademark is invalid because it is generic or descriptive, previous UDRP panels have required, in order to rebut the *prima facie* assumption of the validity of the mark, that the mark, or the part of the mark appearing in the disputed domain name, is so completely devoid of distinctive character that it is clearly incapable of distinguishing the goods and services for which the Claimant's mark is registered (*Çelik Motor Ticaret A.S. v. ONUNO L.L.C*, WIPO Case No. D2015-0369; *Jobs on the Net Limited, Andrew Middleton v. International New Media Limited*, WIPO Case No. D2011-1531). UDRP panels seem to assume such a complete lack of distinctiveness only in exceptional cases (cf. *Das Telefonbuch Zeichen-GbR v. Yajun Zhang*, WIPO Proceeding No. D2016-2228; *Marco Aurich v. Johannes Kuehrer, World4You Webservice*, WIPO Proceeding No. D2012-1147; *Islamic Bank of Britain Plc v. Ifena Consulting, Charles Shrimpton*, WIPO Proceeding No. D2010-0509).

3.2.4. However, the Tribunal acknowledges that a strict application of this UDRP case law in cases adjudicated under the Expedited Rules may not be entirely appropriate. The Expedited Rules provide for more extensive proceedings allowing a closer examination of the relevant issues. Furthermore, the Expedited Rules lead to a final decision, whereas the UDRP allows for a wider possibility to seek recourse through a court proceeding.

3.2.5. This issue, however, must not be decided in the present case, as even a closer examination of the Claimant's trademarks does not cast doubt on their legal validity.

3.2.6. The Claimant's A AVENE mark is registered, *inter alia*, as a Polish trademark. Thus, Polish law is relevant. However, the substantive requirements for trademark registration are largely harmonized throughout the European Union. Therefore, the highest authority on the relevant questions of law concerning the validity of Polish trademarks is the Court of Justice of the European Union (the "CJEU").

3.2.7. The CJEU has emphasized that a sign may not be refused registration based on an exclusively descriptive character unless the geographical name in respect of which registration as a trademark is sought designates a place which is associated in the mind of the relevant class of persons, at the time the application for registration is made, with the category of goods concerned, or it is reasonable to assume that such an association may be established in the future (see, to that effect, CJEU judgments of 4 May 1999, *Windsurfing Chiemsee, C-108/97 and C-109/97*, paragraph 31, and of 12 February 2004, *Koninklijke KPN Nederland, C-363/99*, paragraph 56).

3.2.8. The Respondent merely submits that the term AVENE also refers to a commune in France. However, the Respondent himself admits that the commune Avène is very small and from the Wikipedia article the Respondent submitted, it can be deduced that Avène has merely 280 inhabitants. Therefore, it seems extremely unlikely to the Tribunal that the public outside of France will perceive the term AVENE as a reference to this commune or even be aware of its existence. Furthermore, the Respondent did not provide any evidence showing that Avène is associated in the mind of the relevant class of persons with the goods for which the Claimant's trademarks are registered. In fact, the Respondent did not even claim that this is the case. Therefore, the Respondent did not cast doubt on the legal validity of the Claimant's "A AVENE" trademark.

3.2.9. For a finding of confusing similarity under paragraph 4(a)(i) of the UDRP, the threshold is generally modest (*Alfred Dunhill, Inc. v. Registration Private, Domains By Proxy, LLC v. Abdullah Altubayieb*, WIPO Proceeding No. D2017-0209). In cases where a domain name incorporates the entirety of a trademark, or

where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar (see paragraph 1.7. of the WIPO Overview 3.0).

3.2.10. The disputed domain name consists of the term AVENE, which is the dominant feature of the Claimant's A AVENE mark, and the country code Top-Level Domain ("ccTLD") ".pl". ccTLDs are generally disregarded when evaluating the identity or similarity of the Claimant's mark to the disputed domain name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the ccTLD (see section 1.11 of the WIPO Overview 3.0). Therefore, the disputed domain name is identical to the domain feature of the Claimant's A AVENE mark and thus confusingly similar to this mark.

3.2.11. Accordingly, the Tribunal finds the Claimant has satisfied the requirements of Policy paragraph 4(a)(i).

3.3 Paragraph 4(a)(ii) UDRP: Rights or Legitimate Interests

3.3.1. While the overall burden of proof in UDRP proceedings is on the Claimant, 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 claimant 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 (see section 2.1 of the WIPO Overview 3.0).

3.3.2. The Claimant has made its *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name by noting without contradiction that the Respondent has never been known, individually or commercially, by the disputed domain name and that the Claimant has not authorized the Respondent to use its marks. Furthermore, the Claimant has shown that the disputed domain resolved to a pay-per-click (PPC) parking page showing links to third-party websites that, in part, offer goods competing with the Claimant's products. It is well established that pages with PPC links trading on the goodwill of a trademark (as may be evidenced by direct or indirect links to competitors, websites or goods) do not constitute a bona fide offering of goods or services, nor do they constitute a legitimate noncommercial or fair use (see paragraph 2.9. of the WIPO Overview 3.0.). The burden of production to demonstrate that he has such a right or legitimate interest thus shifts to the Respondent.

3.3.3. The Respondent contends that he is a domain investor or "domainer", who can legitimately speculate in the purchase and sale of domain names that have potential value for website development, email, mobile applications, or other lawful uses.

3.3.4. It is indeed well established that a respondent has a right to register and use a domain name to attract Internet traffic based solely on the appeal of a commonly used descriptive phrase, even where the domain name is confusingly similar to the registered mark of a complainant (see *National Trust for Historic Preservation v. Barry Preston*, WIPO Case No. D2005-0424; *Private Media Group, Inc., Cinecraft Ltd. v. DHL Virtual Networks Inc.*, WIPO Case No. D2004-0843; *T. Rowe Price Associates, Inc. v. J A Rich*, WIPO Case No. D2001-1044; *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*, WIPO Case No. D2001-0031; *EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, WIPO Case No. D2000-0047). However, this business model is generally recognized under the UDRP as legitimate only if the domain name was registered because of its attraction as a descriptive phrase comprising dictionary words, and not because of its value as a trademark (see *National Trust for Historic Preservation v. Barry Preston*, *supra*; *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. D2006-0340). Furthermore, to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be

genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights (see paragraph 2.10. of the WIPO Overview 3.0.)

3.3.5. The Respondent did not show or claim that he used to or genuinely intends to use the disputed domain name in connection with the French commune Avène. Furthermore, Tribunal considers it far more likely that the disputed domain name was registered due to its connection with the Claimant's trademarks since the commune Avène is not a commonly known geographic term.

3.3.6. In view of the above, the Tribunal concludes that the Respondent has no rights or legitimate interests in the disputed domain name.

3.3.7. Accordingly, the Tribunal finds the Claimant has satisfied the requirements of Policy paragraph 4(a)(ii).

3.4 Paragraph 4(a)(iii) UDRP: Registered and Used in Bad Faith

3.4.1. The Tribunal concludes that the requirements of paragraph 4(a)(iii) of the Policy have been sufficiently made out by the Claimant and that the Respondent's bad faith registration and use of the disputed domain name have been proven.

3.4.2. UDRP panels have held that especially domainers undertaking bulk purchases or automated registrations have an affirmative obligation to avoid the registration of trademark-abusive domain names. UDRP panels will look to the facts of the case to determine whether such respondent has undertaken good faith efforts to screen such registrations against readily-available online databases to avoid the registration of trademark-abusive domain names. Noting registrant obligations under UDRP paragraph 2, UDRP panels have found that respondents who (deliberately) fail to search and/or screen registrations against available online databases would be responsible for any resulting abusive registrations under the concept of willful blindness. UDRP panels have conversely found that where a respondent provides evidence that it has undertaken additional measures to avoid abusive use of any registered domain names, e.g., through methods such as applying negative keywords, such undertakings will corroborate the respondent's claim to good faith. (see paragraph 3.2.3. of the WIPO Overview 3.0.).

3.4.3. Furthermore, with respect to "automatically" generated pay-per-click links, UDRP panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name. While a respondent cannot disclaim responsibility for links appearing on the website associated with its domain name, UDRP panels have found positive efforts by the respondent to avoid links that target the complainant's mark (e.g., through "negative keywords") to be a mitigating factor in assessing bad faith (see paragraph 3.2.3. of the WIPO Overview 3.0.).

3.4.4. The Respondent freely admits that he is a domainer who automatically registers thousands of domain names without checking them for potential trademark infringements. The Respondent did not show or even claim that he has undertaken any measures to avoid abusive registration or use concerning any of his domain names. In effect, the Respondent's sole contention is that both the registration of the disputed domain name and the generation of the pay-per-click links were done automatically and without any knowledge of the Claimant's trademark. Therefore, it is clear to the Tribunal that the Respondent is engaged in the act of willful blindness and purposefully disregarded his obligation to avoid the registration and use of trademark-abusive domain names.

3.4.5. For these reasons, the Tribunal considers that the Respondent's conduct constitutes bad faith registration and use of the disputed domain name.

3.4.6. Accordingly, the Tribunal finds that the Claimant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

3.5 The available remedies under the Expedited Rules

3.5.1. The Respondent's contention that the transfer of the disputed domain name is not an available remedy is clearly contradicted by Article 36 (a) Expedited Rules, which states

The Statement of Claim shall contain a comprehensive statement of the facts and legal arguments supporting the claim, including the remedies sought. The only remedies available as a result of the proceedings are the cancellation or the transfer of the domain name registration and the costs of the arbitration proceeding.

3.5.2. Accordingly, the Tribunal finds that the transfer of the disputed domain name is the appropriated remedy in the present case.

4. COSTS

4.1. In accordance with Article 56 (a) Expedited Rules, the Tribunal determines the costs of the arbitration at One Thousand Five Hundred Euros (EUR 1,500.00).

4.2. The Claimant has been successful in this arbitration. Further, as described above, the Respondent is a professional domainer engaged in registration of domain names for commercial gain. Accordingly, pursuant to Articles 56 (c) Expedited Rules, it is ordered that the Respondent shall solely bear the costs of this arbitration in the amount of EUR 1,500.00.

4.3. The Claimant did not seek to recover its reasonable legal costs pursuant to Article 57. Therefore, the Tribunal considers an order for costs or a party's expenses not to be justified.

5. DECISION

5.1. Based on the foregoing considerations and reasons, the Sole Arbitrator issues his Final Award in Vienna, Austria, on November 23, 2021 holding as follows:

5.1.1. The Tribunal orders that the disputed domain name <avene.pl> be transferred to the Claimant.

5.1.2. The Respondent shall pay to the Claimant the amount of EUR 1,500.00 to cover the cost of this arbitration.

6. COMMUNICATION OF THE AWARD

6.1 This Award is signed in four (4) originals and is to be communicated by the WIPO Center as follows:

6.1.1 one original to Claimant, addressed to Claimant;

6.1.2 one original to Respondent, addressed to Respondent;

6.1.3 one original to be retained by the WIPO Center; and

6.1.4 one original retained by the Sole Arbitrator.


Dr. Christian Gassauer-Fleissner
Sole Arbitrator
Place of Arbitration: Vienna, Austria
Dated: November 23, 2021