

ADMINISTRATIVE PANEL DECISION

Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v.
Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Shawn Ott
Case No. D2022-0727

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 Domain Admin, Privacy Protect, LLC (PrivacyProtect.org), United States of America (“United States”) / Shawn Ott, United States.

2. The Domain Name and Registrar

The disputed domain name <casinoroyaledemontecarlo.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 2, 2022. On March 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 4, 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 March 4, 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 an amended Complaint on March 7, 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 March 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 5, 2022.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on April 13, 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 company organized under the laws of Monaco, formed originally by a sovereign decree in 1863. The Complainant holds a monopoly on casino gaming services in the Principality and operates numerous venues. It has operated the world-famous Casino de Monte-Carlo for nearly 160 years.

The Complainant holds registrations for the trademarks: (i) CASINO DE MONTECARLO filed with the Monaco Trademark Office, on August 13, 1996 under the number 17485 and renewed on October 10, 2006 under the number R96.17407, and (ii) MONTE-CARLO in numerous jurisdictions, which it uses to designate casino related services in class 41. Monaco Trademark Registration No. 14-30170, for the mark MONTE-CARLO, for example, was registered on December 31, 2013.

The disputed domain name <casinoroyaledemontecarlo.com> was registered on June 7, 2021. The disputed domain name is not active.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The disputed domain name appears to be practically identical to the Complainant's CASINO DE MONTE-CARLO trademark. The only difference is the presence of the word "royale" between the words "casino" and "demontecarlo".

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant has searched in trademark databases for possible trademark registrations or applications in the name of the Respondent. It seems that no trademark "CASINO ROYALE DE MONTE CARLO" has been registered in any searchable jurisdiction and the Respondent, Shawn Ott, owns no trademark.

In addition, the Complainant has never authorized the Respondent to register and use the disputed domain name. The Respondent therefore has no rights or legitimate interests in the disputed domain name.

The disputed domain name has been registered and is being used in bad faith.

The strong notoriety and worldwide renown of the Complainant's trademarks render it impossible for the Respondent to have been unaware that the registration and use of the disputed domain name would violate the Complainant's rights. The trademarks MONTE-CARLO and CASINO DE MONTE-CARLO are well-known especially in the field of gambling. Nonetheless, the Respondent deliberately decided to register a domain name referring to the Complainant's famous casino in order to take advantage of the reputation of the Complainant.

It is impossible that the Respondent's decision to register a domain name which is confusingly similar to the Complainant's trademarks was purely coincidental. As the Respondent was very well aware, these trademarks are well-known, especially in the field of casinos and hotels, and the Respondent deliberately decided to register the disputed domain name composed of the words "casino", "de" and "montecarlo". Such a decision is clearly a proof of bad faith registration.

Creating a strong likelihood of confusion between the Complainant's trademarks and the disputed domain name is a clear example of bad faith not only during the registration process of the disputed domain name, but also in the use thereof even if it does not seem to be in active use at the date of this Complaint. In this regard, it should be reminded that, as confirmed in section 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "from the inception of the UDRP, panelists 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". In such cases, panelists should take into account the totality of the circumstances of the case, including the degree of reputation of the Complainant's trademarks and the implausibility of any good faith use of the disputed domain name.

In the case at hand, the reputation of the Complainant's trademark has already been confirmed by many UDRP panelists and, should the Respondent claim to have registered the disputed domain name with the intent of an active use, it cannot be imagined how such use could be done in a legitimate and bona fide manner. Any active website using the disputed domain name will most likely constitute an act of passing off or another type of infringement on the Complainant's CASINO DE MONTE-CARLO and MONTE-CARLO famous trademarks as it would inevitably lead consumers to believe that there is some sort of association, affiliation, connection, or endorsement between the Complainant and any website that would be operated under the disputed domain name.

All these elements, and, inter alia, the world renown of the Complainant's trademarks, show that the disputed domain name has been registered and used in bad faith by the Respondent.

Complainant request the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, the Complainant is required to establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Panel finds that the Complainant has provided sufficient evidence to show that it is the owner of and has rights in and to the Complainant's trademark.

A review of the disputed domain name shows that the disputed domain name comprises the Complainant's trademark CASINO DE MONTECARLO in its entirety, having added just the word "royale" between the words "casino" and "demontecarlo".

Therefore, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark.

Based on this uncontested evidence, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark, in which Complainant has rights, and that paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests in the domain name. Once such a prima facie case is made, the respondent carries the burden of production of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

Paragraph 4(c) of the Policy lists the ways that a respondent may demonstrate rights or legitimate interests in the domain name:

(i) before any notice 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 (as an individual, business or other organization) has been commonly known by the domain name, even if it has acquired no trademark 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 trademark or service mark at issue.

In this case, the Panel finds that the Complainant has made out a prima facie case. In particular, the Respondent has not submitted any arguments or evidence to rebut the Complainant's contention that it has never authorized, licensed, or permitted the Respondent to use the CASINO DE MONTECARLO trademark in any way. The Respondent is also not using the disputed domain name in any way, nor is Respondent making a legitimate noncommercial or fair use of the disputed domain name.

Therefore, the Panel concludes that the Respondent does not have rights or a legitimate interests in the disputed domain name within the meaning of Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith. The Policy, paragraph 4(b), sets forth four non-exclusive circumstances, which evidence bad faith registration and use of a domain name:

(i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

Based upon the undisputed evidence submitted by the Complainant, the Panel finds that the Respondent clearly had actual knowledge of the Complainant's trademark when registering the disputed domain name. This finding is supported by the uncontested evidence showing that the registration of the disputed domain name by the Respondent in no way pre-dates the Complainant's substantially earlier registration dates for Complainant's trademark.

It is implausible that the Respondent might have registered the disputed domain name without knowing of the Complainant and its CASINO DE MONTE-CARLO mark. See *Société des Bains de Mer et du Cercle des Etrangers à Monaco v. LaPorte Holdings, LLC*, WIPO Case No. [D2005-0526](#) and *Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v. Banana banana*, WIPO Case No. [D2021-4320](#).

Therefore, the Panel is satisfied that the Respondent is, or should have been, aware of the Complainant's reputation and CASINO DE MONTE-CARLO mark when it registered the disputed domain name (see [WIPO Overview 3.0](#), section 3.2.2).

With respect to use, the Panel visited the disputed domain name and was able to verify that the domain name is not in use.

The Panel is of the view that the passive holding of the disputed domain name amounts to a use of it in bad faith by the Respondent. The Respondent must have been aware of the Complainant and therefore, intentionally chose to register the disputed domain name. Any attempt to actively use the disputed domain name would inevitably lead to a likelihood of confusion to the source, sponsorship, affiliation, or endorsement of the Respondent's website among Internet users who would inevitably be led to believe that such website would be owned by, controlled, or in some way associated with the Complainant (see *Société des Bains de Mer et du Cercle des Etrangers a Monaco v. Corril Holding N.V.*, WIPO Case No. [D2005-1342](#) and *Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v Katie Silva, Peppermill Resort Casino Reno*, WIPO Case No. [D2016-2300](#)).

The Panel takes also into account the notoriety of the Complainant's trademark, the fact that the disputed domain name is nearly identical to the Complainant trademark and the use of a privacy service to register the disputed domain name.

Considering the above evidence and findings, the Panel therefore finds that Respondent registered and is using the disputed domain name in bad faith and that paragraph 4(a)(iii) of the Policy has been satisfied.

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 <casinoroyaledemontecarlo.com> be transferred to the Complainant

/Pablo Palazzi/

Pablo Palazzi

Sole Panelist

Date: April 26, 2022