

ADMINISTRATIVE PANEL DECISION

ESMOD v. Dental Week CM

Case No. D2023-0025

1. The Parties

The Complainant is ESMOD, France, represented by Novagraaf France, France.

The Respondent is Dental Week CM, Venezuela (Bolivarian Republic of).

2. The Domain Name and Registrar

The disputed domain name <esmodeacademia.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 January 4, 2023. On January 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 5, 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 January 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 13, 2023. On February 14 and 20, 2023, the Respondent sent informal communications to the Center.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on February 21, 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

It results from the Complainant's undisputed allegations that the Complainant runs an international fashion design and business school, which operates since 1841, with 20 schools in 13 countries around the world. The Complainant itself has been registered in the French Companies' Registry in 1957. Moreover, the Complainant offers courses for professionals on a website available under the domain name <esmodacademy.com>, which is almost identical to the disputed domain name.

The Complaint is based, amongst others, on International Trademark Registration ESMOD (verbal) no. 522602 registered on February 5, 1988 for goods and services in classes 16, 35, 40, 41, and 42, designating many countries worldwide. This mark has duly been renewed and is in force.

The disputed domain name was registered on August 4, 2022.

It results from the Complainant's documented allegations that the disputed domain name resolves to a landing page ("Hello world! Welcome to WordPress. This is your first post. Edit or delete it, then start writing"). However, an email server (MX) has been configured in relation with the disputed domain name.

Finally, the Complainant sent a cease-and-desist letter to the Respondent on October 26, 2022, and several reminders on November 7, 15, 24, 2022, and December 2, 9, 2022 requesting the disputed domain name to be transferred. However, the Complainant did not receive any response.

5. Parties' Contentions

A. Complainant

Firstly, the Complainant points out that the disputed domain name is a complete reproduction of the Complainant's company name, prior well-known trademarks and domain names. Therefore, Internet users will obviously think the disputed domain name belongs to the Complainant or has been registered in its name or for its account.

Secondly, the Complainant alleges that it was not able to find any trademarks in the name of the Respondent. Furthermore, the disputed domain name was registered without the Complainant's consent.

Thirdly, the Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. The Respondent never replied to the Complainant's cease and desist letter and reminders. Moreover, an email server is configured on the disputed domain name. It is therefore possible – in the Complainant's view – that the Respondent has created an email address in order to send fraudulent emails to customers, service providers, suppliers, pretending to be the Complainant to collect personal data, or to place orders in the name of the company or share information about them. Upon reservation, the Respondent, who had no appearing legitimate reason to choose the denomination ESMOD for his domain name, could not have been unaware of the existence of the Complainant's trademarks and domain names.

B. Respondent

The Respondent did not reply to the Complainant's contentions, but instead indicated in two informal email communications sent to the Center, that it had requested the deletion of the disputed domain name and had notified its client of "the name changes, fully agreeing".

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and subsequently establish that the disputed domain name is identical or confusingly similar to said mark.

The Complainant is the registered owner – amongst others – of International Trademark Registration ESMOD (verbal) no. 522602 registered on February 5, 1988, which has duly been renewed and is in force.

The disputed domain name entirely incorporates this trademark. As noted in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7, in cases where a domain name incorporates the entirety of a trademark, or at least where a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for the purposes of UDRP standing. The Panel finds the Complainant’s ESMOD mark to be fully included and therefore readily recognizable in the disputed domain name.

The generic Top-Level Domain “.com” may be disregarded, as it is viewed as a standard registration requirement (see [WIPO Overview 3.0](#), section 1.11.1).

Hence, this Panel finds that the disputed domain name is identical or confusingly similar to the Complainant’s trademark ESMOD pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests in the disputed domain name. In the Panel’s view, based on the un rebutted allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

No true content is displayed on the website to which the disputed domain name resolves. Such use can neither be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish

the trademark or service mark at issue in the sense of paragraph 4(c)(i) and (iii) of the Policy (see, e.g., *Boehringer Ingelheim Pharma GmbH & Co.Kg v. Mrs. Toy Rösler*, WIPO Case No. [D2022-1094](#)). In addition, the disputed domain name fully contains the Complainant's trademark ESMOD (together with the term "academia" and an "e" in between of both terms). As a result, this Panel finds it most likely that the Respondent selected the disputed domain name with the intention to take advantage of the Complainant's registered trademark ESMOD by registering a domain name consisting of said trademark, with an obvious misspelling ("mode" instead of "mod") and adding the descriptive term "academia" (which means "academy" in Spanish language). In this context, the Panel finds it particular relevant, that the Complainant itself runs a website under a very similar domain name, *i.e.* <esmodacademy.com>. In the Panel's view, all these circumstances surrounding the registration are misleading Internet users through the implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Finally, the Panel does not dispose of any elements that could lead the Panel to the conclusion that the Respondent is commonly known by the disputed domain name or that it has acquired trademark rights pursuant to paragraph 4(c)(ii) of the Policy.

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence in this regard, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

According to the Complainant's undisputed allegations, the Respondent does not use the disputed domain name for an active website with true content but just for a landing page with the content described above. With comparative reference to the circumstances set out in paragraph 4(b) of the UDRP deemed to establish bad faith registration and use, prior UDRP panels have found that the apparent lack of active use (*e.g.*, to resolve to an active website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith under the doctrine of passive holding (see, e.g., *Boehringer Ingelheim Pharma GmbH & Co.Kg v. Mrs. Toy Rösler*, WIPO Case No. [D2022-1094](#) with further references). The Panel must therefore examine all the circumstances of the case to determine whether the Respondent is acting in bad faith. Factors that have been considered relevant in applying the passive holding doctrine include (see [WIPO Overview 3.0](#), section 3.3):

- (i) the degree of distinctiveness or reputation of the complainant's mark;
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and
- (iv) the implausibility of any good faith use to which the domain name may be put.

In the case at hand, the Panel finds that the circumstances listed hereinafter and surrounding the registration suggest that the Respondent was aware that he has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith (see *CCA and*

B, LLC v. Domain Administrator, Fundacion Privacy Services LTD, WIPO Case No. [D2021-1532](#); *Actelion Pharmaceuticals, Ltd v. Whois Agent, Whois Privacy Protection Service, Inc / Jean-Paul Clozel, supra*; and *America Online, Inc. v. Antonio R. Diaz*, WIPO Case No. [D2000-1460](#)):

- (i) the fact that the Respondent connected the disputed domain name to an email server (MX);
- (ii) the fact that the details disclosed for the Respondent by the Registrar were incomplete, noting the mail courier's inability to deliver the Center's written communications ("Suburb and City do not match");
- (iii) the Respondent's failure to respond to the Complainant's assertions;
- (iv) the Respondent's failure to respond to the Complaint's cease and desist letter and several reminders before starting the preset UDRP proceedings;
- (v) the distinctiveness of the trademark ESMOD which has existed since many years; and
- (vi) the trademark ESMOD is fully and identically incorporated in the disputed domain name.

In addition, due to these circumstances this Panel concludes that the Respondent knew or should have known the trademark ESMOD when it registered the disputed domain name, and that there is no plausible legitimate active use that the Respondent could make of the disputed domain name.

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant is therefore deemed to also have satisfied the third element, 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, <esmodeacademia.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: March 7, 2023