

ADMINISTRATIVE PANEL DECISION

Compagnie Générale des Etablissements Michelin v. Cameron Jackson Case No. D2016-2392

1. The Parties

The Complainant is Compagnie Générale des Etablissements Michelin of Clermont-Ferrand, France, represented by Dreyfus & associés, France.

The Respondent is Cameron Jackson of Kingston, Australia.

2. The Domain Names and Registrars

The disputed domain names <michelinfrance.online>, <michelinfrance.top>, <michelin-france.xyz>, <michelin.lol> and <michelins.lol> are registered with Uniregistrar Corp. The disputed domain name <michelinfrance.xyz> is registered with Instra Corporation Pty Ltd. (the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 25, 2016. On November 25, 2016, the Center transmitted, by email, to the Registrars a request for registrar verification in connection with the disputed domain names. On November 27, 2016 and November 30, 2016, the Registrars transmitted, by email, to the Center their verification responses confirming that the Respondent is listed as the registrant of each of the names 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”), 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 that the proceedings commenced on December 9, 2016. In accordance with the Rules, paragraph 5, the due date for Response was December 29, 2016. The Respondent did not submit any response. Accordingly, on January 4, 2017, the Center notified the parties of the Respondent’s default.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on January 11, 2017. 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

As reflected in the registration records for the six disputed domain names in the public Whois database (copies of those records appear in Annex A1 to the Complaint), the disputed domain names have the following registration and expiration dates, respectively:

- <michelin-france.xyz> August 20, 2016 and August 20, 2017;
- <michelin.lol> August 5, 2016 and August 5, 2017;
- <michelins.lol> August 20, 2016 and August 20, 2017;
- <michelinfrance.online> August 22, 2016 and August 22, 2017;
- <michelinfrance.top> August 22, 2016 and August 22, 2017; and
- <michelinfrance.xyz> June 21, 2016 and June 21, 2017.

Each of the disputed domain names resolves, as of the filing date of the Complaint, to a corresponding parking page provided by its registrar.

A. The Complainant's MICHELIN Mark

The Complainant owns numerous trademark registrations around the world for the term MICHELIN (in block letters), which of particular relevance here include Australian and International registrations, with the International registration designating, among other countries, Australia. The Complainant has provided in Annex 7 to the Complaint copies of printouts of the registration records from publicly available databases of these Australian and International registrations provided by the Australian IP Office and WIPO, respectively. Salient details of these registrations are as follows.

1. MICHELIN

Australian trademark registration 258104; registration date: May 1, 1972.

This mark is registered for use in connection with: "Pneumatic tyres for vehicle wheels and inner tubes for pneumatic tyres" in international class 12.

2. MICHELIN

International trademark registration 1245891; registration date: December 10, 2014.

This mark is registered for use in connection with: "Business management; business administration; office functions; business management and organization consultancy; consultancy relating to industrial business; advertising and commercial patronage and sponsoring; public relations services for foundations and other establishments dedicated to industrial research, training and education, social and humanitarian actions, health, culture, heritage conservation, protection of the environment, sports; consultancy and advice relating to management, strategy, organization and management of businesses and employees thereof; advice, information linked to employment development and professional and social integration; organization of exhibitions for commercial and advertising purposes" in international class 35; "Capital investments; financial sponsorship and patronage; charitable fundraising; fund raising, collection and distribution of donations to associations, to nonprofit organizations; financing of studies and projects in relation to the fields

of education, social and humanitarian action, health, culture, heritage conservation, protection of the environment, sports; financial support for industrial research, training and education, social and humanitarian acts, health, culture, heritage conservation, protection of the environment, sports” in international class 36; “Transport; transport information; breakdown assistance for towing vehicles; transportation of equipment for humanitarian aid operations and solidarity actions; transportation logistics services” in international class 39; “Waste recycling; information on waste treatment; studies and research related to waste treatment” in international class 40; “Education, training; teaching; entertainment services; organization of exhibitions for cultural or educational purposes; organization and conducting of colloquiums and conferences; organization of competitions (education or entertainment); organization and conducting of workshops and training courses; advice on career guidance” in international class 41; “Support services to facilitate the schooling of adults, domestic help services for people; medical aid services to people in need” in international class 44; and “Legal aid services for the creation of businesses; support and monitoring services for employment search and professional and social integration” in international class 45.

B. The Complainant

The Complainant is Compagnie Générale des Etablissements Michelin (“Michelin”) with its headquarters in Clermont-Ferrand, France.

Michelin, a leading global tire company started in 1889, is dedicated to sustainably improving the mobility of goods and people by manufacturing and marketing tires for various types of vehicle, including airplanes, automobiles, bicycles/motorcycles, earthmovers, farm equipment and trucks. It also offers electronic mobility support services through a website at “www.viamichelin.com” and publishes travel guides, hotel and restaurant guides, maps and road atlases, all as shown in Annex 3 to the Complaint. This Annex contains a copy of a corporate publication from the Complainant providing general corporate information including the Complainant’s history.

Currently, the Complainant is present in more than 170 countries, has 112,300 employees and operates 68 production plants in 17 different countries. It has established local subsidiaries in Europe including Italy (in 1901), Germany and Switzerland (both in 1902), Spain (in 1904) and United Kingdom of Great Britain and Northern Ireland (in 1905); and also in the United States (in 1904). The Complainant also has a technology center which undertakes and coordinates its research, development and process engineering activities with the Complainant’s operations in Europe, North America and Asia.

The Complainant established Michelin Australia Pty Ltd in October 1997 to manage and develop its markets in Australia, New Zealand and the Asia Pacific region. Prior to that time, MICHELIN tires were imported by local distributors. The Complainant’s tires have been present in the Australian automotive market since the 1940s. Today, the products marketed by Michelin Australia include tires for passenger cars, light trucks, earthmover equipment, heavy truck and buses, agricultural and industrial equipment, aviation, motorcycles and bicycles. Michelin Australia employees participate in the “Helping Hands” program through the “Helping Hands Australian” branch, and there through build prosthetic hands that are donated to amputee landmine victims throughout the developing world. See Annex 4 for information appearing on the Complainant’s website regarding its operations in Australia.

C. Interactions between the Parties

On July 26, 2016, the Complainant sent a cease-and-desist letter to the Respondent, via registered mail and e-mail. In the letter, the Complainant requested the Respondent to transfer the disputed domain name <michelinfrance.xyz> to the Complainant at no cost. The Respondent, through its email response on July 27, 2016, proposed to sell that disputed domain name to the Complainant for USD 250. On August 2, 2016, the Complainant refused and again requested that the Respondent transfer the disputed domain name for free. Later the same day, the Respondent replied by email, specifically inquiring as to what price the Complainant would pay for the domain name: “So what do you offer me for www.michelinfrance.xyz”. A copy of all the correspondence between the parties appears in Annex 5 to the Complaint.

Shortly thereafter, the Complainant discovered that, after the Respondent received the Complainant's July 26, 2017 letter, the Respondent had registered five additional domain names, specifically <michelin-france.xyz>, <michelin.lol>, <michelins.lol>, <michelinfrance.online> and <michelinfrance.top>; with the last three having been registered through a privacy service.

As the parties failed to reach a settlement, the Complainant then initiated this administrative proceeding by filing the present Complaint.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that each of the disputed domain names is either identical or confusingly similar to its mark MICHELIN.

Specifically, one domain name, <michelin.lol>, is identical to the Complainant's mark. A variant of that domain name, <michelins.lol>, additionally contains the letter "s" after the mark. The other four disputed domain names include the mark MICHELIN followed by either the country name "France" with or without an intervening hyphen. In each of the latter five domain names, either the misspelling of the mark or the addition of the country name (whether hyphenated or not) is incapable of adding sufficient distinctiveness whatsoever to that domain name to mitigate any resulting user confusion between that domain name and the Complainant's mark MICHELIN.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in any of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Respondent is not affiliated with the Complainant and has never been licensed or authorized to use the Complainant's mark MICHELIN, or register or use any of the disputed domain names. In the absence of any such license or authorization to use the mark, any use to which the Respondent were to put that mark, including by adding a letter "s" to it thus forming a "typosquatted" domain name, would be illegitimate.

Further, there is no evidence indicating that the Respondent is commonly known by the mark MICHELIN nor could there ever be any by virtue of the exclusive trademark rights residing in the Complainant in that mark – rights that existed well before the Respondent registered any of the disputed domain names.

Further, by merely holding the disputed domain names without having established any operative websites to which any of those names resolves, the Respondent has not made any reasonable and demonstrable preparations to use any of these disputed domain names. In addition, the Respondent does not manifest any intent to use any of these domain names in a noncommercial or fair use context, nor can such a use be inferred from the Respondent's exhibited and primary purpose of having registered each of the disputed domain names in order to sell it to the Complainant at a profit, *i.e.* for a sum exceeding its documented out-of-pocket costs for registering that disputed domain name.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using each of the disputed

domain names in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Specifically, given the substantial worldwide recognition which the Complainant's mark MICHELIN enjoys, the Respondent very likely knew of the Complainant and its trademark rights when he registered each of the disputed domain names. In fact, the Complainant's reputation, as a result of its mark and the fame that mark enjoys, is so widespread that it is implausible to think that the Respondent did not know of the Complainant and its exclusive trademark rights and, under the present facts of record here, registered the names for any reason other than to opportunistically exploit those rights by attempting to sell the domain names to the Complainant for a profit.

Moreover, bad faith registration of the six disputed domain names here is consistent with the Respondent's prior actions of having registered more than 1,000 domain names, many of which include third-party marks (as reflected in the list of his registered names provided by the Complainant in Annex 6 to the Complaint), as part of a much larger goal by the Respondent to monetize those domain names by selling each of them, at a profit, to its corresponding trademark owner.

Further, bad faith is clearly evidenced by the Respondent's action in attempting to sell the disputed domain name <michelinfrance.xyz> to the Complainant at a profit. Obviously, the Complainant intended to sell all the disputed domain names at a profit either to the Complainant or one of its competitors which reflects bad faith registration and use of all those domain names.

Additionally, each of the disputed domain names is being passively held and has been so held since its registration date which reflects bad faith use.

Lastly, given the Respondent's prior actions in having registered many domain names containing third-party marks, the Respondent has exhibited a pattern of conduct through which he, by virtue of having registered the six disputed domain names here, has prevented the Complainant from reflecting its mark MICHELIN in any of these six disputed domain names.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that each of the disputed domain names is either identical or confusingly similar to the Complainant's mark MICHELIN.

Under well-established UDRP precedent - certainly pertaining to original and long-standing generic Top-Level Domains ("gTLDs") ".com", ".org" and ".net", the addition of such a gTLD to a second level domain ("SLD") to form a domain name was viewed as generally irrelevant in assessing confusing similarity or identity between the domain name and the mark under paragraph 4(a)(i) of the Policy and thus was ignored. See, e.g., *Audi AG, Automobili Lamborghini Holding S.p.A., Skoda Auto a.s., Volkswagen AG v. JUS TIN Pty Ltd.*, WIPO Case No. D2015-0827. Consequently, in effect, only the SLD was compared to the mark.

Accordingly, as to the disputed domain name <michelin.lol>, a simple comparison between the SLD and the mark MICHELIN, reveals that the SLD is identical to the mark.

With respect to the other five disputed domain names, <michelinfrance.online>, <michelinfrance.top>,

<michelin-france.xyz>, <michelinfrance.xyz> and <michelins.lol>, each name includes the mark MICHELIN to which either the country name “France” (hyphenated and not) or a letter “s” has been appended to form a corresponding SLD, to which a gTLD “.online”, “.top”, “.xyz” or “.lol” has then been affixed to form the corresponding disputed domain name.

It has also become very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming an SLD that results from modifying the mark, to confer requisite and sufficient distinctiveness to the resulting domain name to avoid user confusion. Here, the Respondent’s incorporation of the country name “France” (whether hyphenated or not) or the letter “s” or to form each SLD clearly constitutes such a minor variation. See, e.g., *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; and *National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. D2002-1011.

Recently, when faced with domain names that include the so-called “new” gTLDs, panelists in certain UDRP decisions, have chosen, in appropriate circumstances, not to ignore the new gTLDs, in contrast to the well-established practice of doing so with domain names containing any of the original gTLDs. See, e.g., *Canyon Bicycles GmbH v. Domains By Proxy, LLC / Rob van Eck*, WIPO Case No. D2014-0206; and *Hultafors Group AB v. my domain limited*, WIPO Case No. D2014-0597. These decisions, in assessing identity or confusing similarity between the domain name and a complainant’s mark, have considered the domain name in its entirety, including the new gTLD. Even if that analysis is followed here, the Panel here still finds that identity or confusing similarity exists with respect to each of the disputed domain names simply because of the overwhelming perceptual effect on the domain name made by the mark MICHELIN in light of the substantial global recognition and fame which that mark has established over many years and now enjoys. None of the new gTLDs which the Respondent has chosen to use here, specifically “.lol”, “.online”, “.top”, and “.xyz”, adds any distinctiveness to the corresponding SLD, let alone sufficient, to dispel any user confusion that would inevitably arise between the resulting domain name and the mark MICHELIN.

Therefore, the Panel finds that each of the disputed domain names is either identical or confusingly similar to the Complainant’s mark MICHELIN. Hence, the Complainant has satisfied its burden under

paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to any of the disputed domain names under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's mark MICHELIN and does not have any relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent never did and does not now use nor has he made any demonstrable preparations to use any of the disputed domain names to resolve to an operational website, let alone one through which he will make *bona fide* offerings of any goods or services. Further, the Respondent does not use the disputed domain name in connection with any legitimate noncommercial or fair use. In this regard, each of the disputed domain names, starting at the time it was registered and continuing to at least the filing date of the present Complaint, resolves to a parking page maintained by the Registrar.

Moreover, the evidence of record clearly reflects that the Respondent is not commonly known by any of the disputed domain names or the Complainant's mark. Given the Complainant's exclusive rights in its mark MICHELIN which in Australia significantly predates, by at least some 44 years, the dates (in June 2016, and August 2016) on which the Respondent registered all the disputed domain names, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to those of the Complainant — at least for the goods and services provided by the Complainant under its mark — without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill, supra*; *Cummins Inc. v. Jamie Lent, supra*; and *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen, supra*.

Hence, the Respondent does not fall within any of paragraphs 4(c)(i) to 4(c)(iii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to all of the disputed domain names, constitute bad faith registration and use.

The Panel infers, particularly from the lack of any Response, that it is highly likely that the Respondent was well aware of the Complainant and its mark MICHELIN, the substantial reputation, goodwill and fame which that mark acquired and the exclusive rights which the Complainant held in that mark when the Respondent registered each of the disputed domain names. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally registered each of the domain names for its potential to opportunistically exploit that reputation and goodwill for the Respondent's own pecuniary benefit by subsequently offering to sell each domain name to the Complainant for a profit, *i.e.* an amount exceeding its out-of-pocket costs of registration. This is clearly reflected in the Respondent's subsequent actions in having offered to sell the disputed domain name <michelinfrance.xyz> to the Complainant for USD 250. The Respondent, after being rebuffed by the Complainant, subsequently asked the Complainant what price it would offer to the Respondent for that domain name. Thus, the Respondent's conduct violated paragraph 4(b)(i) of the Policy.

Further, the Respondent, by having registered many domain names that incorporate third-party marks, has established a pattern of abusive registration. By virtue of registering the disputed domain names, in view of that pattern, the Respondent has prevented the Complainant from reflecting its mark MICHELIN in the disputed domain names in violation of paragraph 4(b)(ii) of the Policy.

The facts that the Respondent never used any of the disputed domain names to resolve to an operational website, never made any demonstrable preparations towards that end and left each disputed domain name, from the date of its registration, parked with its registrar are all further evidence that the Respondent never intended to use any of the disputed domain names in a lawful manner, *i.e.*, in connection with a *bona fide* offering of goods or services, a fair use or legitimate noncommercial use.

Hence, the Respondent's conduct reflects both bad faith registration and use under paragraphs 4(a)(iii), and 4(b)(i) and 4(b)(ii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to all of the disputed domain names, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

All of the following domain names are to be transferred to the Complainant: <michelinfrance.online>, <michelinfrance.top>, <michelin-france.xyz>, <michelinfrance.xyz>, <michelin.lol> and <michelins.lol>.

Peter L. Michaelson

Sole Panelist

Date: January 19, 2017