DISPUTE RESOLUTION SERVICE

D00020211

Decision of Independent Expert

MOULIN ROUGE

and

Mr Paul Helyer

1. The Parties:

Complainant: MOULIN ROUGE
Address: 97 rue Royale
Brussels
1000
Belgium

Respondent: Mr Paul Helyer
Address: 113 Barrier Point
London
E16 2SD
United Kingdom

2. The Domain Name:

moulinrougethemusical.co.uk (the "Domain Name")

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 4, October 2016 (the "Policy") unless the context or use indicates otherwise.

17 May 2018	Dispute received
17 May 2018	Complaint validated and notification of complaint sent to the parties
6 June 2018	Response reminder sent
11 June 2018	No response received and notification of no response sent to the parties
20 June 2018	Expert decision payment received

4. Factual Background

The Complainant has since 1889 operated the Moulin Rouge, a Parisian venue presenting the oldest cabaret in Paris, one of the most famous in the world, and the birthplace of the famous can-can. Many movies have been based on the Moulin Rouge including the successful musical with Nicole Kidman and Ewan McGregor.

The Respondent did not reply to the Complaint and so there are no facts before me setting out the Respondent's business or his purpose in registering the Domain Name.

The Respondent registered the Domain Name on 26 April 2005.

5. Parties' Contentions

The Complaint

Complainant's Rights

The Complainant's assertions of rights in the name MOULIN ROUGE are:

1. The Complainant is the proprietor of the following trademark registrations all of which were registered before the registration of the Domain Name:
    a. EU trademark registration MOULIN ROUGE No. 110437 registered on November 5, 1998;
    b. EU trademark registration MOULIN ROUGE No. 000263004 registered on June 23, 1998;
    c. UK trademark registration MOULIN ROUGE No. 1209919 registered on December 23, 1983; and
    d. UK trademark registration MOULIN ROUGE No. 1329686 registered on September 7, 1990.
2. The Domain Name is identical, or at least, confusingly similar, to the Complainant's trademarks for the following reasons:

a. The ccTLDs ".co.uk" is not of distinguishing effect and it is consistently held in domain name disputes that the inclusion of the top-level domain extension does not give any distinctiveness to the domain name (the Complainant quotes DRS D00018787 as an example).

b. The Domain Name reproduces the Complainant's MOULIN ROUGE trademark, except for the addition of generic terms "the musical". The Complainant says that the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical to the Complainant's mark and quotes UDRP cases to support this assertion.

c. The reproduction of the Complainant's trademark in the Domain Name increases the likelihood of confusion and demonstrates that the Respondent intended to cause confusion. An Internet user will be led to believe that the website www.moulinrougethemusical.co.uk belongs to the Complainant or was registered with its consent.
The Complainant quotes UDRP cases to support its assertion that the addition of a generic or non-distinctive word to a complainant's trademark in a domain name does not dispel confusing similarity.

d. The Complainant's MOULIN ROUGE trademarks are famous worldwide in the field of theatre and musical entertainment. The combination of the words "the musical" with the trademark MOULIN ROUGE in the Domain Name may confuse Internet users to believe that the Domain Name is used by the Complainant or with its authorisation.

e. The addition of a generic or descriptive term to the trademark MOULIN ROUGE does not grant self-distinctiveness to the Domain Name nor does it exclude a likelihood of confusion with the Complainant's trademarks because EU trademark MOULIN ROUGE No. 110437 covers services of "shows; radio and television entertainment; film production; theatrical agencies; and stage scenery" which either encompass or presents strong similarities with musicals.

f. The Complainant quotes further UDRP cases to support its assertion that numerous panels have considered that the whole reproduction of a trademark as well-known as the MOULIN ROUGE trademark is per se generating a likelihood of confusion.

Abusive Registration

The Complainant's assertions of Abusive Registration are:

1. The Respondent has no rights or legitimate interests in the Domain Name.

2. The Complainant has no relationship whatsoever with the Respondent; no license, permission nor authorisation to use the words MOULIN ROUGE has ever been granted to the Respondent. The Complainant has never consented to the Respondent's use and reservation of the Complainant's trademarks in any manner, including in connection with the Domain Name. The Complainant

asserts that the right to use a mark as a basis for a domain name requires an express authorisation.

3. The Respondent has no right or personal interest in the words MOULIN ROUGE. A search conducted on the WIPO, EUIPO and TM View trademark databases among the trademarks filed in the Respondent's name revealed no results. Thus, it is reasonable to conclude that the Respondent has no trademark or trade name rights corresponding to the Domain Name.

4. The Domain Name does not include the Respondent's name or a name that is otherwise commonly used to identify the Respondent, and nothing in the publicly available WHOIS records indicates that the Respondent is or has been commonly known by the Domain Name.

5. To the Complainant's knowledge, there is no evidence of the Respondent's use or preparations to use the Domain Name in connection with a bona fide offer of goods or services. The Domain Name has never been active according to extracts saved on the Wayback Machine on www.archive.org. It is therefore reasonable to assume that the Respondent's only intent is to sell the Domain Name to the Complainant for valuable consideration exceeding the costs directly related to the registration of the Domain Name.

6. The Domain Name was registered and is being used in bad faith since the Complainant's trademark MOULIN ROUGE is well-known and has been extensively used for more than a century in the field of theatre, musical entertainment and for derived products.

7. Since its creation in 1889, the Complainant says it has endeavoured to develop a performance concept and a distinctive imagery that are today recognised worldwide.

8. The Moulin Rouge is a tourist attraction, offering musical dance entertainment for visitors from around the world.

9. The Complainant presents evidence to demonstrate its claim that after more than 125 years of shows, the Moulin Rouge has become the oldest Parisian cabaret and one of the most famous cabarets in the world.

10. The Complainant presents evidence that its Moulin Rouge theatre inspired several movies that have contributed to the worldwide renown of its cabaret:

    a. Queen of the Moulin Rouge (1922)

    b. Le Fantôme du Moulin-Rouge (1925)

    c. Moulin Rouge (1928)

    d. L'Étoile du Moulin-Rouge (1934)

    e. La Chaste Suzanne (1937/1938)

    f. Moulin-Rouge (1939)

    g. La P'tite Femme du Moulin-Rouge (1945)

    h. Moulin Rouge (1952)

i. French Cancan (1955)

j. Une nuit au Moulin-Rouge (1957)

k. La Chaste Suzanne (1963)

l. Moulin Rouge (2001) with Ewan McGregor and Nicole Kidman

m. Paris (2008)

n. Mystère au Moulin-Rouge (2011)

11. The Complainant is the owner of the French trademark MOULIN ROUGE, which has been in use continuously in France in connection with its cabaret since 1889. The MOULIN ROUGE cabaret was immortalised by the painter Henri de Toulouse-Lautrec. Also, many international stars have performed on stage at the Moulin Rouge: Ella Fitzgerald, Liza Minelli, Frank Sinatra, Elton John. They have followed in the footsteps of French celebrities such as Maurice Chevalier, Jean Gabin, Edith Piaf and Yves Montand.

12. The Complainant says that having invested several million Euros in the worldwide promotion of the MOULIN ROUGE theatre for more than a century, its trademark MOULIN ROUGE has acquired a worldwide notoriety.

13. The Complainant has operated a web portal located at www.moulinrouge.com for over 17 years.

14. The Complainant has registered several domain names to promote its reputation on the Internet inclusing:

    a. moulinrouge.fr registered since March 24, 1999 in the name of Le Moulin Rouge;

    b. moulin-rouge.fr registered since October 28, 1999 in the name of Le Bal du Moulin Rouge (a company affiliated to the Complainant).

15. The Complainant presents evidence that a search on Google with the keywords "MOULIN ROUGE" show that the name is well-known and only refers to the Complainant.

16. A Wikipedia page is dedicated to the MOULIN ROUGE and its history which demonstrates the iconic nature of the Complainant's cabaret.

17. The cabaret MOULIN ROUGE is also referenced on the UK and French websites of Trip Advisor with more than 11,000 reviews.

18. The Complainant quotes nine other website to evidence the renown of the name MOULIN ROUGE including viator.com and francetourisme.fr.

19. The Complainant evidences articles from the UK press to demonstrate the renown of the name MOULIN ROUGE in the UK.

20. As a result of the forgoing the Complainant asserts that the Respondent must have had knowledge of the Complainant's marks MOULIN ROUGE when registering the Domain Name. The Respondent clearly took unfair advantage of the efforts and investments made by the Complainant to promote its musical

shows and derived products and to make its theatre activities well-known over the world.

21. The Complainant quotes a WIPO case to support its assertion that the failure to use the Domain Name does not preclude from a finding of bad faith and that it has never been used by the Respondent can only lead to conclude that its sole purpose was to sell the Domain Name to the Complainant.

22. The Complainant quotes a further "well established principle" from WIPO cases that registration of a domain name that is confusingly similar to a well-known trade mark by any entity that does not have a relationship to that mark can amount to sufficient evidence of bad faith registration and use.

23. The Complainant says that the Respondent has registered another domain name (not named) in bad faith, against which a UDRP complaint has already been filed, which supports its case for abusive registration of the Domain Name.

The Response

The Respondent did not reply to the Complaint.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2.1 and 2.2 of the Policy, both limbs of the test that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

Rights is defined in §1 of the Policy as *"rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"*.

The wholly generic suffix ".co.uk" may be discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has to my satisfaction evidenced extensive registered and unregistered rights in the name MOULIN ROUGE.

The Domain Name comprises the name MOULIN ROUGE with the words "the musical" added as a suffix. I accept the Complainant's assertion that the addition of the words "the

musical" adds a descriptive element to the name MOULIN ROUGE which reinforces the connection with the Complainant's business. These words do not detract to any degree from the similarity of the Domain Name to the name MOULIN ROUGE.

Accordingly, for the purposes of the first limb of the test in §2.1.1 of the Policy, I find that the Complainant has Rights in the name MOULIN ROUGE which is similar to the Domain Name.

Abusive Registration

The Complainant has quoted several UDRP cases in its complaint in support of assertions of bad faith and other principles established in such cases.

The quoting of UDRP cases is irrelevant to a dispute under the DRS Policy and particularly exasperating as the Complainant has not directed the submission wholly to the establishment of Abusive Registration under the Policy.

The Nominet DRS website provides extensive and helpful guidance on making a complaint. On the first page of the Expert's Overview guidance document complainants are warned:

> *"Finally, it should be stressed for the benefit of those who have had experience of domain name disputes under the Uniform Domain Name Dispute Resolution Policy ("UDRP"), that the DRS Policy and the UDRP are different systems. In some places they share very similar wording, but there are significant differences and the citation of UDRP decisions in a dispute under the DRS Policy is rarely likely to be helpful."*

Accordingly I have not considered aspects of the complaint that rely solely upon principles set out in the UDRP policy or as established by UDRP cases.

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §5.1 of the Policy:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.4 It is independently verified that the Respondent has given false contact details to us;

5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively; and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.

It is difficult for a complainant in a case such as this where the domain name has been registered but appears to have been inactive since its registration; the complainant has very little opportunity to acquire evidence of the respondent's intentions and/or use of the domain name. With no response from the Respondent there is nothing to indicate his motives in registering the domain name.

The Complainant asserts that in the hands of the Respondent, there is the potential for the Domain Name to be sold, rented or otherwise transferred either to the Complainant

or one of its competitors, for excessive valuable consideration. This may be so but such potential use is not on the face of it sufficient to evidence Abusive Registration and there is no other evidence in the papers before me to indicate this.

The Complainant says that the use of the Domain Name by the Respondent is likely to confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

Given the fame of the Complainant's trademarks and the unique experience, location and fame of the Moulin Rouge caberet, it is difficult to imagine any circumstances under which the Respondent may put the Domain Name to legitimate use that would not cause initial interest confusion. The linking of the trade mark MOULIN ROUGE with the words "the musical" narrows its use to such an extent that initial interest confusion is almost inevitable. The overwhelming majority of DRS experts view this as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived.

Furthermore, although the Domain Name is not an exact match for the Complainant's MOULIN ROUGE trade mark, thereby putting it squarely within §5.1.6 of the Policy, the Complainant's trade mark has a unique worldwide reputation and the Respondent has not offered any reasonable justification for having registered the Domain Name. The fame of the Complainant's trademark and the unique experience, location and fame of the Moulin Rouge show, in the unique circumstances of this case, outweigh the inclusion of the words "the musical" in the Domain Name which might otherwise take it outside of §5.1.6.

As the registration also occurred a relatively short time after the well-known and successful 2001 movie "Moulin Rouge", a musical, I find it highly unlikely that the Respondent would not have been aware of the Complainant's Rights at the time of registration when deciding to add the words "the musical" to the Complainant's trade mark.

The Respondent's lack of use of the Domain Name for the purposes of a website is not evidence of Abusive Registration (§5.2 of the Policy). Nevertheless, given the length of inactivity, together with the Respondent's failure to provide a response (having had ample opportunity to do so) I find it difficult to believe that the Respondent's purpose in registering the Domain Name was to put it to fair use such as a tribute to Moulin Rouge musicals. Even if this was the Respondent's intention, the nature of the Domain Name would almost inevitably lead to initial interest confusion.

Considering the foregoing in the round, I find on the balance of probabilities that the Respondent's registration of the Domain Name has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights, and is therefore an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name be transferred to the Complainant.

Signed …….. **Dated: 12th July 2018**

Steve Ormand