Decision for dispute CAC-UDRP-100825

Case number	CAC-UDRP-100825
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Domain names	conext.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Schneider Electric IT Corporation
Organization	American Power Conversion Corporation

Complainant representative

Organization	Nameshield (Anne Morin)

Respondent

Organization	Jason Burgess

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademark registrations for CONEXT.

FACTUAL BACKGROUND

The Complainant Schneider Electric IT is a French industrial group which manufactures and offers for sale products in the field of power management, automation and solutions for these businesses. It is included in the NYSE Euronext and the CAC 40 stock market index and achieved a turnover of € 24 billion in 2012.

Schneider Electric IT was previously named American Power Conversion Corporation, as per Articles of Amendment on records. The Complaint has been submitted in the name of both Schneider Electric IT and American Power Conversion Corporation.

Schneider Electric IT is the holder of the American trademark No. 4258862 for CONEXT, filed on October 5, 2011 and registered on December 11, 2012, in International class 9, and of the Community trademark No. 10324242 for CONEXT, filed

on October 7, 2011, and registered on March 8, 2012, in class 9. The following trademark registrations for CONEXT are still formally registered in the name of American Power Conversion Corporation: British trademark No. 2214638, filed on November 18, 1999, and registered on November 10, 2000, in class 9; and French trademark No. 3001063, registered on January 12, 2000, in class 9.

References to “the Complainant” in the subsequent paragraphs of this Decision will need to be read as references to “the Complainant Schneider Electric IT”.

The disputed domain name <conext.com> was registered on October 1, 2000.

On June 4, 2014, the Complainant’s representative sent a cease-and-desist letter to the Respondent, to which the Respondent replied stating that he had registered the disputed domain name 14 years before for several projects unrelated to the Complainant but he was interested in selling the disputed domain name for $15.000 USD.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT

The Complainant asserts that the disputed domain name <conext.com> is identical to its trademark CONEXT, as the addition of the gTLD ".com" in the domain name does change the overall impression of the designation as being connected to the Complainant’s trademark CONEXT.

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that he is not related in any way to the Complainant’s business. The Complainant also informs the Panel that it does not carry out any activity for, nor has any business with the Respondent, and that no license or authorization has been granted to the Respondent to make any use, or apply for registration of, the disputed domain name by the Complainant.

The Complainant indicates that, before the sending of its cease-and-desist letter to the Respondent, the website to which the disputed domain name resolved published information related to the Complainant's trademarks and products, and no mention was made of the Respondent's activity. The Complainant also states that the Respondent seems to be the CEO of a company providing website design and development services and that the Respondent did not have any legitimate interest to register and maintain the disputed domain name since, in response to the cease-and-desist letter, the Respondent cancelled the website at the disputed domain name, where mention of the Complainant's products was made, and indicated his willingness to sell the disputed domain name for the price of $15.000 USD, far in excess with respect to the normal out-pocket expenses directly related to the registration of a domain name.

The Complainant submits that, since many years, contents related to the Complainant's CONEXT products were published on the Respondent's website and that, due to the Respondent’s profession, it can be easily supposed that he deliberately made reference to the Complainant's trademarks CONEXT on his website in order to cause a likelihood of confusion. The Complainant further states that the website published at the disputed domain name also provided commercial links from which the Respondent generated incomes.

The Complainant therefore concludes that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product or service on the Respondent's website.

The Complainant also states that, in light of the Respondent’s offer to sell of the disputed domain name to the Complainant for $15.000 USD, the Respondent registered the disputed domain name with the sole purpose of obtaining a financial gain by

attempting to transfer the domain name registration to the Complainant who is the owner of the corresponding trademark.

The Complainant underlines that, in response to its cease-and-desist letter, the Respondent did not justify his good faith in relation to the disputed domain name and, following such communication, deactivated the website to which the disputed domain name resolved. The Complainant asserts that, as prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

Therefore, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT

The Respondent did not submit an administrative compliant response as his Response did not contain any text concerning the factual and legal grounds.

However, the Respondent submitted nonstandard communications, via email, on June 30, 2014, and via the CAC platform, on July 14, 2014, stating that, at the time of the registration of the disputed domain name, he was working for a company called CoNext Communications and that, during development of said company, he pointed the disputed domain name to different landing pages. He also states that he had no knowledge of Schneider Electric IT Corporation and its trademarks and registered the disputed domain name in order to use it for said company. The Respondent alleges that he kept the disputed domain name for 14 years as it is easy to remember, 6 letter .com domain name, that the disputed domain name was registered before the filing of the Complainant's trademarks and that he was planning to use the disputed domain name at some point in the future.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is identical to the Complainant's trademark CONEXT as it includes the trademark in its entirety, with the mere addition of the Top-Level domain ".com" which, as stated in a number of prior decisions rendered under the UDRP, is not sufficient to exclude the likelihood of confusion.

2. The Complainant has stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent might have been commonly known by the disputed domain name or by a name corresponding to the disputed domain name. According to the evidence on records, the Respondent has redirected the disputed domain name to a web site featuring the Complainant's trademark and publishing information about the Complainant's products, along with sponsored links to third parties commercial web sites. After receipt of the Complainant's cease-and-desist letter, the Respondent deactivated the website and requested $15.000 USD for transferring the disputed

domain name to the Complainant. No evidence has been submitted by the Respondent showing that it made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or that it has made a legitimate non-commercial or fair use of the disputed domain name. The Respondent stated that he registered the disputed domain name for projects unrelated to the Complainant but has failed to provide evidence to substantiate its allegations. In view of the above, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

3. As to bad faith at the time of registration, the Panel notes that two of the Complainant's trademark registrations (though still formally registered in the name of American Power Conversion Corporation) were filed before the registration of the disputed domain name. In addition, as mentioned above, the screenshot submitted by the Complainant shows that the disputed domain name resolved, before the Complainant's cease-and-desist letter, to a web site publishing information about the Complainant's products. In view of the above, and considering that the Respondent is active in the field of website-related services for companies and was thus able to conduct online searches for the Complainant's CONEXT trademark and products, the Panel finds that the Respondent was or could have been aware of the Complainant's trademark at the time of the registration of the disputed domain name. The Panel also finds that the Respondent, by pointing the disputed domain name to a web site publishing information on the Complainant's products and sponsored links to third party web sites, has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website. The Panel also finds that the Respondent's request for $15.000 USD for the transfer of the disputed domain name to the Complainant, which is well over the out-of-pocket costs, is an additional evidence of the Respondent's bad faith. Therefore, the Panel concludes that the Respondent has registered and used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **CONEXT.COM**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2014-07-30

Publish the Decision