Decision for dispute CAC-UDRP-102227

Case number	CAC-UDRP-102227
Time of filing	2018-11-16 09:15:18
Domain names	vinci-faci1ities.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	VINCI S.A.

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Susan Patrick

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 several trademarks. In particular, Vinci S.A. owns:

a) EUTM No. 8203531 VINCI FACILITIES (device) registered on November 22, 2009 for classes 35, 36 and 37;

b) EUTM No. 9381385 VINCI FACILITIES (device) registered on March 1, 2011 for classes 9, 38, 39, 41, 42 and 45.

FACTUAL BACKGROUND

VINCI S.A. (the Complainant) is a leading player in concessions and construction, operating in some 100 countries. In 2017, with around 194.000 employees and 3.000 business units, its revenue amounted to 40.2 billion euros.

As a part of the VINCI GROUP, VINCI FACILITIES provides facility management services for buildings and their occupants, such as ensuring building maintenance with the technical expertise of its teams and enhancing the potential value of real estate assets or performing multitechnical maintenance.

The Complainant has duly proved to be the owner of two trademarks containing the wording VINCI FACILITIES. Furthermore, the Complainant states to be the owner, through its subsidiary VINCI ENERGIES SYSTEMES D INFORMATION, of several domain names containing the trademark VINCI FACILITIES, such as <vincifacilities.com> registered and used since April 26, 2010.

The Complainant informs that the disputed domain name <vinci-faci1ities.com> has been registered only on November 12, 2018 and that it merely redirects to a parking page with commercial links, some of them related to the Complainant.

The Complainant states that the disputed domain name <vinci-faci1ities.com> is confusingly similar to its trademark VINCI FACILITIES since (i) the addition of a dash and (ii) the substitution of letter “L” by the number “1” in the trademark VINCI FACILITIES are not sufficient to escape the finding that the domain name is confusingly similar to the trademark VINCI FACILITIES.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant informs that it does not carry out any activity for, nor has any business with the Respondent and that, as a consequence, the Respondent has no rights or legitimate interests on the disputed domain name <vinci-faci1ities.com>.

In addition, the Complainant contends that the mere addition of the dash and substitution of the letter “L” by the number "1" demonstrate a clear case of typosquatting, which is evidence of bad faith registration and use.

Finally the Complainant notes that the website in connection with the disputed domain name <vinci-faci1ities.com> consists of a parking page with commercial links, some of them related to the Complainant, and this circumstance demonstrates that the Respondent has attempt to attract Internet users for commercial gain to his own website thanks to the Complainant’s trademarks.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(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.

1) The Complainant has established to be the owner of the trademark VINCI FACILITIES at least since November 2009. The Complainant's trademark is registered well before the registration of the disputed domain name (November 12, 2018). The Panel notes that the consensus view in previous UDRP panel decisions is that in determining confusing similarity under paragraph 4(a) of the Policy, the generic Top-Level Domain (“gTLD”) suffix (“.com” in this particular instance) should be disregarded. Therefore the comparison has to be made between the signs VINCI FACILITIES and VINCI-FACI1ITIES.

The Complainant argues that the disputed domain name is confusingly similar to its trademark. In particular, it contents that the only differences between the signs are (i) the replacement of the letter L with the number 1 and (ii) the addition of a hyphen between the words VINCI and FACILITIES. The Panel accepts this contention. The similarity is apparent especially in consideration of the visual similarity between the letter "L" or "I" (lowercase version) and the number 1. The Panel cites WIPO Case No. D2012-0212 Olayan Investments Company v. Janice Carver <O1AYAN.COM> and CAC Case No.101688 ArcelorMittal SA vs Cimpress Schweiz GmbH <ARCELORMITTA1.COM>. In both cases the Panels concluded that the replacement of the letter L with the number 1 is not sufficient to escape the finding that the domain name is confusingly similar to the previous trademark and that said replacement has to be considered as typosquatting. Furthermore, previous Panels have stated that a mere hyphen added between two words in a disputed domain name does nothing to distinguish the disputed domain name from a Complainant's previous trademark (see for istance WIPO Case No D2017-0504 Mr. Michel Teman vs. Domain Admin, Whois Privacy Corp. <MICHEL-TENAM.COM>). The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any substantial response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the Respondent has registered or 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 the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

The Respondent registered the disputed domain name years after the use and registration of the VINCI FACILITIES mark by the Complainant. The Complainant's prior registrations and longstanding use of the VINCI FACILITIES trademark suggest that the Respondent registered the disputed domain name with full knowledge of the Complainant and of its VINCI FACILITIES trademark (see Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735 and E. Remy Martin & C° v. Zhang Xiao, WIPO Case No. D2017-2102). Therefore, especially in consideration of the reputation achieved by VINCI FACILITIES, the Panel's view is that the Respondent was surely aware of the Complainant's trademark at the time of the disputed domain name's registration.

The Respondent parked the disputed domain name offering pay-per-click links, some of them related to the Complainant. This circumstance reveals the Respondent's primary motive in relation to the registration and use of the disputed domain name which is, in the Panel's view, to profit from the Complainant's goodwill in the VINCI FACILITIES. According to previous decisions, by diverting Internet users to the website associated with the disputed domain name, the Respondent is benefiting from pay-per-click revenue and profits, which is evidence of use of the disputed domain name in bad faith (see, Accor SA v. Domain Administrator, PrivacyGuardian.org / Zhichao Yang, WIPO Case No. D2017-1322 and Accor SA v. Jan Everno, The Management Group II, WIPO Case No. D2017-2212).

As the conduct described above falls within paragraph 4(b)(iv) of the Policy (see Triumph International Vietnam Ltd v. Tran Quoc Huy, WIPO Case No. D2017-0340), the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VINCI-FACI1ITIES.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2018-12-14

Publish the Decision