Decision for dispute CAC-UDRP-102573

Case number	CAC-UDRP-102573
Time of filing	2019-10-29 14:47:01
Domain names	besix.group

Case administrator

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

Complainant

Organization	Besix Group

Complainant representative

Organization	Ulys

Respondent

Name	Michael Hannart

OTHER LEGAL PROCEEDINGS

The Complainant filed a criminal complaint to the police In Belgium and the case is still under investigation. The Complainant filed an ADR before the Belgian center for arbitration (CEPANI) in relation with the domain name <BESIX-GROUP.BE> which was also used for the perpetration of the same fraud. A decision has been issued on October 25, 2019 and the Panel has granted the transfer of the domain name. The Panel is not aware of any other proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns the Benelux word trademark “BESIX” No. 0872629, registered on February 10, 2010 in classes 35, 36, 37, 40, 42 under the Nice Classification. The Complainant further owns figurative trademarks that pre-dates the registration of the disputed domain names: (1) The European Union trademark Besix, international registration number 1039445, registered on April 14, 2010 and (2) thirteen identical national trademarks, registered in Azerbaijan, Belarus, Switzerland, Algeria, Egypt, Croatia, Kazakhstan, Morocco, Serbia, Russian Federation, Ukraine, Norway, Turkmenistan, international registration number 1039445, registered on April 14, 2010. And the Complainant owns the Benelux figurative trademark with word elements No. 0872955, registered on February 10, 2010.

The disputed domain name <BESIX.GROUP> was registered on March 8, 2019.

FACTUAL BACKGROUND

The Complainant (BESIX Group) is a leading construction company based in Brussels, Belgium, and operating in Europe, the Middle East, Oceania, Africa, North America and Asia. The Complainant is the owner of several domain names, including <besix.com>, <besix.net>, <besix.be>, <besix.fr>, <besixgroup.com> and <besixgroup.be>.

From June 2018 until the date of the complaint at lease 200 companies have been contacted by email to place an order in the name of the Complainant. The e-mail was sent usually to a business relation of the Complainant, placing an order (PCs, hard disks, phones, office supplies, etc.) in the name of the Complainant and reproducing the Complainant's trademark, the colour scheme and logo of the Complainant as well as its address. The e-mail was drafted in order to cheat the recipient who will falsely believe that the order originates from the Complainant. The following e-mail addresses were notably used: info@besix.group, order@besix.group, contact@besix.group, finance@besix.group, sales@besix.group, larosse@besix.group, achat@besix.group.

The domain name used within the e-mail is a critical element: it gives the impression that the e-mails [XX]@besix.group are effectively originating from the Complainant and it is an important element in trying to convince the recipient that the request is made on behalf of the Complainant.

A complaint against "unknown (X)" was filed with the police and an investigating judge, an investigation is currently conducted.

The disputed domain name is not used in the purpose of hosting a website; its mere use is to exchange e-mails in the context of this largescale fraud.

PARTIES CONTENTIONS

The Complainant owns the Benelux word trademark "BESIX", the European Union figurative trademark "Besix", thirteen identical national figurative trademarks and the Benelux figurative trademark "Besix". The figurative trademarks consist of a combination of figurative and verbal elements: stripes of various colors (red, white and various shades of blue), beside which, written out in full, is the stylised blue word Besix. Within the trademarks, the verbal element "Besix" is predominant and constitutes the essential element to be taken into account when analysing the first UDRP condition.

BESIX, the Complainant's trademarks, is included entirely in the disputed domain name <BESIX.GROUP>. It is considered that where a domain name incorporates the entirety of a trademark, or where at least 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 purposes of UDRP standing. Furthermore, BESIX Group, a trade name as well as the company name, is identical to the disputed domain name.

It should also be added that the confusion is all the more evident since the disputed domain name is used precisely in order to falsely give the impression that the emails sent under that domain are originating from the Complainant. There is therefore even greater confusion since the confusion not only is a consequence of the disputed domain name use, but the intended consequence of the disputed domain name use.

The Complainant's distinctive marks pre-date the registration of the disputed domain name. While the registration of the disputed domain name dates from March 8, 2019, the Complainant's trademarks have been registered since February 10, 2010 and April 14, 2010, and the oldest domain names of the Complainant date back to 1997 (<besix.com>), 2001 (<besix.net>), 2003 (<besix.be>, <besix.fr>), 2004 (<besixgroup.com>) and 2007 (<besixgroup.be>).

The Respondent does not have any rights or legitimate interest in the disputed domain name. There is no relation between the disputed domain name holder and the Complainant; it is impossible to know the identity of the disputed domain name holder who hides behind an anonymous registration and therefore impossible to contact him/her; the e-mail addresses used are info@besix.group, order@besix.group, contact@besix.group, finance@besix.group, sales@besix.group, larosse@besix.group, which are very similar to existing addresses used by the Complainant or its team; the domain names holder usurps the identity of the BESIX Group and Peter Larosse, an employee of a Besix subsidiary and former employee of BESIX Group; he appears in the scam as a present employee of the Complainant and valid representative of the company ;

the company number used is the one of Besix Group, which can be argued is worse than using a similar one.

Moreover, the lack of a right or legitimate interest arises from the fact, that the domain name holder does not hold, whether in the European Union, or elsewhere, any known trademark that corresponds, to a greater or lesser extent, to the disputed domain name; the Respondent is not known as a company or other organisation under the name “besix-group“ or “besix“ and the Complainant has never granted a licence to the domain name holder to use its trademark.

Even in case the Respondent would claim interest or right in the disputed domain name, it would fail proving that this (alleged) interest or right is legitimate. It should be stressed from the outset that, at the stage of analysing the right or the legitimate interest, it is impossible to consider as legitimate a case of identity theft and attempted fraud. It is contrary to fairness to register domain names, leave them unused in terms of website and use them to create mail addresses in order to scam and try to get a fraudulent advantage using the Complaint trademarks, name, logo and colours. Indeed, beyond looking at the domain names and the nature of their content, panels assess whether the overall facts and circumstances of the case support a claimed fair use.

Eventually, it should be stressed that Panels have categorically held that the use of domain names for illegal activity (e.g. phishing, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a Respondent.

In this respect, Complainant doesn’t have to prove that Respondent has been convinced of illegal activity by a Court. Panels have found that circumstantial evidence can support a Complainant’s otherwise credible claim of illegal Respondent activity. In this case, the existence of more than 200 identified victims, the deep enquiry by the police (still ongoing), and the nature of the fraud (a pure scam-scheme where hidden persons are trying to cheat the recipient of the e-mails and lead them to believe that the order is placed by the Complainant), are enough to demonstrate a blatant illegal activity.

Not only is it for sure that Respondent was aware of the existence of Complainant when registering the disputed domain name (the Complainant is the largest Belgian constructor and among the top 69 in the world), but the disputed domain name has been carefully chosen in order to be as close as possible to the Complainant’s websites, in order to exchange e-mails from a domain that appears as original as possible. Bad faith is blatant.

It is considered that the apparent intention of disrupting the business of the Complainant, through contacting its co-contractors under the identity of the Complainant, but using a different e-mail address to place fraudulent orders, should be interpreted as an attempt, by the disputed domain name holder, to knowingly create a risk of confusion between him and the Complainant. Such a conclusion is confirmed by the use of the trademark and the company name of the Complainant.

These circumstances, coupled with the use of the disputed domain name without the Complainant’s consent and the lack of information provided to DNS.be at the moment of registration, the use of e-mail addresses similar to those of the Complainant and of the same company number similar to the one of the Complainant (logically, the use of an identical number should be deemed more serious), tends to confirm the domain names holder’s bad faith.

In this case, arguments raised regarding the second condition may also be assessed as far as the third condition is concerned: such common assessment is recommended for example where clear indicia of bad faith suggest there cannot be any Respondent rights or legitimate interests (and vice-versa). In such cases, panels have found that the facts and circumstances of the case would benefit from a joint discussion of the policy elements.

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

This Complaint was initially relating to three domain names (<BESIX-GROUP.COM>, <BESIX-GROUP.NET>, and <BESIX.GROUP>) because the Complainant was of the opinion that the same person (or group of persons) was perpetrating the fraud. The first domain name (<BESIX-GROUP.COM>) was released in the meantime. However, concerning the two others domain names, the registrars have disclosed the identification (the original registrations were anonymous) and it appeared that the names of the holders are different for the two domain names. The Complainant has decided to amend its complaint and limit it to one domain name: <BESIX.GROUP>.

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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) The respondent has no rights or legitimate interests in respect of the domain name; and

(iii) The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the Benelux word trademark “BESIX” No. 0872629, registered on February 10, 2010, EU figurative trademark Besix, international registration number 1039445, registered on April 14, 2010, thirteen identical national figurative trademarks, international registration number 1039445, registered on April 14, 2010, Benelux figurative trademark No. 0872955, registered on February 10, 2010, all these trademarks containing the term “BESIX”. Moreover, the Complainant has established the fact, that it has valid rights for the company name “BESIX GROUP” and for the several domain names containing term “BESIX“ or “BESIXGROUP“.

The disputed domain name has been registered on March 8, 2019, i.e. almost 9 years after the first trademark registration. The disputed domain name is <BESIX.GROUP>, where the term “BESIX“ is the second level domain registered within the top-level domain GROUP.

The disputed domain name <BESIX> fully corresponds to the Complainant’s trademarks and the first element of the Complainant’s company name. Moreover, due the registration of the disputed domain name within the top-level domain <GROUP>, the entire domain name <BESIX.GROUP> corresponds to the entire Complainant's company name.

The Panel therefore considers the disputed domain name to be identical with the Complainant’s trademarks “BESIX” and confusingly similar to the Complainant’s company name “BESIX GROUP” which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The Complainant has established a prima facie case (not challenged by the Respondent who did not filed any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term “BESIX” or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

Moreover the disputed domain name has been used to address the third parties in the form of scam and therefore for the fraudulent activities. Such use does not constitute a bona fide offering of goods and services or a legitimate non-commercial fair use.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

The Respondent has registered the disputed domain name that contains the entire word element of the Complainant’s trademarks. Moreover, the disputed domain name has been registered in such a top-level domain that the both elements of the disputed domain name (second and top-level domain) together directly links to the entire company name of the Complainant. In addition, the Complainant’s trademarks and company name are highly distinctive and widely known as proved by the Complainant. It could be therefore concluded that the Respondent had or should have the Complainant and its trademarks in mind when registering the disputed domain name and the registration has been realized in bad faith. Furthermore, the disputed domain name has been used in a fraudulent activity and therefore in bad faith as well.

Considering the (i) similarity between the Complainant’s trademarks and company name and the disputed domain name, (ii) fraudulent use of the disputed domain name, (iii) distinctiveness of the Complainant’s trademarks and (iv) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that 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.

The Panel finally considers that the Complainant has shown that the disputed domain name <BESIX GROUP> is confusingly similar to a trademarks in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BESIX.GROUP**: Transferred

PANELLISTS

Name	**JUDr. Petr Hostaš**

DATE OF PANEL DECISION 2019-12-06

Publish the Decision