Decision for dispute CAC-UDRP-103041

Case number	CAC-UDRP-103041
Time of filing	2020-04-29 14:05:22
Domain names	spiebatignolles-fr.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	SPIE BATIGNOLLES

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Organization	eastman.com

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of “several trademarks” that consist of “SPIE BATIGNOLLES,” including Int’l Reg. No. 535,026 (registered February 17, 1989), EU Reg. No. 3,540,226 (registered October 21, 2003), and French Reg. No. 1,494,661 (registered October 19, 1988). These marks are referred to hereafter as the “SPIE BATIGNOLLES Trademark.”

FACTUAL BACKGROUND

Complainant states that it “is a French construction company based in Neuilly-sur-Seine” that “provides building and infrastructure construction in France, Germany, the United Kingdom, Spain, Portugal and Switzerland.” Complainant is the registrant of and uses the domain name <spiebatignolles.fr> (created July 30, 2004).

The Disputed Domain Name was created on April 14, 2020, and “redirects to commercial links (‘PPC’).”

Paragraph 4(a)(i): Complainant states, inter alia, that the Disputed Domain Name is confusingly similar to the SPIE BATIGNOLLES Trademark because “[t]he addition of the country geographically descriptive abbreviation ‘FR’ for ‘France’ is

not sufficient to avoid the likelihood of confusion with the Complainant."

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in the Disputed Domain Name because, inter alia, "Respondent is not identified in the WHOIS database as the disputed domain name"; "Respondent is not affiliated with nor authorized by SPIE BATIGNOLLES SA in any way"; "[n]either licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark SPIE BATIGNOLLES"; and "use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with Complainants' trademark."

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, "the disputed domain name redirects to a parking page with commercial links" and "[i] t has been recognized that such use of trademark to generate revenue from Internet advertising can constitute registration and use in bad faith" and, therefore, "the Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website, by creating a likelihood of confusion with Complainant's mark."

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 UDRP).

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 UDRP).

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 UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registration cited by Complainant, it is apparent that Complainant has rights in and to the SPIE BATIGNOLLES Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the SPIE BATIGNOLLES Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., "spiebatignolles-fr") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Overview 3.0, section 1.11.1.

Here, the Disputed Domain Name contains the SPIE BATIGNOLLES Trademark in its entirety, simply omitting a space (which is an invalid character in a domain name) and adding the letters "fr," which are abbreviation for France and also are identical to the top-level domain in the domain name <spiebatignolles.fr > used by Complainant. As set forth in section 1.7 of WIPO Overview 3.0, "in cases 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." Further, section 1.9 of WIPO Overview 3.0 states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states, inter alia, that "Respondent is not identified in the WHOIS database as the disputed domain name"; "Respondent is not affiliated with nor authorized by SPIE BATIGNOLLES SA in any way"; "[m]either licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark SPIE BATIGNOLLES"; and "use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with Complainants' trademark."

WIPO Overview 3.0, section 2.1, states: "While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 registrant's website or location or of a product or service on the registrant's website or location.

WIPO Overview 3.0, section 3.1.4, states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

Further, numerous panels under the UDRP have found the registration and use of a domain name that is confusingly similar to a complainant's trademark to constitute bad faith pursuant to paragraph 4(b)(iv) of the UDRP where, as here, the domain name is associated with monetized parking pages that could be construed as associated with the complainant. See, e.g., Wal-Mart Stores, Inc. v. Whois Privacy, Inc., WIPO Case No. D2005 0850; Columbia Pictures Industries, Inc. v. North West Enterprise, Inc., WIPO Case No. D2006-0951; and Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service, WIPO Case No. D2011-1753.

Accordingly, the Panel finds that Complainant has proven 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. **SPIEBATIGNOLLES-FR.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2020-05-27

Publish the Decision