Decision for dispute CAC-UDRP-103573

Case number	CAC-UDRP-103573
Time of filing	2021-02-12 09:32:32
Domain names	extsocgen.com , sgsssocgen.com

Case administrator

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

Complainant

Organization	SOCIETE GENERALE

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Bob Coleman

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 names.

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the registered owner of several trademarks relating to its abbreviated company name and brand “SOCGEN”, inter alia, the following:

- Word mark SOCGEN, International trademark, Registration No.: 772893, Registration Date: December 5, 2001, Status: active;

- Word mark SOCGEN, European Union Intellectual Property Organization (EUIPO), Registration No.: 000476671, Registration Date: December 17, 1998, Status: active.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The term “SOCGEN” is a contraction of “SOCiete GENerale”. There is no meaning in English or any languages. The disputed domain names are confusingly similar to the Complainant's well-known trademark SOCGEN®. See WIPO Case n° D2002-

0457 Societe Generale v. DLI, Dale Miller (“the Panel accepts the evidence of the Complainant that it is a well known bank and that the trade mark "SOCGEN" is used in France and all over the world to designate the Complainant especially in the international press.”).

Regarding the use of disputed domain names:

- <extsocgen.com>: The disputed domain name is inactive since its registration. As prior panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, is evidence of bad faith registration and use. (See Telstra Corporation Limited v Nuclear Marshmallows D2000-0003 WIPO Feb 18 2000);

- <sgsssocgen.com>: The disputed domain name redirects to a commercial links in relation with the Complainant (See “Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service, WIPO Case No. D2011-1753. A respondent cannot disclaim responsibility for programmatically generated PPC content. See WIPO Overview 3.0 at section 3.5.”).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

As a procedural comment, given that both disputed domain names (1) have been composed in a very similar way combining the Complainant’s SOCGEN trademark with a prefix “ext” or “sgss”, accordingly, and (2) have been registered at almost the same point of time through the same registrar using the same DNS, it is reasonable to argue that the disputed domain names are subject to common control which is why it is fair and equitable to all parties that this Complaint is consolidated against multiple respondents at the same time.

Now, therefore, the Panel finds that the disputed domain names <extsocgen.com> and <sgsssocgen.com> are confusingly similar to the SOCGEN trademark in which the Complainant has rights. The disputed domain names both incorporate the Complainant’s entire SOCGEN trademark. Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the disputed domain name is at least confusingly similar to a registered trademark. Moreover, it has been held in many UDRP decisions and has meanwhile become a consensus view among UDRP panels that the mere addition of descriptive or other terms, such as “ext” or “sgss” (which even is an abbreviation of “Société Générale Securities Services” and so directly refers to the Complainant’s business), is not capable to dispel the confusing similarity arising from such incorporation of the Complainant’s SOCGEN trademark in the disputed domain names.

Therefore, the Complainant has satisfied paragraph 4(a)(i) and, thus, the first element of the Policy.

Moreover, the Complainant contends, and the Respondents have not objected to these contentions, that the Respondents have neither made use, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services, nor are the Respondents making a legitimate noncommercial or fair use of the disputed domain names, nor are the Respondents commonly known thereunder. The Respondents have not been authorized to use Complainant's SOCGEN trademark, either as a domain name or in any other way. Also, there is no reason to believe that the Respondents' names somehow correspond with the disputed domain names and the Respondents do not appear to have any trademark rights associated with the term "SOCGEN" whatsoever. Finally, by the time of the rendering of this decision, both disputed domain names do not resolve to any valid content on the Internet (so-called "passive holding"); however, many UDRP panels have recognized that the mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase, may not of itself confer rights or legitimate interests in a disputed domain name. Accordingly, the Panel has no difficulty in finding that the Respondents have no rights or legitimate interests in respect of the disputed domain names.

Therefore, the Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

The Panel finally holds that the disputed domain names were registered and are being used by the Respondents in bad faith. The way in which the disputed domain names have been composed (e.g. including an abbreviation of "Société Générale Securities Services" on top of the Complainant's SOCGEN trademark and so directly referring to the Complainant's business) clearly indicates that the Respondents had knowledge of the Complainant's SOCGEN trademark at the time of the registration of the disputed domain names and leaves little, if no doubt that both disputed domain names aim at targeting this very trademark. Also, there is a consensus view among UDRP panelists that a passive holding of a domain name may, in appropriate circumstances, be consistent with the finding of bad faith, in particular in circumstances in which, for example, there is no conceivable use that could be made of the disputed domain name and would not amount to an infringement of the complainant's trademark's rights. In the case at hand, in the absence of any other reasonable explanation as to why the Respondents should rely on the disputed domain names and given that the Respondents have brought forward nothing in substance relating to the intended use of the disputed domain names that would have allowed the Panel to hold for the Respondents, the Panel finds that the Respondents have registered and are making use of the disputed domain names in a manner which at least takes unjustified and unfair advantage of the Complainant's SOCGEN trademark and related reputation and must, therefore, be considered as registered and being used in bad faith within the meaning of the Policy.

Therefore, the Complainant has also satisfied paragraph 4(a)(iii) and, thus, 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. **EXTSOCGEN.COM** : Transferred
2. **SGSSSOCGEN.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2021-03-18

Publish the Decision