

Decision for dispute CAC-UDRP-103598

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| Case number | CAC-UDRP-103598 |
| Time of filing | 2021-02-23 09:17:33 |
| Domain names | sgcibb.com, sgciib.com |

Case administrator

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| Organization | Denisa Bilík (CAC) (Case admin) |
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Complainant

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| Organization | SOCIETE GENERALE |
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Complainant representative

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| Organization | Nameshield (Laurent Becker) |
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Respondent

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| Organization | Transfers of Learning, LLC |
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OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade mark:

- French trade mark registration no. 3223420, dated 2 May 2003, for the word mark SGCIB, in classes 09, 16, 35, 36 and 38 of the Nice Classification.

FACTUAL BACKGROUND

The Complainant's contentions can be summarised as follows:

I. The disputed domain names are confusingly similar to a trade mark in which the Complainant has rights

The Complainant is one of Europe's leading financial services groups and a major player in the economy for over 150 years, supporting 29 million clients every day with 138,000 staff in 62 countries.

In addition to the trade mark mentioned above, the Complainant states that it is also the owner of the domain name <sgcib.com> registered on 22 February 2000.

The disputed domain name <sgcibb.com> was registered on 2 February 2021, and the disputed domain name <sgciib.com> was registered on 2 January 2021.

The Complainant avers that the disputed domain names are confusingly similar to the Complainant's trade mark SGCIB, and that they are clear cases of typosquatting.

In order to substantiate its claim, the Complainant relies on previous UDRP decisions, most notably CAC Case No. 100797, SOCIETE GENERALE S.A. v Afs Inc (Afiandi Benson), in respect of the domain name <ssgciib.com>; and CAC Case No. 100587, SOCIETE GENERALE S.A. v Direct Navigation Data, in respect of the domain name <scgib.com>.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain names

The Complainant asserts that the Respondent has no rights in the disputed domain names, and that the Respondent is not affiliated with, nor authorised by, the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with, the Respondent. The Respondent has not been authorised or licensed by the Complainant to make any use of the Complainant's trade mark SGCIB nor to apply for registration of the disputed domain names by the Complainant. The Complainant further asserts that the Respondent is not known by the disputed domain names and that the Respondent has no demonstrable plan to use the disputed domain names since their registration.

III. The Respondent registered and is using the disputed domain names in bad faith

The Complainant contends that, given the Complainant's trade mark's distinctiveness and reputation, the Respondent has registered the disputed domain names with full knowledge of the Complainant's trade mark SGCIB and, therefore, could not ignore the Complainant. The Complainant also contends that the misspellings in the disputed domain names were intentionally designed to be confusingly similar with the Complainant's trade mark SGCIB. On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain names in bad faith.

PARTIES CONTENTIONS

The Respondent did not file an administratively compliant Response and did not submit any reply to the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are identical or confusingly similar to a trade 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 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

Pursuant to Rule 15 of the UDRP Rules, the panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the panel deems

applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to divest the Respondent of the disputed domain names:

- i. The disputed domain names are 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 names; and
- iii. The disputed domain names have been registered and is being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three Policy elements in turn.

I. Identical or Confusingly Similar

The UDRP test under the first element provides for a juxtaposing approach, according to which the textual components of the disputed domain names and the Complainant's trade mark are to be compared side by side.

In order to succeed under the first element of the Policy, the Complainant must provide evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain names are identical or confusingly similar to the Complainant's trade mark.

Upon review of the case file, the Panel is satisfied that the Complainant has trade mark rights in the term "SGCIB", dating back to 2003.

The disputed domain names are <sgcibb.com> and <sgciib.com> and, at the time of writing, none of them resolve to active websites.

The Complainant's trade mark SGCIB is wholly incorporated in the disputed domain names. The additions of the letters "b" and "i" in the disputed domain names <sgcibb.com> and <sgciib.com>, respectively, are rather immaterial in the Panel's view to produce any distinctive character and, therefore, insufficient to dispel the visual and phonetic confusion between the disputed domain names and the Complainant's trade mark SGCIB (see e.g. WIPO Jurisprudential Overview 3.0, paragraph 1.9; CAC Case No. 100797, SOCIETE GENERALE S.A. v Afs Inc (Afiandi Benson), in respect of the domain name <ssgciib.com>; and CAC Case No. 100587, SOCIETE GENERALE S.A. v Direct Navigation Data, in respect of the domain name <scgib.com>.).

The Panel further notes that TLD suffixes are typically disregarded in the assessment of the first element of the Policy. The reason for that is because a TLD is part of the anatomy of a domain name, being the last component positioned right after the final dot (e.g. ".com") (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trade mark SGCIB, the result of which being that the Complainant has succeeded under the requirement of paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The second element of the Policy provides that the Respondent shall demonstrate that it has rights or legitimate interests in the disputed domain names. It therefore falls on the Complainant the burden to refute any such allegations.

Paragraph 4(c) of the Policy sets out a non-exhaustive list of examples by which the Respondent can demonstrate its rights or legitimate interests in the disputed domain names, as follows:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The evidentiary standard under the UDRP proceedings is such that, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to provide evidence to the contrary.

The Respondent did not submit a Response in these UDRP proceedings. Therefore, the Panel will make a determination on the basis of the available evidence.

Having reviewed the case file, the Panel notes that the Respondent does not carry out any activity for, or has any business or relationship of any nature with, the Complainant. There is no contractual arrangement between the parties to that effect, nor has the Complainant otherwise authorised the Respondent to make any use of the Complainant's trade mark, or to apply for registration of the disputed domain names on the Complainant's behalf. The Complainant has also not authorised the Respondent to make any use of the Complainant's trade mark SGCIB, and there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain names. The Panel is of the view that the evidence on the available record does not demonstrate that before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a bona fide offering of goods or services. In addition, the available record does not demonstrate that the Respondent is making a legitimate non-commercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers.

The Panel notes that there is also no evidence on record to suggest that the Respondent is affiliated with, or endorsed by, the Complainant (and, in any event, any affiliation or endorsement has been denied by the Complainant).

In addition, in the Panel's view, the choice of a domain name which incorporates a complainant's trade mark wholly or nearly wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for this coincidence, could further evidence a lack of rights or legitimate interests.

For the foregoing reasons, and noting that the Respondent has not refuted any of the allegations and evidence produced by the Complainant in these proceedings, the Panel finds that the Complainant has made a prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain names under paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

In order to meet the third requirement under the Policy, the Complainant must provide evidence that the disputed domain names were registered and are being used in bad faith.

The Policy enumerates non-exhaustive circumstances which would evidence bad faith registration and use of a domain name, as follows:

1. circumstances indicating that the respondent has registered or 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 your documented out-of-pocket costs directly related to the domain name; or

2. the respondent 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 you have engaged in a pattern of such conduct; or
3. the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
4. by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The Panel has considered the evidence put forward by the Complainant and has undertaken some factual research into matters available on the public record. In the Panel's view, the case circumstances warrant a concurrent assessment of bad faith registration and use, as follows:

- The disputed domain names wholly incorporate the Complainant's trade mark SGCIB and the additions of the letters "b" and "i" in the disputed domain names <sgcibb.com> and <sgciib.com>, respectively, are rather insufficient to dispel the overall visual and phonetic confusion between the disputed domain names and the Complainant's trade mark SGCIB in the Panel's view;
- There is no credible explanation for the Respondent's choice of the disputed domain names, which were registered in 2021. Firstly, the Complainant has been in operation for over 150 years, including in the United States, where the Respondent is based. Secondly and most compellingly, the Complainant owns, and operates its activities through, an almost identical domain name <sgcib.com>, which was registered in 2000, over 20 years before the registration of the disputed domain names. Therefore, the Panel does not look favourably upon the Respondent, and finds it highly unlikely that the Respondent was not aware of the Complainant's prior rights in the trade mark SGCIB at the time of registering the disputed domain names, given the Complainant's reputation, which the Panel accepts;
- The Respondent has not provided a Response within the time prescribed under the UDRP Rules, or at all, and has thus failed to offer any explanation of justification to the matters raised by the Complainant in the context of these proceedings. The Panel is empowered to draw adverse inferences by such failure (UDRP Rule 14 (b));
- There is nothing on the record suggesting that the Respondent is affiliated or otherwise connected with the Complainant and the Complainant denies any association;
- The disputed domain names <sgcibb.com> and <sgciib.com> mirror almost identically the Complainant's domain name <sgcib.com> by which the Complainant operates and commercialises its products and services across the globe. In CAC Case No. 103538, Intesa Sanpaolo S.p.A. v lisa brgr, the Panel raised in obiter the rather unfortunate issue of certain business sectors having a heightened risk of being targeted for phishing or fraudulent activities, in particular, those in the banking and finance sector such as the Complainant. In the same decision, the Panel also voiced concerns that panels should be mindful of this red flag and act accordingly by placing adequate weight on such evidence as they see fit. Whilst the Complainant's claim in the present matter is not grounded on phishing or fraudulent activities, the Panel nevertheless is of the view that there is a possibility that the disputed domain names might have been registered with the prospective intention of being used in connection with fraudulent activity; and
- The Panel considers that the case circumstances warrant a finding of bad faith under the passive holding doctrine (see e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Having considered the totality of the circumstances, the reasons for this include, most compellingly (i) the degree of reputation of the Complainant's trade mark; (ii) the Complainant owns and operates through an almost identical domain name <sgcib.com>, which was registered over 20 years before the registration of the disputed domain names; (iii) the failure of the Respondent to submit a Response or provide any evidence of actual or contemplated good faith use of the disputed domain names; and (iv) the overall unlikelihood of any good faith use of the disputed domain names.

The Panel has looked at the overall composite picture of events and finds it, collectively, to be sufficient to justify a finding that the Respondent has registered and is using the disputed domain names in bad faith under the Policy.

Accordingly, the Complainant has made a prima facie showing that the Respondent has registered and is using the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **SGCIBB.COM**: Transferred
- 2. **SGCIIB.COM**: Transferred

PANELLISTS

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| Name | Dr Gustavo Moser |
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DATE OF PANEL DECISION 2021-04-11

Publish the Decision