

## Decision for dispute CAC-UDRP-103683

Case number CAC-UDRP-103683

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Time of filing 2021-03-23 09:18:50

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Domain names spiefondations.com

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### Case administrator

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

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### Complainant

Organization SPIE BATIGNOLLES

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### Complainant representative

Organization Nameshield (Enora Millocheau)

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### Respondent

Organization Tool Domains Ltd

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#### 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.

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#### IDENTIFICATION OF RIGHTS

- International trademark registration SPIE BATIGNOLLES n° 535026 registered since February 17, 1989;
  - European trademark registration SPIE BATIGNOLLES n° 3540226 registered since October 31, 2003; and
  - French trademark registration SPIE BATIGNOLLES n° 1494661 registered since October 19, 1988.
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#### FACTUAL BACKGROUND

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

Complainant refers to prior panel decisions:

- WIPO Case No. D2010-2124, Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill (“The addition of certain words, as here, can “exacerbate [...] the confusing similarity between the [Complainant’s] trademark and the Domain Name and increase [...] the risk of confusion between the Domain Name and the [...] trademarks.”);
- Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).”);

- WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe ("Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.");

- Forum Case No. 937704, Williams-Sonoma, Inc. v. Kurt Fees c/o K Fees ("The Panel finds that Respondent's willingness to sell the disputed domain name registration suggests that it has no rights or legitimate interests pursuant to Policy 4(a)(ii).");

- WIPO Case No. D2018-0564, Dubizzle Limited BVI v. Syed Waqas Baqir ("By allowing the use of pay-per-click links on a website having a confusingly similar domain name to the Complainant's marks, the Respondent must have intended to use the disputed domain name to attract Internet users to its website for commercial gain and such intentional use constitutes bad faith under UDRP paragraph 4(b)."); and

- Forum Case No. FA 1769400, Robert Half International Inc. v. Domain Registries Foundation ("Offering a confusingly similar domain name for sale can evince bad faith registration under Policy 4(b)(i). [...] As noted above, Respondent displays a link stating "Buy this domain" on the resolving webpage.").

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#### PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

(Note: during the ADR procedure, the Respondent has sent an e-mail to the Complainant's representative to provide explanation on the reason for choosing the disputed domain name. In its answer, the Complainant's representative (1) has invited the Respondent to use the ADR platform to answer to the Complaint, and (2) informed the Panel of these e-mails in a Nonstandard Communication. The e-mail from the Respondent to the Complainant's representative does not comply to the procedure for filing an answer to a complaint. The Panel shall not take it into account and shall consider that no administratively compliant response has been filed.)

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#### 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).

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#### 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).

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#### 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

##### FIRST CONDITION

It is commonly accepted that the first condition functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In this comparison, the cc- or g- TLD is usually not taken into account.

The disputed domain name includes entirely an important part ("SPIE", the word "BATIGNOLLES" being less distinctive since it refers to an area of Paris close to the place where the history of the Complainant originally began) of the Complainant's trademark, with the adjunction of the generic word "fondations". The Panel is of the opinion that in a situation where the Complainant's trademark is entirely included in the disputed domain name, the adjunction of generic terms does not

generally change the assessment as far as the first condition is concerned. (see also WIPO, Swiss Re, No. D2014-1873). It is even more the case in a situation like the one in this case, where this generic term refers to the activity of the Respondent. First condition is satisfied.

## SECOND CONDITION

The Panel has 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.

The Complainant claims, without being contradicted, that:

- The Respondent is not identified in the WHOIS database as the disputed domain name;
- The Complainant has not licensed or authorized the Respondent to register or use the disputed domain name;
- There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks;
- The disputed domain name is offered for sale for a minimum offer of 250 USD; and
- The disputed domain resolves to random pages including a parking page with commercial links.

The Respondent has chosen not to answer to the Complaint.

Based on the elements presented by Complainant, the Panel finds that the second condition is satisfied.

## THIRD CONDITION

The disputed domain name incorporates nearly entirely the Complainant’s trademark. In the absence of any credible explanation, such incorporation appears as a direct reference to the Complainant’s trademark. There is no apparent plausible reason for the Respondent to register the domain name, except its probable intention of taking advantage of the distinctiveness of the Complainant’s trademark.

It is therefore prima facie highly probable that the Respondent registered and used the disputed domain name having the Complainant in mind, and acted in order to attract traffic by using the notoriety of the Complainant in order to make money when a visitor clicks on the commercial links inserted on the Respondent’s website and/or to have an opportunity to sell the disputed domain name to the Complainant.

The Respondent has chosen not to answer to the complaint.

Based on the elements presented by Complainant, the Panel finds that the third condition is satisfied.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SPIEFONDATIONS.COM**: Transferred

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## PANELLISTS

Name	Mr. Etienne Wéry
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DATE OF PANEL DECISION 2021-04-16

Publish the Decision

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