

Decision for dispute CAC-UDRP-103900

Case number	CAC-UDRP-103900
Time of filing	2021-07-01 12:48:59
Domain names	schneiderelectricmarket.com

Case administrator

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

Organization	SCHNEIDER ELECTRIC SE
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Complainant representative

Organization	Nameshield (Laurent Becker)
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Respondent

Organization	Tekniker Elektrik
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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.

IDENTIFICATION OF RIGHTS

The Complainant owns trademarks including the terms "SCHNEIDER ELECTRIC", such as (1) the international trademark SCHNEIDER ELECTRIC no 715395 registered since March 15, 1999; (2) the international trademark SCHNEIDER S ELECTRIC no 715396 registered since March 15, 1999 and (3) the European trademark SCHNEIDER ELECTRIC no 1103803 registered since March 12, 1999.

The Complainant is also the owner of many domain names which include the trademark SCHNEIDER ELECTRIC such as <schneider-electric.com> registered and used since October 3, 1997.

The disputed domain name <schneiderelectricmarket.com> was registered on April 1, 2021 and redirects to a website purporting to be an online store selling the Complainant's and other Competitors' products.

FACTUAL BACKGROUND

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

The Complainant, which was founded in 1871, is a French industrial business trading internationally. It manufactures and offers products for power management, automation, and related solutions. The Complainant is featured on the NYSE Euronext and the French CAC 40 stock market index. In 2019, the Complainant revenues amounted to 27.2 billion euros.

I. The disputed domain name is confusingly similar to the protected mark

The Complainant states that the disputed domain name is confusingly similar to its trademark SCHNEIDER ELECTRIC. Indeed, the addition of generic term "MARKET" in the disputed domain name is not sufficient to avoid the likelihood of confusion with the Complainant's trademark. It is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP".

Moreover, the Complainant contends that the addition of the generic Top-Level Domain suffix ".COM" does not change the overall impression of the designation as being connected to the trademark SCHNEIDER ELECTRIC of the Complainant. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Thus, the disputed domain name is confusingly similar to the Complainant's trademark SCHNEIDER ELECTRIC®.

II. The Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Complainant asserts that the Respondent "Tekniker Elektrik" is not known as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain name by the Complainant.

Finally, the disputed domain name points to a website purporting to be an online store selling the Complainant's others Competitors' products. A reseller or distributor may be making a bona fide offering of goods and services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Oki Data Americas, Inc. v. ASD, Inc*, WIPO Case No. D2001-0903 ("Oki Data"), including:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the website to sell only the trademarked goods;
- the site itself must accurately disclose the respondent's relationship with the trademark owner; and
- the respondent must not try to "corner the market" in all relevant domain names, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

The Complainant finds the Respondent did not place any statement or disclaimer disclosing accurately its relationship with the Complainant. Further, the website under the disputed domain name also contained the Complainant's logo as well as its product images. With such a view, the Complainant finds that the use of the disputed domain name does not meet the Oki Data criteria and thus, does not constitute a bona fide use.

Thus, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name <schneiderelectricmarket.com>.

III. The disputed domain name has been registered and is being used in bad faith

The disputed domain name is confusingly similar to the Complainant's well-known trademark. Also, in consideration of the use of the disputed domain name and the contents of the website thereunder, the Complainant is of the view that the Respondent obviously knew of the Complainant and its trademarks when it registered the disputed domain name, and the Complainant considers the registration is an attempt by the Respondent as to take advantage of the Complainant's goodwill.

The Complainant contends that any Internet users seeking to purchase the Complainant's SCHNEIDER ELECTRIC products would very likely mistakenly believe that the Respondent is either connected to or associated with the Complainant, while no such connection exists in fact. Such misleading behavior is indicative of bad faith. By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 website or location or of a product or service on the website or location.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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.

The Complainant has established the fact that it has valid rights for the (1) international trademark SCHNEIDER ELECTRIC no 715395 registered since March 15, 1999; (2) international trademark SCHNEIDER S ELECTRIC no 715396 registered since March 15, 1999 and (3) European trademark SCHNEIDER ELECTRIC no 1103803 registered since March 12, 1999.

The disputed domain name has been registered on April 1, 2021, i.e. more than 20 years after the trademarks' registrations.

The first part of the disputed domain name (SCHNEIDERELECTRIC) fully corresponds to the Complainant's trademarks. Two words of the trademarks are divided by the space and this space is deleted within the disputed domain name. The replacement of the space is usually made by the deletion or by the hyphen as the space is not supported character to be used in the domain names. Therefore, the deletion of the space between two parts of the trademark does not distinguish the disputed domain name from the Complainant's trademarks.

The second part of the disputed domain name (MARKET) is a descriptive term referring to the generic name "SHOP" or "STORE". The addition of this descriptive term does not change the overall impression of the designation as being connected to the Complainant and its trademarks and more likely strengthens the likelihood of confusion between the disputed domain name and Complainant's products could be sold in the "shops", "stores" or "markets".

Finally, the addition of the generic top level domain “.COM” does not change the overall impression of the designation as being connected to Complainant’s trademark.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant’s trademarks “SCHNEIDER ELECTRIC” in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file 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 “SCHNEIDER ELECTRIC” or “SCHNEIDER ELECTRIC MARKET”. There is also no evidence, that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without the intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Moreover, the disputed domain name resolved to an online shop with offer of the products labeled by the “SCHNEIDER ELECTRIC” brand containing the Complainant’s logo.

If the Respondent was the reseller or distributor of the Complainant’s products, it may be making a bona fide offering of goods and services and thus had a legitimate interest in the disputed domain name. However, certain cumulative requirements described in the “Oki Data test” first defined in the decision *Oki Data Americas, Inc. v. ASD, Inc*, WIPO Case No. D2001-0903, must be met. The website associated with the disputed domain name became inactive during the proceeding as it returned the 403 Error code only (“Access to this resource on the server is denied!”) and the Panel was not able to make further investigation of the website content. But according to the presented evidence, the Panel finds, that there is no statement or disclaimer disclosing accurately Respondent’s relationship with the Complainant on the website under the disputed domain name. Moreover, not only the products labeled by the Complainant’s trademarks or logo were offered on the website under the disputed domain name. Therefore, the Panel finds that at least two of the requirements of the “Oki Data test” were not met as the site itself doesn’t accurately disclose the Respondent’s relationship with the Complainant as the trademark owner and the website is not used to sell only the trademarked goods. With such a view, the Panel finds that the use of the disputed domain name does not meet the Oki Data test criteria and thus, does not constitute a bona fide use.

The Panel therefore considers that 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The Respondent has registered the disputed domain name which consists of the full content of the Complainant’s trademarks “SCHNEIDER ELECTRIC” and generic term “MARKET” that refers to the style of sale of the goods. There are no doubts that the Complainant’s trademark is distinctive and is well-known worldwide. Moreover, some, products offered to be sold on the disputed domain name are labeled by the “SCHNEIDER ELECTRIC” logo or trademark. It could be therefore concluded that the Respondent had the Complainant and its trademark in mind when registering and using the disputed domain name.

Considering the (i) confusing similarity between the Complainant’s well-known trademarks and the disputed domain name, (ii) long time between the registration of the Complainant’s trademark and the disputed domain name, (iii) use of the disputed domain name for the online shopping, (iv) distinctiveness of the Complainant’s trademark and (v) 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.

Thus 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

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

The Panel considers that the Complainant has shown that the disputed domain name <schneiderelectricmarket.com> 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. SCHNEIDERELECTRICMARKET.COM: Transferred
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PANELLISTS

Name	JUDr. Petr Hostaš
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DATE OF PANEL DECISION 2021-07-30

Publish the Decision
