

Decision for dispute CAC-UDRP-103961

Case number	CAC-UDRP-103961
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Time of filing	2021-08-05 09:47:47
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Domain names	colascanada-ca.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	COLAS
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Ivan Peter
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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 bases its Complaint on the International trademark registration "COLAS", no. 753190, registered since 16.02.2001, for goods and services in classes 01, 19, 37, designating several countries for protection and the French trademark "COLAS", no. 3051318, registered on 13.09.2000, for goods and services in classes 01, 19, 37.

FACTUAL BACKGROUND

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

The Complainant is a French company, a major player in transport infrastructure activities, present in three main businesses: roads (road construction and maintenance work), materials (production and recycling of construction materials, mainly aggregates and bitumen) and railways known worldwide under the COLAS trademark. It employs around 55,000 people globally and undertakes about 60,000 projects every year via a network of 800 construction units and 3,000 material production and recycling sites in some fifty countries on five different continents. In 2020, the Complainant's consolidated revenue totaled EUR 12.3 billion, with international markets accounting for 55% of this figure.

The Complainant owns a portfolio of trademarks including the International trademark registration “COLAS”, no. 753190, registered since 16.02.2001, for goods and services in classes 01, 19, 37, designating several countries for protection and the French trademark “COLAS”, no. 3051318, registered on 13.09.2000, for goods and services in classes 01, 19, 37.

Furthermore, the Complainant is the owner of the domain name <colas.com> registered since 10.03.1997.

The disputed domain name < colascanada-ca.com> has been registered on 27.07.2021 and resolves to an inactive page. Moreover, the disputed domain name has been used in a phishing scheme.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

The Complainant's contentions are the following:

The disputed domain names < colascanada-ca.com > is confusingly similar to its trademarks and branded services COLAS.

The Complainant sustains that the addition of the terms “CANADA” and “CA” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark COLAS.

The likelihood of confusion is worsen by the aspect that it directly refers to the Complainant's official domain name <colascanada.ca>, used for email addresses.

Moreover, the Complainant contends that the addition of the gTLD “.COM” does not change the overall impression of the designation as being connected to the Complainant's trademark COLAS.

Further, the Complainant sustains that the Respondent does not have any rights or legitimate interest in the domain name for several reasons.

The Complainant asserts that the Respondent is not identified in the WHOIS database as the disputed domain name and not known as the disputed domain name.

The Complainant contends that the Respondent is not affiliated with nor authorized by COLAS in any way.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and he is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent.

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

Finally, the Complainant asserts that Respondent uses the disputed domain name to pass itself off as one of the Complainant's employees, in order to receive payment in place of the Complainant. Using the domain name in this manner is neither a bona fide offering of goods or services.

The Complainant further sustains that the domain name has been registered and is being used in bad faith.

The following categories of issues would be involved:

1. Constructive knowledge/prior knowledge of potential rights
2. Inactive website
3. Phishing

The Complainant contends that the disputed domain name <colascanada-ca.com> is confusingly similar to the trademark COLAS.

The Complainant has been the owner of the international trademark COLAS since as early as 2000. The registration and use of the trademark COLAS therefore significantly predate the Respondent's registration of the disputed domain name.

Besides, the disputed domain name has been used in a phishing scheme, as the Respondent choose to register it to create a confusion with the Complainant's official domain name <colascanada.ca>, used for email addresses. Thus, the Respondent necessarily knew about the Complainant and its affiliates.

Finally, the Respondent has used the domain name in a phishing scheme as the Respondent attempted to pass of as one of the Complainant's employees.

Thus, the Complainant asserts that the Respondent used the disputed domain name in bad faith.

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

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).

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).

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).

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

I. Confusing Similarity

The Panel agrees that the disputed domain name <colascanada-ca.com> is confusingly similar to the Complainant's earlier trademarks COLAS. The addition of the geographical terms "CANADA" and "CA" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark COLAS.

In fact, the likelihood of confusion is underlined by the addition of these geographical terms as it might induce the idea that this domain name is related to the Complainant's official domain name <colascanada.ca>.

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's

trademark and the disputed domain name (WIPO Case No. D2005-0016, *Accor v. Noldc Inc.*). The mere adjunction of a gTLD such as “.com” is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, *L’Oréal v Tina Smith*, WIPO Case No. D2008-0820 *Titoni AG v Runxin Wang* and WIPO Case No. D2009-0877, *Alstom v. Itete Peru S.A.*).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

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 burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of a confusingly similar trademark in the disputed domain name.

The disputed domain name resolves to an inactive page. Also, the Respondent appears from what the Complainant has filed in the file to use the disputed domain name to pass itself off as one of the Complainant’s employees, in order to receive payment in place of the Complainant. Such use does not amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name, as other UDRP panels have found.

The Panel notes that the Respondent had an opportunity to comment on the Complainant’s allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

The Complainant has been the owner of the international trademark COLAS since 2001 and of the French trademark since 2000. The registration of the trademark COLAS predates the Respondent’s registration of the disputed domain name.

Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was aware of the Complainant’s trademark and has intentionally registered the domain name in order to create confusion with the Complainant’s trademark.

In the present case, the following factors should be also considered:

(i) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(ii) the Respondent registered the disputed domain name containing the Complainant’s earlier trademarks COLAS to which it added the geographical terms “CANADA” and “CA”, in the context where the Complainant has also a domain name <colascanada.ca>;

(iii) the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name similar to the Complainant’s trademark;

(iv) the disputed domain name redirects to an inactive page and moreover has been used in a phishing scheme as the Respondent attempted to pass of as one of the Complainant's employees by reflecting the domain name in email addresses, which is an evidence of bad faith.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COLASCANADA-CA.COM**: Transferred

PANELLISTS

Name	Delia-Mihaela Belciu
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DATE OF PANEL DECISION	2021-09-10
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Publish the Decision
