

Decision for dispute CAC-UDRP-103976

Case number	CAC-UDRP-103976
Time of filing	2021-08-12 09:17:30
Domain names	schneiderelectricparts.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 S.A.S.
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Respondent

Organization	GID Industrial
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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 international trademark SCHNEIDER ELECTRIC n° 715395 registered on March 15, 1999;
- The international trademark SCHNEIDER S ELECTRIC n° 715396 registered on March 15, 1999;
- The European trademark SCHNEIDER ELECTRIC n° 1103803 registered on March 12, 1999.

FACTUAL BACKGROUND

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

The Complainant is a French industrial company trading internationally, founded in 1871. 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.

SCHNEIDER ELECTRIC INDUSTRIES SAS is the registrant of the domain name <schneider-electric.com> created on February 10, 1997. This company is not the Complainant. Therefore, it shall not be taken into consideration.

The disputed domain name <schneiderelectricparts.com> was registered by the Respondent on September 13, 2019, using a Privacy service. The website under this domain name redirects to a content offering Complainant's branded products.

The Respondent has not published any visible disclaimer on the website linked to the disputed domain name to explain that there is no existing relationship between the Respondent and the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Confusing similarity

The Complainant submits that the disputed domain name <schneiderelectricparts.com> is confusingly similar to its SCHNEIDER ELECTRIC trademarks.

It contends that the disputed domain name wholly incorporates its trademark. It adds that the addition of word "parts" in the disputed domain name is not sufficient to avoid the likelihood of confusion with the Complainant's trademark.

The Complainant contends that the addition of the suffix ".com" does not change the overall impression of the designation as being connected to the SCHNEIDER ELECTRIC trademark of the Complainant. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trademarks and domain names.

Right or legitimate interest

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

It contends that the Respondent is not identified in the Whois database as the disputed domain name and therefore is not known by the disputed domain name.

It also asserts that the Respondent is not affiliated with nor authorized by the Complainant in any way. It does not carry out any activity for, nor has any business with the Respondent. It also did not grant any license or authorization to make any use of the Complainant's SCHNEIDER ELECTRIC trademark, or to register or use the disputed domain name.

It adds that the disputed domain name redirects to a content offering Complainant's products and does not contain any information that discloses the relationship between the Respondent and the Complainant. Consequently, the Complainant considers that the Respondent is creating the false impression that the Respondent might be an official and authorized distributor for the Complainant's products and is using the domain name to create a likelihood of confusion with the Complainant's trademarks.

Bad faith

The Complainant submits that the disputed domain name <schneiderelectricparts.com> has been registered and is being used in bad faith.

It asserts that the disputed domain name is confusingly similar to the Complainant trademark SCHNEIDER ELECTRIC. It adds that the Respondent has intentionally registered the disputed domain name for the purpose of creating an association with the Complainant in order to generate traffic to its own website.

The disputed domain name <schneiderelectricparts.com> is confusingly similar to the Complainant trademark SCHNEIDER ELECTRIC®. The Respondent relies on the prior UDRP D2020-1403, Schneider Electric S.A. v. Whois Privacy Protection Foundation / Sales department which said that: "The Complainant and its trademark are well-known worldwide. The Complainant has been established almost 150 years ago while the disputed domain name was only registered a couple of months ago. The Respondent must have been fully aware of the Complainant and its trademark when it registered the disputed domain name."

It also contends that the Respondent did not publish any visible disclaimer on the website linked to the disputed domain name to explain that there is no existing relationship between the Respondent and the Complainant.

It relies on the WIPO Case No. D2018-1706 Renault s.a.s v. Cem Aydin: "It even appears that the Respondent has registered the disputed domain name solely for the purpose of creating an association with the Complainant. After having reviewed the Complainant's screenshot of the website linked to the disputed domain names, the Panel is convinced that the Respondent has intentionally registered the disputed domain names in order to generate traffic to its own website. The Panel notes that the Respondent has not published any visible disclaimer on the website linked to the disputed domain names to explain that there is no existing relationship between the Respondent and the Complainant. Quite the opposite, the design of the website linked to the disputed domain names and the prominent use of the Complainant's RENAULT word mark is sufficient evidence in view of the Panel that the Respondent intentionally tries to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's RENAULT trademark as to the source, sponsorship, affiliation or endorsement of

its website. In the Panel's view, the Respondent is trying to represent itself as the trademark owner without being entitled to do so."

Consequently, the Complainant considers that the Respondent is intentionally trying to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's SCHNEIDER ELECTRIC trademark as to the source, sponsorship, affiliation or endorsement of its website.

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has submitted evidence of its prior registered SCHNEIDER ELECTRIC trademarks which are protected in several countries worldwide.

The disputed domain name <schneiderelectricparts.com> entirely incorporates the Complainant's SCHNEIDER ELECTRIC trademark.

The addition of the generic term "parts" to SCHNEIDER ELECTRIC in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

The extension ".com" is a standard registration requirement, and is disregarded when determining identity or confusing similarity under the first element.

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed Domain Name by demonstrating any of the following:

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

The Respondent reacted to the Complaint by offering to transfer the disputed domain name <schneiderelectricparts.com> to the Complainant. It did not contest the Complainant's position.

The Respondent is not commonly known by the disputed domain name and is not related in any way with the Complainant nor has ever been authorized by the Complainant to use the SCHNEIDER ELECTRIC trademark to register the disputed domain name.

The Respondent used the disputed domain name to provide access to a website selling Complainant's products.

The website www.schneiderelectricparts.com includes a mention on the bottom of the litigious page: "site logo and content © schneiderelectricparts.com or licensed from third parties".

This mention is misleading the internet users, who can believe that the website is operated with the consent of the Complainant, as owner of the well-known SCHNEIDER ELECTRIC trademark.

This is a commercial unfair use of the SCHNEIDER ELECTRIC trademark.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the disputed domain name.

It provides that:

"For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

(i) circumstances indicating that the Respondent has registered or the respondent 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 the respondent's documented out-of-pocket costs directly related to the Domain Name; or

(ii) 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 the respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website 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 the respondent's website or location or of a product or service on the respondent's website or location."

The Respondent registered the disputed domain name on September 13, 2019, which means years after the Complainant obtained its trademark registrations. The Complainant and its trademark are well-known worldwide. Consequently, the Respondent must have been fully aware of the Complainant and its trademark when it registered the disputed domain name. The disputed domain name redirects to the website www.schneiderelectricparts.com offering Complainant's products on a page where the following mention is included on the bottom: "site logo and content © schneiderelectricparts.com or licensed from third parties".

This mention aims at misleading the internet users, as above explained.

The Respondent is attempting to attract, for commercial gain, Internet users to Respondent's own website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location in the meaning of Par. 4(b) (iv) of the Policy.

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 disputed domain name <schneiderelectricparts.com> incorporates the SCHNEIDER ELECTRIC trademark.

The addition of the generic term "parts" does not avoid any likelihood of confusion.

It has been used to offer for sale the Complainants' products.

The Respondent did not contest the complaint. Its reaction has been to offer to transfer the disputed domain name.

Absence of rights or legitimate interest in the disputed domain name.

The Respondent is not commonly known by the disputed domain name and is not related in any way with the Complainant nor has ever been authorized by the Complainant to use the SCHNEIDER ELECTRIC trademark to register the.

The Respondent made a commercial unfair use of the disputed domain name.

Registration in bad faith and bad faith use.

The Respondent was well aware of the SCHNEIDER ELECTRIC® trademark when it registered the disputed domain name, to take advantage of SCHNEIDER ELECTRIC trademark, in the meaning of Par. 4(b) (iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SCHNEIDERELECTRICPARTS.COM**: Transferred

PANELLISTS

Name Marie-Emmanuelle Haas, Avocat

DATE OF PANEL DECISION 2021-09-21

Publish the Decision