

Decision for dispute CAC-UDRP-104059

Case number **CAC-UDRP-104059**

Time of filing **2021-10-05 11:41:03**

Domain names **apcspares.com**

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

Organization **Schneider Electric IT Corporation**

Complainant representative

Organization **NAMESHIELD S.A.S.**

Respondent

Organization **ODESIGNING WEB SERVICES**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade mark, amongst others:

- International trade mark registration no. 715395, dated 13 January 1995, for the stylised mark APC AMERICAN POWER CONVERSION, in class 9 of the Nice Classification.

FACTUAL BACKGROUND

The Complainant's contentions can be summarised as follows:

I. The disputed domain name is confusingly similar to trade marks in which the Complainant has rights

The Complainant is a French industrial business founded in 1871 and trading internationally. The Complainant manufactures and offers products for power management, automation, and related solutions.

The Complainant states that it is featured on the NYSE Euronext and the French CAC40 stock market index, and its revenue in 2020 amounted to EUR 25.2 billion.

The Complainant informs that it is the owner of American Power Conversion (APC), a manufacturer of uninterruptible power supplies, electronics peripherals, and data center products.

In addition to the trade mark mentioned above and the many more trade marks in its portfolio, the Complainant informs that it is also the owner of numerous domain names which contain the mark APC, including <apc.com>, which was registered as far back as 1993.

The disputed domain name <apcspares.com> was registered on 15 April 2020, and it resolves to an online shop which contains references to the Complainant and the Complainant's products ("the Respondent's website").

The Complainant avers that the disputed domain name is confusingly similar to the Complainant's trade mark APC. The addition of the term "spare" is insufficient to escape the finding of confusing similarity with the Complainant's trade mark APC. The Complainant refers to the WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v Vasily Terkin, according to which a domain name that wholly incorporates a complainant's registered trade mark may be sufficient to establish confusing similarity under the Policy.

The Complainant further alludes to the fact that UDRP panels have found that the Top-Level Domain (TLD) suffixes (<.com> in the present matter) are typically not relevant in the appreciation of confusing similarity. In this respect, the Complainant cites WIPO Case No. D2006-0451, F. Hoffmann- La Roche AG v Macalve e-dominios S.A.

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

The Complainant relies on WIPO Case No. D2003-0455, Croatia Airlines d.d. v Modern Empire Internet Ltd. to elucidate the evidentiary test under the UDRP, which requires the Complainant to make out a prima facie case. If successfully made, the burden of production is shifted to the Respondent to elicit any evidence to the contrary.

The Complainant asserts that the Respondent has no rights in the disputed domain name, 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 APC nor to apply for registration of the disputed domain name by the Complainant.

The Complainant further asserts that the Respondent is not known by the disputed domain name, in so far as the Whois information is not similar to the disputed domain name. On this point, the Complainant cites Forum Claim No. FA1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v Chad Moston / Elite Media Group.

The Complainant articulates that there is no information to identify the owner of the Respondent's website.

Finally, the Complainant informs that the website to which the disputed domain name resolves displays the Complainant's trade mark APC along with competing products, in an attempt by the Respondent to pass itself off as the Complainant. The Complainant contends on this point that such an attempt is a further indicator of the Respondent's lack of rights and legitimate interests in the disputed domain name. Lastly, and in furtherance of this particular ground, the Complainant cites Forum Claim No. FA1299362, American Power Conversion, Corp. v. Redy Battery Co. (in relation to the domain name <apccupsbattery.com>).

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

The Complainant contends that the Respondent's website sells products that directly compete and disrupt with the Complainant's business, such that this gives rise to a finding of registration and use of the disputed domain name in bad faith under the Policy.

In addition, the Complainant states that the Respondent has attempted to pass itself off as the Complainant by displaying the Complainant's trade mark APC on the Respondent's website, as well as selling competing products.

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

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is 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 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

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 name:

- i. The disputed domain name is 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 name; and
- iii. The disputed domain name has 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 name 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 name is identical or confusingly similar to the Complainant's trade mark.

Upon review of the case file, the Panel is satisfied that the Complainant owns trade mark rights in APC AMERICAN POWER CONVERSION, dating back to 1995. Given that “AMERICAN POWER CONVERSION” clarifies the acronym “APC”, the Panel is also satisfied that the Complainant has trade mark rights in APC (“the Complainant’s APC trade mark”).

The disputed domain name <apcspares.com> was registered on 15 April 2020. In view of the finding in the above paragraph, the Panel considers that the Complainant’s trade mark is wholly incorporated in the disputed domain name.

The disputed domain name contains the word “spares”. According to the Oxford Dictionary “spare” is “an item kept in case another item of the same type is lost, broken, or worn out” (definition available at <https://www.lexico.com/>).

The Panel notes that the Complainant operates in the field of power supplies and electronics peripherals, such that the word “spares” is in common parlance in the Complainant’s day-to-day business. Therefore, the addition of the term “spares” in the disputed domain name enhances the confusing similarity with the Complainant’s APC trade mark as the word “spares” is so closely related and connected with the Complainant’s areas of business.

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”, “.org”, “.net”) (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trade mark, 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 name. 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 name, 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 APC trade mark, or to apply for registration of the disputed domain name on the Complainant’s behalf. The Complainant has also not authorised the Respondent to make any use of the Complainant’s APC trade mark, 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 name. The Panel notes that there is also no evidence on the 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).

On this particular point, this Panel alludes to the jurisprudential view formed by domain name disputes under the UDRP Policy and UDRP Rules (see WIPO Jurisprudential Overview 3.0, paragraph 2.8), according to which resellers and distributors using a domain name containing a complainant's trade mark to undertake sales related to the complainant's goods or services may be making a bona fide offering of goods and services, and thus have a legitimate interest in such domain name. UDRP Panels have termed this as the "Oki Data test" (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

- i. The respondent must actually be offering the goods or services at issue;
- ii. The respondent must use the site to sell only the trade marked goods or services (emphasis added);
- iii. The website must accurately and prominently disclose the registrant's relationship with a trade mark holder (emphasis added); and
- iv. The respondent must not try to "corner the market" in domain names that reflect the trademark.

The Respondent would have failed to meet the Oki Data test in view of the requirements ii and iii set out above. The Panel is furthermore unconvinced that, before any notice 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.

In addition, in the Panel's view, the choice of a domain name which incorporates a complainant's trade mark wholly (as in this case) 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.

Lastly, the Panel notes that under the second element of the Policy, the Complainant also contends that the Respondent is not known by the disputed domain name because the Whois information is not similar to the disputed domain name. The Panel does not find the argument put forward by the Complainant to be particularly compelling. Whilst the Whois information may be a factor to be considered in the overall assessment of whether or not a respondent is "known by the domain name", that in isolation lacks the probative value to sustain the allegation that the Respondent lacks rights or legitimate interests, in the Panel's view.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute 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 name was registered and is 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, which the Panel deems sufficient to rule on the bad faith element.

The Panel has looked at the overall composite picture of events and finds it, collectively, to be sufficient to give rise to a finding of bad faith registration and use of the disputed domain name by the Respondent, for the following reasons:

- The disputed domain name wholly incorporates the Complainant's APC trade mark, and the addition of the term "spares" is insufficient to dispel the overall visual and phonetic confusion between the disputed domain name and the Complainant's trade mark in the Panel's view;
- There is no credible explanation for the Respondent's choice of the disputed domain name, which was registered in April 2020, whereas the Complainant has been trading under the APC mark since at least 1995 when the Complainant first registered its trade mark. Consequently, the Panel is reticent to show any sympathy for the Respondent in this instance, and finds it that the Respondent was well aware of the Complainant given the specific references to the Complainant on the Respondent's website (as discussed further below);
- 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 name <apcspares.com> mirrors almost identically the Complainant's domain name <apc.com>, registered in 1993, and by which the Complainant operates its business activities across the globe, including in Pakistan, where the Respondent appears to be located;
- At the time of writing, the disputed domain name to a landing page on which the following message is displayed: "This website is currently unavailable due to maintenance. Please visit again later. If you have any inquiries forward to the site admin. Please subscribe with our Newsletter". Nonetheless, the Panel notes that Annex 6 to the Complaint contains a screenshot from the Respondent's website, on which the Complainant's APC logo is displayed in a rather prominent manner, in addition to the presence of various references to the Complainant's APC trade mark and products, including an email address [info@apcspares.com], and a section headed "Become a Vendor". This behaviour suggests that the disputed domain name was registered for a potential financial gain, i.e. to misleadingly divert Internet users (most likely the Complainant's - existing or otherwise - customers because of the use of the Complainant's trade mark within the disputed domain name string and on the Respondent's website) to the Respondent's website and inviting them to consume their goods and services through the Respondent's website (circumstance 4 above). In particular, the Panel finds that the Respondent has attempted to suggest an affiliation with, or a connection to, or an endorsement of the Complainant or even to impersonate the Complainant through the use of the Complainant's APC trade mark in the dispute domain name string and on the Respondent's website in the manner described above. On closer inspection, the Panel also notes that the Respondent's website used to mimic some of the distinctive layout features of the Complainant's website, including the green bar on the upper level of the Complainant's website;

and

- The Respondent's failure to provide any evidence of actual or contemplated good faith use of the disputed domain name, as discussed above.

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

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **APCSPARES.COM**: Transferred

PANELLISTS

Name	Dr Gustavo Moser
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DATE OF PANEL DECISION	2021-11-07
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Publish the Decision