

Decision for dispute CAC-UDRP-104349

Case number	CAC-UDRP-104349
Time of filing	2022-02-11 09:26:21
Domain names	societegenerale.melbourne

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	SOCIETE GENERALE
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	David Marks
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of “several trademark” registrations for “SOCIETE GENERALE,” including Int’l Reg. Nos. 430,526 (registered June 1, 1977), 546,707 (registered November 23, 1989), 885,005 (registered February 24, 2006), and 882,062 (registered March 2, 2006) (the “SOCIETE GENERALE Trademark”).

FACTUAL BACKGROUND

Complainant states that it is “one of Europe’s leading financial services groups and a major player in the economy for over 150 years” and that it “supports 30 million clients every day with 133,000 staff in 61 countries.” Complainant also states that it is the registrant of the domain name <societegenerale.com> (created June 4, 2000).

The Disputed Domain Name was created on December 7, 2021, and is associated with what Complainant describes as “a registrar parking page.”

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that the Disputed Domain Name is confusingly similar to the SOCIETE GENERALE Trademark because “it includes the trademarks in their entirety, without any addition or deletion” and “the addition of the new GTLD ‘.MELBOURNE’ does not change the overall impression of the designation as being connected to the trademark SOCIETE GENERALE.”

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, “Respondent is not identified in the WHOIS database as the disputed domain name”; “Respondent is not affiliated with nor authorized by SOCIETE GENERALE in any way”; “[n]either licence nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark SOCIETE GENERALE®, or apply for registration of the disputed domain name by the Complainant”; and “the lack of use of a domain name is considered as an important indicator of the absence of legitimate interests by the Respondent.”

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, “given the distinctiveness of the Complainant’s trademark and reputation, the Complainant can state that the Respondent has registered the disputed domain name with full knowledge of the Complainant’s trademarks SOCIETE GENERALE®, and therefore could not ignore the Complainant”; “it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law”; and “the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.”

PARTIES CONTENTIONS

No administratively compliant response has been filed.

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 UDRP).

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 UDRP).

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 UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registration cited by Complainant, it is apparent that Complainant has rights in and to the SOCIETE GENERALE Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the SOCIETE GENERALE Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., “melbourne”) because “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” WIPO Overview of WIPO Overview

3.0, section 1.11.1.

Here, the Disputed Domain Name contains the SOCIETE GENERALE Trademark in its entirety. As set forth in section 1.7 of WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark,... the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Respondent is not identified in the WHOIS database as the disputed domain name"; "Respondent is not affiliated with nor authorized by SOCIETE GENERALE in any way"; "[n]either licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark SOCIETE GENERALE®, or apply for registration of the disputed domain name by the Complainant"; and "the lack of use of a domain name is considered as an important indicator of the absence of legitimate interests by the Respondent."

WIPO Overview 3.0, section 2.1, states: "While the overall burden of proof in UDRP proceedings is on the complainant, panels have 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant 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 registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 registrant's website or location or of a product or service on the registrant's website or location.

Although the Disputed Domain Name is not associated with an active website, section 3.3 of WIPO Overview 3.0 (citing *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, <telstra.org>) states: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding."

"While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put."

Here, in light of the long and multiple registrations for the SOCIETE GENERALE Trademark, as well as the broad scope of Complainant’s business associated with the SOCIETE GENERALE Trademark, it appears that the SOCIETE GENERALE Trademark has a high degree of distinctiveness or reputation. Further, Respondent did not submit a response or provide any evidence of actual or contemplated good-faith use. And finally, it is implausible that the Disputed Domain Name may be put to any good faith use.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **SOCIETEGENERALE.MELBOURNE:** Transferred

PANELLISTS

Name	Douglas M. Isenberg
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DATE OF PANEL DECISION 2022-03-16

Publish the Decision