

Decision for dispute CAC-UDRP-104381

Case number CAC-UDRP-104381

Time of filing 2022-03-01 08:45:45

Domain names colasaccounting.com

Case administrator

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

Complainant

Organization COLAS

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Adrian Alberto Salom Berrio

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 is the owner of several trademarks. In particular, COLAS owns:

- (i) the International Registration No. 753190 "COLAS" registered on February 16, 2001 for classes 1, 19 and 37, duly renewed and protected in numerous countries;
 - (ii) the French Registration No. 3051318 "COLAS" registered on September 13, 2000 for classes 1, 19 and 37, duly renewed.
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FACTUAL BACKGROUND

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

PRELIMINARY REQUEST FOR ENGLISH TO BE THE LANGUAGE OF THIS PROCEEDING

As requested by the CAC, the Complainant filed preliminary request in order to require English to be the language of the administrative proceeding at issue for the following ground:

- The domain name is constituted of trademark "COLAS" and English term "Accounting".

Therefore, in accordance with the instructions submitted by the CAC, for the reason described above, the Complainant requested the Panel to maintain English as the proceedings language.

ON THE MERIT

The Complainant is a major player in transport infrastructure activities and it is present in three business areas: roads (road construction and maintenance work), materials (production and recycling of construction materials, mainly aggregates and bitumen) and railways. The Complainant is worldwide known by its "COLAS" trademark. The Complainant 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. On 2020, the Complainant's consolidated revenue totalled EUR 12.3 billion.

The disputed domain name <colasaccounting.com> was registered on September 21, 2021.

The Complainant states that the disputed domain name <colasaccounting.com> is confusingly similar to its trademark "COLAS". Actually, in the Complainant's view, the addition of the term "accounting" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark "COLAS".

The Complainant states that the Respondent is not affiliated with him nor authorized by him in any way. The Complainant states that the Respondent has no right nor legitimate interest in the disputed domain name and it 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. The Respondent is not commonly known by <colasaccounting.com> or by other names similar to the disputed domain name.

The Complainant also notes that the domain name <colasaccounting.com> is not used and that, given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with the full knowledge of the Complainant's trademarks. It is the Complainant's view that the incorporation of a famous mark into a domain name, coupled with an inactive website, is evidence that the Respondent has registered the disputed domain name and is using it in bad faith.

Finally, the Complainant notes that, although the website associated with the disputed domain name does not appear to be used, the MX record seems to have been configured in such a manner to likely offer e-mailing capabilities associated with the disputed domain name.

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 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

PRELIMINARY REQUEST FOR ENGLISH TO BE THE LANGUAGE OF THIS PROCEEDING

As regards to the Complainant's request for the language of the proceedings to be in English, notwithstanding the fact that, as evidenced by the Domain Registrar's Verification, Spanish is the language of the registration agreement of the disputed domain name, under Paragraph 11 of the Rules, the Panel is free to deviate from the language of the registration agreement depending on the particular circumstances of each case. Here, the Respondent has clearly decided to avoid any communication after the filing of the Complaint maintaining an obvious passive attitude during this proceeding. Also, the disputed domain name consists of the trademark "COLAS" and English term "accounting" and both terms are correctly spelt, this meaning that the Respondent is familiar with the English language. Against this background, the Panel is willing to accept to lead this proceeding in English, given that the Respondent obviously has no disadvantages arising from doing so and is still treated equally and fair within the scope of Paragraph 10 of the Rules (see, between many others, Intesa Sanpaolo S.p.A. vs. Marco Fabrone, CAC Case No. 102689 and Intesa Sanpaolo S.p.A. vs. Michele Del Nvo, CAC Case No. 102993).

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

According to paragraph 4(a) of the Policy the Complainant is required to prove each of the following three elements to obtain the transfer 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.

The disputed domain name <colasaccounting.com> combines three elements: (1) the wording "colas" (2) the term "accounting" and (3) the top-level domain name ".com". The relevant comparison to be made is with the portion of the domain name <colasaccounting>. Actually, it is well established that the top-level domain name (i.e., ".com") should be disregarded for this purpose (see, between many others, Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006 - 0561). Furthermore, the term "accounting" does not distinguish the disputed domain name from Complainant's "COLAS" mark since it is a generic and descriptive term insofar as accounting is a function in which all companies engage (see, between many others, The Swatch Group AG, Swatch AG v. John Wison, WIPO Case No. D2019-3182). In general, when a distinctive mark is combined with less distinctive terms, the combination will typically be found to be confusingly similar to the distinctive mark. Therefore, in the case at hand, the combination does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark (see, for instance, Arcelormittal S.A. v. Name Francois Dumontier, CAC Case. No. 100855). Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark "COLAS". The Complainant therefore succeeds on the first element of the Policy.

The Complainant has long standing rights in the mark "COLAS". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized to use the domain name by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant has not licenced or otherwise permitted the Respondent to use the Complainant's marks in the disputed domain name. On the basis of the evidences submitted and in the absence of a response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

The Complainant's trademark "COLAS" is distinctive and well-known in many countries. It is uncontroverted that Complainant's worldwide use and registration of the "COLAS" mark largely precede the registration date of the disputed

domain name. The fact that the Respondent has registered a domain name that is almost identical to it clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. This is a clear evidence of registration of the domain name in bad faith. The Complainant has demonstrated that the disputed domain name is inactive since it is not connected to any accessible website. The fact that the Respondent effectively passively holds the disputed domain name cannot prevent a finding of use in bad faith (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003). The Panel wishes to stress that the disputed domain name holds no Internet content; it means that customers searching for information on the Complainant and the Complainant's service may come to the conclusion that there are problems at the Complainant's site, that the Complainant's web information and services are no longer in active use. Such 'non-use' by the Respondent can have the same negative result on the Complainant as active use of a disputed domain name, and amounts to bad faith use" (*FIL Limited v. George Dyle*, WIPO Case No. D2014-1418). Furthermore, the Complainant has provided evidence that the Respondent has set up "MX-records" for the disputed domain name. This entails that the Respondent can send e-mails through the e-mail address "@colasaccounting.com". The Respondent could therefore use the disputed domain name to send fraudulent e-mails such as messages containing spam and/or phishing attempts that Internet users could well assume were sent by the Complainant (see *Confédération Nationale du Crédit Mutuel, Crédit Industriel et Commercial v. Khodor Dimassi*, WIPO Case No. D2016-1980 and *Paris Saint-Germain Football v. MHP Private*, WIPO Case No. D2019-0036). Albeit that there are no concrete examples of such use, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. The Panel finds that the mere conduct of making preparation for sending emails which are very likely to confuse the recipient of such e-mails as to their origin, is without justification and is inconsistent with the Complainant's exclusive rights in the "COLAS" trademark (see *Accenture Global Services Limited v. Registration Private, Domains by Proxy, LLC / Richa Sharma, Name Redacted*, WIPO Case No. D2019-2453). As a result of the above, the Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant therefore succeeds also on 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. COLASACCOUNTING.COM: Transferred

PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION 2022-04-01

Publish the Decision
