

Decision for dispute CAC-UDRP-104492

Case number	CAC-UDRP-104492
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Time of filing	2022-04-13 09:07:21
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Domain names	algecoaffinity.com
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Case administrator

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

Organization	ALGECO
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	Domain Sales - (Expired domain caught by action winner)
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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 is a worldwide market-leading supplier of portable, modular space and secure storage solutions for businesses and public sector agencies, with multiple delegations including across France and Europe. It was created in the early 1950's; the Complainant offers from single portable buildings to stylish and inspiring multi-storey design and build structures under quality-controlled highest standards.

The Complainant owns the following Trademarks:

- International Trademark ALGECO, Reg. No. 386452 granted on January 27, 1972, in force until January 27, 2032, in connection with classes 6, 12, 19, 20, 36, 39 and 42; and
- International Trademark ALGECO, Reg. No. 1099894 granted on October 21, 2011, in force until October 21, 2031, in connection with classes 6, 19, 20, 37, 39 and 43.

The disputed domain name <algecoaffinity.com> was registered on March 28, 2022, and resolves to an active website where the disputed domain name is offered for sale.

FACTUAL BACKGROUND

The Complainant was created in the early 1950's, it is a pioneer in modular solutions constructions since 1955. The Complainant is a worldwide market-leading supplier of portable, modular space and secure storage solutions for businesses and public sector agencies, with multiple delegations across Europe, including France and even in China through a joint venture Algeco Chengdong. The Complainant offers from single portable buildings to stylish and inspiring multi-storey design and build structures under quality-controlled highest standards.

The Complainant constructions are as modular offices, modular schools, bases of life on site, modular medical and health, modular event building and storage spaces, considering comfort and aesthetics, risk prevention and energy. The Complainant has achieved a consistent list of significant constructions as the forecourt of lines 14 and 18 at Orly Airport (ORY); the setting up modular additional buildings for the health sector at the Antony Hospital before the health crisis; at the Lycée Pierre Mendès France of Ris-Orangis in 2019 to allow the teaching activity during its renovation; as part of the reinforcement work of the tunnel of the RER line C, SPIE Batignolles and Soletanche Bachy in Paris.

According to the evidence presented before the Panel, the disputed domain name <algecoaffinity.com> was registered on March 28, 2022, and it is redirected to an active website <https://dan.com/es-es/buy-domain/algecoaffinity.com?redirected=true&tld=com> where the disputed domain name is offered for sale initially for 995 USD.

By the time of this Decision, the disputed domain name and the website are active.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

1) The Complainant asserts that the disputed domain name is confusingly similar to the trademark ALGECO, that the addition of the term "AFFINITY" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark ALGECO. It does not change the overall impression of the designation as being connected to the Complainant's trademark ALGECO. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademarks.

2) The Complainant also asserts that it is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (see Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin, WIPO Case No. D2003-0888).

3) On the contrary, the addition of the term "AFFINITY" worsens the likelihood of confusion, as it directly refers to filed UK trademark "ALGECO AFFINITY", filed by the Complainant's entity ALGECO UK LIMITED.

4) The Complainant asserts that the Respondent is not known as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name (see Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group, Claim No. FA 1804001781783).

5) The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name <algecoaffinity.com> and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

6) The Complainant also contends, that neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark ALGECO, or apply for registration of the disputed domain name by the Complainant.

7) The disputed domain name points to a DAN.COM page where the domain name is offered for sale for 995 USD. The Complainant contends that this general offer to sell the disputed domain name evidences the Respondent's lack of rights or legitimate interest.

8) The Complainant also contends that the disputed domain name <algecoaffinity.com> has been registered the day of the filing of the corresponding trademark "ALGECO AFFINITY" by the Complainant's subsidiary ALGECO UK LIMITED; that the terms "ALGECO AFFINITY" have no meaning in English or any language, except in reference to the Complainant and its establishment in UK.

9) The Complainant contends that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark (see Ferrari S.p.A v. American Entertainment Group Inc., WIPO Case No. D2004-0673); moreover, that the disputed domain name resolves to a DAN.COM page displaying a general offer to sell the domain for 995 USD, failing in its active use, constituting an evidence of bad faith registration and use (see Airbnb, Inc. v. khaled salem, Claim No. FA 1804001784212).

10) The Complainant contends that the Respondent has registered the disputed domain name only to sell it back for more than the out-of-pockets costs, which evidences bad faith registration and use (see Citigroup Inc. v. Kevin Goodman, Claim No. FA 1506001623939).

RESPONDENT: The Respondent did not reply to any of the Complainant's contentions.

RIGHTS

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

The Complainant has sufficiently proved before the Panel, that owns International Trademark Registrations over the term ALGECO, Reg. No. 386452 since January 27, 1972 (granted date) in force until January 27, 2032, and ALGECO, Reg. No. 1099894 since October 21, 2011 (granted date) in force until October 21, 2031.

The disputed domain name <algecoaffinity.com> registered on March 28, 2022, it is composed by two terms as "ALGECO" and "AFFINITY". The term "ALGECO" undeniably refers to Complainant's Trademarks, and the term "AFFINITY", can be considered as a generic word, however for the purposes of the Second UDRP Element and Third UDRP Element analysis of the present Case scenario, this Panel, will take into consideration, that the trademark ALGECO AFFINITY was filed by the Complainant's subsidiary ALGECO UK LIMITED on March 28, 2022.

The Domain Name Jurisprudence has established that:

“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.” (see point 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”)).

The Complainant’s trademark ALGECO was exactly reproduced, and the additional term “Affinity” which can be considered as a generic word, both at the end, implying a connection to Complainant’s business activity, increasing the confusion in the Internet User (see *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. 2001-0110; *ALGECO v. Aktif Medya, Ismail Hakki Yildiz*, WIPO Case No. 2010-1170 and *ALGECO vs. Amina ouarda Hachemi*, CAC Case No. 104038).

It is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLD “.com”, “is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test” (see point 1.11.1 of the WIPO Jurisprudential Overview 3.0”).

Therefore, the disputed domain name <algecoaffinity.com> is confusingly similar to Complainant’s ALGECO Trademarks.

Regarding the Second UDRP Element, to this Panel it is clear that:

(1) the Respondent is not associated or affiliated or hasn’t been authorized or licensed by the Complainant to register the disputed domain name.

(2) there is no evidence why the Respondent selected such a well-known trademark as ALGECO and added the term “Affinity”, which even when it can be considered as a generic word, it is more likely that refers to Complainant’s UK Application ALGECO AFFINITY filed on the exact same date of the disputed domain name registration on March 28, 2022.

(3) there is no evidence that the Respondent corresponds or has become commonly known by the term “ALGECO AFFINITY.COM”.

(4) the Respondent registered the disputed domain name on March 28, 2022, meaning at least 50 years AFTER the Complainant’s acquired its trademark rights over ALGECO on January 27, 1972.

(5) the Respondent is not making a bona fide offering of goods or services nor for a legitimate non-commercial or fair use of the disputed domain name, due to it is linked to an active website of a Domain Name Business Services entity named Dan.com (<https://dan.com/es-es/buy-domain/algecoaffinity.com?redirected=true&tld=com>), where the disputed domain name is offered for sale for 995 USD or 332 USD providing an additional evidence of Respondent’s lack of rights or legitimate interests in the disputed domain name (see *N.V. Nutricia v. Rob Monster*, Claim No. FA 2106001952511).

Therefore, this Panel finds that the Complainant has successfully made a prima facie case, which was not rebutted in any manner by the Respondent and concludes that the Respondent have no rights or legitimate interests in respect of the disputed domain name.

In relation to the Third Element of the UDRP, the Bad Faith, this Panel analyses the following:

The Complainant has more than 60 years in the market and acquired its trademark rights on January 27, 1972, meaning at least 50 years BEFORE the Respondent registered the disputed domain name on March 28, 2022. In addition, a Complainant’s subsidiary ALGECO UK LIMITED filed the Trademark ALGECO AFFINITY Application No. UK00003770850 on March 28, 2022, being the same exact words of the disputed domain name and date of its registration, constituting to this Panel consistent evidence of Respondent’s knowledge about the Complainant business and its trademark value.

Furthermore, in relation to the assessment of respondent's knowledge, point 3.2.2. of the WIPO Jurisprudential Overview 3.0. titled "Knew or should have known" states:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

Therefore, this Panel concludes that the disputed domain name was registered with Complainant's Trademark's value on mind, meaning that it was registered in bad faith.

Point 3.1 of the WIPO Jurisprudence Overview indicates:

"(...) UDRP paragraph 4(b) provides that any one of the following non-exclusive scenarios constitute evidence of a respondent's bad faith:

"(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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.

(...) Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant's trademark would also satisfy the complainant's burden."

In the present Case, the Respondent linked the disputed domain name to a parked website named Dan.com, used to offer the disputed domain name for sale. The entity Dan.com, has as a core business different Domain Name Transactions, as Offers, Buying, Selling, (fast and easy) Transfers, among others. The disputed domain name is offered for sale for 995 USD or 332 USD or by inviting users to submit offers to the Respondent. Such amounts exceed the costs of registration and maintenance of the disputed domain name, and of course, such offers open the gate to a potential Complainant's competitor as a Buyer (see Airbnb, Inc. v. khaled salem, Claim No. FA 1804001784212 and Citigroup Inc. v. Kevin Goodman, Claim No. FA 1506001623939). These facts are sufficient to this Panel, to conclude that the Respondent has incurred into paragraph 4(b)(i) of the Policy, and that the disputed domain name is used in bad faith as well.

Therefore, this Panel concludes that, the disputed domain name has been registered and used in faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALGECOAFFINITY.COM**: Transferred

PANELLISTS

Name	Ms. MARÍA ALEJANDRA LÓPEZ GARCÍA
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DATE OF PANEL DECISION	2022-05-09
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