

Decision for dispute CAC-UDRP-105778

Case number	CAC-UDRP-105778
Time of filing	2023-09-14 10:37:37
Domain names	usa-schneider-electric.com

Case administrator

Name	Olga Dvořáková (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	Bilington Lordship
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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, trading under the company name Schneider Electric SE, owns several trademarks including the terms “SCHNEIDER ELECTRIC”, such as:

- international trademark SCHNEIDER ELECTRIC no. 715395 registered since March 15, 1999 in Classes 6, 9, 11, 36, 37, 39, 42;
- international trademark SCHNEIDER S ELECTRIC no. 715396 registered since March 15, 1999 in Classes 6, 9, 11, 36, 37, 39, 42;
- European Union trademark SCHNEIDER ELECTRIC no. 1103803 registered since March 12, 1999 in Classes 6, 9, 11, 36, 37, 39, 42.

The Complainant is also the owner of many domain names which include the trademark SCHNEIDER ELECTRIC, such as <schneiderelectric.com> registered since April 4, 1996.

The above-mentioned rights are hereinafter collectively referred to as SCHNEIDER ELECTRIC trademark.

FACTUAL BACKGROUND

The Complainant, founded in 1871, is a French industrial business trading internationally. It manufactures and offers products for power management, automation, and related solutions. The Complainant's corporate website can be found at www.schneider-electric.com.

The Complainant is featured on the NYSE Euronext and the French CAC 40 stock market index. In 2022, the Complainant revenues amounted to 34.2 billion euros.

The disputed domain name <usa-schneider-electric.com> was registered on August 7, 2023 and resolves to a parking page.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its trademark, since the SCHNEIDER ELECTRIC trademark is reproduced in its entirety and the addition of the geographical term "usa", and the TLD does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark. On the contrary, according to the Complainant, it worsens the likelihood of confusion, as this addition directly refers to the Complainant's subsidiary in the United States.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain name by the Complainant. The Respondent is not commonly known by the domain name, nor has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

Furthermore, the disputed domain name is not actively used. The Complainant contends that the Respondent has made no demonstrable preparations to use the disputed domain name in good faith. Therefore, the Respondent did not use the disputed domain name for any bona fide offering of goods or services.

Finally, the Complainant contends that the registration of disputed domain name confusingly similar to the well-known trademark of the Complainant and, thus, the constructive knowledge on behalf of the Respondent of the Complainant's potential rights, as well as the passive holding of the disputed domain name, clearly shows the Respondent's bad faith in the registration and use of the disputed domain name.

The Complainant requests the transfer of the disputed domain name.

RESPONDENT:

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

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

Under paragraph 4(a) of the UDRP Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

- (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 by the Respondent in bad faith.

I. RIGHTS AND CONFUSING SIMILARITY

In UDRP disputes the test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. UDRP panels have also consistently found that the adding, deleting, or substituting letters, numbers, punctuation, or other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to the relevant trademark, recognizable within the disputed domain name, would not prevent a finding of confusing similarity under the first element. Finally, UDRP panels agree that the TLD is to be ignored for the purpose of determination of confusing similarity between the disputed domain name and the complainant's trademark, as it is a technical requirement of registration (paragraphs 1.7, 1.8, and 1.11.1 WIPO Overview 3.0).

The Complainant has established that it has rights in the SCHNEIDER ELECTRIC trademark since 1999. The disputed domain name incorporates the entirety of such mark and differs from the Complainant's mark by merely adding the geographical term "usa" (which stands for the United States of America), hyphens, as well as the TLD ".com". The addition of such geographical term to the Complainant's mark neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain name from the Complainant's mark. On the contrary, the addition of the geographical term "usa" even enhances the likelihood of confusion, since the Internet users might erroneously believe that the disputed domain name refers to the Complainant's US subsidiary.

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's trademark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. If 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 (paragraph 2.1 WIPO Overview 3.0).

The Respondent is Bilington Lordship, residing in Austin, Texas, United States. No evidence is available that the Respondent has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain name.

The Respondent registered the disputed domain name incorporating the Complainant's SCHNEIDER ELECTRIC trademark adding a geographical term ("usa") and punctuation ("-"), and, thus confusingly similar to such mark. UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use (paragraph 2.5.1 WIPO Overview 3.0).

Moreover, there is no evidence that, before any notice to the Respondent of the dispute, the Respondent used, or demonstrably prepared to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services. Indeed, the disputed domain name resolves to a parking page.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel believes that the disputed domain name has been registered and is being used in bad faith for the following reasons.

The disputed domain name is to be considered confusingly similar to the Complainant's SCHNEIDER ELECTRIC trademark, since it incorporates such well-known and prior mark in its entirety and differs from it merely by adding the geographical term "usa", hyphens, and the TLD ".com", which is disregarded for the purpose of determination of confusing similarity between the disputed domain name and the trademarks of the Complainant as it is a technical requirement of registration.

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive or geographical term) to a famous or widely-known trademark by an unaffiliated

entity can by itself create a presumption of bad faith (paragraph 3.1.4 WIPO Overview 3.0).

Given the distinctiveness and the reputation of the Complainant's mark acquired over the years, it is inconceivable that the Respondent could have registered the disputed domain name confusingly similar to the Complainant's trademark for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website. The Complainant has provided a Google search which confirms that all results are related to the Complainant.

Even assuming that the Respondent had no knowledge of the Complainant's prior mark at the time of registration of the disputed domain name (which is quite unlikely), it omitted to verify that the disputed domain name would have infringed the Complainant's earlier rights or, even worse, it verified it and deliberately proceeded with the infringing registration. Under paragraph 2 of the Policy, it is the Respondent's responsibility to determine whether a domain name registration infringes or violates third party's rights. By registering the disputed domain name confusingly similar with the Complainant's well-known mark, the Respondent has violated, inter alia, the cited provision of the Policy.

The disputed domain name does not resolve to any active website. UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see 3.3 WIPO Overview 3.0 and in particular Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003).

The following factors were considered by the Panel when applying the passive holding doctrine in the present case:

- (i) the degree of distinctiveness and/or reputation of the Complainant's trademark;
- (ii) the failure of the Respondent(s) to submit a response or to provide any evidence of actual or contemplated good faith use;
- (iii) the implausibility of any good faith use to which the disputed domain name may be put.

Taken into account all circumstances of this case, the Panel finds that 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 an infringement of the Complainant's trademark under trademark law, a passing off, or an infringement of consumer protection legislation.

The Panel, thus, finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

Therefore, the disputed domain name should be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **usa-schneider-electric.com**: Transferred

PANELLISTS

Name	Ivett Paulovics
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DATE OF PANEL DECISION	2023-10-19
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Publish the Decision