Decision for dispute CAC-UDRP-106018

Case number	CAC-UDRP-106018
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Domain names	a4csr-sanef.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	SANEF

Complainant representative

Organization	Cabinet Vidon, Marques & Juridique PI

Respondent

Name	Mr Alexander Kazmin

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 holder of the following registrations of the trademark “SANEF” (the “SANEF trademark”):

- the French trademark SANEF (combined) with registration No. 93478220, registered on 28 July 1993 for services in International Classes 35, 36 and 37; and

- the European Union trademark SANEF (combined) with registration No. 008310831, registered on 27 January 2010 for goods and services in International Classes 09, 16, 25, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45.

FACTUAL BACKGROUND

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

The Complainant was established in 1963. Its name “SANEF” by which it is known by the public, is the acronym of “Société des Autoroutes du Nord et de l'Est de la France” (in English: “Motorway Company for the North and East of France”). The Complainant is a major actor in the field of motorway management. In 2005, it was acquired by the Spanish Group ABERTIS.

The Complainant’s official website is located at the domain name <sanef.com>, registered on 21 April 1998.

The disputed domain name was registered on 14 May 2018 and resolves to a gambling website promoting hyperlinks to third-party online casinos. It was previously registered and used by the Complainant for the purposes of its CSR project, described below in this decision.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

The Complainant states that the disputed domain name is confusingly similar to its SANEF trademark, because it identically reproduces the same trademark with the addition of the element “A4csr”, which is not distinctive. Rather, it is a combination of “A4” - the name of a motorway that runs from Paris to Strasbourg in the east of France, and “CSR”, which is the acronym for “Contournement Sud Reims” (in English: “South Reims Bypass”, which designated the project led by the Complainant to build a motorway bypass around the Reims agglomeration, which project was completed in 2010.

The Complainant maintains that the Respondent has no right or legitimate interest in respect of the disputed domain name, because it is not commonly known by the disputed domain name and is not affiliated with the Complainant, and the Complainant has not authorized the Respondent to use the Complainant’s SANEF trademark or to register a domain name including it. The Complainant points out that the SANEF trademark was first registered in 1993, many years before the Respondent registered the disputed domain name.

The Complainant submits that the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services. The disputed domain name resolves to a website dedicated to gambling and betting, which aims to generate traffic and commercial advantage. The Complainant points out that the disputed domain name was previously owned by it and was well known by the Complainant’s employees, in particular those involved in the CSR project. According to the Complainant, when confronted with the disputed domain name, these persons may consider its use by the Respondent to be legitimate considering the Complainant itself used it previously, thus creating a high risk for phishing attacks.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the Respondent knew about the Complainant’s trademark, because the Complainant is a major economic actor in motorway management, and the SANEF trademark is a coined word with a high degree of distinctiveness and is highly visible to users of French motorways. In the Complainant’s submission, the Respondent registered the disputed domain name to prevent the Complainant from obtaining it, because it is identical to the SANEF trademark and includes the descriptive term A4 combined with the element "CSR", which is the abbreviation for the Complainant’s motorway project. The Complainant adds that it was the previous registrant of the disputed domain name and used it to inform the public about the status of construction of the CSR project. An eventual use of the disputed domain name for the setting up of email accounts may expose current or former employees of the Complainant to the risk of phishing, as they may regard email correspondence from such accounts as originating from the Complainant.

The Complainant points out that the disputed domain name resolves to a gambling website promoting hyperlinks to third-party online casinos. According to the Complainant, such use of the disputed domain name has no relation with the elements “A4csr” and “Sanef”, and shows that the disputed domain name was registered not as a coincidence, but in a bad faith attempt to attract for commercial gain Internet users to the associated website by creating a likelihood of confusion with the Complainant’s SANEF trademark.

RESPONDENT:

The Respondent did not reply to the Complainant’s contentions and did not submit any arguments or evidence in its defence.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the 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 domain name; and

(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the SANEF trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence "a4csr-sanef". As pointed out by the Complainant, it represents a combination of the wordl element of the SANEF trademark with the element "a3csr", where "a4" is the name of a motorway in the east of France and "csr" is the abbreviation of a motorway project of the Complainant. The SANEF trademark is easily recognized in the disputed domain name, and the addition of the other elements does not prevent a finding of confusing similarity with the SANEF trademark. As discussed in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), 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 terms may however bear on assessment of the second and third elements.

Taking all the above into account, the Panel finds that the disputed domain name is confusingly similar to the SANEF trademark in which the Complainant has rights.

Rights and legitimate interests

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 Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because it is not associated to the Complainant and has not been authorized by the Complainant to use the SANEF trademark. According to the Complainant, the disputed domain name resolves to a website promoting third-party gambling websites. The Complainant adds that it was the previous owner of the disputed domain name and used it for its CSR project, so emails sent from an account at the

disputed domain name may confuse Internet users as to the identity of their sender. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not alleged that it has rights and legitimate interests in the disputed domain name; it has not disputed the Complainant's allegations and evidence in this proceeding.

The disputed domain name is indeed confusingly similar to the Complainant's SANEF trademark and the Complainant's name, and combined the trademark with the elements "a4" and "csr", which indicate a motorway in France and a motorway section around the city of Reims connected to this motorway, both managed by the Complainant. Taking this into account, and in the absence of any plausible explanation by the Respondent why it has chosen and registered the disputed domain name, it can only be regarded as referring to the SANEF trademark and the motorway mentioned above, and the combination of these elements appears to have been intended to confuse Internet users and attract them to the Respondent's website which promotes third-party gambling services without disclosing the lack of relationship with the Complainant. As further noted by the Complainant, if the disputed domain name is used for email communications, this may create the risk for confusion of the potential addressees of such communications.

The above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant and of the SANEF trademark, has registered the disputed domain name in an attempt to exploit this trademark's goodwill for commercial gain by confusing Internet users and attracting them to the associated website where to offer them gambling services for commercial gain. In the Panel's view, such activity is not legitimate and does not give rise to rights and legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have 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

(ii) you have 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

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location."

As discussed above, the disputed domain name is confusingly similar to the SANEF trademark and the name of the Complainant. It combines the trademark with the elements "a4" and "csr", which indicate a motorway in France and a motorway section around the city of Reims connected to it, both of which are managed by the Complainant. The associated website contains hyperlinks to third-party gambling websites and has no disclaimer for the lack of relationship with the Complainant.

Taking the above into account, and in the absence of any plausible explanation by the Respondent why it has chosen and registered the disputed domain name, it appears to the Panel as more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the SANEF trademark in an attempt to mislead and attract Internet users to the disputed domain name and to the associated website where gambling services are offered for commercial gain, by creating a likelihood of confusion with the Complainant's SANEF trademark as to the affiliation or endorsement of the Respondent's website and of the services offered there.

This satisfies the Panel that the Complainant has established that the Respondent has registered and used 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. **a4csr-sanef.com**: Transferred

PANELLISTS

Name	Assen Alexiev

DATE OF PANEL DECISION 2024-02-06

Publish the Decision