Decision for dispute CAC-UDRP-106082

Case number	CAC-UDRP-106082
Time of filing	2023-12-27 10:22:22
Domain names	sanef-sapn.com

Case administrator

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

Complainant

Organization	SANEF
Organization	SOCIETE DES AUTOROUTES PARIS NORMANDIE (S.A.P.N.)

Complainant representative

Organization	Cabinet Vidon, Marques & Juridique PI

Respondent

Name	noname tarba

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 SANEF has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- the French trademark SANEF (registration n°93478220) dated July 28, 1993;

- the French trademark SANEF (registration n°4712040) dated April 9, 2021; and

- the European Union trademark SANEF (registration n°008310831) dated April 17, 2009.

Moreover, the Complainant SANEF is also the owner of the domain names bearing the sign “SANEF” such as the domain names <groupe.sanef.com>, <autoroutes.sanef.com>.

The second Complainant SOCIETE DES AUTOROUTES PARIS NORMANDIE (S.A.P.N.) has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- the French trademark SAPN (registration n°3646712) dated April 27, 2009;

- the French trademark E.SAPN (registration n°4495909) dated October 30, 2018; and

- the French trademark SAPN PAY (registration n°4504229) dated November 29, 2018.

FACTUAL BACKGROUND

The Complainant SANEF is a major actor in the field of motorway management. Whereas the second Complainant SOCIETE DES AUTOROUTES PARIS NORMANDIE (S.A.P.N.) which is also active in motorway sector is a company under the control of the first Complainant SANEF.

On December 6, 2022; the Respondent registered the disputed domain name <sanef-sapn.com>. The disputed domain name is currently inactive.

PARTIES CONTENTIONS

COMPLAINANT:

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The disputed domain name is confusingly similar to the Complainants' well-known and distinctive trademarks "SANEF" and "SAPN" as it bears both of the Complainants' trademarks "SANEF" and "SAPN" as a whole with the addition of hyphen in between the marks.

The Complainants stated that the hyphen and the top level ".com" are not distinctive and the disputed domain name is confusingly similar to the Complainants' trademarks.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainants state that the Respondent has no rights on the disputed domain name as the Respondent is not known as the disputed domain name and as the Respondent does not hold any trademark neither for "SANEF" nor for "SAPN".

The Complainants also state that the Respondent is neither affiliated nor authorized by the Complainants in any way.

The Complainants argue that the Respondent is not using the disputed domain name in connection with bona fide offering of goods or services or a legitimate non-commercial or fair use.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainants indicate that the Respondent intentionally used "SANEF" and "SAPN" trademarks to attract the Complainants' clientele in bad faith.

The Complainant argues that "SANEF" and "SAPN" trademarks consist of distinctive words and the Respondent could not ignore the existence of the well-known "SANEF" and "SAPN" trademarks belonging to the Complainants.

The Complainant asserts that considering the well-known status of the Complainants' trademarks, the Respondent knew about the Complainants and their rights before the registration of the disputed domain name. Accordingly, the disputed domain name was registered and is being used in bad faith.

The Complainants state that the disputed domain name is not being used for any bona fide offering and this fact, not being used of the disputed domain name, alone is sufficient to prove the bad faith of the Respondent according to many WIPO UDRP decisions.

The Complainants allege that the disputed domain name has not been using by the Respondent and the passive holding of the disputed domain name demonstrates the bad faith of the Respondent.

Accordingly, the Complainants allege that the disputed domain name was registered and is being used in bad faith.

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

1. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainants to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainants are the owners of registration of “SANEF” and “SAPN” trademarks.

The Panel finds that the disputed domain name is confusingly similar to the Complainants’ “SANEF” and “SAPN” trademarks and the addition of the hyphen between the trademarks is not sufficient to vanish the confusingly similarity.

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainants. The Panel recognizes the Complainants’ rights and concludes that the disputed domain name is confusingly similar with the Complainants’ trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

2. NO RIGHTS OR LEGITIMATE INTERESTS

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 domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name,

even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainants contend that the Respondent has nothing to do with the Complainants and any use of the trademarks “SANEF” and “SAPN” has to be authorized by the Complainants and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

In the absence of a response, the Panel accepts the Complainants’ allegations as true that the Respondent has no authorization to use the Complainants’ trademarks in the disputed domain name.

Hence, as the Complainants have made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain dame, the Panel concludes that the Complainants have satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

The Panel concludes that the Complainants’ “SANEF” and “SAPN” trademarks are of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainants in the “SANEF” and “SAPN” trademarks, the Respondent, was aware of the Complainants and their trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainants’ trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Further, the Panel is of the opinion that the combination of “SANEF” and “SAPN” trademarks which belong to the same group companies cannot be evaluated as a coincidence and the Respondent combined the trademarks in question in bad faith in order to take advantage from the Complainants’ clientele.

Moreover, the link <sanef-sapn.com> is currently inactive.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainants have established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **sanef-sapn.com**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2024-03-04

Publish the Decision