Decision for dispute CAC-UDRP-106288

Case number	CAC-UDRP-106288
Time of filing	2024-02-28 16:37:18
Domain names	schneiderelectricindustries.com

Case administrator

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

Complainant

Organization	SCHNEIDER ELECTRIC SE

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	STAVROPOULOS PANAGIOTIS

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 owns several trademarks including the terms “SCHNEIDER ELECTRIC”, such as:

- The international trademark SCHNEIDER ELECTRIC n° 715395 registered on March 15, 1999;
- The international trademark SCHNEIDER S ELECTRIC n° 715396 registered on March 15, 1999;
- The European trademark SCHNEIDER ELECTRIC n° 1103803 registered on March 12, 1999.

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.

FACTUAL BACKGROUND

The Complainant, which was founded in 1871, is a French industrial business trading internationally. It manufactures and offers products for power management, automation, and related solutions.

The Complainant is featured on the NYSE Euronext and the French CAC 40 stock market index. In 2023, the Complainant revenues

amounted to 36 billion euros.

The disputed domain name <schneiderelectricindustries.com> was registered on January 2, 2024 and points to a website where the Respondent allegedly sells electronic items under the name Schneider Electric Industries SAS.

PARTIES CONTENTIONS

COMPLAINANT:

A. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant states that the disputed domain name <schneiderelectricindustries.com> is confusingly similar to its trademark SCHNEIDER ELECTRIC as the trademark is fully contained in the disputed domain name.

The Complainant asserts that the addition of the term “INDUSTRIES” in the trademark SCHNEIDER ELECTRIC is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark. It does not change the overall impression of the designation as being connected to the Complainant’s trademark.

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” (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

Moreover, the Complainant contends that the addition of the gTLD suffix “.COM” does not change the overall impression of the designation as being connected to the trademark SCHNEIDER ELECTRIC. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark. The Complainant cites Forum Case No. FA 153545, Gardline Surveys Ltd v. Domain Finance Ltd. ("The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.").

Thus, the Complainant contends that the disputed domain name <schneiderelectricindustries.com> is confusingly similar to the Complainant's trademark SCHNEIDER ELECTRIC.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name

According to the WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd., the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Complainant asserts that the Respondent is not identified in the Whois database 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. The Complainant cites Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy ¶ 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c)(ii).”).

The Complainant contends that the Respondent is not affiliated with nor authorized by SCHNEIDER ELECTRIC in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 SCHNEIDER ELECTRIC, or apply for registration of the disputed domain name by the Complainant.

Finally, the disputed domain name points to a website where the Respondent allegedly sells home appliances and other various items under the name Schneider Electric Industries SAS, which is one of the Complainant’s subsidiaries domiciled at the same postal address. The Complainant asserts that the Respondent used the disputed domain name in a way that fails to confer rights and legitimate interests, as it is used to promote unrelated services under the Complainant’s subsidiary name.

The Complainant cites Forum Case No. FA1808541, Baylor University v. Pan Pan Chen / Chen Pan Pan (“Complainant argues that Respondent uses the disputed domain name to offer services completely unrelated to those offered by Complainant. Using a confusingly similar domain to promote unrelated services can evince a lack of a bona fide offering of goods or services or legitimate noncommercial or fair use.”).

Thus, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name <schneiderelectricindustries.com>.

C. The disputed domain name was registered and is being used in bad faith

The disputed domain name <schneiderelectricindustries.com> is confusingly similar to the Complainant trademark SCHNEIDER ELECTRIC. The Complainant cites WIPO Case No. D2020-1403, Schneider Electric S.A. v. Whois Privacy Protection Foundation /

Sales department (“The Complainant and its trademark are well-known worldwide. The Complainant has been established almost 150 years ago while the disputed domain name was only registered a couple of months ago. The Respondent must have been fully aware of the Complainant and its trademark when it registered the disputed domain name.”).

Moreover, the disputed domain name resolves to a website displaying the name of the Complainant’s subsidiary SCHNEIDER ELECTRIC INDUSTRIES SAS, and the address “35 Rue Joseph Monier 92500, Rueil Malmaison, Ile De France FRANCE”, which is the official address of the Complainant and its subsidiary.

On those facts, given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks. The Complainant refers to WIPO Case No. D2004-0673, Ferrari S.p.A v. American Entertainment Group Inc.

Finally, the disputed domain name points to a website where the Respondent allegedly sells home appliances and other various items under the name Schneider Electric Industries SAS, which is one of the Complainant’s subsidiaries domiciled at the same postal address. The Complainant contends that the Respondent attempts to attract internet users by creating a likelihood of confusion with the Complainant’s trademark. The Respondent is obtaining commercial gain from its use of the domain name and the resolving website. Past panels have held that this is an evidence of bad faith registration and use.

The Complainant cites Forum Case No. FA893000, The Vanderbilt University v. U Incorporated (“By diverting Internet users to its own website and promoting books unrelated to Complainant’s university under the VANDERBILT mark, Respondent is taking advantage of the confusing similarity between the <vanderbilt.mobi> domain name and Complainant’s VANDERBILT in order to profit from the goodwill associated with the mark, and that such registration and use constitutes bad faith under Policy ¶ 4(b)(iv).”).

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name 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).

This is a case of adding a generic term - in this case "industries" - to a well-known trademark and in respect of the well-established practice that the specific top level of a domain name such as “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar, it is found that the disputed domain name is confusingly similar to Complainant´s well-known trademark SCHNEIDER ELECTRIC.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant’s trademark SCHNEIDER ELECTRIC and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain names without prior knowledge of the Complainant and the Complainant’s mark.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name currently resolves to an active website selling counterfeit goods and it is indisputable that the disputed domain name uses Complainant's trademark to facilitate the sales of these counterfeit products or as bait to obtain personal data or payments from internet users without actually providing the goods offered for sale. Furthermore, the Panel finds that it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law. The Panel finds that the mere registration of a domain name that is identical or confusingly similar to a well-known or widely-known trademark by an unaffiliated entity is sufficient to create a presumption of bad faith. The Panel finds that the Respondent has intentionally attempted to attract for commercial gain internet users to its websites by creating a likelihood of confusion with Complainant’s mark as to Complainant as a source, sponsor, affiliate or endorser of

Respondent’s websites.

.

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

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

   i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

   ii. the Respondent has no rights or legitimate interests with respect to the disputed domain name; and

   iii. the disputed domain name has been registered and is being used in bad faith.

   2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

   3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

   4. The Panel therefore came to the following conclusions:

   a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

   The disputed domain name is therefore deemed confusingly similar.

   b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name. The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

   c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered.
   The disputed domain name resolves to websites offering counterfeit goods. It is concluded that the Respondent by attempting to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves and which makes bad faith use of the disputed domain name.

   The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

   For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **schneiderelectricindustries.com**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2024-04-03

Publish the Decision