Decision for dispute CAC-UDRP-106363

Case number	CAC-UDRP-106363
Time of filing	2024-03-19 09:02:23
Domain names	pointpsas.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	POINT P SAS

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	regisfontainee@gmail.com

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, inter alia, a registered owner of the following trademark containing a word element "POINT P”:

- POINT P (word), International (WIPO) Trademark, registration date 8 December 2021, trademark no. 1654998, registered for goods and services in classes 09, 16, 35, 36, 37, 38, 39, 40, 41, 42, and 45;
- POINT P (figurative), EU Trademark, filing (priority) date 3 October 20047, registration date 11 September 2008, , trademark no. 006330609, registered for goods in classes 11, 19, and 35;

besides other national and international (WIPO) trademarks consisting of the "POINT P" denominations (collectively referred to as "Complainant's trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term “POINT P”.

Moreover, Complainant’s company name reads POINT P S.A.S. (whereas S.A.S. stands for “société par actions simplifiée”) which also establishes Complainant’s rights in the “POINT P” name.

FACTUAL BACKGROUND

The Complainant (POINT P S.A.S), belonging to the SAINT-GOBAIN group, is a company specializing in the distribution of construction materials and the manufacture of prefabricated and ready-mixed concrete, to a clientele composed mainly of professionals of the building.

The disputed domain name <pointpsas.com> was registered on 15 October 2022 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) is currently not used and has no genuine content available to as it merely reads “Coming soon. A new website is in the works”.

The evidence provided by the Complainant shows that the disputed domain has been used in an e-mail address for apparent phishing purposes as the sender (likely the Respondent) impersonated an employee of the Complainant and addressed third parties on behalf of that employee with unsolicited emails and offers.

PARTIES CONTENTIONS

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains “POINT P” word elements, and it is thus almost identical (i.e. confusingly similar) to Complainant’s trademarks;

- The addition of the term “SAS” (abbreviation for French “société par actions simplifiée” which is Complainant’s corporate form) is not sufficient to escape the finding that the disputed domain name is confusingly similar to Complainant's trademarks as it does not prevent the likelihood of confusion between the disputed domain name and the Complainant, Complainant's trademarks and its business;

- The Complainant refers to previous domain name decisions in this regard;

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name;

- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name;

- Furthermore, the disputed domain name website has been during its existence inactive (it resolves to a registrar parking page) and it has been used in a phishing scheme, which implies that there was no Respondent’s intention to use the disputed domain name for legitimate purposes;

- The Complainant refers to previous domain name decisions in this regard.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain name registration and such trademarks are well known in relevant business circles. The Respondent can be considered to be aware of the Complainant's trademark when registering the disputed domain name due to well-known character thereof.

- The disputed domain name (at the time of filing of the complaint) did not resolve to any active website. In the light of the foregoing, the Complainant asserts that the disputed domain name was registered and used with the sole purpose of selling thereof to the Complainant.

- Moreover, the disputed domain name has been used in a phishing e-mail.

- It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant’s trademarks which enjoys strong reputation, plus other facts, such as above described non-use of the disputed domain name (inactive holding) are sufficient to establish bad faith under the 4(a)(iii) of the Policy;

- The Complainant refers to previous domain name decisions contending that registering a domain name incorporating trademarks that enjoy high level of notoriety and well-known character and at the same time constitute prima facie registration in bad faith, despite a fact that such domain names are not genuinely used.

RESPONDENT:

The Respondent has not provided any response to the Complaint.

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

CONFUSING SIMILARITY

Since the disputed domain name and the Complainant's trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term "POINT P" is confusingly similar to the Complainant's trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the disputed domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name in question.

Applying the principles described above, the Panel contends that incorporation of a dominant "POINT P" element of Complainant's trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitutes confusing similarity between Complainant's trademark and the disputed domain name.

Addition of a non-distinctive element - suffix "SAS" that likely stands for French "société par actions simplifiée" which is Complainant's corporate form" - cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the disputed domain name (i.e. the ".com") must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant's assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

In addition, given the fact that (i) the disputed domain name has not been genuinely used and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain name was intended to be used in connection with a bona fide offering of goods or services as required by the Policy.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant 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 Respondent has not used the disputed domain name in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com>, Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of so-called active use (e.g. to resolve to a website) of the domain name(s) without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use (e.g. a mere "parking") of the disputed domain name by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

In addition, it is clear that the disputed domain name has been used in a fraudulent e-mail which purpose was to deceive its recipient that it originates from the Complainant. Although it is not entirely clear that such email was sent by the Respondent or on its behalf, it is very likely that the Respondent has approved or endorsed such fraudulent (likely phishing) activity.

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business (ii) there is no real use of the disputed domain name and (iii) the Respondent clearly misleads the internet users about association of the disputed domain name with the Complainant, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith.

Thus, the Panel has taken a view that 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **pointpsas.com**: Transferred

PANELLISTS

Name	**Jiří Čermák**

DATE OF PANEL DECISION 2024-04-23

Publish the Decision