Decision for dispute CAC-UDRP-106960

Case number	CAC-UDRP-106960
Time of filing	2024-10-21 13:19:20
Domain names	legrandvietnam.com

Case administrator

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

Complainant

Organization	Legrand France

Complainant representative

Organization	Coöperatie SNB-REACT U.A.

Respondent

Name	Mr. Hung Manh Nguyen

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 has registered the “LEGRAND” trademark for a broad range of goods in numerous countries worldwide, including Vietnam. The “LEGRAND” trademark was initially registered in France for goods in Classes 6, 8, 9, and 17 under Registration No. 946593 on February 23, 1976. The Complainant holds ownership of the LEGRAND trademark through various international trademark registrations, inter alia, as outlined below:

- Mark: LEGRAND (wordmark): Registration No. 425730, registered on August 16, 1976.
- Mark: LEGRAND (semifigurative mark): Registration No. 510016, registered on August 11, 1986.

The Complainant has operated its official domain name, <legrand.com>, since December 22, 1995.

FACTUAL BACKGROUND

The Complainant is a global specialist in electrical and digital building infrastructures, committed to fostering technological, societal, and environmental advancements worldwide. Founded in 1904 in France, the Complainant now operates in over 90 countries, employing more than 38,000 individuals globally. Present in Vietnam since 1994, the Complainant is recognized as a leading solution provider across all market segments in Vietnam, with two representative offices located in Ho Chi Minh City and Hanoi. All of the Complainant’s products are marketed under the renowned “LEGRAND” trademark, which is distributed in nearly 180

countries and widely acknowledged for its high quality and innovative features.

The disputed domain name was registered on September 30, 2020. The website associated with the disputed domain name prominently displays a copy of the Complainant's mark at the top and in other parts of the page. At the bottom of the page, the Respondent has included the designation "LEGRAND VIỆT NAM," which is nearly identical to the trade name of the Complainant's subsidiary in Vietnam, i.e., "CÔNG TY TNHH LEGRAND VIỆT NAM" (its English name being LEGRAND VIETNAM COMPANY LIMITED). Below this designation, the Vietnamese text is translated into English as: "Legrand is one of the world's leading corporations in the field of providing high-end electrical equipment and electronic switching equipment specialized for civil, industrial, and commercial markets."

PARTIES CONTENTIONS

COMPLAINANT:

(i) The Complainant holds rights in the LEGRAND marks as detailed in the "Identification of Rights" section above. The disputed domain name is confusingly similar to the Complainant's LEGRAND mark, as it fully incorporates the Complainant's mark with the mere addition of the geographic term "Vietnam."

(ii) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is neither known, nor has ever been known, by the distinctive LEGRAND mark. The Respondent has not been authorized or licensed by the Complainant to register a domain name incorporating the LEGRAND mark or any confusingly similar variation thereof. Furthermore, the Respondent has not used, nor demonstrated preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Instead, the disputed domain name resolves to a website that misrepresents itself as the Complainant or impersonates the Complainant by prominently displaying the Complainant's marks and using the trade name of the Complainant's subsidiary in Vietnam. Between May and September 2024, the Complainant's representatives issued multiple takedown requests to the host, registrar of the domain name, and the WHOIS-listed e-mail address of the Respondent, as well as the e-mail address provided on the website associated with the disputed domain name. However, the Respondent has not provided any response or explanation for its choice of the disputed domain name. The website also lacks any form of disclaimer.

(iii) The Respondent has registered and is using the disputed domain name in bad faith. The Respondent registered the disputed domain name with prior knowledge of the Complainant's trademarks, deliberately targeting these marks. By prominently featuring the Complainant's visual marks "LEGRAND" on the website linked to the disputed domain name and including the designations "LEGRAND VIỆT NAM" and the statement "Legrand is one of the world's leading corporations in the field of providing high-end electrical equipment and electronic switching equipment specialized for civil, industrial, and commercial markets" in Vietnamese, the Respondent is passing off as or impersonating the Complainant.

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

Language of Proceedings

The Panel observes that the Registration Agreement for the disputed domain name is written in Vietnamese, which would typically make Vietnamese the language of the proceedings. However, the Complainant has requested that the proceedings be conducted in English. Pursuant to UDRP Rule 11(a), the Panel has the discretion to determine the appropriate language of the proceedings, taking into account the specific circumstances of the case. Reference is made to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, Section 4.5, and Lovehoney Group Limited v. yan zhang, CAC 103917 (CAC August 17, 2021), where the Panel found it appropriate to conduct proceedings in English under Rule 11, despite the Registration Agreement designating Japanese as the required language.

The Complainant has provided compelling arguments in support of its request, asserting the following:

1. The disputed domain name is registered with “P.A. Viet Nam Company Limited,” whose Registration Agreement is available in both Vietnamese and English.
2. The disputed domain name incorporates the English-language trademark "LEGRAND" and the English word "Vietnam." Additionally, the Registration Agreement references ICANN regulations regarding the “Rights and Responsibilities of gTLD Domain Name Registrants,” which are provided in English. This indicates that by registering the domain name through this registrar, the Respondent was likely aware of English-language provisions.
3. The Respondent has demonstrated a capacity to understand English. Although the website associated with the disputed domain name is primarily in Vietnamese, it includes various English terms. Moreover, the disputed domain name is registered in the international .com zone, and English is commonly used in international business. English is also widely understood and used in Vietnam, where the Respondent is located.
4. Conducting the proceedings in Vietnamese would impose undue costs and delays on the Complainant, creating an unfair disadvantage by requiring the translation of the Complaint into Vietnamese.

The Panel finds the Complainant’s arguments persuasive. Given the circumstances of this case, including the absence of a Response from the Respondent and no objection to the Complainant's request, the Panel determines that the proceedings shall be conducted in English, in accordance with UDRP Rule 11(a).

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(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(2) Respondent has no rights or legitimate interests in respect of the domain name; and

(3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnetmarketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Rights

The Complainant asserts ownership of the registered trademark LEGRAND, as outlined in the “Identification of Rights” section above. The Panel observes that both international and national trademark registrations are sufficient to establish rights in a trademark. Accordingly, the Panel concludes that the Complainant has established its rights in the LEGRAND mark.

The Complainant further argues that the disputed domain name **<legrandvietnam.com>** is confusingly similar to its LEGRAND mark, as it fully incorporates the mark with the addition of the geographic term "Vietnam." The Panel concurs with the Complainant and notes that the inclusion of a geographic term does not materially differentiate a disputed domain name from the trademark under paragraph 4(a)(i) of the Policy. Such terms are typically disregarded when assessing similarity. Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark LEGRAND.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Section 2.1, WIPO Jurisprudential Overview 3.0 ("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.").

Complainant argues that Respondent has no rights or legitimate interest in the disputed domain name as Respondent is not commonly known by the disputed domain name, nor has Respondent been authorized by Complainant to use Complainant's mark, and Respondent is not affiliated with Complainant. Relevant information, such as WHOIS information, can be used as evidence to show a respondent is or is not commonly known by the disputed domain name under Policy paragraph (c)(ii). The Panel notes that the unmasked WHOIS data lists "Hung Manh Nguyen" as the registrant, and there is no evidence in the record to suggest Respondent was authorized to use the mark. Therefore, the Panel finds that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).

The Complainant further asserts that the Respondent is not using the disputed domain name for a bona fide offering of goods or services under Policy paragraph 4(c)(i), nor for legitimate noncommercial or fair use under Policy paragraph 4(c)(iii). Specifically, the Complainant highlights that the website associated with the disputed domain name prominently displays copies of the Complainant's mark at the top and in other areas of the page. Additionally, at the bottom of the page, the Respondent has included the designation "LEGRAND VIỆT NAM," which is nearly identical to the trade name of the Complainant's subsidiary in Vietnam, i.e., "CÔNG TY TNHH LEGRAND VIỆT NAM" (its English equivalent being LEGRAND VIETNAM COMPANY LIMITED). Beneath this designation, the website includes Vietnamese text translated as: "Legrand is one of the world's leading corporations in the field of providing high-end electrical equipment and electronic switching equipment specialized for civil, industrial, and commercial markets."

Previous UDRP panels have consistently held that attempts by a respondent to pass itself off as a complainant do not constitute a bona fide offering of goods or services, nor legitimate noncommercial or fair use under Policy paragraphs 4(c)(i) and (iii). For instance, in Crow v. LOVEARTH.net, FA 203208 (Forum Nov. 28, 2003), the panel ruled: "It is neither a bona fide offering of goods or services, nor an example of legitimate noncommercial or fair use under Policy paragraph 4(c)(i) & (iii) when the holder of a domain name, confusingly similar to a registered mark, attempts to profit by passing itself off as Complainant…" Furthermore, panels have held that using a confusingly similar domain name to compete with the complainant disqualifies a respondent from having any rights or legitimate interests. See Coryn Group, Inc. v. Media Insight, FA 198959 (Forum Dec. 5, 2003) (finding no bona fide offering of goods or services, nor legitimate noncommercial or fair use, where the respondent used the domain names to divert users to a competing website).

The Complainant has submitted a screenshot of the website linked to the disputed domain name. The Panel notes that the website prominently displays the Complainant's company name, mark, and logo. This use is likely to cause confusion among Internet users, leading them to believe that the website is operated by, or affiliated with, the Complainant. The Panel concludes that the Respondent's use of the disputed domain name does not constitute a bona fide offering of goods or services, nor legitimate noncommercial or fair use. Instead, the Respondent is using the disputed domain name to mislead users by diverting them to a website displaying content that competes with the Complainant's offerings, which falls outside the scope of Policy paragraphs 4(c)(i) and (iii).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith by disrupting the Complainant's business and attracting users for commercial gain. Where a respondent uses a disputed domain name to impersonate a complainant, the Panel may find evidence of bad faith disruption under Policy paragraph 4(b)(iii) and an attempt to attract users for commercial gain under Policy paragraph 4(b)(iv). For instance, in Bittrex, Inc. v. Wuxi Yilian LLC, FA 1760517

(Forum Dec. 27, 2017), the panel held that bad faith existed under Policy paragraph 4(b)(iv) where "Respondent registered and uses the <lbittrex.com> domain name in bad faith by directing Internet users to a website that mimics Complainant's own website in order to confuse users into believing that Respondent is Complainant, or is otherwise affiliated or associated with Complainant."

As previously noted, the Complainant has submitted a screenshot of the website associated with the disputed domain name. The Panel specifically observes that the website prominently displays copies of the Complainant's mark at the top and in other areas of the page. At the bottom of the page, the Respondent has included the designation "LEGRAND VIỆT NAM," nearly identical to the trade name of the Complainant's subsidiary in Vietnam, i.e., "CÔNG TY TNHH LEGRAND VIỆT NAM" (its English equivalent being LEGRAND VIETNAM COMPANY LIMITED). Beneath this designation, the website contains Vietnamese text translated as: "Legrand is one of the world's leading corporations in the field of providing high-end electrical equipment and electronic switching equipment specialized for civil, industrial, and commercial markets."

The Panel finds that the Respondent's use of the disputed domain name is likely to cause confusion among Internet users, leading them to believe that the website is operated or authorized by the Complainant or a company affiliated with the Complainant. Such conduct disrupts the Complainant's business and demonstrates bad faith registration and use. Accordingly, the Panel concludes that the Respondent's actions constitute bad faith under Policy paragraphs 4(b)(iii) and (iv).

The Complainant also argues that given the distinctiveness and reputation of its trademark, it is reasonable to infer that the Respondent registered and used the disputed domain name with actual knowledge of the Complainant's rights in the LEGRAND mark. While constructive knowledge alone is insufficient to establish bad faith, actual knowledge can support a finding of bad faith registration and use. For example, in Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum February 6, 2014), the panel held: "The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding bad faith per paragraph 4(a)(iii) of the Policy, the Panel here finds actual knowledge through the name used for the domain and the use made of it." Based on the renown of the Complainant's mark and the specific manner in which the disputed domain name has been used, the Panel infers that the Respondent registered the domain name with actual knowledge of the Complainant's trademark rights. This demonstrates bad faith registration and use under Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **legrandvietnam.com**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2024-11-25

Publish the Decision