Decision for dispute CAC-UDRP-107045

Case number	CAC-UDRP-107045
Time of filing	2024-11-07 17:52:56
Domain names	sanefautoroutes.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	SANEF

Complainant representative

Organization	Cabinet Vidon, Marques & Juridique PI

Respondent

Organization	Njalla Okta LLC

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 the following trademark registrations:

- “SANEF”, French trademark n° 4712040 filed on 14 December 2020 and registered on 9 April 2021 for products/services in classes 09, 16, 25, 35, 36, 37, 38, 39, 41, 42, 43, 44, 45 ;
- “SANEF (with device)” European Union trademark n°008310831, filed on 17 April 2009 and granted 17 January 2010 for products/services in classes 09, 16, 25, 35, 36, 37, 38, 39, 41, 42, 43, 44, 45.

FACTUAL BACKGROUND

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

The Complainant is a major actor in the field of motorway management.

The Complainant name is the acronym of “**S**ociété des **A**utoroutes du **N**ord et de l'**E**st de la **F**rance” (France’s North and East Motorway Company), essentially known as “SANEF” by the public.

Since its creation in 1963, the Complainant became a major actor in the field of information and concession related to motorways in France. SANEF has been acquired by the Spanish Group ABERTIS in 2005.

In 1994, there has also been an expansion of activity in the field of radio broadcasting, with the channel “SANEF 107.7”.

The trademark are registered well before the registration of the contested domain name <sanefautoroutes.com> which was registered on November 2, 2024.

The SANEF mark is affixed to signs on French motorways, which is a photograph of the affixed SANEF word and semi-figurative marks. The marks enjoy an increased degree of distinctiveness in that it is highly visible to users of French motorways.

The Complaint also benefit from a great visibility online through domain name reservations and used of related reservations with the following subdomains:

- <groupe.sanef.com>
- <autoroutes.sanef.com>

If a search is made on Google for the word 'SANEF', the abovementioned websites appear as the first results.

In addition, the great majority of results for this search are in relation with the Complainant, whether from the Complainant's own websites and social medias, or from third parties’ websites, referring to the Complainant's activities.

This Complaint is based on the following grounds:

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

1. The disputed domain name identically reproduces the Complainant's trademark SANEF.

The disputed domain name’s root is composed of the combination of words “sanef” and “autoroutes”, associated with the Top Level Domain “.com”.

The elements to be taken into account in the course of the first UDRP criteria, namely determining whether the domain name is confusingly similar to a trademark or service mark in which the Complainant has rights, is the domain name’s root <sanefautoroutes> and the Complainant’s trademarks “SANEF”.

Given the above, it shall also be noticed that, as per constant Case Law, the addition of the word “autoroutes” isn’t sufficient to discard likelihood of confusion between the contested domain name and the Complainant’s trademarks, considering its lack of distinctive character.

Indeed, the word “AUTOROUTES” is the French word for “MOTORWAYS”. Therefore, “Autoroutes” in the hereby case lacks of any distinctive character as referring directly, and without doubt, to the main activity of the Complainant. On the contrary, the Complainant asserts that this addition is in the nature of reinforcing the likelihood of confusion, insofar the word refers to its activity.

The domain name’s root “sanefautoroutes” reproduces in an identical and complete manner the client's trade mark 'SANEF' in relation to a word describing the complainant's sector of activity. Therefore, it creates a likelihood of confusion for consumers.

This likelihood of confusion is emphasized by the circumstance the Complainant’s trademark element “SANEF” does not have any meaning in relation to the products covered and must therefore be considered **distinctive**. Its reproduction can consequently even less be a coincidence, and also characterizes the reproduction or at least the imitation of the Complainant’s trademarks.

2. The Complainant has not given any authorization to the Respondent, in any form, to use the sign “SANEF”, nor to register a

domain name including its trademark.

It shall also be noted that the Respondent is not making any legitimate use of the disputed domain name. Indeed, the disputed domain name resolves to an active website, that bears the Complainant's own mark and purports to check whether a user has outstanding motorway tolls.

In addition, the fact that the Respondent chose to hide his identity is a proof of a use without bona fide of the disputed domain name.

Further to the disclosure of contact details associated with the Respondent, the Complainant confirms that it has not given authorization to use its trademarks SANEF nor to register a domain name including this trademark, to Host Master / Njalla Okta LLC (it should also be noted that "HOST MASTER" doesn't sound like name at all of a living individual actually).

In addition, a Google search with the key words Host Master / Njalla Okta LLC leads to no result in relation to the contested domain name's root <SANEFAUTOROUTES>, confirming the Respondent has no legitimate interest in relation to the contested domain name, independently from the Complainant's trademarks.

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

The domain name <sanefautoroutes.com> has been registered and is being used in bad faith, which may be demonstrated through the fact the Respondent knew, or at least should have known, about the Complainant's trademark rights, due to its wide scope of activities.

The Complainant states:

the Complainant is a major economic actor in motorway management;

The trademark "SANEF" enjoys a high degree of distinctiveness in that it is highly visible to users of French motorways;

the Complainant websites including the "SANEF" trademark also are highly visible on the web.

the sign "SANEF" is widely protected as a trademark and used in its core geographical area, i.e. France.

The Complainant claims that the its trademarks were known, or at least should have been known to the Respondent, due to the fact the "SANEF" trademarks are widely filed and registered. Moreover, "SANEF" appears to be a coined term and is not in the dictionary, the disputed domain name only refers to the Complainant's name "SANEF", and therefore is distinctive.

It has been acknowledged within WIPO Arbitration Centre's Case Law that the fact the Respondent knew or should have known about the Complainant's rights may be constitutive of bad faith.

At stake, there is several indications that the Respondent knew about the Complainant's trademark rights considering:

the figurative trademarks are reproduced within the website associated with the disputed domain name;

the disputed domain name associates the Complainant's trademark in relation to a generic word descriptive of the Complainant's activity.

Worth mentioning, the website associated with the disputed domain name is highly similar, not to say identical, to the Complainant's legitimate platform payment for motorways toll.

Thus, the Respondent's website will necessarily mislead the Complainant's customers into believing that they are accessing the Complainant's website. Such use of the disputed domain name cannot be considered a bona fide offering of services or a fair use.

As above announced, it is very likely that the Respondent also is responsible for the sending of courier, letters, letting people know they requesting people to log into the disputed domain name website.

It also has come to the Complainant's attention the sending of courier to potential users of the Complainant's motorways. An example of letter is provided, with personal and sensitive information redacted.

This letter mentions that a toll corresponding to a journey has not been paid, giving information enabling this journey to be paid, and informing that failure to do so would result in surcharges being due. The letter also states that this journey can be paid using the www.sanefautoroutes.com website. Said letter is bearing the trademark of the complainant, and other information that can let believe its recipient the courier is legitimate (address, name of sister companies, subsidiaries, other trademarks of the Complainant, etc…).

The fact that the letter reproduces the domain name <sanefautoroutes.com>, that is the disputed domain name, highly presume

of the connection of the Respondent with this document.

The Respondent appears to use the disputed domain name for nefarious purposes, to misleadingly divert customers and collect personal and financial information, that cannot be considered legitimate.

The Complainant therefore believes the website found at the disputed domain name is being used for phishing or spoofing scams by appearing to be a legitimate website operated, maintained, and monitored by the Complainant. The Complainant asserts that it has reason to believe that the Respondent's website is designed and intended to mislead online users into providing their personal and/or financial information.

Such behavior is manifestly evidence of bad faith.

The Complainant summarises that:

the Respondent choose a domain name confusingly similar to the Complainant's trademarks and domain name;

the disputed domain name leads to a login page almost identical to the Complainant's official page, depicting the Complainant's trademarks, in identical colours and inviting users to insert their personal data.

It may highly be presumed that the Respondent also is responsible of the sending of letters requesting a payment (and threatening possible payment of penalty if not regularized) through the domain name <sanefautoroutes.com>.

Finally, and following disclosure of the details of the Registrant, the Complainant found that the Respondent Host Master / Njalla Okta LLC, has previously been the Respondent in numerous UDRP procedures.

It can be noticed from these cases a pattern of conduct:

the disputed domain names are reproducing famous trademarks or at least trademarks known by a public at large;

the disputed domain names are used in relation to websites that provides goods and/or services related to the field of activity of the rightful owners;

are registered within the same registrar (Tucows);

by the same Respondent e.g. Host Master / Njalla Okta LLC, residing in Saint Kitts and Nevis.

In all these cases, the panels have decided to transfer the domain names to their respective rightful owners, given the obvious bad faith of the actions of the serial cybersquatter HOST MASTER / NJALLA OKTA LLC.

This imitation of the trademark of the Complainant, and of the Complainant's website shall be characterized as a phishing scheme, in addition to the fact that the Respondent appears to be a serial cybersquatter characterizes bad faith of the Complainant in accordance with Paragraph 4(b), (ii), and (iv) of the Policy.

The Complainant also note the rather inhabitual name of the Respondent and has proceeded with additional searches. The Complainant believe that the actual domain name registrant is using privacy registration services named Njalla Okta LLC to conceal its actual identity and location. Apart from the fact that the Respondent choose to hide its identity is a sign of bad faith according to the Policy, it also has to be noticed that this circumstance cannot discard the evidences of bad faith found (use of a website for phishing purposes, evidenced pattern of conduct in contradiction with rule 4(b)(ii) of the Policy,...).

For all of the foregoing reasons, the Complainant alleges that the registration of the disputed domain name was made in bad faith.

PARTIES CONTENTIONS

Complainant´s contentions are summarized above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

RIGHTS

The disputed domain name is confusingly similar to the Complainant’s SANEF registered trademark.

As stated in Crédit Industriel et Commercial v. Manager Builder, Builder Manager, WIPO Case No. D2018-2230:

“The disputed domain name incorporates the CIC trademark in its entirety. Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the disputed domain name is at least confusingly similar to a registered trademark (see e.g., PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS), WIPO Case No. D2003-0696). Moreover, it has been held in many UDRP decisions and has become a consensus view among panelists (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.8), that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element of the UDRP.

Accordingly, the addition of the term “banks”, which even is the English translation of the French term “banques” as it is reflected in Complainant’s CIC BANQUES trademark, does not avoid the confusing similarity arising from the incorporation of Complainant’s CIC trademark in the disputed domain name.”

In this case, the Complainant’s SANEF is clearly recognizable, despite the addition of the term “AUTOROUTES”, thatsimply describes the Complainant's activity.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, they have submitted no information on possible rights or legitimate interests they might hold. On its part, the Complainant has submitted information and arguments which, prima facie, allow it to be reasonably assumed that the Respondents have no rights or legitimate interest in the domain names in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D2002-0856:

“As mentioned, [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed domain name, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists.“ WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, the Complainant has proved that its trade mark is well known and SANEF is not a preexisting word. Therefore, it is very unlikely that the Respondent may allege any right or legitimate interest.

BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant´s allegations and evidence with regard to the Respondent’s registration and use of the disputed domain name in bad faith.

The Complainant has filed evidence of the well-known character of its SANEF trademark. It can only be concluded that the Respondent’s intention is to take advantage of the Complainant's position in the sector. Because of the renown of the Complainant ´s trademark, the Panel agrees that the disputed domain name was registered in bad faith.

The addition of the term AUTOROUTES to the disputed domain name indicates a deliberate intent to impersonate the Complainant, as that is precisely what the Complainant does. Any consumer would think that the Respondent's website belongs to the Complainant, as owner of the SANEF mark for AUTOROUTES.

In addition, the Complainant has provided clear indications that the Respondent is fraudulently using the domain name in an attempt to obtain economic benefit.

As mentioned in Andrey Ternovskiy dba Chatroulette v. Alexander Ochki, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see AT&T Corp. v. Amjad Kausar, WIPO Case No. D2003-0327)."

The Respondent Host Master / Njalla Okta LLC, has previously been the Respondent in numerous UDRP procedures, as proven by the Complainant. It can be noticed from these cases a pattern of conduct, as confirmed in the CAC decision in the case No.CAC-UDRP-106195: “The Respondent has repeatedly been involved in, and lost, domain name disputes based on a similar pattern as this case concerning typo squatting of well-known trademarks. It is concluded that the Respondent makes bad faith use of the disputed domain name.”.

As alleged by the Complainant, the Respondent has been a party to several proceedings in which its cybersquatting activity has been recognised, which confirms bad faith.

It has, therefore, been satisfactorily demonstrated to the Panel that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **sanefautoroutes.com**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2024-12-13

Publish the Decision