

Decision for dispute CAC-UDRP-107176

Case number **CAC-UDRP-107176**

Time of filing **2024-12-17 10:03:23**

Domain names **arkemagroup-eu.com**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **ARKEMA FRANCE**

Complainant representative

Organization **IN CONCRETO**

Respondent

Organization **web Company**

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 submitted evidence, which the Panel accepts, showing that it is the registered owner of the trademarks bearing "ARKEMA", *inter alia*, the following:

- International trademark registration for "ARKEMA" numbered 847865 covering Armenia, Austria, Australia, Azerbaijan, Bosnia and Herzegovina, Bulgaria, Benelux, Belarus, Switzerland, China, Cuba, Cyprus, Czech Republic, Germany, Denmark, Algeria, Estonia, Egypt, Spain, Finland, United Kingdom, Georgia, Greece, Croatia, Hungary, Ireland, Iran, Italy, Japan, Morocco, Monaco, Norway, Singapore, Russia, Ukraine, Vietnam and Turkey filed on November 30, 2004;
- Trademark registration for "ARKEMA" numbered 004181731 in the European Union filed on December 8, 2004;
- Trademark registration for "ARKEMA" numbered 3082057 in the United States of America filed on December 16, 2004.

The Complainant also owns several domain names containing "ARKEMA", such as <arkema.com>, <arkema.info>, <arkema.eu>, <arkema.fr>, <arkema.us> among others.

FACTUAL BACKGROUND

The Complainant, founded in 2006, is a world leader in materials science offering a wide range of products for various domains such as Paints, Adhesives, Coats, Glue, Fiber, Resins, Rought materials and Finished materials for both general industry and consumer goods.

The Complainant operates in 55 countries around the world for a global amount of 151 production plants with more than 21.100 employees and approximately 9.5 billion EUR sales.

The Complainant owns “ARKEMA” numbered IR 847865 in Armenia, Austria, Australia, Azerbaijan, Bosnia and Herzegovina, Bulgaria, Benelux, Belarus, Switzerland, China, Cuba, Cyprus, Czech Republic, Germany, Denmark, Algeria, Estonia, Egypt, Spain, Finland, United Kingdom, Georgia, Greece, Croatia, Hungary, Ireland, Iran, Italy, Japan, Morocco, Monaco, Norway, Singapore, Russia, Ukraine, Vietnam and Turkey; “ARKEMA” numbered 004181731 in the European Union; “ARKEMA” numbered 3082057 in the United States of America.

PARTIES CONTENTIONS

COMPLAINANT:

THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant states that the disputed domain name <arkemagroup-eu.com> is confusingly similar to its “ARKEMA” trademarks covering many jurisdictions, as the Complainant’s trademark “ARKEMA” trademark is reproduced identically within the disputed domain name.

The Complainant submits that the addition of “Group” and “EU” terms in the disputed domain name would not prevent a finding of confusing similarity as they are not distinctive terms. The word “GROUP” is a common term used by entities to designate an international group of companies, whereas the word “EU” is the abbreviation for European Union and so qualifies a territory of interest, it also makes a direct reference to Complainant ARKEMA France, which is a company that originates from the European Union and operates in such territory through its numerous subsidiaries.

Moreover, the Complainant requests the disputed domain name suffix to be disregarded under the first element confusing similarity test (see VAT Holding AG v. VAT.com, WIPO Case No. D2000 0607; Shangri La International Hotel Management Limited v. NetIncome Ventures Inc., WIPO Case No. D2006 1315).

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

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name <arkemagroup-eu.com> since the Complainant has not licensed the Respondent to use its trademarks or domain names, nor has it allowed the Respondent to reserve or use a domain name incorporating the Complainant's rights.

The Complainant submits that the Respondent uses the disputed domain name for sending fake e-mails with the fraudulent e-mail address <sales@arkemagroup-eu.com> by impersonating the Complainant, and its subsidiaries.

In the past, the Respondent filed and used a domain name <arkema-bv.com>, sent fraudulent e-mails with <sales@arkema-bv.com> e-mail address, impersonated the Complainant and its Dutch subsidiary Arkema B.V Netherlands. The Respondent created the disputed domain name on December 5, 2024, the day the Complainant filed the UDRP action to the Czech Arbitration Court against the domain name <arkema-bv.com>

The Complainant states that the Respondent is unlawfully using the disputed domain name to impersonate the Complainant by sending fraudulent e-mails. This deceptive conduct aims at exploiting the Complainant’s reputation and illegitimately trade on its fame for potentially extorting money while misleading the public/recipient into believing that it is the Complainant's subsidiary in the Netherlands (located in the European Union (EU) as in arkemagroup-eu.com) and even the Complainant’s employee. In this regard, the Complainant explains that the Respondent cannot possibly have acquired a right or have a legitimate interest in the disputed domain name.

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

The Complainant states that the “ARKEMA” phrase is not a descriptive term, a commonly used expression or a word that would be instantly understood in the field of industry. Therefore, the phrase “ARKEMA” has a highly distinctive character (See Arkema France v. Zheng Chu He, WIPO Case No. D2016-2227; Arkema France v. Swapnil S Mashalkar, WIPO Case D2021-1479; ARKEMA FRANCE v. Kasz-Han, Richard Hajdu, WIPO Case No. D2021-0149). The Respondent, therefore, could not have ignored the existence of the Complainant’s trademarks, company names and domain names at the time of the registration of the disputed domain name.

The Complainant asserts that the reservation of a disputed domain name identical or highly similar to a trademark in which the Complainant has rights while the Respondent has no right to the disputed domain name or legitimate interests in this respect and without authorization, demonstrates in itself that the Respondent registered the disputed domain name in bad faith. Moreover, the Complainant explains that thanks to the well-established status of the Complainant, the Respondent knew that the disputed domain name would be confusingly similar to the Complainant’s prior rights and thus registered the disputed domain name.

In addition, the Complainant explains that the disputed domain name has been used to create messaging servers with various IP addresses and in addition to the creation of such messaging servers, an email address based on the disputed domain name has been

created namely and used to address fraudulent emails to third parties which proves the Respondent's bad faith.

The Complainant submits that the creation of the disputed domain name as well as the e-mail address <sales@arkemagroup-eu.com> is in a bad faith manner and is targeting random recipients by addressing fraudulent e-mails to probably obtain sensitive details from them or to extort money from them. Thus, it can therefore deeply impact the image of the Complainant if the victims are confused regarding the source of these emails. It is also particularly prejudicing for the users of the Internet as they can easily be deceived when receiving the emails through a domain name reproducing the well-known trademark "ARKEMA". Given the distinctiveness and renown of „ARKEMA“, the random recipient will easily consider that the fraudulent e-mails originate from the Complainant and as a consequence, deliver the required information.

The Complainant explains that the Respondent reserved and used the disputed domain name for phishing/fraud and impersonation purposes.

Based on these grounds, the Complainant concludes 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).

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:

- the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- 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 Complainant 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 Complainant is the owner of the registered “ARKEMA” trademarks.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s “ARKEMA” trademarks as it incorporates the Complainant’s “ARKEMA” trademark in its entirety (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).

The term “GROUP” pertains to a business that contains several different companies, and the term “EU” is the abbreviation of the European Union. Since the Complainant is comprised of group companies and is based in the European Union, these words do not eliminate the similarity and may even enhance it, given its connection to the Complainant’s company. The disputed domain name covers identically the Complainant’s trademark “ARKEMA,” leading the Panel to believe that Internet users are likely to mistakenly think that the disputed domain name is officially affiliated with the Complainant. Additionally, the addition of the terms “GROUP” and “EU” does not sufficiently mitigate the risk of confusion.

Lastly, the addition of the disputed domain name’s suffix in <arkemagroup-eu.com> does not differentiate the disputed domain name from the trademark (see VAT Holding AG v. VAT.com, WIPO Case No. D2000 0607; Shangri La International Hotel Management Limited v. NetIncome Ventures Inc., WIPO Case No. D2006 1315).

Lastly, the addition of the domain name suffix in < arkemagroup-eu.com> does not differentiate the disputed domain name from the trademark (see VAT Holding AG v. VAT.com, WIPO Case No. D2000 0607; Shangri La International Hotel Management Limited v. NetIncome Ventures Inc., WIPO Case No. D2006 1315).

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 Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy are met.

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 disputed 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 Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name <arkemagroup-eu.com>. The Panel is satisfied that the Complainant is the owner of distinctive “ARKEMA” trademarks, while the Respondent registered the disputed domain name recently without authorization.

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

Hence, as the Complainant has 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 name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

The Panel is of the opinion that the Complainant's "ARKEMA" trademarks have a distinctive character (see Arkema France v. Zheng Chu He, WIPO Case No. D2016-2227; Arkema France v. Swapnil S Mashalkar, WIPO Case D2021-1479; ARKEMA FRANCE v. Kasz-Han, Richard Hajdu, WIPO Case No. D2021-0149).

In addition, the Panel finds that due to the earlier rights of the Complainant in "ARKEMA" trademarks in different jurisdictions, the Respondent was or should have been aware of the Complainant and its trademarks at the time of registration of the disputed domain name. Thus, the choice of registration of the disputed domain name cannot be considered to be out of coincidence.

The Panel finds that the Respondent's use of the disputed domain name to send fraudulent e-mails, and impersonating the Complainant's employee is an example of bad faith use. As explained in Article 3.4 of WIPO's Jurisprudential Overview 3.0, "use of a domain name for purposes other than hosting a website may constitute bad faith, including sending emails, phishing, identity theft, or malware distribution." (see Arkema France v. Renji Kuruvilla, CAC UDRP Case No. CAC-UDRP-107125).

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 Complainant has 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. **arkemagroup-eu.com**: Transferred

PANELLISTS

Name	Mrs Selma Ünlü (Presiding Panelist)
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DATE OF PANEL DECISION 2025-01-21

Publish the Decision
