

## **ADMINISTRATIVE PANEL DECISION**

Bureau Veritas v. Jones Saintd

Case No. D2023-5306

### **1. The Parties**

The Complainant is Bureau Veritas, France, represented by Dennemeyer & Associates S.A.S., France.

The Respondent is Jones Saintd, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <bureauveritaslab.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 21, 2023. On December 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 21, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 21, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 22, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2024. The Respondent sent an email communication to the Center on December 22, 2023. The Respondent did not submit any formal response. Accordingly, the Center notified the commencement of panel appointment process on January 24, 2024.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on January 31, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant, established in 1828, is a world leader in testing, inspection and certification (TICS) services and has several subsidiaries. The Group employs over 82,000 people in more than 1,600 offices and laboratories worldwide. Bureau Veritas helps its clients improve their performance by offering services and innovative solutions to ensure that their assets, products, infrastructures and processes meet standards and regulations in respect of quality, health and safety, environmental protection and social responsibility.

The Complainant has a large international portfolio of trademark registrations for BUREAU VERITAS, including the following marks: European Union Trade Mark registration BUREAU VERITAS number 004518544 registered on June 1, 2006; European Union Trade Mark registration BUREAU VERITAS 1828 005927711 registered on February 6, 2008; and International trademark registration BUREAU VERITAS number 1289458 filed on December 23, 2015 in class 42 designating the following jurisdictions: India, United States, Japan, Republic of Korea, Singapore and China. The Complainant also has a strong online presence and owns a domain name portfolio including the following domain names <bureauveritas.com> and <group.bureauveritas.com>.

The disputed domain name was registered on November 15, 2023, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name redirects to the Complainant's website <group.bureauveritas.com>, without its authorization.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its trademarks for BUREAU VERITAS since it incorporates such marks in their entirety with the mere addition of the descriptive word "lab". The Complainant also contends that the fact that the Respondent has hidden its identity shows that he registered the disputed domain name in bad faith and with full knowledge of the trademarks, in disregard of the Complainant's rights in the BUREAU VERITAS trademarks, with malicious and unfair intent and to prejudice the Complainant. As to the bad faith of the Respondent, the Complainant argues that the Respondent is making unlawful and unfair use of the disputed domain name with the intention of diverting customers by creating confusion about the origin of the services and thus tarnishing the Complainant's trademarks and damaging the Complainant's image and reputation.

The Complainant requests the transfer of the disputed domain name.

##### **B. Respondent**

The Respondent did not formally reply to the Complainant's contentions and the Respondent's only communication in this case is limited to an email communication sent to the Center on December 22, 2023, in which the Respondent simply states, without adding any substantive argument or evidence, that the Respondent chooses to amend the Complaint.

#### **6. Discussion and Findings**

##### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between

the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "lab", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Upon review of the evidence and arguments in this case, the Panel accepts that the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services, nor any credible preparations for that purpose. The Panel considers that the only use made of the disputed domain name by the Respondent is to redirect it to the Complainant website <group.bureauveritas.com>, without its authorization. The Panel considers this an attempt to impersonate the Complainant. Panels have held that the use of a domain name for illegal activity, here, impersonation or passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

## **C. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered a domain name which is confusingly similar to the Complainant's well-known, intensely used and distinctive trademarks for BUREAU VERITAS, combined with the term "lab" which refers to one of the Complainant's main activities, namely the provision of laboratory services. The Panel also refers to prior decisions under the Policy which have

recognized the well-known nature of these trademarks, see for instance *Bureau Veritas v. Registration Private, Domains By Proxy, LLC / Domain Privacy, Above.com Domain Privacy*, WIPO Case No. [D2022-0079](#). The Panel deduces from this fact that by registering the disputed domain name, the Respondent deliberately and consciously targeted the Complainant's prior well-known trademarks for BUREAU VERITAS. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states "[p]anels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Furthermore, the Panel also notes that the Complainant's trademarks were registered several years before the registration date of the disputed domain name. The Panel deduces from these elements that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks at the time of registering the disputed domain name. In the Panel's view, these elements indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Panel accepts that the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services, nor any credible preparations for that purpose. The Panel considers that the only use made of the disputed domain name by the Respondent is to redirect it to the Complainant website <group.bureauveritas.com>, without its authorization. The Panel considers this an attempt to impersonate the Complainant.

Panels have held that the use of a domain name for illegal activity, here, impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <bureauveritaslab.com> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: February 12, 2024