

ADMINISTRATIVE PANEL DECISION

Swisscom Directories AG v. Privacy service provided by Withheld for Privacy ehf / Hicham Benlahssen
Case No. D2022-0352

1. The Parties

Complainant is Swisscom Directories AG, Switzerland, represented by FMP Fuhrer Marbach & Partners, Switzerland.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Hicham Benlahssen, Morocco.

2. The Domain Name and Registrar

The disputed domain name <localsearch.sarl> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2022. On February 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on February 2, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on February 3, 2022.

The Center verified that the Complaint together with the amendment to the 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 Respondent of the Complaint, and the proceedings commenced on February 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 17, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 23, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on April 26, 2022. 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

Per Complaint, Complainant is a 100per cent subsidiary of Swisscom AG, one of the largest telecommunications and IT companies in Switzerland. The Swiss government owns 51 per cent of Swisscom AG. Complainant is historically the successor of the state-owned telecommunication operation. Complainant operates the “www.local.ch” and the “www.search.ch” platforms and maintains a large number of address and telephone data for Switzerland and Liechtenstein. Complainant creates, maintains and markets directories containing contact information for individuals, businesses and service providers under the umbrella brand LOCALSEARCH. The platform “www.local.ch” is Switzerland’s most popular resource for finding phone numbers and detailed information on companies, while “www.search.ch” offers information and tools to help planning and organizing work and leisure activities. In 2015 “www.local.ch” and “www.search.ch” were combined under the umbrella brand LOCALSEARCH.

Complainant is the owner of the Swiss trademark registration no. 686840, LOCALSEARCH (figurative), filed on January 5, 2016, and published on April 20, 2016, for services in international classes 35, 38, 41, 42, 43, and 45.

Complainant is also the holder of the domain name <localsearch.ch>, registered on November 10, 2005.

The Domain Name was registered on March 1, 2016.

Respondent used the Domain Name in forms sent for the correction of allegedly incorrect directory entries and asked the recipient to reply to an email address incorporating the Domain Name. Respondent namely sent out forms with the request to update official company data provided by Complainant and to return the form via email to “[...]@localsearch.sarl”. The form appeared to be an official form of Complainant, using the data from the official directory operated by Complainant, its website address including the Domain Name and a logo very similar to that of Complainant. The form gives the impression that it originates from Complainant under its LOCALSEARCH brand. Recipients usually only realized that the form was not issued by Complainant after they had received suspicious and high invoices.

At the time of filing of the Complaint, the Domain Name also led to a website classified as “Malicious Website” by various Internet security programs and its display was prevented. Prior to that, per Complainant, it lead to a site that appeared to belong to a registry service similar to that of Complainant. Currently it leads to an inactive website.

5. Parties’ Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Domain Name incorporates Complainant's trademark LOCALSEARCH in its entirety.

The generic Top-Level Domain ("gTLD") ".sarl" may be disregarded, as gTLDs typically do not form part of the comparison as they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Name is identical to the LOCALSEARCH mark of Complainant.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, Respondent's use of, or 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) Respondent (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) Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complaint, Respondent was not authorized to register the Domain Name and Respondent has not been commonly known by the Domain Name.

Prior to or after the Notification of Complaint, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name was used in emails with invitations to correct supposedly inaccurate business directory details, purportedly sent by Complainant, in the context of a fraud scheme impersonating Complainant, followed by high value invoices for payment by the recipients of the initial emails. Use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition

(“[WIPO Overview 3.0](#)”), section 2.13.1). Furthermore, the Domain Name resolved, per Complainant, to a webpage providing services similar to those of Complainant and subsequently to a webpage with malicious content. Currently, it resolves to an inactive page.

In addition, the nature of the Domain Name, comprising Complainant’s trademark in its entirety, carries a high risk of implied affiliation ([WIPO Overview 3.0](#), section 2.5.1).

Lastly, the Domain Name was initially registered with a privacy shield service.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

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

(iii) Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other on line location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. Because the LOCALSEARCH mark was applied for prior to the Domain Name registration, and the Complainant’s identical domain name <localsearch.ch> was also registered prior to the Domain Name registration, the Panel finds it more likely than not that Respondent had Complainant’s mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

Respondent’s knowledge of Complainant is also clearly evident from Respondent’s attempt to impersonate Complainant, through the emails, asking recipients to correct their directory business data and to pay for invoices.

As regards bad faith use, Complainant demonstrated that the Domain Name was employed in fraudulent emails.

The Panel considers the following factors:

(i) the use of the Domain Name shortly after the filing of the LOCALSEARCH trademark of Complainant, in an email fraud scheme which involved impersonating Complainant and sending emails purportedly sent by

Complainant, with invitations to correct and update business directory data, followed by high value invoices;

(ii) the failure of Respondent to submit any response; and

(iii) the fact that the Domain Name initially led to websites which per Complainant had content for services similar to those of Complainant and then to a website with malicious content.

Lastly, the Domain Name was registered with a privacy shield service to hide the registrant's identity. Respondent's concealment of the Domain Name holder's identity through use of a privacy shield constitutes further indication of bad faith in the circumstances of this case (*Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#)).

The Domain Name currently leads to an inactive website. The non-use of a domain name does not prevent a finding of bad faith (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the Domain Name in bad faith.

Complainant has established Policy, paragraph 4(a)(iii).

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 Domain Name, <localsearch.sarl>, be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: May 10, 2022