

ADMINISTRATIVE PANEL DECISION

Sopra Steria Group v. MOUAD MARHOUM

Case No. D2022-1573

1. The Parties

The Complainant is Sopra Steria Group, France, represented by Herbert Smith Freehills Paris LLP, France.

The Respondent is MOUAD MARHOUM, France.

2. The Domain Name and Registrar

The disputed domain name <soprasteria.click> (the “Domain Name”) is registered with Registrar.eu (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2022. On May 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 2, 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 the Complainant on May 6, 2022 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 May 13, 2022.

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 May 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 8, 2022.

The Center appointed Vincent Denoyelle as the sole panelist in this matter on June 21, 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

The Complainant is a French headquartered group of companies specialized in consulting, information technology and software.

The Complainant is the owner of a large trade mark portfolio for SOPRA STERIA. The Complainant's SOPRA STERIA trade marks include the following trade mark which predates the registration of the Domain Name:

- French Trade Mark SOPRA STERIA, registration No. 4125228, filed and registered on October 13, 2014.

The Domain Name was registered on December 13, 2021 and the Domain Name does not resolve to any website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is identical to the Complainant's SOPRA STERIA trade marks as at the second level the Domain Name reproduces the Complainant's entire SOPRA STERIA trade mark and the generic Top-Level Domain ("gTLD") ".click" should be disregarded for the purposes of assessing confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Complainant declares that the Respondent is not known to the Complainant and that to the best of the Complainant's knowledge, no third party entity is known in the course of business under the Domain Name or is a registered holder of any trade mark in the term "sopra steria". The Complainant contends that it has not granted any license to the Respondent to use its SOPRA STERIA trade mark and that it has not authorized the Respondent to register or use the Domain Name. In addition, the Complainant points to the fact that the Respondent cannot justify of any use, or preparation to use the Domain Name in connection with a *bona fide* offering of goods or services as the Domain Name resolves to an inactive website.

The Complainant asserts that the Domain Name was registered and is being used in bad faith. The Complainant asserts that given the fact that its non-generic and non-descriptive SOPRA STERIA trade mark is reproduced identically in the Domain Name, the Respondent must have had knowledge of the Complainant and its trade mark when registering the Domain Name. The Complainant adds that the choice of gTLD further indicates an intention on the part of the Respondent to target the Complainant. As for use of the Domain Name in bad faith, the Complainant argues that the passive use of the Domain Name constitutes use in bad faith under the doctrine of passive holding.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

In order to prevail the Complainant must substantiate that the three elements of paragraph 4(a) of the Policy have been met, namely:

(i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

(ii) the 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

In light of the evidence provided by the Complainant, the Panel is satisfied that the Complainant has substantiated that it holds valid trade mark rights in SOPRA STERIA, which is reproduced in its entirety in the Domain Name.

The second point that has to be considered is whether the Domain Name is identical or confusingly similar to the trade mark SOPRA STERIA in which the Complainant has rights.

At the second level, the Domain Name only consists of the trade mark SOPRA STERIA. Then there is the addition of the gTLD “.click”. As is generally accepted, the addition of a gTLD such as “.click” is merely a technical registration requirement and as such is typically disregarded under the first element confusing similarity test.

Thus, the Panel finds that the Domain Name is identical to the trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out relevant circumstances that could demonstrate that a respondent has rights or legitimate interests in a domain name, namely:

Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [the respondent] of the dispute, [the 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) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trade mark or service mark rights; or

(iii) [the 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 trade mark or service mark at issue.

Numerous previous panels have found under the UDRP that once the complainant makes a *prima facie* showing that the respondent does not have rights or legitimate interests in the domain name, the burden of proof shifts to the respondent to rebut the showing by providing evidence of its rights or interests in the domain name.

Having reviewed the Complainant's assertions and evidence, the Panel is satisfied that the Complainant has made a *prima facie* showing that the Respondent does not have rights or legitimate interests in the Domain Name.

There is no indication that the Respondent has any rights in respect of the trade mark SOPRA STERIA and the Complainant declared that the Respondent had not been granted any authorization to use its SOPRA STERIA trade mark in the Domain Name.

The absence of use of the Domain Name cannot be considered *bona fide*, legitimate or fair given the reputation of the Complainant's SOPRA STERIA trade mark.

Furthermore, UDRP panels have found that domain names identical to a complainant's trade mark carry a high risk of implied affiliation (see section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Thus, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a number of relevant non-exhaustive circumstances, which can be deemed to constitute evidence of registration and use of a domain name in bad faith, namely:

(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] 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 trade mark or service mark or to a competitor of that 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 trade mark 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 [the respondent's] 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 Domain Name reproduces the exact SOPRA STERIA trade mark of the Complainant and this cannot be a coincidence.

This is even more likely given (i) the renown of the SOPRA STERIA trade mark, particularly in the Respondent's country of residence where the Complainant is headquartered, (ii) the fact that the trade mark of the Complainant – which is not descriptive or generic – is reproduced identically in the Domain Name, (iii) the fact that the Domain Name was registered relatively recently and many years after the registration of several SOPRA STERIA trade marks and (iv) the targeted choice of gTLD under which the Domain Name is registered.

Thus, the Panel finds that the Domain Name was registered in bad faith.

As for use of the Domain Name in bad faith, given the circumstances described in the Complaint and the documentary evidence provided by the Complainant, the Panel is satisfied that the Domain Name is used in bad faith.

The Domain Name appears to be passively held. Passive holding itself would not cure the Respondent's bad faith given the overall circumstances here, specifically the renown of the Complainant's SOPRA STERIA trade mark in the country of residence of the Respondent.

Thus, the Panel finds that the Domain Name is being used in bad faith.

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 <soprasteria.click> be transferred to the Complainant.

/Vincent Denoyelle/

Vincent Denoyelle

Sole Panelist

Date: July 5, 2022